Panel Decision for dispute CAC-ADREU-003571

Case number	**CAC-ADREU-003571**
Time of filing	**2006-11-07 10:19:12**
Domain names	**mattis.eu, m-m.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Dr. Marcus Mattis**

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 pending in respect to the disputed domain names.

FACTUAL BACKGROUND

All capitalized terms not defined herein are used by reference to the various regulations and rules identified in this decision.

This complaint arises out of the interpretation and application of Commission Regulation (EC) No 874/2004 of 28 April 2004 (“Regulation”), European Parliament and Council Regulation (EC) No 733/2002 of April 22, 2002 (“EU Regulation”) and the .eu Domain Name Terms and Conditions and phased registration rules for domain name applications made during the phased registration period (“the Sunrise Rules” and the “Conditions”).

1. The Domain name application proceeding

Dr. Marcus Mattis, "the Complainant" applied for the domain name “MATTIS” on 7 February 2006 and for the domain name “M-M” on the same date.
For both domain names Documentary evidences were provided for the registration to the processing agent by Dr. Marcus Mattis.

Eurid, the Respondent, rejected the Complainant’s application for the domain name “MATTIS” and for the domain name “M-M”.

2. The ADR proceeding

On 20 October 2006, the Complainant submitted a Complaint to the ADR Center filed in the English language to ask for the annulment of the disputed decisions taken by the Registry.

On 7 November 2006, the ADR Center confirmed the receipt of the Complaint and requested verification information from EUrid.

On 13 November 2006, EUrid answered in a non-standard communication providing information requested and disclosing the Documentary Evidence related to the disputed domain names as requested by the Complainant.

On 14 November 2006, the ADR Center notified the conformity of the Complaint and notified to the Respondent that an ADR Proceeding

had been commenced against it pursuant to the Regulation and the EU Regulation.

On 21 December 2006, Respondent submitted a Response to the ADR Center filed in the English Language and on 28 December 2006, the ADR Center notified that the Response satisfied and the formal standards set by ADR rules.

On 30 December 2006, the ADR Center notified the appointment of the ADR Panel and the projected decision date.

On 3 January 2007, the case 3571 was transmitted by the ADR Center to the ADR Panel.

A. COMPLAINANT

The complaint is:

The decisions taken by the Registry conflicts with the European Union regulations.

B. RESPONDENT

The Respondent responded to the Complaint on December 21, 2006.

The Response is as follows.

1. GROUNDS ON WHICH THE RESPONDENT REJECTED THE APPLICATION BY DR. MARCUS MATTIS FOR THE DOMAIN NAMES MATTIS AND M-M

Article 10 (1) of Commission Regulation (EC) No 874/2004 of 28 April 2004 (hereafter "the Regulation") states that: "Holders of prior rights recognised or established by national and/or Community law and public bodies shall be eligible to apply 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 and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works".

Article 10 (2) of the Regulation 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.

Article 14 of the Regulation states that "every applicant shall submit documentary evidence that shows that he or she is the holder of the 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".

Section 17 of the Sunrise Rules states that: "If an Applicant claims a Prior Right to a name on the basis of his family name, in as far as it is protected in the member state of which he is a resident of, he must select the "other" type of Prior Right in his Application and it must prove the existence of such Prior Right in accordance with Sections 12(1) or (2) hereof".

Section 12(1) of the Sunrise Rules states that: "Unless otherwise provided under Sections 13 to 18 of these Sunrise Rules, the Applicant must submit Documentary Evidence containing
(i) an affidavit signed by a competent authority, legal practitioner or professional representative declaring that the type of Prior Right claimed by the Applicant is protected under the laws of the relevant member state, including
a. references to the relevant legal provisions, scholarly works and court decisions and
b. the conditions required for such protection; and
(ii) proof that the complete name for which a Prior Right is claimed meets all of the conditions set forth in such laws, including the relevant scholarly works and court decisions, and that such name is protected by the relevant Prior Right claimed".

Section 19 (2) of the Sunrise Rules states 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".

I. Domain name MATTIS

Dr. Marcus Mattis (hereafter "the Complainant") applied for the domain name MATTIS on 7 February 2006.

The processing agent received the documentary evidence on 3 March 2006, which was before the 19 March 2006 deadline.

The documentary evidence consisted of a copy of the Applicant's identity card and a "certificate of existence" signed by a public notary.

The validation agent concluded from the documentary evidence that the Complainant did not sufficiently establish the protection of the claimed prior right.

Therefore, the Respondent rejected the Complainant's application.

II. Domain name M-M

The Complainant also applied for the domain name M-M on 7 February 2006.

The processing agent received the documentary evidence on 17 March 2006, which was before the 19 March 2006 deadline.

The documentary evidence consisted of:
a letter from HÖSSLE KUDLEK & Partner (a firm of patent attorneys) stating that the Complainant is the owner of the German trademark No. 301 59 891 "mm multi utility consulting" and the Community trademark No. 002585297 "mm multi utility consulting" and that the emphasized representation of the two stylised letters M is the "formative component of the trademarks", therefore similarity exists between the domain name M-M and the trademarks in the sens of trade mark right;
certificates of registration for the German trademark No. 301 59 891 "mm multi utility consulting" and the Community trademark No. 002585297 "mm multi utility consulting".

The validation agent concluded from the documentary evidence that the Complainant did not sufficiently establish the claimed prior right.

Therefore, the Respondent rejected the Complainant's application.

2. COMPLAINANT'S CONTENTIONS

The Complainant's only contention reads as follows: "The decision taken by the Registry conflicts with the European Union regulations". The Complainant requires this Panel to annul the decision taken by the Respondent.

3. RESPONSE

3.1 The burden of proof was with the Applicant to demonstrate that the claimed prior right is protected or established under national law

Article 10 (1) of the Regulation states that only the holders of prior rights shall be eligible to apply to register domain names during the period of phased registration.

Pursuant to article 14 of the Regulation, the applicant must 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.

Section 21.2. of the Sunrise Rules clearly states 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 and scanned by the processing agent.

It is therefore of crucial importance that the validation agent is provided with all the documentary evidence necessary for it to assess if the Applicant is indeed the holder of a prior right.

In other words, the Applicant bears the burden of proof to substantiate that the claimed prior right is protected under German law. (see for example cases 127 (BPW), 219 (ISL), 294 (COLT), 551 (VIVENDI), 984 (ISABELLA), 843 (STARFISH), 1931 (DIEHL, DIEHLCONTROLS)).

3.2 Regarding the domain name MATTIS, the Complainant did not comply with article 14 of the Regulation and section 12(1) of the Sunrise Rules

In order to meet his burden of proof pursuant to article 14 of the Regulation to demonstrate that the family name claimed as a prior right is protected under German law, the Complainant needed to provide the documents required by section 12(1) of the Sunrise Rules.

This provision requires the Complainant to submit:
an affidavit signed by a competent authority declaring that the type of family name claimed by the Applicant is protected under the German laws (including references to the relevant legal provisions, scholarly works and court decisions and the conditions required for such protection); and
the proof that the complete name for which a Family name is claimed meets all of the conditions set forth in such laws, including the relevant scholarly works and court decisions, and that such name is protected by the relevant Prior Right claimed.

Family names are not protected by the same laws in all Member States and the only way for the validation agent to verify that the Family name in question meets the requirements set forth by local law is to have, as a part of the documentary evidence, a statement by a legal practitioner or competent authority under local law which analyses the requirements for protection and confirms that the claimed prior right is indeed protected under local law. This is the reason why the Sunrise Rules require an affidavit.

In the present case, "certificate of existence" signed by the public notary did not explain the requirements for protection of family names under German law and did not state that the prior right claimed by the Applicant meets those requirements.

This certificate of existence merely mentions that the Complainant visited the Public Notary Felix Kübler on 8 February 2006 between 5.15 pm and 5.25 pm in his office in Stuttgart and that they had a conversation together.

Therefore, the validation agent was not able to assess whether the Complainant's family name (MATTIS) meets the requirements for protection under German law.

Consequently, the Respondent correctly rejected the Complainant's application because the Complainant did not meet its burden of proof pursuant to article 14 of the Regulation and section 12(1) of the Sunrise Rules.

For the sake of completeness, the Respondent reminds that the Sunrise Rules have been accepted by every applicant during the Sunrise Period since the cover letter which every applicant must sign clearly states that: "The Rules, including the special terms that relate to the phased registration period, apply and have been read and approved without reservation by the Applicant".

With regard to the validity and the importance of these Sunrise Rules, article 5 (3) of Regulation N° 733/2002 states that "Before starting registration operations, the Registry shall adopt the initial registration policy for the .eu TLD in consultation with the Commission and other interested parties. The Registry shall implement in the registration policy the public policy rules adopted pursuant to paragraph 1".

The Sunrise Rules have been amply applied by several Panels in many .eu domain name arbitration cases, such as ADR 00210 (BINGO), 00127 (BPW), 00293 (POOL), 2592 (TANOS), 2597 (GAYROMEO), etc.

3.3 Regarding the domain name M-M, the Complainant did not comply with article 10.2 of the Regulation and section 19(2) of the Sunrise Rules

Article 10 (2) of the Regulation 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, 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.

The German semi-figurative trademark No. 301 59 891 "mm multi utility consulting" and the Community semi-figurative trademark No. 002585297 "mm multi utility consulting" consist of the following elements:
two highly stylised letters M; and
the words "multi utility consulting".

Pursuant to this section 19 (2) of the Sunrise Rules, the Respondent must separate the alphanumerical elements from the device elements.

In the case at hand, the Respondent found that the highly stylized letters "M" depicted alphanumerical characters. Consequently, they need to be included in the domain name applied for.

But the trademarks also contain several other alphanumerical characters reading " multi utility consulting".

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 and section 19 of the Sunrise Rules.

Therefore, the complete name for which a prior right exists, based on those trademarks, is "m m multi utility consulting". This is also the opinion expressed in the letter from HÖSSLE KUDLEK & Partner (a firm of patent attorneys), which states that the trademarks read "mm multi utility consulting".

Since the Complainant applied for the domain name M-M, which is not the complete name for which the prior right exists, the Respondent correctly rejected the Complainant's application pursuant to article 10.2 of the Regulation and section 19.2 of the Sunrise Rules.

The Respondent refers to the very similar case Nr 470 (O2). In this case, the applicant applied for the domain name "O2", on the basis of a French Trademark consisting of the characters "O2" accompanied, on the right side, by the stylized words (slogan) "l'oxygène de votre quotidien".

The Panel decided that "all alphanumeric characters of the composite sign invoked by Complainant (i.e. the French Trademark), are not contained in the domain name "O2". Indeed, the words (slogan) "l'oxygène de votre quotidien" are part of the composite sign, namely the French Trademark, but do not appear in the domain name Complainant applied for. Accordingly, the decision taken by Registry to reject the "O2" domain name application does not conflict with the Regulation 874/2004 ".

In ADR 1427 (BONOLLO), the applicant relied on a trademark consisting of the following characters: 1) a graphic device element, 2) the word “BONOLLO” where the fourth letter “O” is enlarged and the words “DISTILLERIE BONOLLO S.p.A”. The applicant applied for the domain name consisting only of the name BONOLLO and the Panel correctly decided that "It has been argued by the Complainant that only distinctive elements of a composite sign must be included in the domain name. This is contrary to the wording in Section 19(2) of the Sunrise Rules and Article 10(2) of Regulation (EC) No 733/2002."

For these reasons, it is clear that the Regulation does not require the Respondent to investigate whether some parts of the trademarks are more distinctive than the others or, as suggested by the letter from HÖSSLE KUDLEK & Partner are "formative component of the trademarks".

The Regulation only requires the Respondent and the validation to verify that the domain name applied for consists of the complete name of the prior right on which the application is based, as written in the documentation which proves that such a right exists.

If the prior right as written in the documentary evidence is not the complete name of the domain name applied for, the Respondent must reject the application.

The Respondent also refers, amongst others, to the ADR decisions 1053 (SANTOS), 1438 (ELLISON), 713 (HUETTINGER), 2224 (POWERON), 02499 (PSYTECH), 02494 (BPSC), 2297 (FENRISULVEN), and 02047 (UNI-C).

DISCUSSION AND FINDINGS

Article 22 of the Regulation 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 the Regulation or with the EU Regulation.

I. THE COMPLAINT

The Complaint is as follows “The decisions taken by the Registry conflicts with the European Union regulations.”

Article B – 1(b)(10)(ii) of the ADR Rules provides that the Complaint shall describe the grounds on which the Complaint is made including, in particular, “in case of an ADR Proceeding against the Registry, the reasons why a decision taken by the Registry conflicts with European Union Regulations.

This Complaint does not comply with the above ADR Rule. No reason is stated as to why the decisions taken by the Registry conflict with the European Union Regulations.

As a result and on this basis alone the Panel can reject the Complaint.

However, since Respondent has provided a thorough response to the Complaint, the Panel will examine the decisions by Respondent to reject the applications for the domain names.

II. THE DECISIONS BY RESPONDENT

1. Burden of proof

According to Article 14 of the Regulation, the Applicant alleging a Prior Right in the name pursuant to Article 10 (1) of the Regulation, must submit Documentary Evidence showing that he or she is the holder of a Prior Right in such name.

2. Prior right and Documentary Evidence

2.1 “M-M”

It results from the Documentary Evidence that the domain name application “M-M” is based on the German Trademark No. 301 59 891 “mm multi utility consulting” and on the Community trademark No. 002585297 “mm multi utility consulting”. These constitute the Prior Right upon which the “M-M” domain name application has been based.

Article 10.1 of the Regulation provides that “holders of prior rights recognized or established by national and/or Community law and public bodies 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 and community trademarks (…)”

Article 10.2 of the Regulation 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 such a right exists.”

These conditions are confirmed by the Sunrise Rules. Section 19.2 of the Sunrise Rules states 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 they appear in the sign, and
(b) the general impression of the word is apparent, without reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear.”

The Prior Right used for the application to register the domain name “M-M”, consists of two stylised letters M and the words “multi utility consulting”.

The domain name “M-M” could therefore not be considered as a name included a composite sign that exclusively contains the domain name.

The panel finds that all alphanumerical characters of the composite sign invoked by the Complainant (i.e. the German Trademark and the Community Trademark), are not contained in the domain name “M-M”. Indeed, the words “multi utility consulting” are part of the composite sign but do not appear in the domain name Complainant applied for.

Accordingly, the decision taken by Respondent to reject the “M-M” domain name application does not conflict with the Regulation and the EU Regulation.

2.2 “MATTIS”

According to Article 14 of the Regulation “All claims for prior rights under Article 10(1) and (2) must be verifiable by documentary evidence which demonstrates the right under the law by virtue of which it exists.”

Article 17(2) of the Sunrise Rules states that “If an Applicant claims a Prior Right to a name on the basis of his family name, in as far as it is protected in the member state of which he is a resident of, he must select the “other” type of Prior Right in his Application and it must prove the existence of such Prior Right in accordance with Sections 12(1) or (2) hereof.”

Article 12(1) and (2) of the Sunrise Rules states
“1. Unless otherwise provided under Sections 13 to 18 of these Sunrise Rules, the Applicant must submit Documentary Evidence containing
(i) an affidavit signed by a competent authority, legal practitioner or professional representative declaring that the type of Prior Right claimed by the Applicant is protected under the laws of the relevant member state, including
a. references to the relevant legal provisions, scholarly works and court decisions and
b. the conditions required for such protection; and
(ii) proof that the complete name for which a Prior Right is claimed meets all of the conditions set forth in such laws, including the relevant scholarly works and court decisions, and that such name is protected by the relevant Prior Right claimed.
2. It is in any case sufficient to submit a copy of a relevant final judgment by a court or an arbitration decision of an official alternative dispute resolution entity competent in at least one of the member states stating that the Applicant has protection for the complete name for which a Prior Right is claimed.”

In the present case the Applicant provided as Documentary Evidence two pieces of evidence which consisted of a copy of the Applicant’s identity card and a “certificate of existence” signed by a public notary to establish the protection of the claimed Prior Right.

A photocopy of an identity card and a “certificate of existence” are not sufficient to enable the Validation Agent to ascertain whether the application fulfills the conditions set forth under Article 14 of the Regulation and 12(1) of the Sunrise Rules.

The decision taken by Respondent to reject the “MATTIS” domain name application does not conflict with the Regulation and the EU Regulation. Nor does it conflict with the Sunrise Rules.

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	Jean Albert

DATE OF PANEL DECISION 2007-01-20

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complaint does not state the reasons for which the decisions by the Respondent should be considered a violation of the Regulation and the EU Regulation. The Panel can on this basis alone deny the Complaint.

In any case, the decisions taken by the Respondent were validly taken.

In the case of the application for the domain name M-M.EU the Documentary Evidence fails to show that the Applicant has a prior right in the word "mm" or "m-m" as per Article 10.2 of the Regulation and Article 19.2 of the Sunrise Rules. The Applicant's rights are in ""mm multi utility consulting" as protected by its trademarks.

In the case of the application for the domain name Mattis, the documentary evidence fails to show that the Applicant has a Prior Right in the word "mattis" as per Article 14 of the Regulation, 17(2) of the Sunrise Rules and 12(1) and (2) of the Sunrise Rules. In the case of an application for a domain name based on a family name, the conditions to be fulfilled are clearly listed in the Sunrise Rules and the Documentary Evidence submitted to the Validation Agent in support of the application for the domain name MATTIS.EU does not satisfy such conditions.