Decision for dispute CAC-UDRP-100739

Case number	CAC-UDRP-100739
Time of filing	2014-02-13 16:15:28
Domain names	ficep.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	FICEP SPA

Complainant representative

Organization	n/a

Respondent

Organization	FICEP

Respondent representative

Organization	Lawint

OTHER LEGAL PROCEEDINGS

The Complainant previously brought a Complaint under the Uniform Domain Name Dispute Resolution Policy (UDRP) against the Respondent in relation to the same Domain Name, <ficep.com>. The First Complaint was denied on 1 October 2013 - CAC Case Number 100630.

IDENTIFICATION OF RIGHTS

The Complainant relies on ownership of the following trade marks:

- US trade mark registration 78178282 FICEP (figurative) filed on 25 October 2002 and registered on 15 June 2004;

- Italian trade mark registration 1031782 FICEP (figurative) filed on 7 May 2002 and registered on 16 December 2006; and

- Community Trade Mark (CTM) application 11858065 FICEP (figurative), filed on 30 May 2013.

FACTUAL BACKGROUND

The Complainant has been active in the machine tool manufacturing market since 1930 when it was founded in Italy. It is now one of the world's leading machine tool manufacturing companies and has become the largest producer in the world today of automated systems for the fabrication of structural steel and plate and the forging industry.

The Respondent is a French company incorporated on 19 January 1978, although its founder began providing services in 1973 under the term FICEP. This originally stood for "Froid Isolation Calorifuge Echafaudage Peinture" (Cold, Insulation, Industrial Roofing, Scaffolding and Painting), but it has now been changed to "Frigorifuge, Isolation, Calorifuge, Echafaudage, Plafonds" (Cooling, Insulation, Industrial Roofing, Scaffolding and Ceilings).

The Respondent registered the Domain Name on 29 June 1998.

The Complainant previously brought a Complaint under the Uniform Domain Name Dispute Resolution Policy (UDRP) against the Respondent in relation to the same Domain Name, <ficep.com> (the "First Complaint"). The First Complaint was denied on 1 October 2013 - CAC Case Number 100630 (the "First Decision"). The Panel concluded as follows:

"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."

The Complainant filed another Complaint against the Respondent concerning the Domain Name on 13 February 2014 (the "Second Complaint"). However, the Czech Arbitration Court found that it was deficient for a number of reasons, including the fact that the Complainant had not specified whether any other proceedings concerning the Domain Name had previously been brought.

The Complainant corrected such deficiencies and filed an amended version of the Second Complaint on 20 February 2014. The Respondent filed a Response on 13 March 2014, within the required deadline. The Complainant then filed a Supplemental Filing on 16 March 2014, which was followed by a Supplemental Filing by the Respondent on 20 March 2014. The Complainant provided a Second Supplemental Filing on 24 March 2014.

PARTIES CONTENTIONS

Parties' Contentions:

Complainant

The Complainant argues that it also has unregistered rights as well as registered rights and that such rights existed before the Respondent's registration of the Domain Name.

It also points out that the Respondent has no registered trade marks in the term FICEP and argues that French law does not recognise unregistered trade marks. It states that, whilst French law provides for specific protection of well-known trade marks, this has to be on the basis of opinion polls or surveys.

The Complainant argues that the Domain Name is identical to the Complainant's registered trade mark rights.

It also states that the Respondent has no rights or legitimate interests in the Domain Name because the Respondent's use of the Domain Name is not in connection with a bona fide offering of goods or services. This is because the Respondent's website is used to offer scaffolding material and this can be confused by a non-expert as being the same or similar to the

systems offered by the Complainant. In addition internet users may think that the Domain Name is owned by the Complainant because the Complainant owns trade marks and many other domain names containing the term FICEP, but the Respondent does not. According to the Complainant, the Domain Name has been used since 1998 as a means to deceive the Complainant's customers.

The Complainant also states that the Respondent has not been commonly known by the Domain Name because the Complainant is commonly known by this term, and two companies cannot be commonly known by the same term. Furthermore the Complainant argues that the Respondent is not making a legitimate non-commercial or fair use of the Domain Name because the Respondent is using the Domain Name to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant's trade mark.

The Complainant argues that the Respondent registered the Domain Name in bad faith for much the same reasons and therefore seeks transfer of the Domain Name.

Respondent

As a preliminary issue, the Respondent makes reference to the First Complaint filed by the Complainant which was denied.

The Respondent underlines that a case under the UDRP may be reheard under certain circumstances, according to previous UDRP case law (WIPO Case No. D2000-0703, Grove Broadcasting Co. Ltd v. Telesystems Communications Limited). Such circumstances cover (a) serious misconduct on the part of a judge, juror, witness or lawyer, (b) perjured evidence having been offered to the Court, (c) the discovery of credible and material evidence which could not have been reasonably foreseen or known at trial and (d) a breach of natural justice.

In the Respondent's opinion none of these circumstances are met in the present case because the content of the First Complaint and the Second Complaint is almost the same, except that the in the Second Complaint the Complainant has added some paragraphs relating to (i) French trade mark legislation and case law and (ii) cybersquatting. According to the Respondent, these new paragraphs do not contain any new evidence and so do not justify a rehearing: the Complaint has already been judged by a Panel and so must be rejected.

Nevertheless, the Respondent also provides substantive arguments as follows:

The Complainant and the Respondent are not competitors and do not provide services or products for the same customers or in the same market. They have very different websites.

The term “FICEP” was chosen and is used by the Respondent to designate the services it provides. The Respondent has evidence of serious and continuous use of such term since 1973.

The Respondent registered the Domain Name in order to propose its services to customers across Europe on the internet. It has not previously had any issues with such registration.

The Respondent argues that it has rights and legitimate interests in the Domain Name because it has used the name FICEP since 1973 and registered it as its company name in 1978. Even though it does not have a registered trade mark in the term FICEP, the Respondent argues that FICEP is recognised as a well-known trade mark under both French and international law and submits evidence to support this.

The Respondent states that it was not aware of the Complainant's trade marks before it received a letter from the Complainant's representative in 2011.

The Respondent argues that it has always used the Domain Name in good faith and has never benefited commercially as a result of the similarity between the Domain Name and any domain names used by the Complainant. In the Respondent's opinion, the Complainant has not provided any evidence of the Respondent's bad faith.

The Respondent also states that, since the Complainant filed the Second Complaint, it has received several emails and letters addressed to the Complainant, supposedly from suppliers or consumers. The Respondent asserts that such confusion has never happened before and states that the email address used (ficep@ficep.com) does not appear on the Respondent's website (which refers to ficep@wanadoo.fr), only on its business cards and commercial advertisements. In the Respondent's opinion, this indicates that the senders probably did not go to the Respondent's website but were given the address by the Complainant in an effort to demonstrate confusion between the two companies, thus showing the Complainant's bad faith.

In this regard, the Respondent states that it has initiated a criminal procedure for fraud before the French criminal authorities and that the legal representative of the Respondent was heard by an officer of French police on 11 March 2014 as part of preliminary investigations.

Complainant's First Supplemental Filing

The Complainant states that it has two additional pieces of evidence that were previously unavailable, as follows:

(i) On 13 March 2014, the Office for Harmonization in the Internal Market (OHIM) issued a decision regarding the Respondent's opposition to the Complainant's CTM application number 11858065 in the term FICEP. Such opposition was based on the use of the Respondent's company name in France. However the Respondent failed to supply relevant evidence and so the opposition was rejected. In the Complainant's opinion, this clearly indicates that the Respondent does not have any rights in the term FICEP.

(ii) The Complainant argues that the French police report submitted by the Respondent does not prove that the Complainant has committed any fraud, and that this is ultimately a question for a court to decide. Instead the Complainant argues that the report illustrates the Respondent's bad faith as it did not reply to such emails and did not forward them to the Complainant. In the Complainant's opinion, the Respondent clearly registered the Domain Name in order to prevent the Complainant (the trade mark owner) from reflecting its trade mark in a corresponding domain name, which is evidence of bad faith in accordance with paragraph 4(b)(ii) of the UDRP.

Respondent's Supplemental Filing

The Respondent addressed the Complainant's two additional points as follows:

(i) OHIM's decision is not new evidence as referred to in the case WIPO No. D2000-0703, Grove Broadcasting Co. Ltd v. Telesystems Communications Limited. The Complainant applied for its CTM in May 2013, but the Domain Name was registered in 1998, well before this. Furthermore, the Respondent argues that this decision cannot be taken into account as it is not final and the Respondent is preparing to appeal.

(ii) The Respondent argues that the French police report does suggest the Complainant's involvement, despite the Complainant's submissions, and repeats its belief that the senders of the wrongly addressed emails must have been given the address by the Complainant. In response to the Complainant's assertion that the Respondent registered the Domain Name in order to prevent the Complainant from reflecting its trade mark in a corresponding domain name, the Respondent points out that the Domain Name was registered in 1998, but the Complainant did not have a registered trade mark until 2004. Thus the Respondent argues that the FICEP brand did not exist when the Domain Name was registered and therefore the Respondent could not have registered it in bad faith.

Complainant's Second Supplemental Filing

The Complainant states that it has been using the unregistered trade mark FICEP since 1930, and indeed has submitted copies of invoices dating from 1958. The Complainant points out that the email address of the Complainant (ficep@ficep.it) is confusingly similar to that of the Respondent (ficep@ficep.com). It adds that the Complainant's clients could easily be

misled as the Complainant is an international company and exports 98% of all its products.

In addition, the Complainant submits evidence of a Google search indicating that ficep@ficep.com is publicly available on many websites, and thus argues that the Respondent's submission that ficep@ficep.com is not publicly available is not true.

Finally, the Complainant points out that it did not mention the misdirected correspondence until being informed about it by the Respondent, and argues that this is a clear indication that the Complainant is not linked to such correspondence.

RIGHTS

Not Applicable (See below)

NO RIGHTS OR LEGITIMATE INTERESTS

Not Applicable (See below)

BAD FAITH

Not Applicable (See below)

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

Re-filed Complaint

The Complainant made no reference to the First Complaint in its Second Complaint, and simply did not fill in the section "Insert any information you have regarding other legal proceedings, pending or decided, which relate to the disputed domain name." The CAC found the Second Complaint to be deficient for a number of reasons, one of them being that the Complainant had not answered this question, and so the Complainant made reference to the previous case in the amended version of the Second Complaint.

The UDRP and the UDRP Rules do not contain any specific provisions relating to this situation, namely when the same complainant files another complaint against the same respondent which relates to the same domain name. However clearly it would not be correct for a panel to consider the subsequent complaint de novo, because this was the role of the initial panel which issued its decision. The UDRP does not contain any appeal procedure, and panel decisions are final – if either party wishes to pursue the matter this must be done via a different forum. Therefore complainants are generally prohibited from simply re-filing the same complaint several months or even years later, as this would amount to a backdoor way of allowing a "second bite of the cherry" – in other words simply making another attempt in the hope of a better result with a different panel.

Thus in this case the first question for the Panel to consider is whether the merits of the re-filed Complaint should actually be considered, or whether it should simply be dismissed for the reasons set out above. Numerous prior panels have already considered this question and the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (the "WIPO Overview 2.0") summarizes the consensus view on re-filed complaints as follows:

"A refiled case concerns the complainant submitting a second complaint involving the same domain name(s) and the same respondent(s) as in an earlier complaint that had been denied. 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. A re-filing complainant's failure to clearly identify that its complaint is a re-filing of an earlier UDRP complaint may constitute a material omission for the purpose of any panel assessment of reverse domain name hijacking."

In this case not only did the Complainant not state that the Second Complaint was a re-filed Complaint until prompted by the CAC, it did not provide any arguments as to why such a re-filed complaint should be accepted. The Respondent, quite rightly, drew the Panel's attention to this and argued that the Panel should reject the Second Complaint out of hand without consideration on the merits. The Respondent cited one of the main prior cases on the issue of re-filing, Grove Broadcasting Co. Ltd v. Telesystems Communications Limited (WIPO Case No. D2000-0703), which provides that a re-filed case may only be reconsidered on certain very limited grounds, such as:

- serious misconduct by a judge, juror, witness or lawyer;
- perjured evidence being offered to the Court;
- the discovery of credible and material evidence which could not have been reasonably foreseen or known at the time; and
- a breach of natural justice / due process.

The Respondent argued that none of the above applied and that the Second Complaint did not contain any new evidence, only some additional paragraphs relating to (i) French trade mark legislation and case law and (ii) cybersquatting. The Complainant then filed a Supplemental Filing setting out what it asserted to be two additional pieces of evidence that were previously unavailable.

In Creo Products Inc. v. Website In Development (WIPO Case No. D2000-1490), the panel set out some general principles concerning the acceptance of re-filed complaints and commented as follows:

"First, the burden of establishing that the Refiled Complaint should be entertained under the Uniform Policy rests on the refiling complainant. Secondly, that burden is high. Thirdly, the grounds which allegedly justify entertaining the Refiled Complaint need to be clearly identified by the refiling complainant."

The Panel has therefore examined the two additional pieces of evidence put forward by the Complainant in its First Supplemental Filing in the light of the above and has found that, although both of them did indeed come to light after the First Complaint (and indeed the after Second Complaint, which the Panel will come to later), neither of them is actually material to the case.

It should be reminded that the UDRP is intended for simple cases of cybersquatting and a panel will only order a transfer of a domain name when all three of the following circumstances are satisfied:

(i) the domain name registered by the respondent is identical or confusingly similar to a trade mark or service mark in which the complainant has rights; and

(ii) the respondent has no rights or legitimate interests in the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

The first Panel had no hesitation in finding that (ii) and (iii) were not satisfied and left no room for the possibility of a re-filing, commenting that:

"…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."

The first piece of new evidence, namely the Respondent's unsuccessful opposition to the Complainant's CTM application, does not affect the above in any way. It does not mean, as argued by the Complainant, that the Respondent does not have any rights in the term FICEP. In any case the Respondent does not have to prove that it in some way has a "better right" than the Complainant – this is not the issue under the UDRP. Under the UDRP the Respondent merely has to demonstrate that it has a legitimate interest, and it has provided more than ample evidence of that. The Respondent also has to prove that it did not register and use the Domain Name in bad faith, and again the First Decision left no room for dispute in this regard, given that the Respondent registered the Domain Name in 1998 and, even though the Complainant was established at that time, there is absolutely no evidence to suggest that the Respondent was, or indeed should have been, aware of the Complainant and its rights. Thus the Respondent's unsuccessful opposition is irrelevant for the purposes of making a decision under the UDRP and is not material to the case.

The second piece of new evidence cited by the Complainant, the French police report, is also not material. The Complainant argues that it demonstrates that the Respondent registered the Domain Name in order to prevent the Complainant from reflecting its trade mark in a corresponding domain name, which is evidence of bad faith in accordance with paragraph 4(b)(ii) of the UDRP. However, the Panel cannot see how the police report helps to demonstrate this at all, and draws absolutely no inferences from it. Indeed whether or not the allegations contained therein are true or not can have no bearing on the outcome of this case and so the report is irrelevant for the purposes of the UDRP and the three criteria listed above. In any case it should be noted that whether or not the use of the Domain Name is confusing (as supposedly demonstrated by the misdirected correspondence) does not matter for the purposes of the UDRP as both bad faith use and registration must be found and, given the evidence presented, the Panel has no doubt that the Respondent's registration was entirely in good faith.

In conclusion, the Panel finds that the Complainant has not met its burden of demonstrating that the re-filed Complaint falls within the limited grounds on which re-filed complaints should be allowed. The Panel agrees with the panel's comments in GetMore A/S v. Sooyong Kim (WIPO Case No. D2009-0357) as follows:

"The purpose of the Policy is to provide an expedited means of resolving domain name disputes. Complainants have the option of seeking relief from the appropriate national court. Allowing unsuccessful complainants to refile without solid grounds that could not have been presented before would clog the system with repeat cases, interfering with expedited adjudication of domain name disputes."

The Panel therefore dismisses the re-filed Complaint without going on to consider it on the merits.

However for the sake of completeness the Panel briefly adds that it has considered both the Complaint and the Response and all three Supplemental Filings, even though such filings are usually only accepted on an exceptional basis as the UDRP is intended to be a short, quick procedure. In this case the Panel was of the opinion that the Complainant's First Supplemental Filing was required, as it was the first time that the Complainant had set forth the necessary argumentation concerning why the re-filed Complaint should be accepted, and the Respondent needed to be given the opportunity to reply to this in its Supplemental Filing. The Panel allowed the Complainant's Second Supplemental Filing to be admitted only because it was very short, but would not have allowed any further submissions from the parties.

Having considered all the pleadings and the evidence the Panel would just briefly conclude that, had it indeed gone on to

consider this case on the merits, it would not have found any differently from the learned panel who made the First Decision, precisely because the supposed new evidence was simply not material and there are no other facts or circumstances that appear to be significantly different.

Reverse Domain Name Hijacking

For a Panel to make a finding of Reverse Domain Name Hijacking ("RDNH") it is not necessary for the Respondent to have requested such a finding. As can be seen from paragraph 15(e) of the Rules, if the Panel finds that the Complaint was brought in bad faith, he or she is under an obligation to so declare in the decision:

"If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

Prior Panels have found that a finding of RDNH is merited for a number of reasons, including if the Complainant knew that the Complaint was doomed to failure (Timbermate Products Pty Ltd v. Domains by Proxy, LLC / Barry Gork, WIPO Case No. D2013-1603).

In this case, the Complainant re-filed a very similar Second Complaint and made no reference to the fact that it was a re-filing until asked by the CAC, initially leaving the section dealing with other proceedings blank. The First Complaint resulted in a clear-cut decision in favour of the Respondent, and the panel did not hint that this was a case where a re-filing could potentially be possible. Even when the Complainant filed the amended version of its Second Complaint making brief reference to the First Decision, it made no attempt to explain why a re-filing should be accepted, and only provided arguments in this respect (concerning new evidence) in its First Supplemental Filing after the Respondent highlighted the issue.

However, the reason that the Complainant did not provide arguments relating to the supposed new evidence in its re-filed Second Complaint was undoubtedly the fact that, at the time that the Second Complaint was filed, neither of these two pieces of evidence was known to it because they were not yet in existence. The Complainant filed its amended Complaint on 20 February 2014, but OHIM did not reject the Respondent's opposition until 13 March 2014, and, by its own admission, the Complainant was not aware of the French police report until the Respondent made reference to this in its Response (and in any case the report was made on 11 March 2014).

Thus it is clear that, at the time that the Complainant filed the Second Complaint, there were absolutely no grounds in existence to justify a re-filing because nothing had changed since the First Decision. The new evidence (although not in fact material) had not even come into existence. Given that the First Decision was very clear and left no room for argument, it is therefore reasonable to assume that the Complainant must have known that the Second Complaint had no reasonable chance of success. Given this the Panel finds that the Complainant's failure to declare the First Decision in the initial version of its Second Complaint was unlikely to have been an accidental omission and is thus relevant for the Panel's consideration of RDNH (as also underlined in the WIPO Overview 2.0 set out above). In the Panel's opinion, the Respondent should never have been put to the time and expense of defending the Second Complaint and should certainly not be troubled by further similar Complaints.

The Panel therefore finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

Summary

The Panel finds that this is a re-filed Complaint and that it should not be accepted and considered on the merits by the Panel as none of the limited grounds for allowing re-filed complaints have been made out by the Complainant. In this regard the Complainant argued in its First Supplemental Filing that two new pieces of evidence had come to light, but neither of these pieces of evidence was material and had any bearing on any of the three criteria that must necessarily be made out under

the UDRP.

Furthermore the Panel finds that the Complainant has engaged in RDNH because, at the time that the Second Complaint was filed, the new evidence had not yet come into existence, meaning that the Second Complaint was substantially similar to the First Complaint. Given the unequivocal nature of the First Decision, the Complainant must therefore have known that the Second Complaint had no reasonable chance of success. However the Complainant did not declare that the Second Complaint was a re-filing until prompted by the CAC.

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	**Jane Seager**

DATE OF PANEL DECISION 2014-04-22

Publish the Decision