Panel Decision for dispute CAC-ADREU-003492

Case number	**CAC-ADREU-003492**
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Domain names	**mapco.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**Göbel & Voigt, Dipl.-Ing. Anet Göbel, Rechtsanwältin**

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 other legal proceedings which are pending or decided and which relate to the disputed domain name.

FACTUAL BACKGROUND

This decision arises from an appeal by the Complainant, MAPCO Autotechnik GmbH, against the decision by the Respondent, EURid, to decline to register the domain name <mapco.eu> (hereinafter: “the Disputed Domain Name”) to the Complainant under the eu Registration Policy and Terms and Conditions for Domain Name Applications made during the Phased Registration Period (hereinafter: "Sunrise rules") Sunrise period.

On 2 March February 2006, the Complainant applied for the Disputed Domain Name during the second so-called Sunrise period. The Complainant submitted documentary evidence consisting of (i) a copy of the national German trademark registration n° 103857 “MAPCO Mondial Automobile Parts Company”; and (ii) a full page picture of the logo “MAPCO”. These documents were received by EURid on 10 April 2006 within the deadline set for doing so.

On 14 September 2006, EURid informed via electronic communication the Complainant of the refusal of the Disputed Domain Name.

On 26 October 2006, the Complainant filed a complaint before the Czech Arbitration Court (hereinafter: “CAC”), requesting the annulment of the rejection decision and the registration of the Disputed Domain Name in his favour.

The acknowledgment receipt of complaint was duly forwarded on even date and EURid, on 2nd November 2006, communicated to the C AC all information concerning the application for the Disputed Domain Name.

On 15 December 2006, the Respondent filed a response to the Complaint.

On 19 December 2006, the CAC appointed the three-member panel consisting of Ms Marie-Emmanuelle HASS, Mr Gunther MEYER and Mr David-Irving TAYER (acting as President) in this case. The Panel finds that it was properly constituted and submitted the Statement of acceptance and Declaration of Impartiality in compliance with the ADR Rules and Supplemental ADR Rules.

A. COMPLAINANT

The Complainant argued, after confirming that the owner of the German trademark "MAPCO Mondial Automobile Parts Company" n° 1 030 857 is Mr Detlev Seeliger, that there exist a licence agreement of 27th January 2006 between the owner and the Complainant.

Moreover, the Complainant mentioned that it is a company registered under the company name "MAPCO GmbH" or "MAPCO Autotechnik

GmbH", in the commercial register of the Posdam Local Court since 1990 and that it started doing business successfully throughout Europe under the sole name "MAPCO" as early as in 1977. Since then the Complainant is using the trade name MAPCO.

Finally, the Complainant declared being the owner of the domain name <mapco.de>, and is also using this name in business.

In the light of these rights and information, the Complainant concluded that “the negative decision of the Respondent is in contradiction to Article 10, paragraphs 1 and 2 of EC Directive No. 874/2004”.

The Complainant went on arguing that, in the registered German trademark "MAPCO Mondial Automobile Parts Company" constituted by a picture element having the word part "MAPCO", and the word part "Mondial Automobile Parts Company" set below, the word part "MAPCO" characterizes the trademark`s overall impression. Therefore, the word part comprising four words, which is arranged below the word/picture element, is practically submerged and insisted on the distinctive character of the word MAPCO.

Again, the Complainant insisted on the prior right owned on the company name "MAPCO GmbH" or "MAPCO Autotechnik GmbH", respectively, and the Disputed Domain Name as a special business designation.

Finally, the Complainant stated that the Respondent infringes the principles of fair proceedings pursuant to Article 4, paragraph 1 of the European Parliament and the Council Regulation (EC) No. 733/2002 of 22 April 2002 on the implementation of the .eu Top Level Domain (hereinafter: “Regulation 733/2002”), which provides for transparent proceedings, since the Respondent did not inform the Complainant of the detailed reasons why the Disputed Domain Name had been rejected in the negative decision of 14th September 2006.

In the light of this, the Complainant concluded to the annulment of the decision and the Disputed Domain Name be registered in his name.

B. RESPONDENT

Respondent based its rejection of the application on the following legal grounds:

- Article 10.1. of Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (hereinafter: "Regulation 874/2004") provides that holders of prior rights recognised or established by national or Community law shall be eligible to apply to register domain names during a period of phased registration before general registration of .eu domain starts, and that prior rights shall be understood to include, inter alia, registered national and community trademarks.

- Article 10.2. of the Regulation 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 19.2. of the Sunrise rules further clarifies Article 10.2 of the Regulation 874/2004, by stating that: "A prior right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if (i) the sign exclusively contains a name, or (ii) the word element is predominant, and can be clearly separated or distinguished from the device element, provided that (a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for, in the same order as that in which they appear in the sign, and (b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear".

Pursuant to Article 14 of the Regulation 874/2004, it is up to the applicant to submit documentary evidence showing that he or she is the holder of the prior right claimed on the name in question. Based on this documentary evidence, the validation agent shall examine whether the applicant has prior rights on the name.

The Complainant applied for the Disputed Domain Name on 2 March 2006, claiming a prior right in the form of a trademark registered in Germany.

The documentary evidence was received on 10 April 2006, which was before the 11 April 2006 deadline.

The documentary evidence received by the validation agent consisted of: (i) a certificate of registration for the German semi-figurative trademark N° 1030857, consisting of the following alphanumerical characters: "MAPCO Mondial Automobile Parts Company " and registered to Mr Seeliger, Detlev; and (ii) a full page picture of the logo “MAPCO”.

The validation agent found that the documentary evidence submitted by the Complainant did not establish that it was the holder of a

prior right consisting of a trademark with as complete name "MAPCO".

Consequently, the application was rejected

In reply to the arguments of the Complainant, the Respondent indicated that:

- Documents submitted for the first time in the framework of the present proceedings may not be considered as documentary evidence to establish the claimed prior right

In the first part of its complaint, the Complainant tries to establish its rights on the name “MAPCO” by attaching the several documents to its complaint.

These documents may not serve as documentary evidence for the Complainant's application, since those documents are submitted almost 5 months after the end of 40 days period set forth by the Regulation 874/2004. Accepting these documents as documentary evidence would clearly violate the Regulation 874/2004.

Furthermore, Article 22.1) b of the Regulation 874/2004 states that a decision taken by the Respondent may only be annulled when it conflicts with the Regulation 874/2004.

Therefore, only the documentary 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 (see notably cases ADR 294 (COLT), 954 (GMP), 1549 (EPAGES), 1674 (EBAGS), 2124 (EXPOSIUM), etc.).

This verification is the only task for the Panel in these proceedings, which may not in any case serve as a “second chance” or an additional round providing applicants an option to remedy their imperfect original application that was rejected during the Sunrise period (see cases N°. 551 (VIVENDI) and N°. 810 (AHOLD)).

In other words, as decided in case N°. 1194 (INSURESUPERMARKET), "[t]he ADR procedure is not intended to correct domain name applicants’ mistakes".

The new documents attached to the present Complaint were not received by the validation agent during the 40 days period, which means that the Respondent could not use this information in taking its decision. Therefore, this new information may not be taken into consideration to evaluate whether the Respondent's decision conflicts with the Regulation 874/2004, which is the only purpose of the present ADR proceedings.

- The burden of proof was with the Complainant to demonstrate that it is the holder of the claimed prior right

The Respondent concluded that the Complainant did not demonstrate the existence of prior right in his name. The Respondent cited several ADR decisions from the CAC to sustain its argumentation and in particular case ADR 1886 (GBG), where the panel indicated that "According to the Procedure laid out in the Regulation the relevant question is thus not whether the Complainant is the holder of a prior right, but whether the Complainant demonstrated to the validation agent that it is the holder of a prior right. If an applicant fails to submit all documents which show that it is the owner of a prior right the application must be rejected".

In the present case, the documentary evidence received by the validation agent consisted of: (i) a certificate of registration for the German semi-figurative trademark N° 1030857 "MAPCO Mondial Automobile Parts Company ", registered to Mr Seeliger, Detlev; and (ii) a full page picture of the logo “MAPCO”.

The Complainant's name is "MAPCO Autotechnik GmbH ".

The documentary evidence demonstrates that the owner of the trademark is "Mr Seeliger, Detlev ".

Respondent rejected also the existence of licensee agreement of the registered owner of the trademark N° 1030857, this document not being filed in due course.

The Complainant failed to submit a license declaration form or even any document establishing with legal certainty that the Complainant is licensed by "Mr Seeliger, Detlev ", the person mentioned as the owner of the German trademark.

Therefore, the documentary evidence submitted by the Complainant did not clearly indicate the name of the Complainant as being the holder of the prior right claimed.

The Respondent concluded that the decision of rejection was correctly rendered, pursuant to Article 14 of the Regulation and section 20.1 of the Sunrise rules, because the Complainant failed to meet its burden of proof.

Finally, the Respondent developed a complete argumentation based on the regulations, Sunrise rules and the ADR decisions (in particular cases N° 470 (O2), N°1053 (SANTOS), N°1438 (ELLISON), N°713 (HUETTINGER), N°2224 (POWERON), N°02499 (PSYTECH), N°02494 (BPSC), N°2297 (FENRISULVEN), and N° 02047 (UNI-C)) to demonstrate that the Complainant could not rely on right on the sole term “MAPCO” where the trademark comprises also the terms “Mondial Automobile Part Company”.

The Respondent added that in order to avoid confusion, it must be noted that the full page picture of the logo “MAPCO” was not protected by the trademark N° 1030857, for which the graphic representation includes more characters than just the logo.

In the case at hand, the logo «MAPCO» clearly depicts the alphanumerical characters. Consequently, they should have been included in the domain name applied for. But the trademark also contains several other alphanumerical characters consisting of the slogan "Mondial Automobile Parts Company" and the locations and contact details of the Complainant.

Because the general impression of these words is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear, they all should be included in the domain name applied for (in the same order as that in which they appear in the sign), pursuant to Article 10.2 of the Regulation 874/2004 and Section 19 of the Sunrise rules.

Therefore, Respondent correctly rejected the Complainant's application.

The Respondent finally conclude that “unfortunately for the Complainant, the trademark submitted as documentary evidence did not establish a prior right on the domain name applied for” and requested the confirmation of the decision of rejection.

DISCUSSION AND FINDINGS

Article 22 of the Regulation 874/2004 provides that in case of a procedure against the Registry (i.e. Respondent), the ADR panel shall decide whether a decision taken by the Registry conflicts with this Regulation or with the Regulation 733/2002.

It results from the Case File that there is no discussion between Complainant and Respondent regarding the documentary evidence and their submission in due time.

These documents are (i) a certificate of registration for the German semi-figurative trademark N° 1030857 "MAPCO Mondial Automobile Parts Company ", registered to Mr Seeliger, Detlev including the graphic representation of the trademark N° 1030857 ; and a (ii) full page picture of the logo “MAPCO” dated “20060410”.

It must be noted that the full page picture of the logo “MAPCO ” dated “20060410” as such does not form part of the German trademark and can therefore not be considered as a prior right as mentioned in Article 10.1. of the Regulation 874/2004.

Moreover, it must also be noted that the licence agreement even if it is dated at a date prior to the filing, it was not filed and ought not to be taken into consideration

It must be concluded that the rightful owner of the trademark and the sole person being entitled to register a domain name including the term “MAPCO” would have been Mr Seeliger, Detlev according to the regulation set for the Sunrise periods.

Therefore, at this stage, the Panel finds that this sole condition is sufficient to confirm the rejection of the Disputed Domain Name.

The claims of Complainant all relate to the interpretation of Article 10.2. of the Regulation 874/2004 as to what has to be construed by the notion of “complete name”. Paragraph 10.2. of the Regulation 874/2004 deals with the registration on the basis of a prior right in the Sunrise period and stipulates:

“The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exist, as written in the documentation which proves that such a right exists”.

In the present case it has to be determined whether the Complainant complied with this exigency in other words whether part of a

German trade mark is liable to constitute a prior right and entitle the Complainant to obtain the registration of the Disputed Domain Name.

Article 10.1. of the Regulation 874/2004 provides that "(h)olders of prior rights recognized or established by national (…) law (…) shall be eligible to register domain names during a period of phased registration before general registration of .eu domain starts. 'Prior rights' shall be understood to include, inter alia, registered national (…) trademarks."

Article 10.2. of the Regulation 874/2004 is worded as follows: "(t)he 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 such a right exists."

These conditions are confirmed by the Sunrise rules. Moreover, Section 19.2 of the Sunrise rules states: "A prior right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos etc…) will only be accepted if:

(i) the sign exclusively contains a name, or
(ii) the word element is predominant and can be clearly separated or distinguished from the device element provided that

(a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the domain name applied for, in the same order as that they appear in the sign, and

(b) the general impression of the word is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear."

The prior right to the Disputed Domain Name, namely the German Trademark, consists of a composite sign including words and devices, and more specifically the stylized characters "MAPCO" printed on specific design and accompanied, below, by the stylized words "Mondial Automobile Parts Company" (MAPCO being the acronym of theses words).

The prior right to the Disputed Domain Name could therefore not be considered as a name included a composite sign that exclusively contains the Disputed Domain Name.

Alternatively, it has to be examined whether the characters "MAPCO" could be considered as the "word element" that is predominant and that can be clearly separated or distinguished from the device element. It appears from the Case File that Respondent does not contest Complainant's allegation that the characters "MAPCO" are to be considered as a "word element" that is predominant and that can be clearly separated from the device element.

However, provided the wording of Section 19.2. of the Sunrise rules, Complainant can not be followed in his argumentation that, in case the domain name applied for (in the present case: "MAPCO") consists of a word element that is predominant and that can be clearly separated from the device element, the application should and would (automatically) result in the registration of the domain name.

Indeed, Section 19.2. provides two other conditions which, both, have to be fulfilled in order to register a domain name under the Sunrise rules. One of these conditions is that all alphanumeric characters (including hyphens, if any) included in the sign are contained in the domain name applied for, in the same order as that they appear in the sign.

The Panel finds that all alphanumeric characters of the composite sign invoked by Complainant (i.e. the German Trademark), are not contained in the Disputed Domain Name. Indeed, the words "Mondial Automobile Pats Company" are part of the composite sign, namely the German Trademark, but do not appear in the Disputed Domain Name Complainant applied for. An identical finding was held notably in the O2 or PSYTECH cases.

Accordingly, the decision taken by Respondent to reject the application for the Disputed Domain Name does not conflict with the Regulation 874/2004.

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	**Marie Emmanuelle Haas**

DATE OF PANEL DECISION 2006-12-27

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant contends that the decision of the Respondent (i.e. the Registry) to reject the application for the domain name "MAPCO" is in conflict with the EC Regulations on .eu domain names.

The Complainant is owner of a national (i.e. German) trade mark consisting of a composite sign including words and devices, and more specifically the stylized characters "MAPCO" printed on specific design and accompanied, below, by the stylized words "Mondial Automobile Parts Company" (MAPCO being the acronym of theses words).

The Complainant sought the annulment of the Respondent's decision and the attribution of the domain name based in particular on further evidencing document not filed during the time frame allowed for filing such documents.

The Panel finds that the documentary evidence provided by the Complainant proved an existing Prior Right but which is not held by the Complainant – a licence agreement filed with the Complaint cannot be taken into consideration. The Panel also finds that, notwithstanding the fact that the characters "MAPCO" are considered by parties as the predominant element of the composite sign, the application does not respect the conditions set fourth is Section 19.2. of the Sunrise rules because not all alphanumeric characters of the composite sign, and more exactly the words "Mondial Automobile Parts Company " should have form part of the domain name "MAPCO" the Complainant applied for.

The Panel decided that the Respondent's decision to reject the "MAPCO" domain name application by the Complainant, does not conflict with the Regulation 874/2004. Therefore, the complaint is denied.