Decision for dispute CAC-UDRP-100630

Case number	**CAC-UDRP-100630**
Time of filing	**2013-07-22 13:29:07**
Domain names	**ficep.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**FICEP SPA**

Complainant representative

Name	**Daniel Dimov**

Respondent

Organization	**FICEP**

OTHER LEGAL PROCEEDINGS

No other legal proceedings concerning the disputed domain names are currently pending.

IDENTIFICATION OF RIGHTS

Complainant relies on ownership of the following trademarks:

- US trademark registration 78178282 FICEP (fig.), filed on 25 October 2002 and granted on 15 June 2004.

- CTM application 11858065 FICEP (fig.), filed on 30 May 2013.

- Italian trademark registration 1031782 FICEP (fig.), filed on 7 May 2002 and granted on 16 December 2006.

FACTUAL BACKGROUND

Respondent registered the ficep.com domain name on 29 June 1998.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant (FICEP SPA) is one of the world's leading machine tool manufacturing companies.

The Complainant has registered the trademark "FICEP" in Italy and the United States. The Complainant has applied for a Community mark in the European Union.

Before registering the trademark "FICEP", the Complainant had rights in the unregistered trademark "FICEP."

The Domain Name is identical to the trademark registered by the Complainant.

The Respondent has no right or legitimate interests in respect of the Domain Name. The Respondent's use of the Domain Name is not in connection with a bona fide offering of goods or services. There are no facts indicating that the Respondent has been commonly known by the Domain Name.

The Domain Name has been registered and is being used in bad faith. The Respondent registered the Domain Name in bad faith because the purpose of the registration was to attract internet users for commercial gain by creating a likelihood of confusion with the "FICEP" trademark registered by the Complainant.

In consequence, the Complainant requests that the domain name be transferred to it.

RESPONDENT:

The Respondent FICEP is a French limited company (SAS) duly registered under French law on 19 January 1978 ("FICEP"). The company has always had this corporate name and has been offering its services to customers under the FICEP name since 19 January 1978.

In the 1970's the term "FICEP" meant « Froid Isolation Calorifuge Echafaudage Peinture » (Cold, Insulation, Industrial Roofing, Frames and Paint) and later «Frigorifuge, Isolation, Calorifuge, Echafaudage; Plafonds » (Scaffolding, Insulation, Industrial Roofing, Frames and Ceilings).

On 29 June 1998 the Respondent reserved the "ficep.com" domain name in order to offer its services on the Web to customers located across Europe. The Respondent has not faced any problem or any claim or procedure regarding the domain name since 1998.

"FICEP" is considered a "well-known trademark" within the meaning laid down in the provisions of the Paris Convention.

The Respondent uses the term "FICEP" and the "FICEP" domain name in good faith. Today the Respondent uses the "ficep.com" domain name and corresponding website for its activity, surveys, presentations, etc.

In consequence, the Respondent requests that the complaint be dismissed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

The Complainant has shown, to the satisfaction of the Panel, the domain name to be identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

The Respondent itself acknowledges the Domain Name is identical to the Complainant's trademarks.

The Complainant has duly demonstrated its ownership of the cited trademark registrations, in that the trademarks' particulars were accessible by means of the links included in the complaint

In consequence, the Panel deems the first of the conditions for accepting the complaint is fulfilled.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant affirms that the Respondent has no rights or legitimate interest in the disputed domain name. Nevertheless, the Respondent has shown that FICEP has been its company's corporate name since its incorporation in 1978.

In addition, the Respondent has also demonstrated that it has been using the said name in the course of their business activities since that date.

In consequence, the panel finds that the Respondent has fulfilled the conditions laid down in paragraph 4(a)(ii) of the Policy, namely:

(i) that before any notice to the respondent of the dispute, the respondent used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent has been commonly known by the domain name, even if the Respondent has not acquired trade mark or service mark rights.

Peaceful use of FICEP by the Respondent since 1978 is clearly sufficient grounds for recognizing that it has rights or a legitimate interest in the domain name. In this sense WIPO Case No. D2004-0531 can be mentioned.

There is no basis for assessment by the Panelist of other issues, such as whether the Complainant holds superior rights in FICEP under trademark law, since this is not the purpose of this type of proceedings.

A very clear ruling in this regard was issued by the Panelist in WIPO Case No. D2000-1470:

This Panel is not a general domain name court, and the Policy is not designed to adjudicate all disputes of any kind that relate in any way to domain names. Rather, the Policy is narrowly crafted to apply to a particular type of abusive cybersquatting. To invoke the Policy, a Complainant must show that the domain name at issue is identical or confusingly similar to a mark in which the Complainant has rights, that the Respondent lacks rights or a legitimate interest in the domain name, and that the Respondent registered and used the name in bad faith. Policy 4(a). To attempt to shoehorn what is essentially a business dispute between former partners into a proceeding to adjudicate cybersquatting is, at its core, misguided, if not a misuse of the Policy.

The decision in WIPO Case No. D2001-1324 also ruled along these same lines:

The Policy, though, is a limited tool for acting against certain types of cybersquatting, and provides a contractual-based remedy. If there is a "legitimate interest" as that term is defined in the Policy, the Policy precludes transfer of the domain name, even if the use does not seem "legitimate" in the broader understanding of that word. Cf. e-Duction, Inc. v. Zuccarini, WIPO Case No. D2000-1369 <../2000/d2000-1369.html> (February 5, 2001); The Thread.com, LLC v. Poploff, WIPO Case No. D2000-1470 <../2000/d2000-1470.html> (January 5, 2001).

Lastly, there is likewise no justification for contesting, at this date, the validity of a domain name that has been registered peacefully since 1998. According to the principle of legal certainty, such a long-standing state of affairs cannot be overturned unless there are powerful reasons for doing so.

In consequence, this Panel finds that the Complainant has failed to show that the Respondent does not have rights or

legitimate interests.

BAD FAITH

Pursuant to the foregoing, there is no indication of bad faith in the Respondent's conduct, inasmuch as the domain name is the same as their company name, which has been in use for decades.

There is likewise no indication that the Respondent has sought to take unfair advantage of the Complainant's trademarks and no other indication of bad faith.

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.

PRINCIPAL REASONS FOR THE DECISION

While the Complainant has demonstrated that the contested domain name is identical to its registered trademarks, the Respondent has demonstrated that the disputed domain name is the same as their company name and that it has been making use of the name in good faith for decades. As this is the case, the Panel finds that the Respondent does have rights or a legitimate interest in the name, and consequently, there is no other circumstance indicating of bad faith on the Respondent's part, the complaint is hereby dismissed.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **FICEP.COM**: Remaining with the Respondent

PANELLISTS

Name	**Mr. Luis H. de Larramendi**

DATE OF PANEL DECISION 2013-10-01

Publish the Decision