

.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE

Decision of Independent Specialist

Case Number: 627

1. The Parties:

Complainant:	Insolvency Service of Ireland
Registrant:	BT Communications Ireland Ltd.

2. The Domain Name(s):

isi.ie	("the Domain Name")
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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:

Action	Comment / date
Dispute received	25 th November 2021
Complaint validated	25 th November 2021
Notification of complaint sent to Complainant, including Complaint Form and Rules	29 th November 2021
Notification of complaint sent to Domain Holder, including Response Form and Rules	29 th November 2021
Reminder sent to Registrant	12 th and 17 th January 2022
Invoice sent to Complainant	29 th November 2021
Case Fees paid by Complainant	20 th December 2021
Forum Opened	21 st December 2021
Complaint Form received	24 th December 2021
Response Form received	18 th January 2022
Adjudication Requested	28 th January 2022
Adjudication Decision	30 th January 2022
Specialist decision posted	1 st February 2022

4. Factual Background

The Complainant is a statutory body established under the Personal Insolvency Act 2012.

The Registrant is a telecommunications service provider.

The IEDR Whois database indicates that the domain name was registered on 3 April 1997. (The Registrant, which is also the registrar, indicates that it was first registered in 1995 but nothing turns on this point.)

The domain name was initially registered in the name of Horizon Technical Services Ltd. and following a series of mergers and acquisitions has been in the control of the Registrant since 2000. The Registrant uses the domain name for nameservers as part of its network management.

The registration remained in the name Horizon Technical Services Ltd. until 26 November 2021 when the Registrant updated the Whois database to record it as the registrant. Horizon Technical Services Ltd. was dissolved as of 9 April 2017.

5. Parties' Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant states that:

- It is known by the term ISI in its advertising and publicity material.
- It would like to have the isi.ie domain name as its website URL as it will be unable to use the www.isi.gov.ie domain from next year for technical reasons.
- The isi.ie domain name does not have an active website on it.
- It contacted the Registrant (as registrar for the domain name) on 15 November 2021 seeking transfer of the domain name.
- The Registrant replied on 23 November that the domain name was used for internal purposes and would not be released.
- The domain name was at that point registered to Horizon Technical Services Ltd., which was a dissolved company, and the Registrant has not demonstrated that it acquired ownership of the domain name.
- The Complainant registered a dispute with the IEDR on 25 November 2021.
- The Registrant transferred the domain to itself on 26 November 2021.
- The domain name was registered or used abusively in the that transfer was done with the sole purpose of satisfying the IEDR registration criteria and to avoid being registered to a dissolved company or a company with no ties to Ireland.

Response

A summary of the Response is as follows:

The Registrant states that:

- The domain name was registered and actively in use by BT and its corporate predecessors since 1995, 18 years before the Complainant was established.
- The initial registrant Horizon Technical Services Ltd. was a fully owned subsidiary of Horizon Technology Group Ltd. which was acquired by ESAT Telecommunications Ltd. in 1997, and ESAT Technologies Ltd. was in turn acquired by the Registrant in 2000. Control of the domain name was transferred to the Registrant as part of these transactions.
- The re-registration of the domain merely updates the records to reflect the true status of the domain.
- The domain has and continues to be used for the Registrant's ns.isi.ie nameservers, and is relied upon by 300 customers and 500 isi.ie related domains.
- Transfer of the domain would require formal notice for each affected customer, of up to three months, updating of the Registrant's RIPE objects, and tens of thousands of euro in terms of employee hours to complete this work.
- The Registrant's sector is entirely unrelated to the Complainant.
- There is no evidence of any confusion between the Complainant and Registrant.
- The Registrant has not disrupted the business of the Complainant in any way.
- The Complainant's requirement to move from their existing domain is due to its own technical issue and is nothing to do with the Registrant.
- The Complainant does not hold a trademark in the term ISI, which is an informal and inconsistently used abbreviation of its formal name.

6. Discussions and Findings

Under paragraph 4.1 of the Alternative Dispute Resolution Policy ("ADRP") the burden of proof is on the Complainant who must prove three elements, specifically that:

A. the Complainant would ordinarily be eligible to register the domain name in question if it was not already registered by the Registrant, and

B. the Complainant

- (i) has rights in the domain name or in marks or identifiers very similar to it, or
- (ii) the Complainant's rights have been negatively impacted by the registration, and

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

A. Complainant Eligibility to Register the Domain Name

The Complainant is an Irish statutory body and would be eligible to register the domain name if it was not already registered.

B. Complainant's Rights in the Domain Name

(i) Rights in the domain name or in marks or identifiers very similar to it

Paragraph 4.1.B(i) of the ADRP defines the term "rights" as follows:

Any legal or other enforceable right can be considered, including but not limited to:

- Trade and service marks protected in the island of Ireland, or
- Personal names (including pseudonyms) by which the Complainant is commonly known or has acquired a reputation in on the island of Ireland, or
- Geographical indications that can prima facie be protected in the island of Ireland,
- Unregistered rights acquired through use.

In this case the Complainant does not have a trade mark, service mark, personal name or protected geographic indicator. In order to succeed the Complainant must therefore establish an "unregistered right acquired through use" or some other "legal or enforceable right".

The Complainant has failed to specify in its complaint what right it claims to have.

Taking the Complainant's case at its highest, the only right which would appear to be available to it would be an action for passing off. While there has been some dispute as to when public bodies can maintain a passing off action, for the purpose of this decision it will be assumed that the plaintiff can do so if it demonstrates the necessary goodwill (compare the judgment of the General Court of 18 November 2015 in case T-508/13 *Government of Malaysia v. OHIM* ECLI:EU:T:2015:861, para.38).

The standard for a passing off action in this context is that the complainant runs a business on the island of Ireland and has goodwill in this business, and that the unregistered trade mark is a distinctive identifier of that business. (See Case No. DIE2013-0002, *Budget Energy Limited (Budget Energy ROI) and Budget Energy Limited (Budget Energy NI) v. Prepay Power Limited.*)

For guidance regarding whether there is the necessary goodwill and whether an unregistered trade mark is a distinctive identifier the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") can be taken into account except where the .IE policy or Irish law differ (see e.g. Case No. DIE2019-0001, *Puma SE v. Stephen Connell, Puma Transport Ireland Limited*).

Paragraph 1.3 of the WIPO Overview 3.0 provides as follows:

What does a complainant need to show to successfully assert unregistered or common law trademark rights?

To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of

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advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

(Particularly with regard to brands acquiring relatively rapid recognition due to a significant Internet presence, panels have also been considering factors such as the type and scope of market activities and the nature of the complainant's goods and/or services.)

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.

The Complainant has provided evidence of significant use of the term "ISI" on its website, advertising materials, annual reports, and other publications. While it has not identified the specific market in which it may hold goodwill (for example, among citizens generally or practitioners in the insolvency industry) nor has it put forward specific evidence (such as surveys) showing that the actual extent of recognition, I will assume for the sake of this decision that it has the necessary goodwill and the term is a distinctive identifier so that consumers in the relevant market would associate the term with it.

(ii) Complainant's rights negatively impacted by registration

It is not necessary to consider the alternative ground that the Complainant's rights have been negatively impacted by the domain registration.

C. Domain Used or Registered Abusively or in Bad Faith

Under paragraph 4.1 of the ADRP the Complainant must prove that "the registration of the domain should be revoked as it has been registered or used abusively or in bad faith". These terms are defined in paragraph 1 of the ADRP which provides as far as relevant that:

"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; [and]

"Bad Faith" means a domain name which was registered or used without legitimate intent, and/or to engage in deceptive conduct [...]

Paragraph 4.1.C of the ADRP includes a non-exhaustive list of examples which may provide evidence of abuse and bad faith. As far as is relevant to this case it provides that:

A Complainant can demonstrate that the domain has been registered or is being used Abusively or in Bad Faith by the Registrant if it can provide evidence that [...]

The domain name is registered to a company which currently has a dissolved company trading status; or [...]

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The domain name is registered to a Registrant which does not have (and never had) a connection to the island of Ireland, or

Paragraph 4.1 further provides that:

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.

Finally, paragraph 4.2.A provides, as far as relevant, that a Registrant can demonstrate that a registration is not abusive or in bad faith if:

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 essence of the Complainant's case is that the domain name was used in bad faith or its transfer and reregistration was abusive as (at the time the complaint was submitted) the domain was registered to a company which had been dissolved and therefore did not have a connection to the Ireland of Ireland. This position, in effect, relies entirely on the two quoted examples in paragraph 4.1.C of the ADRP.

Paragraph 4.1.C, however, is not a free standing provision and merely provides examples of situations which may support a finding of abusive registration or bad faith as defined in paragraph 1 of the ADRP. In this case the Complainant has not engaged with the paragraph 1 definitions. It has not provided any evidence that the domain name was "abusively registered" within the definition of paragraph 1, i.e. that it "was registered or used to take unfair advantage of or was unfairly detrimental to the Complainant's Rights". Nor has the Complainant put forward any ground for showing "bad faith" within the meaning of paragraph 1, i.e. that the domain name "was registered or used without legitimate intent, and/or to engage in deceptive conduct". The uncontradicted evidence of the Registrant is that it acquired control of the domain name as part of a series of acquisitions and has used it on an uninterrupted basis for many years, and there is no credible basis to infer "abusive registration" or "bad faith" from what could at most be described as an administrative oversight. I therefore find that the Complainant has not met its burden of proof to establish that the domain name has been registered and used in bad faith.

It is, therefore, not strictly necessary for me to consider the factors set out in paragraph 4.2.A. Nevertheless, it is a serious matter for a state body to accuse a private company of acting in bad faith and abusively, so for the avoidance of any doubt I specifically find that the Registrant and its corporate predecessors have used the domain name for the purposes of network administration services from at least 1997, long before the Complainant was established, and that no evidence of any sort has been put forward to suggest any bad faith, abuse, or any form of interference with the Complainant's rights. I also note that the Complainant has suggested that the Registrant still does not have proper ownership of the domain name. Specifically, the Complainant states in its response that "I do not see anything to suggest that the ownership of the isi.ie website domain [sic] was purchased by BT or an associated entity

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as part of the liquidation process”. Again, it is a serious allegation to suggest that a private company may be using an asset which it is not entitled to, and it is therefore unfortunate that the Complainant does not appear to be aware of paragraph 3.6.2.vi of the .IE Namespace Policy which specifically permits the transfer of domain registrations of dissolved or struck off registrants to a party which acquired the business assets of the registrant prior to dissolution or strike off, subject to a verification process with supporting documentation.

7. Decision

For the foregoing reasons the Complaint is denied.

Signed: **Dr. TJ McIntyre**

Dated: **30 January 2022**