Decision for dispute CAC-UDRP-100458

Case number	CAC-UDRP-100458
Time of filing	2012-05-22 18:02:33
Domain names	COMPARETHEMARKET.XXX

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	BGL Group Ltd

Complainant representative

Organization	TLT LLP

Respondent

Name	Jon Watkins

OTHER LEGAL PROCEEDINGS

The disputed domain name <COMPARETHEMARKET.XXX> has already been the subject of UDRP decision No. 100421 between the same parties as in the present case. In that first case the Panel rejected the Complaint by its decision issued on 15 May 2012.

IDENTIFICATION OF RIGHTS

Complainant owns the following trademarks, all registered in classes 35 and 36:

- UK Trademark 2456693A which incorporates the text "comparethemarket.com"
- UK Trademark 2456693B which incorporates the text "comparethemarket.com"
- UK Trademark 2456693C which incorporates the text "comparethemarket"
- UK Trademark 2456693D which incorporates the text "comparethemarket"
- UK Trademark 2522721 for "comparethemarket"
- UK Trademark 2486675 for "comparethemarket.com"

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

In its amended Complaint filed with the On-line ADR Center of the Czech Arbitration Court (CAC) on 6 June 2012 the Complainant presents the following contentions:

The Complainant, BGL Group Limited ("BGL"), is a company incorporated in England and Wales. In 2005, BGL created its “Compare the Market” ("CtM") brand as part of its business as a personal-lines insurance intermediary. As part of the CtM brand, BGL created the website <www.comparethemarket.com>. This was, and still is, a price-comparison website for personal-lines insurance products. In January 2009, the CtM brand was re-launched. The re-launch included television advertisements featuring Aleksandr the Meerkat, an anthropomorphized meerkat character. A companion website was also created at <www.comparethemeerkat.com>. The CtM brand is extremely well-known, particularly by reference to the Aleksandr the Meerkat character.

The Respondent is the registrant of the disputed domain name <COMPARETHEMARKET.XXX>. The domain name was registered on 7 December 2011, more than 7 years after the Complainant registered the domain names <comparethemarket.com> and <comparethemarket.co.uk>.

Apart from the different top level domain, the domain name is identical to the Complainant’s domain name <comparethemarket.co.uk> and <comparethemarket.com>. The domain name also contains the Complainant's Trademark "COMPARETHEMARKET" and is very similar to the other Trademarks above. As such, the domain name is confusingly similar to the Complainant’s domain name and trademark.

The Registrant has no rights or legitimate interest in the domain name. The domain name is not being used to host any legitimate site; rather, it is completely inactive. No legitimate interest is being pursued through the domain name. The sole motivation is to benefit from the Complainant's established brand.

The Registrant should be taken as having registered the domain name in bad faith because, knowing of the Complainant's UK rights and its reputation in the mark "COMPARETHEMARKET", (1) the Registrant hid his contact details behind a privacy service, (2) it has not used the domain name to host any legitimate website or any website at all and (3) did not seek to explain his actions in Administrative Proceeding No. 100421.

These are circumstances indicating that the Registrant registered the domain name primarily for the purpose of selling it to the Complainant at an inflated price and/or as a blocking registration against a mark in which the Complainant has extensive rights and/or for the purpose of unfairly disrupting the business of the Complainant.

Since the Registrant was hiding behind a privacy service, the Complainant did not know his identity when it filed its Complaint in Administrative Proceeding No. 100421. However, it is now clear that the Registrant lives in the United Kingdom. As such, the Registrant should be taken to be fully aware of the Complainant's brand, that brand being extremely well-known in the UK.

With regard to the decision of the Panel in Administrative Proceeding No. 100421 the Complainant presents further observations, concluding that the effect of the Panel's reasoning in that Administrative Proceeding gives cyber-squatters (particularly "first time" cyber-squatters) a significant advantage in domain dispute proceedings if they (i) hide behind a privacy service, and (ii) do not respond to domain Complaints. Thus, it comes to the conclusion that this cannot be right, and that the result in Administrative Proceeding No. 100421 was unjust.

RESPONDENT:

The Response was received on the CAC’s online platform on 27 June 2012, whereas the deadline for filing a response on the on-line platform expired on 26 June 2012. The Response was in fact received nearly half an hour after the fixed deadline, this might be due to the differences in local time. However, for the reasons explained below, under the Procedural Factors’ section, there is no need to discuss whether the response of the Respondent should be deemed acceptable or not.

According to the Respondent the Complaint, filed only some days after the decision in Case No. 100421 is in essence an appeal from that first decision.

As to the substance, the Respondent states that the disputed domain name is not truly identical, the addition of .XXX making it different from other cases that may be considered similar such as '.co.uk' or '.com' for example. Domain name parking is not present on the inactive domain name.

The Complainant does not hold the trademark comparethemarket.xxx. Furthermore, the Complainant had multiple opportunities throughout 2011 to defensively register, should it have wished. ICM Registry provided a number of sunrise periods before release to the general public, however the Complainant did not take the opportunity during those sunrise periods to register.

The Respondent does not foresee future use to include personal lines insurance and does not foresee a time when his domain name would intrude into the Complainant's business. "Compare the market" could relate to things other than the Complainant's brand. "The creation of .XXX will create a clearly signposted place where adult entertainment can be accessed and allow surfers to have a clear idea of the nature of the site before they click, rather than after" (ICM Registry). The use of a privacy service with full contact details has not delayed contact at any point by CAC or other interested parties.

Finally the Respondent invites the Panel to consider reverse domain name hijacking.

RIGHTS

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NO RIGHTS OR LEGITIMATE INTERESTS

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BAD FAITH

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PROCEDURAL FACTORS

Before considering the merits of the Complaint, the Panel must first consider whether the Complaint is acceptable for a decision, given that it is a refiled Complaint. For the reasons explained below, the Panel is not satisfied that this procedural requirement is met. In particular the Panel finds that the refiled Complaint is not admissible under the UDRP.

By UDRP decision in CAC Case No. 100421 dated 15 May 2012 a Panel has already rejected a Complaint filed by the same Complainant as in the present case, against the same Respondent as in the present case and involving the same domain name as in the present case. In that case, the Panel found that the domain name <COMPARETHEMARKET.XXX> is confusingly similar to the Complainant's domain name and trademark. Furthermore, the Panel held that the Respondent did not offer any countervailing arguments to show its legitimate interest, despite the Complainant's claim to the contrary. However, the Panel rejected the Complaint as the Complainant had failed to prove bad faith registration or use of the disputed domain name. For this finding, the Panel considered the Complainant's registered rights in the UK, "where Respondent appears resident".

On 22 May 2012, one week after the first decision in Case No. 100421, the Complainant filed the Complaint in the present case. The Panel considers this Complaint as a refiled case as it involves the same domain name and the same Respondent as in the earlier Complaint that had been denied in Case No. 100421.

The Policy itself is silent on the question of refiled Complaints. There is no express prohibition against refiling Complaints, and the Policy does not state any explicit standards for accepting or rejecting refiled Complaints for consideration by a new Panel. It is conceivable that a well-funded Complainant could simply refile successive Complaints until it found a Panel willing to order the transfer of the disputed domain name. This would not be a fair burden to impose on Respondents, it

would not be an efficient use of the resources of the dispute resolution service provider, and it would not promote consistency and predictability in UDRP decisions (see WIPO Case No. D2011-0057 – Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page Marketing B.V.).

Paragraph 5(a) of the Rules allows the Panel to consider "any rules and principles of law that it deems applicable." UDRP-Panels have dismissed some refiled Complaints after referring to widely accepted legal principles such as res judicata (preclusion of identical claims), judicial efficiency, and the fundamental fairness of not imposing on Respondents the burden of replying to repetitious Complaints, sometimes expressed as a principle of "natural law", "fair process", or "due process". Such principles, as well as common exceptions to the doctrine of res judicata, are found in both common law and civil law jurisdictions, and with application to civil, criminal, administrative, and arbitral proceedings (see examples quoted by WIPO Case No. D2011-0057 – Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page Marketing B.V.).

It is therefore the consensus view of UDRP Panels that a refiled case may be accepted only 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. Finally, 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 (see WIPO Case No. D2011-0057 – Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page Marketing B.V.; WIPO Case No. D2009-0357 – GetMore A/S v. Sooyong Kim; WIPO Case No. D2009-0540Cheung Kong (Holdings) Limited and Chueng Kong Property Development Limited v. Netego DotCom).

In its refiled Complaint, the Complainant presented its observations regarding the first decision in Case No. 100421 concluding that the result in Administrative Proceeding No. 100421 was unjust. Furthermore, the Complainant seeks to justify the refiling of a UDRP Complaint against the same Respondent concerning the same domain name with only one argument: according to the Complainant's allegations, it was not aware of the Respondent's true identity, being a UK-resident when filing the first Complaint. The background was that at that time, the Respondent used a privacy service. Therefore, in its first Complaint the Complainant did not rely on this fact to argue that its web-portal under <COMPARETHEMARKET.COM> and trademarks <COMPARE THE MARKET> were renowned in UK so that the Respondent must have been aware of these rights.

It has to be noted that the Panel in UDRP-Case No. 100421 explicitly considered the fact that the Respondent appeared to be resident in the UK.

Therefore, the Panel finds that the above limited conditions for accepting a refiled case are not met in the present case. The Complainant has established neither that relevant new actions have occurred since the original decision, nor that a breach of natural justice or of due process has occurred, nor that there was other serious misconduct in the original case (such as perjured evidence), nor that the Complaint in the present case includes newly presented evidence that was reasonably unavailable to the Complainant during the original case. Finally, the Panel in the previous case did not find it appropriate to record in its decision that, if certain conditions were met, a future refiled Complaint may be accepted.
For the foregoing reasons, the Panel concludes that the Complainant has not met its burden of demonstrating that the refiled Complaint falls within the limited grounds on which refiled Complaints should be entertained.

PRINCIPAL REASONS FOR THE DECISION

REVERSE DOMAIN NAME HIJACKING:

The Respondent invites the Panel to consider whether the Complainant has engaged in reverse domain name hijacking. Paragraph 1 of the Rules defines reverse domain name hijacking as "using the Policy in bad faith to attempt to deprive a

registered domain-name holder of a domain name". Although the Panel has concluded that the requirements for consideration of the refiled Complaint have not been met, the Complainant presented some arguments and evidence in support of its argument that the Refiled Complaint should be considered. The Panel therefore concludes that these arguments are sufficient to avoid a finding that Complainant was proceeding in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **COMPARETHEMARKET.XXX**: Remaining with the Respondent

PANELLISTS

Name	**Dr. Tobias Malte Müller, Dr. Fabrizio Bedarida, Alan Limbury**

DATE OF PANEL DECISION 2012-07-18

Publish the Decision