

.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE

Decision of Independent Specialist

Case Number: 631

1. The Parties:

Complainant:	Activity Nation Limited
Registrant:	Jorge Oliveira

2. The Domain Name(s):

activitynation.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	21 st January 2022
Complaint validated	21 st January 2022
Notification of complaint sent to Complainant	24 th January 2022
Notification of complaint sent to Respondent	24 th January 2022
Forum Opened	25 th January 2022
Complaint Form received	7 th February 2022 and 25 th February 2022
Response received	8 th February 2022
Forum Closed	3 rd March 2022
Adjudication Started	4 th March 2022
Adjudication Decision Posted	4 th March 2022
Specialist Decision published	4 th March 2022

4. Factual Background

The Complainant is a limited company, no. 604445, which provides outdoor and adventure activities for adults and children.

The Registrant is a private individual resident in Ireland.

The domain name was initially registered by the Complainant in 2012 and since then has been the main contact point for the Complainant through website and email. The domain was allowed to lapse in 2021 through inadvertence.

The domain name was registered by the Registrant on 27 September 2021.

The Complainant (through its web designer Owen McHale) contacted the Registrant on 27 November 2021 to discuss repurchase of the domain name and discussions by email took place on 1 and 2 December 2021. On 2 December 2021 the Registrant offered to sell the domain to the Complainant for €4,500.

Since registration the Registrant has used the domain name as follows:

2 December 2021 (12:30): A WordPress blog which used RSS feeds to display content from various news sites.

2 December 2021 (16:02): A prebuilt generic website for a personal trainer service.

2 December 2021 (16:16): A blank landing page.

2 December 2021 (16:38): A for sale page asking €4,500 for the domain.

2 December 2021 (18:11): A landing page stating that a website on fitness is coming soon.

11 January 2022 (20:08): The domain does not resolve to any host.

5. Parties' Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant states that:

- It carries on business as Activity Nation, has done so continuously since 2010 and is known by that name to customers, suppliers and business partners.
- The Registrant purchased the domain name immediately after it became available for re-registration.
- The Registrant purchased the domain in bad faith for the sole purpose of reselling it at an inflated price.
- The Registrant's holding of the domain name has caused it to suffer business disruption by losing contacts with customers and others, and has caused it harm in search rankings.

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- By posting fitness content the Registrant is causing confusion to Activity Nation customers regarding their business.
- The Registrant initially offered on a telephone conversation to transfer the domain to it for €450 but then increased the asking price on the same day to €4,500.
- The Registrant's claim that he intended to set up a fitness website is not credible as the initial use of the site was to display random news from sites such as Independent.ie; the Registrant did not put any fitness content onto the site until after increasing his asking price to €4,500.
- The fact that the Registrant entirely changed the web content hosted at the domain name several times in the space of the afternoon of 2 December (after contact with the Complainant and increasing his asking price) shows that he is very technologically capable and undermines his arguments that he was not aware of the previous use of the domain and that the news content initially hosted on the website was put up inadvertently.

Response

A summary of the Response is as follows:

The Registrant states that:

- He registered the domain name "with the intention of creating a blog on physical/exercise/wellness/mindfulness activities".
- He "bought it legally, obviously after a cool down period within which there's a three months grace period before any domain becomes available publicly to which the claimant voluntarily did not avail of".
- The domain name was automatically suggested to him by the registrar's website "when searching for 'activity news' domains to register" and when seeking to register "activity.ie".
- He was not aware of the previous use of the domain name.
- His project has nothing to do with the previous use and purpose of the domain name.
- His first use of the domain name to display news was "probably due to research and testing of" blog plugins and add-ons "in an initial phase" and "often themed websites come prepopulated with content, homepage designs and advertising spaces by default".
- He is not infringing the copyright or any intellectual property right of the Complainant.

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 a company registered in Ireland 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. (While it has a registered business name, this is not sufficient.) In order to succeed the Complainant must therefore establish an “unregistered right acquired through use” or some other “legal or enforceable right”. In general this requires the Complainant to show that it could bring a passing off action in respect of the use of the domain name.

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.*)

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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 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 “Activity Nation” since 2010 in its advertising, brochures, invoices, and previous use of its website, and the Registrant has not challenged this evidence nor argued that the term is generic. I accept therefore that the Complainant has rights in the domain name for the purpose of the ADRP.

(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:

- 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
- 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
- The domain name was registered or is being used with the primary purpose of unfairly disrupting or interfering with the Complainant's business, or
- 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,

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.

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.

In this case the Complainant alleges that the Registrant registered the domain name abusively or in bad faith for the purpose of reselling it to the Complainant at a profit. The fact that the domain was purchased immediately after the grace period for re-registration lapsed and that the Registrant sought to resell the domain to the Complainant for €4,500 provide significant support for this allegation.

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The Registrant asserts that he was not aware of the previous use of the domain and he used the domain himself in preparation for a fitness related website. If accepted, these would be sufficient factors to defeat the allegation of bad faith registration. However these assertions depend on the credibility of the Registrant and there are significant factors undermining that credibility.

First, the Registrant asserts that he did not originally plan to register the domain name and that it was suggested to him by the registrar. It would be a remarkable coincidence for this precise domain name to be suggested to him at the same moment as the grace period for re-registration lapsed. Elsewhere in his submissions he shows that he is familiar with the grace period for re-registration, lending support to the argument that he knew of the prior registration and was waiting for the grace period to expire. His submissions on this point are also inconsistent and undermine his argument: at one point he states that he sought to register “activity.ie” while at another he states that he was searching for terms related to “activity news”.

Second, the Registrant claims that the domain name was acquired to set up a fitness website. However the Registrant has not provided any evidence of any fitness related preparations before this dispute arose and did not take any steps towards this until after contacted by the Complainant. The Registrant states that the initial use of the domain to display Irish newspaper news feeds was “probably due to research and testing of” blog plugins and add-ons “in an initial phase”. I note that the Registrant does not explicitly state why the site was initially configured in this way and relies on the caveat “probably”. Similarly the Registrant states that “often themed websites come prepopulated with content, homepage designs and advertising spaces by default”. Again I note that the Registrant relies on the weasel word “often” and is not willing to state that this was actually true in his case, and in any event it is improbable that a themed website would come fully populated with Irish newspaper newsfeeds by default.

Third, I note that on 2 December 2021, following contact with the Complainant, the Registrant changed the contents of the website shown at the domain name entirely on several occasions, including displaying a prebuilt (off the shelf) generic personal trainer website, a for sale page, and eventually a “coming soon” web page. These rapid changes are not consistent with his having made prior preparations to set up a fitness website and I accept that they are more consistent with an attempt to manufacture a story to retrospectively explain the purchase of the domain name. They also show considerable technical expertise on the part of the Registrant, such that the Registrant would have been capable of identifying and sniping an expiring domain.

I therefore find that the Registrant registered the domain name for the primary purpose of selling or renting it specifically to the Complainant (or a competitor) for more than the Registrant paid for it.

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7. Decision

For these reasons the Complaint is upheld and I direct that the domain name be transferred to the Complainant.

Signed: Dr. TJ McIntyre

Dated: 4 March 2022
