Decision for dispute CAC-UDRP-106285

Case number	CAC-UDRP-106285
Time of filing	2024-02-23 09:43:11
Domain names	scipio.email

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	SCIPIO BIOSCIENCE

Complainant representative

Organization	ICOSA

Respondent

Name	Christian SCIPIO

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the disputed domain name <scipio.email> ('the disputed domain name').

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks:

- French trade mark registration no. 4850223, filed on 8 March 2022, for the word mark SCIPIO, in classes 1, 9, 10, and 42 of the Nice Classification;
- International trade mark registration no. 1690471, filed on 8 March 2022, for the word mark SCIPIO, in classes 1, 9, 10, and 42 of the Nice Classification; and
- United States trade mark registration no. 7075166, filed on 23 August 2022, for the word mark SCIPIO, in classes 1, 9, 10, and 42 of the Nice Classification.

(Collectively or individually referred to as 'the Complainant's trade mark', 'the Complainant's trade mark SCIPIO, or 'the trade mark SCIPIO').

The disputed domain name was registered on 27 November 2023 and, at the time of writing of this decision, it directs Internet users to the website at www.christian-scipio.de, the details of which are discussed further below (for present purposes, the website is referred to as 'the Respondent's website').

FACTUAL BACKGROUND

A. Complainant's Factual Allegations

The Complainant's statements of fact can be summarised as follows:

The Complainant, Scipio bioscience, is a French biotech startup incorporated in 2017, which develops, manufactures and commercialises laboratory kits and analysis software for single-cell RNA sequencing. 'Scipio' is a distinctive name with regard to the Complainant's business segment, namely medical devices and medical software.

In addition to the trade marks set out in the above section 'Identification of Rights', the Complainant is the owner of domain names bearing the term 'scipio', including the Complainant's official website at <scipio.bio>, which was registered in 2017.

B. Respondent's Factual Allegations

The Respondent served a Response in this UDRP administrative proceeding on 28 February 2024, the contents of which are laid down in the below section 'Parties' Contentions'.

The Respondent is a German individual who works as a Senior Key Expert Transformation at Siemens Healthineers AG, in Germany.

In response to the PO1 (defined below), the Respondent provided documentary evidence that 'Scipio' is his surname by virtue of marriage in 2020.

PARTIES CONTENTIONS

A. Complainant's Submissions

The Complainant's contentions can be summarised as follows:

I. The disputed domain name is confusingly similar to a trade mark in which the Complainant has rights

The Complainant submits that the disputed domain name incorporates the trade mark SCIPIO in its entirety, and that the generic Top-Level Domain ('the gTLD') <.email> heightens the confusion with the Complainant's trade mark to the extent that Internet users will be misled to believe that it is associated with the Complainant.

The Complainant therefore concludes that the disputed domain name is identical to the Complainant's trade mark.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The disputed domain name is held by the Respondent, Mr Christian Scipio, a German individual who holds no trade marks in the sign 'scipio' and has never been authorised by the Complainant to use the Complainant's trade mark.

The Complainant submits that the disputed domain name redirects to the website at <www.christian-scipio.de>, where Mr Scipio presents himself in the form of a curriculum vitae which, inter alia, provides that he is a Senior Key Expert Business Transformation & Architect for Healthcare Digitalization at Siemens Healthcare.

The Complainant further submits that the Respondent has no legitimate interest in the disputed domain name as he can and does communicate in his full name with the domain name <christian-scipio.de>, and could retain this sole domain name or any variations thereto.

In addition, the Complainant states that 'Scipio' is not a common family name in Germany, where the Respondent is located. According to the Complainant's own research, only 56 persons bear such surname in Germany, which makes it very rare.

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

The Complainant submits that MX servers are configured to the disputed domain name and that the Respondent could thus be sending fraudulent e-mails to the Complainant's partners, clients, potential clients, providers, employees, etc.

The Complainant has reached out to the Respondent to alert him of these circumstances and to ask him to communicate only under his full name and to abandon the disputed domain name, in order for him to avoid any confusion with the Complainant's trade mark. The Respondent, however, refused the Complainant's reasonable proposition, which shows bad faith, particularly as he only uses the domain name <christian-scipio.de>.

Furthermore, the Complainant avers that besides the risk linked to fraudulent messages, the Respondent will certainly – and unduly

– divert Internet users looking for the Complainant to the Respondent's website.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent's Submissions

The Respondent served a Response in this UDRP administrative proceeding on 28 February 2024.

The Respondent's contentions can be summarised as follows:

I. The disputed domain name is neither identical nor confusingly similar to a protected trade mark

The Respondent's surname is 'Scipio' and the personal ownership of this name predates the registration of the Complainant's trade mark.

II. The Respondent has rights or legitimate interests in the disputed domain name

The disputed domain name is used for the Respondent and his family as a personal mail server and web-forward host.

The Respondent provides mail accounts to his family members and does not intend to sell any goods or services through the disputed domain name, nor to cause any harm to the Complainant or any other legal entity.

The Respondent has already switched to use [christian@scipio.email] as his primary e-mail address and so did other family members.

The Respondent is merely working as an employee in the same industry sector but for another company.

III. The disputed domain name has not been registered and used in bad faith

The Respondent has never used the disputed domain name for any fraudulent purposes and does not intend to do so. The mail server is used for private, family mail purposes only. The number of e-mails from the disputed domain name to other mail services is less than 25 since the beginning of 2024.

The Respondent submits that the Complainant has not shown that the Respondent has been using the disputed domain name for fraudulent activities. The Complainant was also not able to prove that the Respondent’s presence has caused confusion among the Complainant's customers.

The Respondent further submits that in an exchange prior to commencing this UDRP administrative proceeding the Complainant has made unproven allegations of the Respondent's bad faith use associated with the disputed domain name. The Complainant has also falsified information submitted to CAC in so far as the copy of the e-mail exchange between the Parties prior to the dispute, provided by the Complainant, makes reference to a UDRP claim which had not been raised with the Respondent at the time.

IV. Reverse Domain Name Hijacking

The Respondent seeks a finding for reverse domain name hijacking (RDNH) against the Complainant, for the following reasons:

- Shortly after the registration of the disputed domain name, the Complainant reached out to the Respondent and made unfounded allegations of the Respondent's bad faith simply because the Respondent had not yet set up a website;
- The Complainant's allegation that the Respondent offers digital healthcare solutions is incorrect;
- The Complainant has shown no proof of actual confusion or that the Respondent has engaged with irreprehensible practices associated with the disputed domain name; and
- The Complainant has also falsified information submitted to CAC as set out under item III above.

V. Settlement options

The Respondent is open to reasonable negotiations with the Complainant.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has failed to make prima facie showing of the Respondent’s lack of rights or legitimate interests in the disputed

domain name (within the meaning of paragraph 4(a)(ii) of the UDRP Policy).

BAD FAITH

The Panel makes no ruling on this UDRP Policy ground for the reasons set forth in section 'Principal Reasons for the Decision' further below.

PROCEDURAL FACTORS

A. Unsolicited filings

On 7 March 2024, the Parties filed new – albeit unsolicited – submissions which the Panel has considered and decided to accept into the case record due to their materiality to the case.

A.1 Complainant's submission

The Complainant's submission reads as follows:

'We revert to you since the Parties were not able to settle the matter amicably.

Indeed, the Respondent is only willing to sell the litigious domain name, at the price of 5 000 €. Obviously, this is an attempt to take advantage of the Claimant's legitimate concerns regarding a risk of confusion and of fraudulent messages sent to impersonate him, to earn money. It clearly shows the Respondent's lack of good faith.

Indeed, we remind our client has prior company name, trademark and domain name rights on the name SCIPIO. We also emphasize on the fact that SCIPIO, if not associated with a first name, will not be immediately perceived as a patronym, since it is a very rare name, in Germany notably. On the contrary, SCIPIO is easily perceived as a trademark.

That is why the Respondent must use its name as a family name, i.e Christianscipio, Christian-scipio or other combination associated with his first name, and not as a trademark.

We hope we can settle this trademark infringement soon considering our client's prior rights'.

A.2 Respondent's submission

The Respondent's submission reads as follows:

'I revert to you to the new arguments presented by the complainant.

Indeed, I remind that the complainant never entered the standard procedure of negotiating first but rather immediately decided to threaten me via mail and then also further falsified the mail traffic presented to the UDRP by omitting the fact that the UDRP is to be involved in the first place. It clearly shows the complainants behavior is matching the criteria for reverse domain name hi-jacking and bad faith on their end. The fact that the complainant then again immediately demanded to have the domain transferred to them for free and then only offered 50€ after the UDRP validated my response further underlines their disinterest in an honest negotiation.

Indeed, I remind that my ID shows my official personal ownership of the name Scipio as of June 17th, 2020 which predates the trademark registrations of the complainant which were filed in 2022 and 2023. I also emphasize that I have legitimate interest in owning a domain name that matches my last name. The complainant shows no proof that Scipio is [sic] percieved as a trademark by independent individuals outside this case. In fact, Scipio is thus [sic] percieved as a name only.

This is also why I do not use this name as a trademark. I remind that it is clearly visible on my homepage that I do not own a company or that I offer services on my own. The allegation by the complainant that I bought the domain name with intentions to infringe the [sic] complainants trademark thus further supports the criteria for reverse domain name hi-jacking and bad faith on their end in this case.

As said in my response earlier: I am fully willing to cooperate with the result presented by the UDRP'.

B. Procedural Order No. 1

The Panel transmitted to the Parties on 12 March 2024 the Procedural Order No. 1 ('the PO1'), as follows:

1. PROCEDURAL BACKGROUND

1.1 This administrative proceeding is conducted pursuant to the Uniform Domain Name Dispute Resolution Policy ('the UDRP Policy'); the Rules for Uniform Domain Name Dispute Resolution Policy ('the UDRP Rules'), both of which issued under the auspices of the Internet Corporation for Assigned Names and Numbers (ICANN); and the Center of the Czech Arbitration Court ('the CAC') Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ('the Supplemental Rules').

1.2 Rule 10 of the UDRP Rules affords a latitude of discretion for panels to conduct a UDRP administrative proceeding as they see fit, so long as it conforms to the procedural legal framework.

1.3 The Panel has reviewed the available record and hereby issues a procedural order, the particulars of which are set out in section 2 below ('the Procedural Order No.1' or 'PO1' interchangeably).

2. PARTICULARS OF PROCEDURAL ORDER NO. 1

2.1 The Procedural Order No.1 is made to seek the following factual clarification from both the Complainant and the Respondent ('the Parties').

2.2 The Panel notes that, in the Response, the Respondent alludes to his '[…] personal ownership of the name Scipio **as of June 17th, 2020**…', as per a copy of the Respondent's ID card which is appended to the Response (emphasis added).

2.3 The Panel further notes that, in the same Response, the Respondent submits that the Complainant is 'falsifying information to you [CAC] as the step to approach the UDRP was not mentioned in our e-mail conversion (see my Annex C and compare with Annex 10 by the complainant, especially the mail of Dec 18th, 2023)…'.

2.4 In view of the above, the Panel hereby makes the following **ORDER**:

- The Panel invites the **Respondent** to clarify whether 'Scipio' is the Respondent's legal name from birth and, if so, to provide evidence to the Panel thereto. Alternatively, if the Respondent has changed his legal name, please provide evidence of such change and the date on which it came into effect; and
- The Panel invites the **Complainant** (i) to provide documentary evidence of the delivery of the Complainant's letter to the Respondent of 4 December 2023 (Annex 10 to the Complaint); and (ii) to provide a full copy of the email exchange with the Respondent pre-commencement of this UDRP administrative proceeding, with an accompanying statement of truth, which affirms that the Complainant believes all the information stated in the email exchange is correct.

2.5 The Panel invites the **Parties** to respond to the PO1 by **15 March 2024** (CET time)'.

C. The Respondent's Response to PO1

The Respondent provided his response to PO1 on 12 March 2024, the content of which is copied below:

'I respond as invited by you regarding the matter of providing additional factual clarification to the case.

Therefore I present my marriage certificate as evidence (Annex A) which documents the day I changed my legal name from Ullrich to Scipio as the 5th of June 2020. The marriage was conducted and filed by the registry office of the city of Nuremberg under the case number E678/2020 (Annex A) and triggered the subsequent change of my personal ID that I received on June 17th, 2020.

Please mind in addition that I assumed my legal name Scipio from my wife who had this name since her day of birth which is also stated in the marriage certificate (Annex A)'.

D. The Complainant's Response to PO1

The Complainant provided its comments in reply to the Respondent's Response to PO1 on 13 March 2024, the content of which is copied below:

'We revert to you following Respondent's response to PO1.

Please note we never intended to falsify any proof. In this sense, you will find enclosed the first mail sent to the Registrar of <scipio.email> on December 05th 2023, explaining the problem and asking them to transfer our formal notice letter to the Respondent. This email was sent before we had any correspondence with Mr Christian Scipio, as the whois information did not indicate contact information.

We have not received confirmation that the Registrar did transfer our mail to the Respondent, nor that he did not.

Parallel to that email, we contacted the registrant through the Registrar's platform. However said platform restricts the message to a maximum of characters which is very low so that we had to cut through our first mail (enclosed first message sent to Respondent via the platform).

Our message was correctly reproduced in the history of emails already attached to our initial Complaint.

Moreover, we recall that although the Respondent's name is "Scipio" since his wedding, he should use SCIPIO in combination with his first name, so that it will clearly be understood as a patronym, and not be confused with our client's trademarks'.

E. Panel's further directions

Satisfied with the Parties' responses to PO1, the Panel confirmed on 14 March 2024 that it would proceed to a decision on the merits of this UDRP administrative proceeding.

F. Miscellaneous

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

A. General

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy sets out the grounds which the Complainant must establish to succeed:

> i. The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
>
> ii. The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
>
> iii. The disputed domain name has been registered and is being used in bad faith.

It is incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three UDRP Policy grounds in turn.

B. Identical or Confusingly Similar

The test under the first UDRP Policy ground provides for a juxtaposing approach, according to which the disputed domain name and the Complainant's trade mark are to be compared side by side, in a relative straightforward exercise.

In order to succeed, the Complainant must provide evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark.

The Panel is satisfied that the Complainant owns trade mark rights in 'SCIPIO' since 2022.

The disputed domain name is <scipio.email> and it consists of the term 'scipio' in addition to the gTLD <.email>.

The Complainant's trade mark SCIPIO is wholly incorporated into the disputed domain name. The gTLDs (in this case, <.email>) are typically disregarded by UDRP panels under this UDRP Policy ground given that the gTLD is part of the domain name's anatomy.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

C. Rights or Legitimate Interests

The second UDRP Policy ground provides that the Respondent shall demonstrate that it has rights or legitimate interests in the disputed domain name. It therefore falls on the Complainant the burden to refute any such showing.

Paragraph 4(c) of the UDRP Policy sets out a non-exhaustive list of examples by which the Respondent can demonstrate its rights or legitimate interests in the disputed domain name, as follows:

> (i) before any notice of this UDRP administrative proceeding, the Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
>
> (ii) the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain name, even if the Respondent has acquired no trade mark or service mark rights; or
>
> (iii) the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The evidentiary standard under the UDRP proceedings is such that, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to provide evidence to the contrary.

The Respondent has served a Response in this UDRP administrative proceeding and provided documentary evidence of his name being 'Christian Scipio' since 2020, by virtue of marriage.

The coincidence of facts and circumstances in the present case is somewhat perplexing to the Panel: an individual who works in the biotech industry sector in the vicinities (a neighbouring country) acquires, by marriage in 2020, a (rare!) family name which is identical to the name of an unrelated enterprise (incorporated in 2017) which however operates in the same industry sector and owns trade mark rights in such name since 2022.

The crux of the matter in the present case therefore revolves around whether the Respondent, by possessing a surname identical to

the domain name which it holds, gives him sufficient standing in the sense of paragraph 4(c)(ii) of the UDRP Policy.

The Panel has already expressed his views in an unrelated case (see Steve Zinck v Cathy Tie, CIIDRC case n. 21993-UDRP), and in obiter, that the UDRP jurisprudence has developed a rather stringent test for individuals to rely on their names as UDRP-relevant rights. The Panel does not necessarily agree with the test and would be willing to consider a more liberal but reasoned standard for personal names under the UDRP – not least as the current test appears to benefit only a certain class of individuals. The same rationale applies to the Respondent in this UDRP administrative proceeding.

Despite the present case involving a great deal of head-scratching, the Panel cannot fail to note that the Respondent effectively has a right in the name 'Scipio' as his surname by virtue of marriage. As unfortunately a reality to the Complainant as it may be, 'Scipio' is Respondent's surname after all. This suffices for the Panel to find in favour of the Respondent under this UDRP Policy ground, namely that the Respondent has rights or legitimate interests in the disputed domain name.

The Panel therefore finds that the Complainant has failed to make prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the UDRP Policy.

D. Registered and Used in Bad Faith

In light of the Panel's finding under section C above, the Panel shall not consider this UDRP Policy ground given that any such finding would be immaterial to the outcome of this UDRP administrative proceeding.

E. Abuse of the UDRP administrative proceeding

In the Response, the Respondent asserts an RDNH counterclaim.

Paragraph 1 of the UDRP Rules defines RDNH as 'using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name'. Paragraph 15(e) of the UDRP Rules provides, in its relevant part, as follows: "[…] 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".

Furthermore, paragraph 4.16 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ('the WIPO Jurisprudential Overview 3.0') provides further guidance as to the circumstances under which panels would issue a finding of RDNH:

> '[…] (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant's lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (see generally section 3.8) such as registration of the disputed domain name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the WhoIs database, (iii) unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which prima facie justify advancing an alternative legal argument, (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, (vi) the complainant's failure to disclose that a case is a UDRP refiling, (vii) filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis, (viii) basing a complaint on only the barest of allegations without any supporting evidence'.

While the Complainant may have 'sailed very close to the wind' in this case, making use of bare evidence in an attempt to convince the Panel of its claims, and the Panel not agreeing with the manner in which the Complainant approached the Respondent in its pre-action letter (i.e. prior to the commencement of this UDRP administrative proceeding), the Complainant's conduct in this case does not appear to fall squarely into the realm of any of the above mentioned RDNH circumstances. Therefore, the Panel has decided not to make a finding of RDNH on this occasion. The Panel however cautions the Complainant to only invoke the UDRP Policy in the future in circumstances under which the Complainant is able to identify the bases and adduce evidence in respect of all three UDRP Policy grounds.

F. Decision

For the foregoing reasons, the Complaint is denied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **scipio.email**: Remaining with the Respondent

PANELLISTS

Name	Gustavo Moser

DATE OF PANEL DECISION 2024-03-19

Publish the Decision