ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Public Storage v. Deer Valley Mini Storage
Case No. D2012-1149

1. The Parties

The Complainant is Public Storage of Glendale, California, United States of America ("United States"), represented by Lee, Tran, & Liang APLC, United States.

The Respondent is Deer Valley Mini Storage of Scottsdale, Arizona, United States, internally represented.

2. The Domain Name and Registrar

The disputed domain name <publicstoragephoenix.com> is registered with FastDomain, Inc.

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), which was adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, and approved on October 24, 1999, and also in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 30, 2009 and the World Intellectual Property Organization ("WIPO") Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 14, 2009 (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 1, 2012. On June 6, 2012, the Center transmitted by email to FastDomain, Inc. a request for registrar verification in connection with the disputed domain name. On June 7, 2012, FastDomain, Inc. transmitted, by email to the Center, its verification response confirming that the Respondent is listed as the registrant and providing the contact details. In response to a notification by the Center that the Complaint was administratively deficient, regarding the Complainant's designation of a three-member panel, by its failure to specify three candidate panelists as required by paragraph 3(b)(iv) of the Rules, the Complainant filed an amendment to the Complaint on June 15, 2012.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Policy, Rules and Supplemental Rules.

In accordance with paragraphs 2(a) and 4(a) of the Rules, the Center formally notified the Respondent of the Complaint and that the proceedings commenced on June 20, 2012. In accordance with the paragraph 5(a) of the Rules, the Center set the due date for a Response to July 10, 2012. The Center received email communications from the Respondent on June 15 and 19, 2012. The Center further received six email

communications from the Respondent regarding a Response on July 11 and 12, 2012 and two email communications on July 13 and 14, 2012.

The Center appointed Peter L. Michaelson, Michael A. Albert and Maxim H. Waldbaum as panelists in this matter on July 26, 2012. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with paragraph 7 of the Rules.

Based on the deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the Panel no later than August 9, 2012. However, due to exceptional circumstances recently experienced by the Panel, the Panel extended the deadline to August 23, 2012.

This dispute concerns one domain name, specifically <publicstoragephoenix.com> (the "disputed domain name").

4. Background - Prior decision

The Complaint in this proceeding is essentially a re-filing of a complaint previously filed on August 17, 2011 in *Public Storage v. Deer Valley Mini & RV Storage and Deer Valley Mini Storage,* WIPO Case No. D2011-1397 ("*Public Storage 1*"). The panel in that proceeding decided against the Complainant and denied the complaint.

The Complainant states that the Complaint here involves the same parties as in *Public Storage 1* and all the same facts and contentions set forth in the prior complaint though now supplemented with two additional facts. Though *Public Storage 1* concerned two domain names, <publicstorage-phoenix.com> and <publicstoragephoenix.com>, this proceeding only addresses the latter domain name as the registration for the former name has expired and has not been renewed by the Respondent.

Rather than re-iterate the facts and contentions set forth in *Public Storage 1* decision, for the sake of brevity, the Panel simply points the reader to that decision and incorporates by reference herein the corresponding sections of the prior complaint. The Panel will just set forth the two additional facts which the Complainant alleges now justify its re-filing.

Additional Facts

a. Inconsistent prior ICANN decisions

On August 17, 2011, the Complainant filed a complaint, which it stated was substantially similar to that which it filed in *Public Storage 1*, against Southwest Self Storage Advisors. That complaint involved 15 different domain names which the Complainant then contended infringed on its United States trademark registration (no. 1,132,868) for its mark PUBLIC STORAGE. A decision was rendered in that case *Public Storage v. Southwest Self Storage Advisors / Jeff Cain*, WIPO Case No. D2011-1396 ("*Southwest Self Storage Advisors*"), in favor of and specifically transferring all 15 domain names to the Complainant. This decision was issued prior to the issuance of the decision in *Public Storage 1* on October 17, 2011. The result reached in *Southwest Self Storage Advisors* is contrary to that in *Public Storage 1*.

b. Expiration of domain registration for <publicstorage-phoenix.com>

On August 24, 2011, the Respondent's registration for <publicstorage-phoenix.com>, which was one of the domain names in dispute in *Public Storage 1* but not in the present case, expired and was not renewed by the Respondent. The panel in *Public Storage 1* pointed to the Respondent's actions involving that domain name as evidencing a *bona fide* offering of goods upon which the panel predicated a finding of the Respondent's rights or legitimate interests in that domain name.

5. Discussion

Re-filing

Each UDRP case involves its own specific and unique set of facts, with each panel bringing its collective knowledge, expertise, experience and wisdom to the task of deciding the issues involved. Doing so, as with adjudication, necessarily involves some degree of analytic subjectivity whether in assessing the facts and/or the pertinent law, and/or applying that law to the facts to achieve a result, which, in turn, will from time to time yield variable results from one panel to the next. UDRP decisions are not precedential. Though significant efforts are made by panels and the Center to provide uniformity across its decisions that involve highly similar issues and fact patterns and thus avoid inconsistency, complete uniformity is, in practice, unattainable owing, in part, to different perspectives held by different panels and differing interpretations of the facts, the evidence presented and governing law taken by those panels. However, prior decisions that, at first blush, may seem inconsistent may very well, under more discerning scrutiny, appear quite consistent in view of subtle, but key factual differences which were not previously appreciated by the reader.

No provision exists under the Policy, Rules or Supplemental Rules which enables an UDRP panel to function as an appellate body tasked with reviewing another UDRP panel decision. UDRP panels are co-lateral. Hence, UDRP panels have no authority to and consequently cannot function as appellate tribunals.

In view of the lack of an appellate process, some aggrieved complainants, seeking to achieve a similar result of gaining review of a prior adverse decision, have chosen to re-file their complaints. The Policy, the Rules and Supplemental Rules are all completely silent on whether a complaint in a previously decided matter can be re-filed by an aggrieved complainant, thus affording a second hearing and decision on essentially the same matter. Obviously, the societal goal, inherent in the Policy, of providing a relatively inexpensive and expeditious vehicle for summarily handling claims of cybersquatting could be readily thwarted by indiscriminately allowing re-filing. Unfair and unnecessary burdens would be placed on respondents and significant inefficiencies imposed on the dispute resolution providers, such as the Center, by permitting such a complainant to repeatedly file its complaint and repeat the decisional process until a point is reached where that complainant finally, by chance appointment of a panel ultimately persuaded by its allegations, attains the result which it initially sought.

However, extenuating circumstances may well arise where, in expectedly rare instances, re-filing and consideration by a subsequent panel may be appropriate and outweigh the societal goals of finality and judicial efficiency inherent in the application of *res judicata*. The panel in *Grove Broadcasting Co. Ltd. v. Telesystems Communications Limited*, WIPO Case No. D2000-0703 recognized such circumstances, in the context of re-litigation of a prior complaint in a court proceeding, as being:

a) serious misconduct by a judge, juror, witness or lawyer;
b) perjured evidence;
c) discovery of credible, material (though not necessarily incontrovertible) new evidence which could not have been previously obtained with reasonable diligence; or
d) a breach of natural justice.

These criteria were followed and supplemented in *Creo Products Inc. v. Website In Development*, WIPO Case No. D2000-1490 where the panel, also following general principles applicable to re-litigation, required an UDRP complainant to demonstrate that its re-filed complaint should be considered, based on clearly identified grounds, proceeding to a decision on the merits only where the complainant made out a *prima facie* case to justify re-filing. See also, in accord, *Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page Marketing B.V.,* WIPO Case No. D2011-0057 where the panel permitted re-filing of a complaint in view of material, credible results of an investigation conducted by an Australian competition and law enforcement authorities which were simply not available at the time of the prior decision. Paragraph 4.4 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), specifies the criteria justifying a re-filed complaint as being:

a) relevant new actions which have occurred since the original decision;

b) a breach of natural justice or of due process has occurred, or other serious misconduct in the original case (such as perjured evidence); or
c) newly presented evidence that was reasonably unavailable to the complainant during the original case.

Given the criteria set forth above, the Complainant here has not met its burden.

First, the Panel views the existence of potentially inconsistent decisions as insufficient to justify re-filing. As discussed, apparent inconsistencies can and do arise between otherwise seemingly similar decisions, which can be justified on a more careful examination of the specific underlying facts and governing law. Such a situation simply does not rise to the high level demanded by the *Grove/Creo* and WIPO Overview 2.0, paragraph 4.4 criteria above.

This Panel will not substitute its view for those of the panel in *Public Storage 1.* The Complainant had a full, fair and complete opportunity to be heard before that panel. While the Complainant basically points to alleged procedural errors inherent in that panel's decision and fervently disagrees with the result, we will not entertain its disagreement nor opine on the propriety of that decision.

Second, the Panel finds that the additional fact advanced by the Complainant that the registration for one of the domain names in dispute in *Public Storage 1*, which is not before the Panel in the present matter, *i.e.* <publicstorage-phoenix.com>, has expired, coupled with its asserted impact on the prior decision, as immaterial and thus clearly insufficient to justify re-filing. Since that domain name registration expired and has not been renewed by the Respondent, the prior denial of its transfer to the Complainant is now irrelevant.

Any party dissatisfied with a UDRP decision has the right, under paragraph 4(k) of the Policy, to institute litigation against its opponent through a national court of competent jurisdiction. Generally, through such litigation, the court will disregard the prior UDRP decision and proceed, under guiding principles of national law, to a *de novo* review of the dispute at hand. Under the particular circumstances of record here, the Complainant's path for redress from *Public Storage 1* does not lie through this Panel but rather through a timely filed litigation before a United States District Court having competent jurisdiction over the Respondent.

As the Panel has fully decided this proceeding based on procedural grounds, the Panel will dispense with any discussion of the substantive elements set forth in paragraph 4(a) of the Policy as being moot.

6. Decision

Accordingly, the Panel denies the relief sought by the Complainant. The Complaint is dismissed.

Peter L. Michaelson
Presiding Panelist

Michael A. Albert
Panelist

Maxim H. Waldbaum
Panelist
Dated: August 21, 2012