Decision for dispute CAC-UDRP-101516

Case number	CAC-UDRP-101516
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Domain names	MY-GTI.COM

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Volkswagen AG

Complainant representative

Organization	Lubberger Lehment

Respondent

Name	Matthew McDonald

OTHER LEGAL PROCEEDINGS

One of the disputed domain names in the present proceeding, MY-GTI.COM, was the subject of CAC ADR Case No. 101302 between the same parties. The case was decided on 2 November 2016.

The single-member Panel in that case rejected the Complaint. Its Decision is to be found at <udrp.adr.eu/adr/decisions/decision.php?dispute_id=101302>.

The Panel examined the Complainant's rights and applied the Uniform Dispute Resolution Policy's cumulative 3-criteria test to the circumstances revealed in the parties' submissions, including supplementary statements that the Panel at its discretion admitted into consideration. The Panel furthermore conducted its own investigations, notably by examining the MY-GTI.COM website.

The Panel found, in relation to the first UDRP criterion, the disputed domain name MY-GTI.COM to be confusingly similar to a trademark, "GTI", in which the Complainant has rights, despite the Respondent having challenged the distinctiveness of "GTI" itself. Basing itself on previous UDRP ADR decisions, it accepted in this regard the Complainant's contention that:
- the disputed domain name MY-GTI.COM incorporates "GTI" in its entirety and differs from it only by including the descriptive, generic word "my", a hyphen between "my" and "GTI", and the non-distinctive generic Top-Level Domain (gTLD) extension ".com", and
- none of these additional elements altered the effect of confusing similarity with "GTI" itself.
As to the absence of any rights or legitimate interest on the Respondent's behalf – the second UDRP criterion – the Panel

noted the existence of the Complainant's trademark well before registration of the disputed domain name, the visual presentation of the Complainant's branded products on the Respondent's MY-GTI.COM website, and the absence of the Complainant's authorization for the Respondent's use of it.

Yet the Panel declined to find that the second UDRP criterion had been fulfilled in the circumstances. It based itself on the nature of the website associated with the disputed domain name and the Respondent's explanations. In particular, the website displayed no commercial objective but was a "mixture" of a fan site and a site for purposes of review, criticism and information. The Panel also noted the Respondent's explanation that he had registered the disputed domain name after having purchased a Volkswagen Golf GTI car himself and become involved in Volkswagen fan activities.

In relation to the final UDRP criterion of bad faith registration and use, the Panel considered the Respondent was likely to have realized "GTI" was subject to trademark but found that, in the non-commercial context that appeared to it to apply, the registration and use was not in bad faith.

It prefaced its conclusion on the evidence as to bad faith by the following statement, which is repeated verbatim in the Complaint in the present proceeding:

"This Panel would have no difficulty in concluding that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy if there was anything conclusive before the Panel to suggest that the Respondent's purpose was indeed commercial." But there was "nothing before the Panel to demonstrate any commercial purpose".

It then justified this conclusion by explaining that the Respondent's website related to items bearing the Complainant's brand but did so in a manner extraneous to the latter's sphere of control based on its trademark, thanks to the website's essentially non-commercial character. It thus recognized, in line with some earlier UDRP Decisions but contrary to others', scope for the Respondent to be able to have a legitimate interest. It then found that the Respondent's answers to the Complainant's allegations regarding MY-GTI.COM's registration and use were cogent enough to allow his purpose to fall within that scope. It similarly accepted the Respondent's explanations of use of a privacy or proxy registration service, since notably contact details were easily available from the website.

Reiterating the absence of "conclusive evidence of a commercial intent behind the Respondent's registration and use of the domain name", the Panel found it probable that the Respondent's purpose was as he had claimed. But it none the less left the door open to a refiling, by adding:

"If new evidence subsequently comes to light to suggest that the Respondent's intent behind registration of the domain name was not as the Respondent claims, it may be that a re-filed complaint will be accepted".

The Panel concluded its discussion by pointing out the complexity of especially the trademark law issues involved in the case and observed that a court procedure might be more appropriate to address them.

The aspect of allegedly providing access to firmware that infringed the Complainant's copyright rights was mentioned in the Panel's summary of the parties' positions, but not specifically dealt with subsequently, except in general terms to the effect that illegal site content may be significant when determining the presence or absence of bad faith.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the "VOLKSWAGEN" as well as "VW" trademarks which are registered extensively in Nice Classification System Class 12 (and often in several other classes): EU trademark 000703702 "VOLKSWAGEN", German trademark No. 621252 "VOLKSWAGEN" and US trademark No. 71665739 "VOLKSWAGEN" as well as EU trademark 1272004 "VW", international registration 1272004 "VW" and German trademark 682214 "VW" with priority from the years 1952 and 2014 at the latest.

Volkswagen AG is also the owner of the international registration "GTI" (No. 717592), the German trademark "GTI" (No.

39406386) and the US trademark “GTI” (No. 1540381) in Nice Classification System Class 12; the EU trademark "GOLF GTI" 0968810 in Nice Class 12 and other classes; the EU trademark “RNS” 002893105 (in Nice Class 9); the EU trademark "Golf" 00751909 in Class 12 and other classes, international registration "Golf" 403411 in Class 12 and German trademark "Golf" 907094 in Class 12, with priority from the years 1999, 1995, 2008, 2002, 1998 and 1973.
The Complainant provided satisfactory documentary proof of the above-mentioned registrations to the Panel.

FACTUAL BACKGROUND

This is a case of refiling of a Complaint against the Respondent in respect of the domain name MY-GTI.COM with the addition of a further disputed domain name, VWGOLF.TECH.

The Complainant, Volkswagen AG, is a well-known multinational manufacturer of vehicles and vehicle accessories. Its product range includes the Golf GTI in various versions. The modern GTI is often equipped with the RNS navigation system.

The Complainant owns trademarks in Germany, Europe and internationally in respect of Volkswagen, VW, GTI, Golf and RNS (see above).

The Respondent is the registrant of the disputed domain names and has used MY-GTI.COM for several years in conjunction with a website containing content related to VW Golf GTI vehicles.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT:

The Complainant claims that new evidence shows the Respondent's intent behind the registration of MY-GTI.COM does not correspond to that which the Respondent claimed in Case No. 101302 and thus the Complaint "had to be refiled".

Under "Factual Background", the Complainant introduces itself and its trademarks and then the Respondent as "allegedly an Australian citizen". The Complainant alleges he has concealed his identity and enters directly into legal argument already by invoking a finding in Pharmacia & Upjohn AB v. Dario H. Romero, WIPO Case No. D2000-1273 for the proposition that the anonymity of registration afforded by a proxy service indicates registration and use of a domain name in bad faith.

The Complainant denies that the Respondent's MY-GTI.COM site is a fan site. It notes that only the Complainant’s products appear on this site and, asserting the Complainant’s copyright rights in the RNS navigation system, shows that RNS-related download details feature on the site’s entry page.

The Complainant claims that the purpose of the site must be commercial because there are discounts offered on two third-party sites upon mention of the MY-GTI.COM site at purchase and because the Complainant seeks donations. It cites, by way of proof, the appearance of the site as one of an authorized website of the Volkswagen Group or of an authorized dealer.

The Complainant adduces, by way of proof of bad faith, the Respondent's recent registration of VWGOLF.TECH via a proxy service and without it yet being used.

Under "Legal Background", the two disputed domain names are discussed separately.

In relation to MY-GTI.COM, similar points are made as in Case 101302 in regard to the first UDRP criterion and thus are not repeated here, except to observe that UDRP cases relied on are now those that were cited by both the Complainant and the Panel in the previous proceeding:

- As to the insignificance of the prefix “MY” and hyphen: Comerica Bank v. Will Rote, WIPO Case No. D2016-0425; Banque

Pictet & Cie SA v. Brian Dyson and David Kalan, WIPO Case No. D2016-1114;

- As to the insignificance of the .com suffix: L'Oréal v. Tina Smith, WIPO Case No. D2013-0820; Titoni AG v. Runxin Wang, WIPO Case No. D2008-0820; and Alstom v. Itete Peru S.A., WIPO Case No. D2009-0877. (N.B. Two related to .com disputed domain names and one (D2000-0820) to a .biz one.)

As to the second UDRP criterion, the Complainant reiterates part of its argumentation in Case 101302, in particular in regard to its allegation that the Respondent is using the disputed domain name for the distribution and duplication of copyright infringing RNS updates. It denies the Respondent has a right or legitimate interest on the basis of being a Golf GTI owner and alleges that he "does not want to detail his experience with his Volkswagen Golf GTI because most of the site content refers generally to other VW models than the GTI owned by the Respondent".

As to the UDRP criterion of bad faith, the Complainant's contentions centre on the Respondent having "intentionally attempted to attract, for commercial gain, internet users to its website or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website or of a product or service on it."

Regarding knowledge of the "GTI mark", the Complainant alleges in the first place that the Respondent had such knowledge and in the next sentence claims that it is highly implausible that he was ignorant of it. It then asserts that his site "is not a mere fan site". The Complainant relies as evidence in this regard on "direct links to two different web-shops and the possibility to get a discount there". The Respondent is hence alleged to be "obviously" benefitting from these advertisements.

The Complainant then claims, as it did in Case 101302, that the Respondent's site provides information that "could" have an impact on the commercial activity of the Complainant. It next again asserts that legality of the Respondent's "offer" can have a "great impact" on the issue of good or bad faith. Of several screenshots provided from the MY-GTI.COM site, several show links providing access to firmware governed by the Complainant's trademarks and copyright.

In relation to VWGOLF.TECH, the Complainant refers regarding the first UDRP criterion to its rights in "VW" and "GOLF" and to the same cases regarding confusing similarity as for MY-GTI.COM, with one addition contained in the Decision in Case 101302: Accor v. Noldc Inc., Case No. D2005-0016, a .com case (THENOVOTEL.COM).

The Complainant asserts, in regard to the second UDRP criterion, that the Respondent has no rights or legitimate interest in respect of this disputed domain name on the basis of trademarks, authorization by or affiliation to the Complainant, or prior acquired rights.

As to the third UDRP criterion of bad faith, the Complainant invokes absence of use (passivity) as well as registration through use of a proxy server.

It also relies on the recent CAC Case 101459 (FR-CREDIT-AGRICOLE.COM for the proposition that "the undeveloped use of the website at the domain name which incorporates the Complainant's trademarks in its entirety indicates that the Respondent possibly registered the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks of the Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, as per para 4 (b)(iv) of the Policy".

The Complaint ends with the usual declaration that the Complaint does not aim to harass and that the assertions are warranted.

The Complainant attached 13 exhibits to its Complaint, five more than it did in Case 101302.

RESPONDENT

1. MY-GTI.COM

As to the first UDRP criterion, the Respondent alleges that GTI is a descriptive, inherently non-distinctive acronym not exclusive to Volkswagen. He backs this up by reference to the judgment of the Second Chamber of the Court of Justice of the EU in Volkswagen AG vs. OHIM (Case T-63-09, delivered on 21 March 2012) to the effect that a consumer would not automatically assume that all vehicles bearing the GTI mark would come from the same manufacturer. A Wikipedia entry on GTI listing other manufacturers' use of "GTI" or "GTi" was provided in further substantiation.

As to the second and third UDRP criteria, the Respondent reaffirms his honest and rightful registration and use of MY-GTI.COM.

First, he claims rights in using "GTI" by being a VW Golf GTI owner. This status is shown to be mentioned on MY-GTI.COM's About page. He states that he documents the fruit of work he has performed on his car on the site. He explains that the image used on his site does correspond to the model he owns, for which he gave the year of purchase. He furthermore asserts that the common modules across this kind of car make content related to his model valid for others as well.

Second, he reaffirms that he is is part of the fan community for this kind of car, something which he evidences with a screenshot of an online forum account page showing a very large number of posts.

Third, he refers to his background in electronics and computers and to why he was attracted by this kind of car – its potential for adaptation. He claims that he benefits from the fan community and wishes to document information he has encountered in it and to return something to it.

Fourth, refuting claims of illegality and commercial purpose regarding in particular RNS (notably in connection with allegations concerning the dates of links made to firmware updates from his site), the Respondent produces screenshots going back to 2010 to prove his assertions, combined with explanation of the firmware concerned and of when a section on it was included on his site.

Fifth, the Respondent replies to the allegation of use of the Complainant's trademarks on his site by asserting that some such use is unavoidable, in order to provide the information concerned at all, but that he ensures that this is factually accurate and that the use of the trademarks is kept limited.

Sixth, the Respondent recounts the thousands of hours he has spent on the site and insists that it is a fan site.

Seventh, he clarifies that other enthusiasts are the source of many links complained of. He emphatically denies that anything is sold on the site. Links to third party sites are "just that, links". He also affirms that these links have been on the site since 2012 and thus fell within the scope of the Decision in Case 101302. He avers furthermore that one and only one "donation link" generates any revenue, which is less than $50 a year. He states that this arrangement resulted from an unsolicited contact, for which he provides evidence in the form of the sender's email, pixelated to protect identity. He cites Ellen G. White Estate, Inc. v. Cary Mayo c/o Calvary Community Church, FA0709001076568: "the inquiry is not whether use of a domain name involves any commercial activity, but rather an assessment of the primary motive or intent of the domain name holder — to exercise free speech in the form of a criticism or information site, or to operate a commercial site. It is clear that some commercial activity does not transform an otherwise noncommercial site to a commercial one, particularly where the commercial activity is de minimus or ancillary to the domain name's noncommercial purpose." The Respondent's site falls, he claims, within these bounds.

Eighth, the Respondent denies damage is caused to the Complainant, invoking the reluctance or refusal of dealers to assist car owners with usability issues, notably in relation to the RNS navigation system. He includes forum screenshots raising such issues.

Ninth, the Respondent has included a disclaimer on his site in regard to Volkswagen and its marks.

Tenth, procedurally, the Respondent contests that the Complainant has introduced any new evidence, as it is required to do. He thus asks why the refiling was brought at all.

2. VWGOLF.TECH

As to the first UDRP criterion, the Respondent claims that the Complainant has failed to take action in respect of unauthorized incorporation of its trademarks in numerous other domain names that contain “VWGOLF”, such as VWGOLF-GTI.COM. He provides a lengthy list in this regard.

As to the second criterion, the Respondent asserts his right as vehicle owner in respect also of VWGOLF.TECH. He repeats his involvement in the large fan community. He then explains that he registered this domain name because he plans to use the name for the purposes of a forum devoted to VW Golf and related vehicles so that technical information may be shared and discussed.

He cites examples of other forum sites which similarly incorporate the Complainant’s trademark(s) without UDRP action being taken by the Complainant.

He explains the lag between registration and actual use is due to .TECH being a new gTLD; he took advantage of a promotion, as indicated in an invoice he adduced. He foresees better discussion capabilities than on MY-GTI.COM once he is ready to implement the site. The Respondent affirms that none of the objections regarding use made by the Complainant in relation to MY-GTI.COM would apply to the new site, acknowledges that UDRP action could be taken if the use changed so that such objections were to apply, and offers to enter into discussion in such an event.

Regarding the third UDRP criterion of bad faith, the Respondent questions the legitimacy of the Complainant’s making allegations on the same grounds as in regard to MY-GTI.COM. He considers that this would contradict the Panel’s finding in Case 101302, since no (new) evidence supports them. The Respondent avers that no UDRP decision has ever been made against him.

Whereas the Complainant cites various previous Panel Decisions in regard to passive holding of a domain, the Respondent observes that these cases were uncontested. This applies equally to Case 101459 where there was a construction page.

Regarding absence of use, the Respondent adds to what he has said under the second criterion by stating that the Complainant’s UDRP actions against him have taken up large amounts of time in the period following registration. A further reason is that it takes a considerable time to set up a forum from scratch. But he reaffirms that he does have plans for the site and work is in progress.

The Respondent attached 27 exhibits to his Response, eight more than in Case 101302.

FURTHER SUBMISSIONS BY THE PARTIES

The Panel admitted further submissions by the Parties despite the failure of the Complainant, which initiated the submissions, to ask the Panel’s permission to do so. The submissions were made by Non-Standard Communication (NSC) but amount to a Reply to the Response and a Rejoinder to the Reply. When admitting them, the Panel declared their utility would be assessed later (see below).

COMPLAINANT’S REPLY TO THE RESPONSE

MY-GTI.COM

1. Distinctiveness

The Complainant claimed that, in the Volkswagen AG vs. OHIM Case, the Court based its decision mainly on the fact that another word element is highly distinctive in the mark Volkswagen opposed, in contrast to the other elements in MY-GTI.COM. It then argued as follows: “However, even if there were a statement in this decision regarding any weak distinctive character of the term GTI, this decision would have no influence on the present case as the Complaint is based on valid GTI trademarks. Sufficient distinctiveness therefore cannot be called into question.”

It adduced a Google.de search screenshot, claiming that its uniformity of VW-related results proves “GTI” is “only” associated with the VW Golf in the European and especially German customer’s mind.

2. Bad faith

The Complainant stated: “Contrary to the opinion of the Respondent, it is obvious that the Respondent registered the domain my-gti.com to attract internet users to the website or other online location for commercial gain …” and that it is “obvious that the Respondent already registered the domain in the awareness of the Complainant’s famous trademarks GTI”.

In the same vein: “As confirmed in the Response, the domain name was chosen to attract members of the public who are interested in the VW Golf. Consequently, also for the Respondent the term ‘GTI’ was clearly used for the famous GOLF GTI of the Complainant. Otherwise he would have chosen the more specific address my-golf-gti.com” and, despite the Respondent’s statements, “there is obviously no other reason to use the trademark GTI within a domain my-gti.com other than to try to redirect internet users who are searching for information about suppliers of spare parts and accessories for the Complainant’s products. Clearly a domain has an address function. Consequently the consumer connects domains – especially ‘.com-domains’ – containing the trademark GTI with the Complainant”.

The Complainant provided screenshots from www.myVolkswagen.at and www.meinauto.volkswagen.de as “further proof of the common advertising practice whereby a special bond between the sign and the consumer is created” by including “my”, “mein”, etc. (Note: No earlier proof was submitted to this Panel and none is mentioned in the Case 101302 Decision.)

The Complainant refuted the Respondent’s explanations regarding when RNS update posts were introduced on the MY-GTI.COM site. It then states “it is not relevant when the Respondent added the links – the decisive factor is that these links lead to copyright-protected firmware files and that the posts regarding the firmware updates are the relevant posts of the website”. It repeats the reference to the site’s entry page’s RNS posts and alleges it was “obvious for the Respondent that the downloadable files [linked to third-party sites, where files could be uploaded anonymously] had not been legally uploaded by the Complainant. By creating links to them he acted in bad faith”.

The Complainant further asserted damage due to the RNS firmware’s availability, this time invoking safety risks. And it contests the extent of the financial relationship between the Respondent and the firms offering discounts and donations, saying: “It is incomprehensible and not proven that the Respondent embeds links to companies without any consideration or – as claimed – even without any contact to them. This is simply not credible. The Respondent is obviously benefiting from these advertisements”. It concludes: “The commercial purpose of my-gti.com is therefore the promotion of the Volkswagen Group parts which are sold by the linked companies – regardless of any revenue for the Respondent. To avoid the circumvention of the ratio legis of para 4 (a) (iii) UDRP the advertisement of third party companies which sell goods related to the content of the website must therefore also be considered as commercial use of my-gti.com. Furthermore revenues derive from the Respondent’s request for donations – even if the amount of the donations is not very high”.

VWGOLF.TECH

The Complainant affirms that it has not allowed the use of “VWGOLF” for the domains listed in the Response and says most of these websites are inactive and/or of low utility, speculating that they may have been automatically generated and registered to no purpose.

Finally, the Complainant casts into doubt the Respondent’s claimed and unsubstantiated plans to develop a site for technical discussions.

Seven new annexes accompany the Complainant's Reply, making the total it submitted 21 annexes.

RESPONDENT'S REJOINDER TO THE REPLY

The Respondent submitted his Rejoinder on the same day that he received the Complainant's Reply.

He dealt with the issue of "GTI"'s distinctiveness first, then Bad Faith for both disputed domain names together.

Distinctiveness of "GTI"

The Respondent informed the Panel that the Complainant had attempted to make the same point based on search engine results in Case 101302 already and that Google searches are based on location and earlier search history. Thus, a search by someone working on the Complainant's behalf would tend to return Volkswagen-oriented results.

Bad Faith

The Respondent responded point by point to the Complainant's new or repeated allegations.

First, as to the "obvious" registration to attract internet users, this allegation has already been answered and there is no new evidence. As to the allegation that the Respondent should logically have chosen "MY-GOLF-GTI" instead, the Respondent considered the point difficult to understand and in any case the issue has already been dealt with extensively otherwise.

Second, to the "obvious" absence of any other reason to use "GTI" in the disputed domain name except to redirect internet users, he answered, once more, that the website is primarily about modifications to the Respondent's vehicle, as evidenced by the website's volume in this regard.

As to the Complainant's contentions regarding when firmware posts began, the Respondent noted the puzzling confirmation by the Complainant of his own position to which its reasoning led and explained, regarding RNS posts being on the entry page, that the website is a blog and shows the last created pages by default. He further pointed out that he had provided information in both proceedings to explain the small proportion of firmware posted in relation to other site content.

Third, as to it being "obvious for the Respondent" that by creating firmware links on his site which led to file-hosters fed by anonymous users and thus illegally – thereby demonstrating bad faith – the Respondent answered that, on the single page in question, some links are missing or not working. This shows that the Respondent is not involved in hosting the files. They are in fact linked to by dozens if not hundreds of other enthusiast sites.

Fourth, as to the "damage" to which the Complainant alleged it was subject on grounds of firmware being made available contrary to safety requirements, the Complainant distinguished the firmware in question from that alleged by the Complainant and responded that no effective evidence had thus been provided. The Respondent furthermore provided evidence of pertinent warnings regarding illegality having been issued in some but not all US states. Even without being a lawyer, he considered it improbable that the Complainant could be found liable for actions of an owner. Should it, however, wish to restrict the facility in question ("Video in Motion") it should prevent its enabling.

Fifth, to the Complainant's contention that, to avoid safety issues, it does not sell firmware to the public but provides support in every Volkswagen garage, the Respondent replied that this is a misleading statement since not all dealers provide all desired support, especially for cars fitted after sale. He substantiated this claim by providing a sample of forum posts making the same point.

Sixth, as to intention to obtain commercial gain, the Respondent again denied the Complainant's allegations. He moreover found it offensive that the Complainant persists with the unfounded accusation that he is "obviously benefiting from these advertisements" by firms on his site. The Respondent instead averred that he has "links to those companies because he has

used them or found them to be a good source of information or parts which are used in the projects detailed on the my-gti.com website. The Complainant clearly has no idea about the Volkswagen enthusiast community and the work they do with no expectation of financial reward".

Seventh, as to the existence of the "commercial background" to the MY-GTI.COM site alleged by the Complainant, the Respondent found the Complainant's arguments contradictory. He also pointed out that donations providing a "revenue" of $50 a year compared to over $800 in expenses is not a commercial operation.

Eighth, in relation to the Respondent's registration of VWGOLF.TECH and the Complainant's denial that it had allowed use of its trademark for any of the domain names adduced in evidence in the Response, the Respondent answered that the Complainant's reply is "misleading at best". He considered the choice the Complainant made from among them in its Reply was "cherry picking" for the least-quality names. Instead, the Respondent adduced screenshot evidence from websites including VWGOLF.DE and VWGOLF.ORG, taken from among the over 50 names he had earlier listed. These names stand alongside other active ones the Complainant has allowed to carry on unhindered by UDRP action. Some, he continues, undoubtedly have a commercial character or are for sale.

He therefore questions why the Complainant has chosen to proceed against him for VWGOLF.TECH, which is not for sale, suggesting that he is now being singled out.

The Respondent concluded his Rejoinder by noting that the Complainant has made many claims without evidence and made some claims that are offensive. Making an additional, non-standard refiling "is bordering on harassment". He remarked, further, that the Complainant has claimed that "Volkswagen would suffer substantial damage if an accident was caused by a VW driver who was watching a DVD while driving", yet it has taken no action against "companies based in Germany that sell these products for all Volkswagen Group vehicles nor the hundreds of other Volkswagen enthusiast websites that actively promote Video in Motion modifications".

He finally repeated that he is a "huge fan" of Volkswagen products which he has proven time and time again, but the Complainant has continued its action. He created his site to document the work on his vehicle and to share information with other Volkswagen enthusiasts. Thus, claims that the Respondent is engaged in a commercial operation because of links to other sites are "ludicrous".

Three new annexes accompany the Respondent's Reply, making the total it submitted 30 annexes.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name MY-GTI.COM is confusingly similar to a trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy). It notes in making this finding that an issue regarding the distinctiveness of the trademark "GTI" was raised, and this issue is dealt with under the next criterion.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name VWGOLF.TECH is confusingly similar to a trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel finds that the Respondent has shown that he has a legitimate interest in respect of MY-GTI.COM (within the meaning of paragraph 4(a)(ii)of the Policy) but has not yet done so in respect of VWGOLF.TECH.

BAD FAITH

The Panel finds that the Complainant has failed to prove that the disputed domain names have been registered in bad faith or that the disputed domain name MY-GTI.COM is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

The Panel finds that the Complainant's manner of refiling in respect of the disputed domain name MY-GTI.COM did not – absent any factor vitiating the authority of the previous proceeding – accord sufficiently with the substantive requirement indicated in Case 101302 to provide new conclusive evidence of the Respondent's commercial intent when registering and using this domain name.

The Panel thus takes the view that such failure entails procedural implications with respect to any subsequent refiling that may be attempted, requiring that, if such a refiling is undertaken:

(i) it is incumbent upon the Complainant to distinguish explicitly in its Complaint between new evidence and evidence adduced in the previous proceeding, taking into account the content of the Decision(s) in the previous proceeding;

(ii) new assertions and arguments should be limited only to the new evidence, unless the Complainant can show that such evidence also has an impact on specific earlier arguments; and

(iii) failure to comply with (i) and (ii) should be taken into account by the UDRP ADR Provider in question when screening a new Complaint for administrative deficiencies as well as for any abuse of the UDRP procedure.

PRINCIPAL REASONS FOR THE DECISION

1. Preliminary Procedural Questions
1.1. Permissibility of refiling and conditions to be fulfilled

Although a dispute may be pursued via any court or other non-UDRP proceeding (UDRP, Para. 5), the possibility to refile is not addressed in the UDRP, its Rules or the CAC's Supplemental Rules. It has, however, been recognized in practice that a refiling may be admitted but only if certain conditions are fulfilled. These have been synthesized as follows by WIPO into a consensus view derived from eight cases to date (see Overview of WIPO Panel Views on Selected UDRP Questions www.wipo.int/amc/en/domains/search/overview):

"A refiled case may only be accepted in limited circumstances. These circumstances include when the complainant establishes in the complaint that relevant new actions have occurred since the original decision, or that a breach of natural justice or of due process has occurred, or that there was other serious misconduct in the original case (such as perjured evidence). A refiled complaint would usually also be accepted if it includes newly presented evidence that was reasonably unavailable to the complainant during the original case.

"In certain, highly limited circumstances (such as where a panel found the evidence in a case to be finely balanced, and that it was possible that the future behavior of the respondent might confirm bad faith registration and use after all), a panel in a previous case may have found it appropriate to record in its decision that, if certain conditions were met, a future refiled complaint may be accepted. Where this has occurred, the extent to which any such previously-stipulated panel conditions may have been met in any refiled complaint may also be a relevant consideration in determining whether such refiled complaint should be accepted.

"A re-filing complainant must clearly indicate the grounds allegedly justifying the refiling of the complaint. The provider with which such refiled complaint has been filed has responsibility for determining if, prima facie, the refiling complainant has indeed pleaded grounds which might justify entertaining the refiled complaint. An affirmative determination is a precondition for provider acceptance of the refiled complaint, and for panel determination of the refiling request and any decision on the merits. …".

The present Panel endorses this statement. It in effect applies to UDRP proceedings the general principle of law known as res judicata as commonly qualified in order to avoid denial of justice.

1.2. Conditions for refiling applied to the present proceeding

Against this background, the Panel notes that the Panel in Case 101302 specified that:

“If new evidence subsequently comes to light to suggest that the Respondent's intent behind registration of the domain name was not as the Respondent claims, it may be that a re-filed complaint will be accepted”.

This phrasing is consistent with the second paragraph of the WIPO Overview passage cited above. By implication it restricts any refiling regarding the MY-GTI.COM dispute to only “highly limited circumstances”. And the Panel in Case 101302 was specific as to when such circumstances might arise, namely, newly emerged “conclusive evidence of a commercial intent behind the Respondent’s registration and use of the domain name”. The Panel notes from the Complaint’s terms that the Complainant also understood from the Decision in Case 101302 the need to show these grounds.

Grounds must therefore be shown by the Complainant allowing a prima facie determination that new, conclusive evidence of such intent may exist for a refiling to be admitted.

The Panel is satisfied that the coming to light of the Respondent’s registration without use of the domain name VWGOLF.TECH incorporating the Complainant’s trademarks could, prima facie, qualify as new “behavior of the respondent [that] might confirm bad faith registration and use after all” and thus as evidence “reasonably unavailable to the complainant during the original case”.

However, a refiling in the absence of circumstances vitiating the original Decision should not assume the proportions of a full retrial or appeal in a judicial setting, lest it run counter to the qualified principle of res judicata discussed above. It would also be likely to sow confusion, since the Decision in Case 101302 still stands and merely needs to be complemented.

Thus, where in this proceeding the Panel discovers statements that offer little substantially new -- and allowing that new elements will in any case relate to the disputed domain name VWGOLF.TECH – it reserves the right to disregard them. The detailed summary of the parties’ contentions will allow inference of where this occurs. As regards any subsequent refiling, the Panel recommends that the guidance set out under Procedural Factors, above, is applied by the ADR Provider.

1.3. Submission of supplementary submissions

An exchange of further statements was initiated without seeking the Panel’s permission whereas Para. 12 of the UDRP Rules foresees further statements are to be submitted at the Panel’s request.

The Panel observes that it is not obliged to admit further statements so submitted. The test this Panel applies is that of utility to the proceedings and it finds that the exchange contributes to determining the relative weight of the parties’ arguments. The exchange is thus included in the summary of parties’ contentions under Factual Background, above.

2. Reasons for the Decision on the merits

Taking into account the approach adopted to the preliminary questions set out under heading 1, the following addresses the two disputed domain names in this proceeding together by reference to the three cumulative UDRP criteria.

2.1. The Complainant’s trademark rights and identicality or confusing similarity with them

MY-GTI.COM

The Respondent objects in respect of the mark “GTI” that it is descriptive, non-exclusive and too non-distinctive to be the subject of protection. He in particular refers to the judgment of the Court of Justice of the EU in the case Volkswagen AG vs. OHIM Case, T-63-09. The Complainant claims entitlement to unqualified recognition of its trademark pursuant to the first

UDRP criterion.

The Panel considers this point already resolved in the Complainant's favour by Case 101302. But it observes that the CJEU's finding may be relevant for the second UDRP criterion (see below).

VWGOLF.TECH

The identicality or confusing similarity of VWGOLF.TECH with the Complainant's proven marks is incontestable and the Panel finds the Complainant has fulfilled the first UDRP criterion. As to the claim by the Respondent that the Complainant failed to take UDRP or other action to assert its rights, this does not operate to negate or diminish the Complainant's rights under this criterion.

2.2. The absence of rights or a legitimate interest on behalf of the Respondent

MY-GTI.COM

The Panel finds the Complainant has adduced insufficient new evidence to justify deviation from the determination made in Case 101302.

It in particular places little value on the Complainant's claim that its myvolkswagen.at and meinauto.volkswagen.de domain names and websites amount to proof of a "common" advertising practice. There is a self-evidently inconsistent usage of "my" and "mein" between these two German-language sites and only two examples are provided. As to links to RNS firmware on the MY-GTI.COM website, the Panel acknowledges that these, as presented, raise copyright issues but not ones that this or any UDRP Panel is best suited to address. It remains significant for this refiling that MY-GTI.COM is by no means restricted to hosting such links and and that any commercial aspect to them is merely incidental to the website's principal purpose, as already determined in Case 101302.

VWGOLF.TECH

The Panel has far more difficulty in recognizing a legitimate interest on the part of the Respondent, especially because no evidence of use beyond assertion of intention was given by him. It also finds unconvincing the Respondent's argument that the Complainant has been lax in taking action against others using domain names incorporating variants of "VWGOLF". Such inaction does not grant him a right or legitimate interest to use the Complainant's marks. Nor can merely owning a VW Golf car.

Further, as the Complainant indicated, domain names are conceivable that might incorporate "VWGOLF" more innocuously. An alternative could thus be found in connection with a forum for technical discussions that is not so distinctly associated with the Complainant's famous marks.

For these reasons, the Panel concludes that the Respondent has failed to show he has acquired a right or legitimate interest at this time in respect of the disputed VWGOLF.TECH domain name.

2.3. Bad faith

MY-GTI.COM

The Panel finds some new evidence with respect to Case 101302 but that it remains insufficient to prove bad faith, specifically as to commercial intent on the Respondent's behalf.

A potentially significant new element was the registration by the Respondent of VWGOLF.TECH, especially the evidence in Annex 12 of the Complaint, which revealed the Respondent to be the registrant of VWGOLF.TECH but also that he might be the registrant of a great many other domain names. This could have suggested he traded in domain names and so had

commercial intent with respect to both the disputed domain names.

However, this printout evidence from a reverse DNS lookup service was inconclusive, as it related to the unique email address of the Respondent but also to anyone bearing his first and family name. Furthermore, the Panel exercised its general powers under Para. 10 of the UDRP Rules to investigate with the CAC Case Administrator as to whether the Annex 12 had already been made available to the Panel in Case 101302. It had been, and hence cannot constitute new evidence.

Beyond this, the record presented above of the Complainant's contentions and the Respondent's replies to them corroborate the picture of the MY-GTI.COM website being a longstanding, essentially non-commercial "blog" (as the Respondent put it). And this is what the previous case had already determined on similar if not exactly identical evidence overall.

VWGOLF.TECH

The two arguments made by the Complainant are essentially concealment of identity thanks to use of a proxy registration service and absence of demonstrable preparations for use.

As to concealment of identity, not only had the Panel in Case 101302 already had the opportunity to take note of registration of VWGOLF.TECH, but the cases cited by the Complainant in this regard (CAC Cases 101452, 101459, 101457, 101414, 101442) are all uncontested ones, some of which do not relate to concealment of identity, and those that do either led to failure of service of CAC communications due to non-response (Case 101452) or involved quite different circumstances (a bank's name being used in Case 101459 and an offer of sale in Case 101414). All are distinguishable from this case, in which the Respondent could be identified, did file a Response, and has indicated no intention to sell but rather an intention to develop a technical forum related to VW Golf cars.

As to non-use of the domain name VWGOLF.TECH, the Respondent's explanations appear cogent. His statement that the previous UDRP proceeding has absorbed his time is credible, as are his statements that the new site entails different features than MY-GTI.COM and that constructing it from scratch takes time. The Panel acknowledges that Case 101449 (FR-CREDIT-AGRICOLE.COM), decided after Case 101302, allows for the possibility that non-usage of a disputed domain name containing a trademark can indicate bad faith. However, the circumstances of that uncontested case were distinct from the present proceeding, in which a cogent explanation has been offered.

The Panel, further, takes account of the findings made in Case 101302 and above in relation to bad faith not being adequately shown by the Complainant as regards MY-GTI.COM. It also remarks that the Complainant's invocation of Pharmacia & Upjohn AB v. Dario H. Romero, WIPO Case No. D2000-1273 in the manner alleged in the Complaint is misleading. That case involved the making of a false statement by the Respondent as to the registrar the domain name in question was registered with, a kind of circumstance that does not apply in this case. The Panel notes further that Case 101302 reaffirmed the consensus view that "use of a privacy or proxy registration service is not in and of itself an indication of bad faith" and it finds no reason to depart from this view.

All this appreciation of the evidence before the Panel, however, is predicated upon the absence of any commercial intent on the Respondent's behalf, which he denies. He has provided evidence of promotional registration of VWGOLF.TECH for a period of ten years. Should he offer the domain name for sale, including to the Complainant, following this proceeding without using it or engage in activities that resemble commercial ones, including hosting paid links or offering discounts, another Panel might well find bad faith.

Thus, the door is left open in respect of VWGOLF.TECH to a refiling on that ground or a fresh ground under Para. 4(b) of the UDRP, provided the Complainant adduces new conclusive evidence.

3. Alleged abuse of procedure

The Respondent suggests he is being singled out, subjected to unnecessary and unfounded claims and treated by the Complainant in a way bordering on harassment. He finds some of the allegations offensive and others hard to fathom. The

refiling combined with a new dispute comes less than half a year before initiation of the present proceeding.

The Panel is thus obliged to consider whether the Complainant has not respected its undertakings pursuant to Para. 3(b)(xiii) of the UDRP Rules.

It notes, in first place, that the Complainant founds its refiling on the ground of new evidence having come to light. Judging from the merits of the case discussed above, the principal basis for such evidence relates to the registration without use of VWGOLF.TECH.

The Panel takes the view that a domain name holder who includes another famous mark of the same owner in a further domain name cannot expect to do so without recourse being taken by the owner.

That recourse can also be expected to be promptly exercised. Equally, the similarity of conduct in this situation is suggestive of a pattern being formed and thus the domain holder can expect that the owner will wish to have the situation addressed in an earlier UDRP proceeding revisited.

This is the essence of this proceeding and the determination made above that makes this refiling prima facie admissible. The refiling as such cannot therefore be regarded as an abuse of procedure.

In second place, however, a Complainant cannot be given a free hand in a refiling, as explained under the first heading, above.
There is no question that a fair and full procedure was followed and that the Panel in Case 101302 was diligent in the exercise of its duties, so that no ground for vitiating the procedure exists. The Complainant was hence not entitled to reopen the previous proceeding entirely.

Yet, it appears from its submissions to have attempted to reargue extensively what was already determined upon in the earlier proceeding in relation to MY-GTI.COM. While, as explained, the Panel disregarded such parts of the Complainant's argumentation, it did reconsider others. Notably, Annex 12 to the Complaint was of potentially high probative value in this proceeding to both of the disputed names, even if the items of evidence it contains were available in the previous proceeding.

For the event of a subsequent refiling the Panel has set down guidance so that a Complaint will not be accepted in a form that contains matter extraneous to the proper scope of a refiling. But in this case the Panel has duly taken the Respondent's objections into account regarding such scope.

This leaves, in last place, the question of the manner in which the Complainant argued its case.

The Panel agrees that some of the Complainant's claims were unwarranted, such as the allegedly new screenshot evidence to show that "only" Volkswagen is associated with searches for "GTI". Commercial intent was dogmatically alleged with scant proof, new or old. And, from the exchanges between the parties, the Complainant appeared to have been highly selective, both in its presentation of circumstances and in its choice of previous Panel decisions, with some not being on point for the proposition advanced, in particular uncontested ones involving egregious concealment of identity or cybersquatting with unambiguous commercial purpose.

The present Panel nevertheless is not prepared to determine that the Complainant has committed such an abuse of procedure as to justify any further measure. It does recommend that the Complainant takes account of the above remarks in any future proceedings.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **MY-GTI.COM**: Remaining with the Respondent
2. **VWGOLF.TECH**: Remaining with the Respondent

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2017-06-07

Publish the Decision