Panel Decision for dispute CAC-ADREU-003310

Case number	CAC-ADREU-003310
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Domain names	medium.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	Medium GmbH

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

There are no other legal proceedings of which the panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

On February 7, 2006, the Complainant filed a request for registration of the domain name <medium.eu> in the name of “Medium GmbH”.

On February 13, 2006, the Respondent received documentary evidence submitted by the Complainant.

The Respondent rejected the request for registration on the grounds that the Complainant did not demonstrate that it was the holder of the prior right to the name MEDIUM.

The Complainant filed a Complaint against the Respondent which was received by the Czech Arbitration Court (“CAC”) via e-mail on October 10, 2006 and in hardcopy on October 12, 2006. After the compliance review, CAC declared that the formal date of the commencement of the ADR proceeding was October 23, 2006.

The Respondent submitted a Response which was received by CAC on December 7, 2006.

On December 11, 2006 CAC appointed José Checa, Dominik Eickemeier and Johan Sjöbeck as panellists.

A. COMPLAINANT

The Complainant requests that the Registry’s decision to deny Complainant the domain name <medium.eu> shall be annulled and that the domain name shall be attributed to the Complainant.

The Complainant argues that it is eligible to the disputed domain name <medium.eu> during the phased period because it is the holder of prior rights according to Article 10(1) of Regulation No 874/2004. The Complainant argues that the prior right is in the company name “MEDIUM” although the complete company name registered in the Commercial Register is “MEDIUM VERTIEBSGESELLSCHAFT FÜR AUDIOVISUELLE KOMMUNIKATIONSMITTEL MBH”.

The Complainant was founded in 1974 and its business is the distribution of audio-visual communicative devices. The Complainant argues that, according to German law, the Complainant has a prior right not only to the company name “MEDIUM VERTIEBSGESELLSCHAFT FÜR AUDIOVISUELLE KOMMUNIKATIONSMITTEL MBH”, but also to the sole part “MEDIUM” without any additions. Section 5 of the German Trademark Act does not only protect the whole company name but also parts of it under the

condition that such parts do not lack distinctiveness. The part “VERTIEBSGESELLSCHAFT FÜR AUDIOVISUELLE KOMMUNIKATIONSMITTEL MBH” of the company name is merely descriptive and means “Distribution company for audio-visual communication devices” and the suffix “mbH” is the legal form for a company with limited liability. In addition, it is widely common that the consumer shortens a company name and tends to use only the first word of a company name which comprises several words. Due to this, and because the word “MEDIUM” is the only distinctive part of the full company name, the part “MEDIUM” is protected under Section 5 of the German Trademark Act. The public regards the part “MEDIUM” as a catchword. The Complainant acts in business only under the name “MEDIUM” and its customers have used the phrase “Medium GmbH” to identify the Complainant on several invoices.

The Complainant requests that EURid’s decision is annulled and that the domain name <medium.eu> is granted to the Complainant.

B. RESPONDENT

The Respondent contends as follows:

Article 10(1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 states that only holders of prior rights which are recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before the general registration of .eu domain names starts.

Article 10(2) of Commission Regulation (EC) No 874/2004 states that the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a prior right exists.

The burden of proof is with the Complainant to demonstrate that it is the holder or licensee of the claimed prior right. Pursuant to Article 14 of the Commission Regulation (EC) No 874/2004, all claims for prior rights must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists.

Section 21(2) of the Sunrise Rules clearly explains that the validation agent examines whether the Applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set of documentary evidence received by the processing agent. The Respondent refers to Case ADR 1886 (GBG) in which the panel stated that if an Applicant fails to submit all documents which show that it is the owner of a prior right the application must be rejected.

The Complainant applied for the domain name <medium.eu> on February 7, 2006. The documentary evidence was received by the processing agent on February 13, 2006.

The Complainant submitted documentary evidence substantiating that the Complainant’s company name is “MEDIUM VERTRIEBSGESELLSCHAFT FÜR AUDIOVISUELLE KOMMUNIKATIONSMITTEL MBH”. The validation agent concluded from its examination of the documentary evidence that the Complainant did not demonstrate that it was the holder of a prior right to the name MEDIUM and consequently, the Respondent rejected the application for the domain name <medium.eu>.

Pursuant to Article 10(2) of Commission Regulation (EC) No 874/2004 and Section 19 of the Sunrise Rules, the domain name based on a prior right must consist of all alphanumerical characters, except for the company type which in this case is “mbH”. Thus, the company name relied upon as a prior right could only serve as a prior right for “MEDIUM VERTRIEBSGESELLSCHAFT FÜR AUDIOVISUELLE KOMMUNIKATIONSMITTEL” which is the complete name for which the prior right exists, absent the company type.

The Respondent argues that whether one part of the Complainant’s company name is more distinctive than the other parts is not relevant, since the Regulation clearly states that all alphanumerical characters must be included. It is not possible for an applicant to obtain a registration of a domain name comprising part of the complete name for which the prior right exists. Furthermore, it is clear that the Regulation does not require the Respondent to investigate whether some (distinctive) parts of the company name showed on the documentary evidence are protected as such under local law.

Pursuant to Article 14 of Commission Regulation (EC) No 874/2004, the Respondent may only accept, as documentary evidence, documents that are received by the validation agent within 40 days from the submission of the application of the domain name. In this case, the 40 day period ended on March 19, 2006 and the Complainant has submitted new information with its Complaint on October 10, 2006, trying to show that it used the name MEDIUM as a business identifier. These documents may not serve as documentary evidence for the Complainant’s application, since they are submitted more than 5 months after the end of the 40 day period set forth by the Regulation. Only the evidence which the Respondent was able to examine at the time of validation of the application should be considered by the panel to assess the validity of the Respondent’s decision.

The panel should reject the Complaint.

DISCUSSION AND FINDINGS

Article 22 of the Commission Regulation (EC) No 874/2004 of 28 April 2004 states that in the case of a procedure against the Registry, the ADR panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with Regulation (EC) No 733/2002 of 22 April 2002 on the implementation of the .eu Top level Domain.

The Complainant's application for the domain name <medium.eu> was rejected by the Respondent with reference to article 10(2) of Regulation (EC) No 733/2002.

With its Complaint, the Complainant has submitted new additional evidence in order to prove that it has used only the name MEDIUM as a business identifier. However, this additional information was not submitted within the 40 day period as prescribed in Article 14 of Commission Regulation (EC) No 874/2004. Furthermore, Section 21(2) of the Sunrise Rules states that the validation agent shall examine whether an Applicant has a prior right to the name exclusively on the basis of a prima facie review of the first set if documentary evidence it has received.

Therefore, the panel may solely consider the evidence submitted within the 40 day period when deciding whether the Registry's decision to reject the Complainant's application for the domain name <medium.eu> was correct or not.

The evidence submitted within the 40 day period on February 13, 2006 indicates that the Complainant's registered firm is "MEDIUM VERTRIEBSGESELLSCHAFT FÜR AUDIOVISUELLE KOMMUNIKATIONSMITTEL MBH".

Section 19(4) of the Sunrise Rules states that "For trade names, company names and business identifiers, the company type (such as, but not limited to, "SA", "GmbH", "Ltd.", or "LLP") may be omitted from the complete name for which the Prior Right exists."

Thus, it is acceptable to remove the company type "MBH" from the complete company name upon which the domain name application was based. Without the company type, the company name consists of the words "MEDIUM VERTRIEBSGESELLSCHAFT FÜR AUDIOVISUELLE KOMMUNIKATIONSMITTEL".

Article 10(2) of Commission Regulation (EC) No 874/2004 states that "The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists".

Section 19(1) of the Sunrise Rules states that "registration of a Domain Name on the basis of a Prior Right consists in the registration of the complete name for which the Prior Right consists, as manifested by the Documentary Evidence. It is not possible for an Applicant to obtain registration of a Domain Name comprising part of the complete name for which the Prior Right exists."

From Article 14 of Commission Regulation (EC) No 874/2004 it is clear that the burden of proof regarding a prior right is with the Applicant. It states that every Applicant shall submit documentary evidence that shows that he or she is the holder of a prior right claimed on the name in question. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this. The Registry shall register the domain name, on the first come, first served basis, if it finds that the Applicant has demonstrated a prior right in accordance with the procedure set out in the second, third and fourth paragraphs.

That the burden of proof regarding a prior right is with the Applicant is also clear from Section 21(3) of the Sunrise Rules, which states that the validation agent is not obliged, but permitted in its sole discretion, to conduct its own investigations into the circumstances of the application, the prior right claimed and the documentary evidence produced.

The purpose of the Commission Regulation (EC) No 874/2004 is to grant domain names during the Sunrise period on first come first served basis provided that an Applicant can demonstrate a right which makes him entitled to the domain name application. According to paragraph 4 of Article 14 of the said Regulation, every Applicant shall submit documentary evidence that shows that he or she is the holder of the Prior Right claimed in question and if such documentary evidence has not been received within forty days from the domain name application, the application for the domain name shall be rejected.

During the 40 day period, the Complainant did demonstrate that it is the holder of a prior right to the name "MEDIUM VERTRIEBSGESELLSCHAFT FÜR AUDIOVISUELLE KOMMUNIKATIONSMITTEL" but did not demonstrate that it is the holder of a prior right to the name MEDIUM.

If there would be exceptions in favour of the Applicant, allowing additional submissions of evidence after the forty day period, it would affect the legitimate expectancy of the next Applicant in the queue for the domain name in question and conflict with the first come first served principle set out in Article 14 of the Commission Regulation (EC) No 874/2004. In order to ensure a fair and consistent policy of granting domain names, this principle must be applied even in cases where there are no further Applicants in the queue.

Having all of the above in mind, the panel finds that the Respondent's decision to reject the Complainant's application on the grounds that the submitted documentary evidence did not sufficiently prove the right claimed does not conflict with the European Regulations No 874/2004 and 733/2002.

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	**Dominik Eickemeier**

DATE OF PANEL DECISION 2006-12-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant's application for the domain name <medium.eu> was rejected by the Respondent with reference to article 10(2) of Regulation (EC) No 733/2002 which states that "The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists".

During the phased period, the Complainant submitted documentary evidence substantiating that the Complainant's company name is "MEDIUM VERTRIEBSGESELLSCHAFT FÜR AUDIOVISUELLE KOMMUNIKATIONSMITTEL MBH".

With its Complaint, the Complainant submitted additional evidence in order to prove that the term "MEDIUM" is used as business identifier by the Complainant. Only evidence submitted within the 40 day period should be considered by the panel to assess the validity of the Respondent's decision.

The panel found that the Complainant did not demonstrate that it was the holder of a prior right to the name MEDIUM and that the decision taken by the Respondent to reject the Complainants domain name application did not conflict with the Commission Regulation (EC) No 874/2004. Therefore, the Complaint was denied.