

**.ie Alternative Dispute Resolution  
NETNEUTRALS DISPUTE RESOLUTION SERVICE**

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**Decision of Independent Specialist**

**Case Number: 709**

**1. The Parties:**

<b>Complainant:</b>	<b>James Leahy on behalf of Bike to Work Limited</b>
<b>Respondent:</b>	<b>Gaurav Garg</b>

**2. The Domain Name(s):**

<b>biketoworkscheme.ie</b>	<b>(“the Domain Name”)</b>
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**3. Procedural History:**

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

The procedural history is as follows:

<b>Action</b>	<b>Comment / date</b>
<b>Dispute received</b>	15 <sup>th</sup> November 2023
<b>Complaint validated</b>	15 <sup>th</sup> November 2023
<b>Notification of complaint sent to Complainant</b>	18 <sup>th</sup> November 2023
<b>Notification of complaint sent to Respondent</b>	18 <sup>th</sup> November 2023
<b>Forum Opened</b>	21 <sup>st</sup> November 2024
<b>Complaint Form received</b>	28 <sup>th</sup> November 2023
<b>Response received</b>	4 <sup>th</sup> December 2023
<b>Forum Closed</b>	2 <sup>nd</sup> January 2024
<b>Adjudication Started</b>	3 <sup>rd</sup> January 2024
<b>Adjudication Decision Posted</b>	4 <sup>th</sup> January 2024
<b>Specialist Decision published</b>	5 <sup>th</sup> January 2024

#### **4. Factual Background**

The Complainant is Bike to Work Ltd, registered in Ireland No. 464697, with a website at biketowork.ie. The Complainant is holder of Irish registered trademarks for Bike to Work and Bike2Work, references 245872 and 242275. The Complainant provides administration services for Irish companies to administer a Government tax relief called the Cycle to Work Scheme.

The Respondent registrant is director of Pogo Enterprises Limited, registered in Ireland no. 709225. Pogo Enterprises is an online bicycle retailer competing in the same market as the Complainant, via the website biketoworkscheme.ie.

#### **5. Parties' Contentions**

##### **Complaint**

A summary of the Complaint is as follows:

The Complainant complains, in summary, that the Respondent's use of the biketoworkscheme.ie website in direct competition with the Complainant is in breach of its registered trademarks, in bad faith, and has negatively impacted on it such that the domain registration should be revoked and the domain transferred to the Complainant.

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**Response**

A summary of the Response is as follows:

The Respondent responds that:

1. The website at biketoworkscheme.ie expressly disclaims any connection with the Complainant;
2. The words Bike to Work are generic and cannot be trademarked;
3. The words Bike to Work are in widespread use and may be found on Citizens' Advice and Revenue websites;
4. The Respondent has warranty obligations to customers which would be jeopardised if the domain name were revoked;
5. Pogo Enterprises Ltd's logo appears on all company invoices so there can be no confusion with the Complainant;
6. The Respondent has no intent to infringe the Complainant's trademark;
7. The domain name includes the word "scheme" which distinguishes it from the Complainant, and the word 'scheme' is in widespread use;
8. The Respondent 'is a genuine cycle shop which has nothing to do with (sic) patent infringement but planning to run a successful bike to work *scheme* program.'
9. The Complainant's trademark is "biketowork". The Respondent is not infringing on the trademark has no intention to confuse the Complainant's customers but the Respondent does 'want to setup our voucher scheme as well and hence we have mentioned the "scheme".'

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## 6. Discussions and Findings

The burden of proving a complaint under the ADRP is on the Complainant.

Matters to be proved:

### Complaint Submission

The Complainant has proved in accordance with .ie ADR Policy that...

	<ul style="list-style-type: none"><li>the Complainant would ordinarily be eligible to register the domain name in question if it was not already registered by the Registrant. This means that the complainant must prove its identity and it must prove that it has a substantive connection with the island of Ireland. If the complainant has other .ie domains registered in their own name this requirement is satisfied automatically; and</li></ul>
	<ul style="list-style-type: none"><li>the Complainant has rights in the domain name or in marks or identifiers very similar to it, or that the Complainant's rights have been negatively impacted by the registration, and</li></ul>
	<ul style="list-style-type: none"><li>the registration of the domain should be revoked as it has been registered or used abusively or in bad faith.</li></ul>

### General

	<ul style="list-style-type: none"><li>the Complainant would ordinarily be eligible to register the domain name in question if it was not already registered by the Registrant, and</li><li>the Complainant has rights in the domain name or in marks or identifiers very similar to it, or that the Complainant's rights have been negatively impacted by the registration, and</li><li>the registration of the domain should be revoked as it has been registered or used abusively or in bad faith.</li></ul>
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### Complainant's Rights

The meaning of "Rights" is defined in the .ie ADR Policy as follows:

	<ul style="list-style-type: none"><li>the Complainant has rights in the domain name, or in marks or identifiers very similar to it (sufficiently close to the domain that there would be a strong likelihood of confusion), or that the Complainant's rights have been negatively impacted by the registration. Any legal right or entitlement can be considered, including but not limited to:</li></ul>
	<ul style="list-style-type: none"><li>Trade and service marks protected in the island of Ireland, or</li></ul>
	<ul style="list-style-type: none"><li>Personal names (including pseudonyms) by which the Complainant is commonly known or has acquired a reputation in on the island of Ireland, or</li></ul>
	<ul style="list-style-type: none"><li>Geographical indications that can prima facie be protected in the island of Ireland,</li></ul>
	<ul style="list-style-type: none"><li>Unregistered rights acquired through use; and the registration of the domain should be revoked as it has been registered or used abusively or in bad faith.</li></ul>

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***Complainant Rights Negatively Impacted***

The Complainant rights are negatively impacted by the domain registration or use as shown by:

	<ul style="list-style-type: none"><li>• The domain name registration or use is misleading or confusing to its customers, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name registration or use is commercially damaging to its business through activities such as passing-off, content scraping or impersonation, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name is being used to circulate defamatory material relating to the Complainant, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name is being used for the purpose of making unauthorised use of material in which the Complainant has a copyright or another protected interest</li></ul>

***Domain Used or Registered Abusively or in Bad Faith***

.ie ADR Policy defines “Abusively Registered” as:

***Abusively registered*** refers to a Domain Name which was registered or used to take unfair advantage of or was unfairly detrimental to the Complainant's Rights;

The domain has been registered or is being used Abusively or in Bad Faith by the Registrant as evidenced by:

	<ul style="list-style-type: none"><li>• The domain name was registered or is being used with the primary purpose of selling or renting it specifically to the Complainant (or a competitor) for more than the Registrant paid for it, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name was registered or is being used with the primary purpose of preventing the Complainant registering a name or mark in which the Complainant has rights, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name was registered or is being used with the primary purpose of unfairly disrupting or interfering with the Complainant’s business, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name is being used in a way that is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name was registered or is being used for an unlawful purpose (e.g. it is engaging in suspected fraudulent activity, engaging in other criminal/illegal online activity), or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name is registered to a company which currently has a dissolved company trading status, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name is being used to facilitate the circulation of defamatory or racist material, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name is registered to a Registrant which does not have (and never had) a connection to the island of Ireland, or</li></ul>

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	<ul style="list-style-type: none"><li>• The domain name was registered as a result of a relationship between the Complainant and the Registrant, and the Complainant<ul style="list-style-type: none"><li>a) has been using the Domain Name registration exclusively; and</li><li>b) paid for the registration and/or renewal of the Domain Name registration; or</li></ul></li></ul>
	<ul style="list-style-type: none"><li>• Failure by the Registrant to use the Domain Name for the purposes of email or a web site, the Registrant offering a domain name for sale, or use of domain parking services that may include advertising related to the keyword content of the domain name are not of themselves evidence of abuse or bad faith, however the Specialist may consider these issues in combination with other factors when deciding a case.</li></ul>

**The Complainant has established:**

The Complainant has established that the Complainant would ordinarily be eligible to register the domain name in question if it was not already registered by the Registrant.

The Complainant has established that the Complainant has rights in the domain name or in marks or identifiers very similar to it, specifically Irish Registered Trade Marks no. 245872 and no. 242275.

The Complainant has established that the domain name is used in bad faith - specifically, that the Respondent registrant has, through its use of the domain name, intentionally attempted to attract Internet users to a web site or other on-line location by creating confusion with a protected identifier in which the Complainant has rights.

The Complainant has further established that the domain name is used in a way that is likely to dilute the reputation of a trade or service mark in which the Complainant has rights, including by generating quotes through the website for e-bikes which are not eligible for tax relief under the Revenue Cycle to Work Scheme, creating confusion about the Complainant's trademarked trade and services.

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**Domain Holder Response**

**Showing that a Registration is not Abusive or in Bad Faith**

The Registrant may provide information to counter any statements within the complaint and can submit its own evidence to show that its registration and/or use of the domain is not unreasonable, including but not limited to demonstrating any of the factors below:

	<ul style="list-style-type: none"><li>• The Registrant has established rights in the domain name, or in marks or identifiers very similar to the domain name including but not limited to:</li></ul>
	<ul style="list-style-type: none"><li><ul style="list-style-type: none"><li>○ Trade and service marks protected in the island of Ireland, or</li></ul></li></ul>
	<ul style="list-style-type: none"><li><ul style="list-style-type: none"><li>○ Personal names (including pseudonyms) by which the Complainant is commonly known or has acquired a reputation in on the island of Ireland, or</li></ul></li></ul>
	<ul style="list-style-type: none"><li><ul style="list-style-type: none"><li>○ Unregistered rights acquired through use.</li></ul></li></ul>
	<ul style="list-style-type: none"><li>• Prior to any notice of the dispute, the Registrant used the domain name or a name reasonably corresponding to the Domain Name in connection with a bona fide offering of goods or services or made demonstrable preparations for such use, or</li></ul>
	<ul style="list-style-type: none"><li>• The Registrant (as an individual, business, or other organization) has been commonly known by the domain name or similar name, even in the absence of a registered trademark, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name is generic or descriptive and the Registrant is making fair use of it, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name is being used solely for tribute or criticism, or</li></ul>
	<ul style="list-style-type: none"><li>• The domain name contains or references the Complainant's mark but the Registrant is making fair use of it.</li></ul>

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**The Registrant has established:**

The Respondent registrant made no attempt to establish and has not established that it has established rights in the domain name, or in marks or identifiers very similar to the domain name.

The Respondent registrant made no attempt to establish and has not established that prior to any notice of the dispute, the Registrant used the domain name or a name reasonably corresponding to the Domain Name in connection with a bona fide offering of goods or services or made demonstrable preparations for such use.

The Respondent registrant made no attempt to establish and has not established that the Registrant (as an individual, business, or other organization) has been commonly known by the domain name or similar name, even in the absence of a registered trademark.

The Respondent registrant has attempted to argue that the domain name is generic or descriptive and that the Registrant is making fair use of it. Specifically, the Registrant has argued that the words Bike to Work are in common and widespread usage; and that the word 'Scheme' in the domain name distinguishes the domain from the trademark owned by the Complainant. However, the Complainant has successfully trademarked the words "Bike to Work" and, moreover, the trademarks in question expressly apply trademark protection to schemes in multiple contexts, providing expressly that the trademark extends to [emphasis added]:

*"Class: 9*

*Computer software and programs relating to promotional vouchers and incentive schemes; data and databases recorded on data carriers; electronic credit cards; electronic debit and discount cards; electronic publications; electronic vouchers; encoded cards and cards bearing machine readable information; magnetic cards; recording equipment; smart cards; **software relating to the organisation, operation, management and supervision of sales and of promotional vouchers schemes, incentive schemes, benefits and perks schemes, employees benefits packages, employee motivation schemes, loyalty schemes, promotional programmes and promotional services**; telecommunications apparatus and equipment; parts and fittings for all the aforesaid goods.*

*Class: 12*

*Bicycle wheels; parts for bicycles.*

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*Class: 16*

*Banner stands being advertising signboards; bicycle frame stickers; booklets; brochures; business cards; cards, tokens and vouchers for payment or part-payment of bicycles, bicycle leasing and hiring services or bicycle related services; cards, **vouchers and tokens for use in connection with sales, promotional voucher schemes, incentive schemes, benefits and perks schemes, employee benefits packages, employee motivation schemes, loyalty schemes, promotional programmes and promotional services;** catalogues; credit cards [other than encoded or magnetic]; diaries; discount cards; display advertising material; greetings cards; identity cards; instructional and teaching material; leaflets; letter heads; magazines; newsletters; pamphlets; posters; printed cards; printed forms; printed matter; printed plastic cards; printed publications; promotional material; publications; purchase cards and vouchers; stationery; stickers; vehicle stickers and signs; vouchers; window stickers.*

*Class: 35*

*Accounting and database management services; administration of contracts; **administration of registration services for government benefit schemes;** advertising services; book-keeping and accounting services; business administration services; business assistance, administration, advice, management and consultancy; business information; business management; business performance auditing; business planning; business research services; call centre services; computerised record keeping; data processing services; demonstration of goods; direct mail advertising; distribution and dissemination of advertising and promotional material; document reproduction services; **operation of employment benefit schemes; retail services relating to bicycles and accessories; managing the sale of bicycles and bicycle related goods from employers to employees at the end of a hire, rental or lease period;** market and qualitative research services; office functions; operation and supervision of promotional incentive and voucher schemes; operation of telephone call centre services; ordering services; **organisation, operation and supervision of an incentive scheme provided for employees in order to encourage them to commute to work by bicycle; organisation, operation, management and supervision of a scheme for employers for the provision, hire, rental and sale of bicycles and accessories; organisation, operation, management and supervision of sales and of promotional voucher schemes, incentive schemes, benefits and perks schemes, loyalty schemes, employees benefits packages, staff motivation schemes, promotional programmes and promotional services;** organising, arranging and conducting exhibitions or trade fairs for business, marketing and promotional purposes; procurement services; promotional services; provision of information related to tax; provision of information relating to accounts; provision of promotional services; provision of sales information and sales advice concerning bicycles, cycling equipment and accessories; provision of statements of account; **registration and administration services for company promotional schemes;** tax assessment preparation; tax consultancy and planning services; the administration of registration services for electronic payment cards; information, advice and consultancy services in relation to the aforesaid services.*

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*Class: 36*

*Administration of financial affairs; banking; credit, debit and charge card services; discount card services; finance services; finance services relating to rental, leasing or hiring of bicycles; financial advice relating to taxation; financial and monetary services; financial payment services; financial planning and investment advisory services; financial research; financial services; financial settlement services; insurance services; issue and redemption of tokens and vouchers; issuing of printed and electronic retail vouchers; **operation and management of discount and savings schemes**; payment card and debit card services; payroll services; **provision of financial services to support voucher and benefit schemes**; information, advisory and consultancy services relating to all the aforementioned services.*

*Class: 39*

*Bicycle leasing, renting and hiring services; information, advisory and consultancy services relating to all the aforementioned services.*

*Class: 42*

*Computer software design and development and maintenance; creating, developing and maintaining Internet websites for others; hosting an Internet website.”*

In the circumstances, the Registrant has not established that the domain is generic or descriptive and that the Registrant is making fair use of it.

It is of note, in the context of the underlined words above, that the website at [biketoworkscheme.ie](http://biketoworkscheme.ie) nonetheless expressly provides (04/01/2024) “Bike To Work Scheme. The Bike to Work Scheme is to encourage more employees to cycle to and from work, or between workplaces.”

The Registrant has not attempted to establish and has not established that the domain name is being used solely for tribute or criticism.

The Registrant has not acknowledged that the domain name contains or references the Complainant’s mark; however, to the extent to which the words in the Complainant’s mark are used in the domain name, the Registrant has argued that it is making fair use of them by answering a common question (do you offer the bike to work scheme?) and by disclaiming expressly in the first line of its website that it has no connection with [Biketowork.ie](http://Biketowork.ie) and [Travelhub](http://Travelhub) (i.e. the Complainant). However, the remainder of the website advertises the Registrant’s products and services for sale in (by the Registrant’s own acknowledgement) direct competition with the Complainant. Drawing customers to its website using the Complainant’s protected identifiers in order to compete directly with the Complainant does not constitute fair use. Accordingly, the Registrant has not established that the complainant is making fair use of the Complainant’s mark.

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**I therefore readily conclude:**

The Complainant would ordinarily be eligible to register the domain name BiketoWorkScheme.ie if it was not already registered by the Registrant.

The Complainant has rights in the domain name or in marks or identifiers very similar to it.

The registration of the domain should be revoked as it has been used abusively or in bad faith.

**7. Decision**

The domain name shall be transferred to the Complainant.

**Signed: G Brian Hutchinson**

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**Dated: 4 January 2024**

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