Decision for dispute CAC-UDRP-106754

Case number	CAC-UDRP-106754
Time of filing	2024-08-13 09:15:42
Domain names	notinok.shop

Case administrator

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

Complainant

Organization	NOTINO EUROPE LTD

Respondent

Name	rf fw

OTHER LEGAL PROCEEDINGS

The Complainant filed an UDRP complaint against the Respondent regarding the same disputed domain name in a case decided on July 22, 2024 (the "Prior Case"). The complaint in the Prior Case was rejected (CAC-UDRP-106622) as the Complainant has not submitted the relevant evidence of its trademarks rights and failed to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

IDENTIFICATION OF RIGHTS

The Complainant claims in its complainant from August 12, 2024, it is the owner of following European trademarks containing term "NOTINO":

- NOTINO, No. 015221815, verbal;
- NOTINO TODAY IS YOURS, No. 015944127, figurative;
- NOTINO TRY&BUY, No. 016743965, figurative;
- NOTINO TRY&BUY, No. 016804049, figurative;
- NOTINO, No. 017471574, verbal;
- NOTINO, No. 018071749, figurative;
- Notino, No. 018537465, verbal;
- NOTINO, No. 018537464, figurative;

The disputed domain name <notinok.shop> was registered on December 17, 2023.

PARTIES CONTENTIONS

The Complainant claims it is the sole shareholder of the company Notino, s.r.o., Czech Republic, that is the holder of the domain names <notino.cz>, <notino.sk>, <notino.pl>, <notino.it>, <notino.dk>, <notino.ro> etc.) with the e-shops with cosmetics, perfumes, and other related goods in almost all the European Union and also outside the EU.

The disputed domain name is identical or confusingly similar to the domain names notino.cz and other variations, to the company name Notino as well as to the NOTINO trademarks. The obvious interchangeability is audio and visual and is even supported by the fact that on there are e-shops offering cosmetics, perfumes and other related goods to customers.

The Complainant claims there is no known title of the Respondent to use the name in the disputed domain name and the

Respondent is therefore not entitled to use the disputed domain name and should stop using it in order to stop violating the rights of the Complainant and its applicant and its subsidiary.

The Compliant further claims that the Respondent is in bad faith when running the same business activities as Complainant's subsidiary, i.e. offering cosmetics, perfumes and other related goods, on identical or confusingly similar domain names. The Respondent obviously intends for commercial gain to misleadingly divert consumers and to tarnish the NOTINO trademarks.

The Complainant finally claims there is a lack of good faith of the Respondent since there are e-shops running on the disputed domain name with the same categories of products as the Complainant's subsidiary offer and which are protected by the NOTINO trademarks.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

N/A

NO RIGHTS OR LEGITIMATE INTERESTS

N/A

BAD FAITH

N/A

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

After losing the Previous Case, the Complainant presents the complaint involving the same Complainant and Respondent as well as the same disputed domain name and this complaint is therefore so-called refilled complaint.

The Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), does not expressly allow or forbid the losing complainant in one case to file a second complaint against the same respondent and involving the same domain name. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), addresses the issue of refiled complaints in paragraph 4.18 (entitled "Under what circumstances can a refiled case be accepted?"). The WIPO Jurisprudential Overview 3.0 states:

> "A refiled case is one in which a newly-filed UDRP case concerns identical domain name(s) and parties to a previously-decided UDRP case in which the prior panel denied the complaint on the merits. […] As the UDRP itself contains no appeal mechanism, there is no express right to refile a complaint; refiled complaints are exceptional.
>
> Panels have accepted refiled complaints only in highly limited circumstances such as (i) when the complainant establishes that legally relevant developments have occurred since the original UDRP decision, (ii) a breach of natural justice or of due process has objectively occurred, (iii) where serious misconduct in the original case (such as perjured evidence) that influenced the outcome is subsequently identified, (iv) where new material evidence that was reasonably unavailable to the complainant during the original case is presented, or (v) where the case has previously been decided (including termination orders) expressly on a "without prejudice" basis.

> In the refiling itself, a complainant must clearly indicate the grounds it believes would justify acceptance of the refiled complaint. The WIPO Center would initially assess whether grounds have been pleaded which prima facie justify accepting the refiled complaint. It remains however for any appointed panel to ultimately determine whether such preliminarily-accepted refiled complaint should proceed to a decision on the merits."

It is clear, that the panels require the complainants to indicate the grounds that would justify the acceptance of the refiled complaint. **The Complainant in this case, however, presents absolutely no arguments why the refiled complaint should be admissible**. It has been held that the "burden is high" in justifying a refiled complaint (Creo Products, Inc. v. Website in Development, WIPO Case No. D2000-1490). The Panel does not believe that Complainant has carried his heavy burden of justifying the acceptance of a refiled complaint. In the Prior Case, Complainant argued to the panel that he had trademark rights. The panel considered Complainant's evidence and found it insufficient to support Complainant's claim of trademark rights. This Panel does not know the full wording of the complaint rejected in the Previous Case, but it follows from the decision in the Previous Case itself, that **the Complainant returned after the first complaint rejection with almost the same complaint wording, submitted almost the same evidence to the Panel, and presented no arguments why the refilled complaint should be accepted by the Panel**.

The Complainant presents only an Excel table with the enumeration of the trademarks, the link to EUIPO website and the link to TMview website, both with the enumeration of the "NOTINO" trademarks, and didn't submit any certificate of trademarks registration despite the common practice in domain name dispute cases to do so. The absence of evidence proving the existence of the Complainant's trademark rights is all the stranger because the absence of such evidence was the reason why the Complainant's complaint was rejected in the Previous Case. The Panel has to point out that obtaining trademark registration certificates from the EUIPO's official website is not difficult, and there are no significant obstacles preventing the Complainant from presenting them in ADR proceedings. It is not the role of the Panel to carry out investigations and procure evidence instead of the Complainant, especially in a situation where the Complainant has already been warned about the need to present such evidence once in the Previous Case.

Finally, the Panel considers that the Complainant:

- did not indicate the grounds allegedly justifying the refiling of the complaint, such as (i) legally relevant developments occurring since the original decision, (ii) a breach of natural justice or of due process, (iii) serious misconduct in the original case that influenced the outcome, or (iv) the new material evidence that was reasonably unavailable to the complainant during the original case;
- has not proven the existence of the claimed trademark rights.

Therefore, the complaint is not admissible and has to be rejected.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **notinok.shop**: Remaining with the Respondent

PANELLISTS

Name	**Petr Hostaš**

DATE OF PANEL DECISION 2024-09-09

Publish the Decision