Panel Decision for dispute CAC-ADREU-003285

Case number	**CAC-ADREU-003285**
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Domain names	**giebel.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**Giebel Rechtsbesorgungs-GmbH, Achim Wullkopf**

Respondent

Organization / Name	**EURid**

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceedings involving the disputed domain name.

FACTUAL BACKGROUND

On 7/2/2006, the Complainant unsuccessfully applied for the domain name GIEBEL in Sunrise I period. The Application expired.

On 25/3/2006, the Complainant applied again for the same domain name GIEBEL in Sunrise II period. The Complainant based the second Application on a Prior Right arising of its company name “Giebel Rechtsbesorgungs-GmbH.“ This second Application was rejected by the Respondent. The rejection was later reasoned by insufficient demonstration of Prior Rights.

The Complainant seeks annulment of the decision rejecting its second Application and attribution of the domain name GIEBEL to the Complainant. In eventum, the Complainant seeks transfer (attribution) of the domain name GIEBEL without annulment of the Respondent’s decision.

A. COMPLAINANT

The Complainant is German company Giebel Rechtsbesorgungs-GmbH.

The Complainant contends that the decision of the Registry to reject its second Application for the domain name GIEBEL in Sunrise II period violated Regulation (EC) No. 874/2004 (the Regulation).

The Complainant asserts that it has fulfilled all conditions laid down in Article 10 and Article 14 of the Regulation, namely that it was at the moment of filing the Application the holder of prior right to use the name “Giebel” and that it demonstrated this prior right in the Application.

The Complainant argues the existence of the prior right to use the name “Giebel” by the fact that it forms distinctive part of its company name (Firma) “Giebel Rechtsbesorgungs-GmbH” and it is specifically protected according to the German law. The Complainant supports this argument by multiple citations of German black-letter law, case-law and doctrine.

In particular, the Complainant argues that the name “Giebel” forms the distinctive part of the company name Giebel Rechtsbesorgungs-GmbH, as the part “Rechtsbesorgungs” indicates the type of business which the Complainant engages in and part “GmbH” indicates the form of establishment.

The Complainant names and describes two ways of per se protection of the name “Giebel” as the Prior Right according to the German

law, i.e. protection based on German Trademark Act and protection based on German Civil Code. The Complainant argues that in both cases, it is not just the whole registered name, but also its distinctive component that is protected by the German law.

Consequently, the Complainant argues that the name “Giebel” is complete name that receives protection according to the national law in terms of article 10 of the Regulation. The Complainant expresses the opinion that in this case, Section 19(1) in finem of the Sunrise Rules does not exclude it from possibility of registering the domain name GIEBEL as it has to be interpreted with regards to teleology of the superior Regulation (EC) No. 874/2004, namely to its Recital No. 12. The Complainant also points to the procedure when the name PRICEWATERHOUSE was validated and registered to the Validation Agent as well as to the Panel decision No. 01622 where the Panel protected the right to a distinctive part of a company name.

The Complainant contends that it demonstrated sufficiently the existence of prior rights to the name “Giebel” in the second Application. As the Complainant stands on the opinion that the protection of a component of a company name derives directly from the protection of the company name itself, it argues that the evidence submitted with the second Application, namely the copy of the report from the Company register, was sufficient to support the Application in terms of Section 19 of the sunrise Rules and Article 14 of the Regulation.

For the case the Panel would still find the disputed Application as documentary insufficient, the Complainant raises the claim to transfer the domain name GIEBEL on the grounds of material existence of Prior Rights even without annulment of the Respondent’s decision. To support this claim, the Complainant cites the Panel decision No. 1325 (KOHLPHARMA).

B. RESPONDENT

The Respondent is euRID.

The Respondent contends that the Complainant failed to demonstrate the existence of Prior Rights and that the Respondent’s decision to reject the disputed Application was correct.

The Respondent argues that the company name “Giebel Rechtsbesorgungs-GmbH” relied upon by the Complainant as a prior right could only serve as a prior right for the domain name “Giebel Rechtsbesorgungs”, which is the complete name for which the prior right exists, except for the company type. With regards to the Complainant's contention that “Giebel” is the most important or the most distinctive part of its company name, the Respondent notes that whether one part is more distinctive than the other parts is not relevant here, since the Regulation clearly provides that all alphanumerical characters must be included. To support this argument, the Respondent cites Panel decisions No. 470 (O2), ADR 2061 (MODLINE), 1053 (SANTOS), 1438 (ELLISON), 713 (HUETTINGER), 2224 (POWERON), 1427 (BONOLLO), 02499 (PSYTECH), 02494 (BPSC), 2297 (FENRISULVEN), 02047 (UNI-C), ADR 02093 (MAZUR) and ADR 2471 (TAIYO-YUDEN).

In the view of the Respondent, the Complainant bears the burden of proof to substantiate that it is the holder or the licensee of a Prior Right. To support this argument, the Respondent cites Panel decisions No. 27 (BPW), 219 (ISL), 294 (COLT), 551 (VIVENDI), 984 (ISABELLA), 843 (STARFISH), 1931 (DIEHL, DIEHLCONTROLS) and 1886 (GBG).

Regarding the Complainant’s eventual claim to transfer the domain name GIEBEL without annulment of the Respondent’s decision, the Respondent expresses the opinion that the Panel could not decide that the Respondent was correct in rejecting the application and order the transfer of the domain name to the Complainant at the same time and cites Panel decision No. 2756 (TECNO-CENTER).

DISCUSSION AND FINDINGS

As the evidence presented by Parties is not disputable, the Panel can base its decision on following facts:

- The disputed Application for domain name GIEBEL was filed on 25/3/2006. The application was submitted by GRG Giebel Rechtsbesorgungs- GmbH. Later, the Complainant submitted Documentary Evidence containing following documents: copy of concession/documentary approval (Erlaubnisurkunde) issued in favour of Mr. Dierk Giebel, copies of documents from the Company Register in Bremen, file no. B HRB 23017 HB for the company Giebel Rechtsbesorgungs- GmbH and copy of Query Result from WHOIS database on domain name GIEBEL.BIZ
- The Application was rejected by the Respondent due to insufficient demonstration of Prior Rights in terms of Article 10 and Article 14 of the Regulation.

As can be seen from both excellent submissions of the Parties, the dispute arose between them due to their different legal opinion on the question whether requirements laid down in Article 10 and Article 14 of the Regulation and subsequently in Sunrise Rules were fulfilled by the Complainant in his second Application for the domain name GIEBEL. Consequently to remedies sued by the Complainant

and to presented arguments, the Panel has to decide whether there existed Prior Rights of the Complainant at the moment of filing the Application (Article 10 of the Regulation), whether these rights were sufficiently demonstrated to the Respondent (Article 14 of the Regulation) and/or whether there are grounds to transfer (attribute) the domain name to the Complainant even without annulment of the Respondent's decision.

The Panel agrees with arguments of the Complainant regarding the possibility of protection of distinctive parts of company names by the German law. Such protection, however, is neither purely absolute, nor formally implied by the law, as it is always necessary to factually prove that the disputable indication is relatively distinctive.

The protection of distinctive part of a company name is not absolute and exclusive, as it is possible for more corporate units to use at the same time the same distinctive part together with different indicator (there are, for instance, companies legally using the same distinctive part of the company name as Complainant, i.e. "Giebel," named like "Emil Giebel Spedition-Spezialtransporte GmbH & Co.KG, Giebel Kaltwalzwerk GmbH, Giebel GmbH & Co. KG Industrie- und Verkehrswerbemittel" and others). As contended by the Complainant, no German national court would dissent from protecting the name "Giebel" in favour of the Complainant. On the other hand, it is unlikely that such protection would be granted against other companies using the same distinctive name with different descriptive element like those named above. Moreover, it is to be noted that there might be different standards of proof in case such priority right is claimed in relative dispute on the national level and as an absolute right on the European level like in case of the disputed Application.

Also, as noted by the Complainant, the question of protection of a distinctive part of a company name might in specific cases, namely in case of use of personal names, depend even on curiosity of the respective names. Besides the criteria of frequency of use, the distinctiveness of the name, its legal quality and its protection can be also resulting of the renown of its holder, forms of its use, etc. All these factors and many others might be then important in assessment whether some part of the company name is distinctive enough, whether it receives per se the legal protection and to what extent. Again, it is to be noted that not the protection itself but the standard of proof might differ on the national and European level as European institutions can not be required to be a priori aware of all particular and special elements of national languages, local traditions or cultural backgrounds.

The Complainant contends that it is well known German collection and legal services agency. It also contends that the name "Giebel" is not frequent in Germany and that it used it in regular course of business for remarkably long time and became broadly known by it. This should all result to the final conclusion that the name "Giebel" truly is the distinctive part of the company name and receives appropriate protection according to the German law.

If above factual contentions and conclusions would be backed by proper evidence, it might be, in the view of the Panel, even possible to adopt extensive teleological interpretation of Section 19 of the Sunrise Rules and to state that there existed Prior Rights even to a part of the registered company name as suggested by the Complainant. Unfortunately, such evidence has not been brought in front of the Panel. Even more importantly, such evidence was not presented to the Respondent at the time of filing the Application in Sunrise II period and consequently, the Respondent could not discover and validate the existence of Prior Rights under the German law.

Thus, the Panel has to conclude that Prior Rights in terms of Article 10 of the Directive were not properly demonstrated by the Complainant according to Article 14 of the Directive and the disputed decision of the Respondent to reject the Application was correct.

As the Complainant only asserted but did not prove existence and relevance of its Prior Rights in front of the Panel, the Panel sees no reason to consider exceptional attribution of the disputed domain name without regards to perfection of prior decision of the Respondent like in Panel decision No. 01325 (KOHLPHARMA). The simple fact that there are no other applicants for the domain name GIEBEL does not seem to the Panel as enough justification for considering such extraordinary measure.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is Denied.

PANELISTS

Name	**JUDr. Radim Polcak, Ph.D.**

DATE OF PANEL DECISION 2006-12-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed the Application for domain name GIEBEL based on company name "Giebel Rechtsbesorgungs-GmbH". The

Respondent rejected the Application due to lack of demonstration of Prior Rights.

The Complainant argued that the distinctive part of the company name, “Giebel,” is protected per se by the German law and should have been registered as domain name in Sunrise II period.

The Panel held that the Complainant did not bring in his Application sufficient evidence of the fact that the part of the company name “Giebel” is distinctive and is per se protected by the German law. Thus, the Respondent did not have factual grounds to validate existence of Prior Rights in terms of Article 10 of the Directive.

The Complaint was denied.