

.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE

Decision of Independent Specialist

Case Number: 549

1. The Parties:

Complainant:	Christopher Simms for Nagook Limited
Respondent:	Robert Doyle for PLAYBLUE LIMITED

2. The Domain Name(s):

Bondara.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	19 th August 2019
Complaint validated	19 th August 2019
Notification of complaint sent to parties	17 th September 2019
Forum Opened	19 th September 2019
Complaint Form received	20 th September 2019
Response Form received	30 th September 2019 Initial response was 24 th September 2019
Forum Closed	7 th October 2019
Adjudication Started	10 th October 2019
Adjudication Decision Posted	17 th October 2019
Adjudication Decision accepted / rejected	
Specialist Decision published	28 th November 2019

4. Factual Background

Complainant Nagook Ltd is a limited company registered in England and Wales on 27 November 2006 and trading online in adult toys and lingerie.

Respondent Playblue Limited is a limited company registered in Ireland on 10 May 2012 and trading online in adult toys and lingerie.

Complainant holds since 15 January 2008 a European Community Trade Mark in the mark “Bondara” and it trades exclusively under this brand. The Trade mark number is 005603667 -

<https://euipo.europa.eu/eSearch/#basic/1+1+1+1/100+100+100+100/005603667>

Respondent registered the domain name Bondara.ie on 6 March 2018 and is registered as the current holder of the domain.

Respondent caused the name Bondara to be registered as an Irish Registered Business Name on 23 August 2019.

There are no ongoing or terminated legal proceedings in relation to the domain name.

5. Parties’ Contentions

Complaint

A summary of the Complaint is as follows:

Complainant claims that the Respondent has registered and or used the domain name Bondara.ie in bad faith, negatively impacting the complainant’s rights in the Complainant’s trade mark Bondara.

Complainant seeks transfer of the domain name bondara.ie to the Complainant.

Response

A summary of the Response is as follows:

Respondent claims:

That Respondent did not know of the existence of the Complainant at the time of registration;

That Respondent had and has plans to use the domain for a business separate and distinct from its adult toy sales business – namely a wellness - fitness service;

That Respondent’s choice of the name Bondara for its new business venture was a coincidence and that the words Bon Dara are derived from Hebrew meaning “Live Well” which was found after searching Google.

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That when Respondent learned of Complainant's trademark, Respondent immediately pointed the domain away from the Respondent's adult toy sales website to a blog site having nothing to do with the adult toy sales business so as not to infringe the Complainant's trademark;

That Complainant has no business or brand awareness in Ireland;

That Complainant could have and should have acquired the domain name in any time prior to 2018;

That Respondent is not Cybersquatting or infringing Complainant's trade mark;

That Respondent has not acted abusively;

That the registration and or use of the domain name is not in accordance with a contract between Complainant and Respondent and no such contract or any contract exists between them;

That Respondent has recently caused the name Bondara to be registered in Ireland as a Registered Business Name in favour of a separate entity; and

That these proceedings are unfair in that the Complainant is a large UK based business versus a small Irish business and in that the Complainant is acting unfairly in bringing these proceedings when it could have registered the domain itself at any time prior to the Respondent registering the domain name.

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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">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
	<ul style="list-style-type: none">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
	<ul style="list-style-type: none">the registration of the domain should be revoked as it has been registered or used abusively or in bad faith.

General

	<ul style="list-style-type: none">the Complainant would ordinarily be eligible to register the domain name in question if it was not already registered by the Registrant, and
	<ul style="list-style-type: none">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
	<ul style="list-style-type: none">the registration of the domain should be revoked as it has been registered or used abusively or in bad faith.

Complainant's Rights

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

	<ul style="list-style-type: none">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:
	<ul style="list-style-type: none">Trade and service marks protected in the island of Ireland, or
	<ul style="list-style-type: none">Personal names (including pseudonyms) by which the Complainant is commonly known or has acquired a reputation in on the island of Ireland, or
	<ul style="list-style-type: none">Geographical indications that can prima facie be protected in the island of Ireland,
	<ul style="list-style-type: none">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.

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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">• The domain name registration or use is misleading or confusing to its customers, or
	<ul style="list-style-type: none">• The domain name registration or use is commercially damaging to its business through activities such as passing-off, content scraping or impersonation, or
	<ul style="list-style-type: none">• The domain name is being used to circulate defamatory material relating to the Complainant, or
	<ul style="list-style-type: none">• 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

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">• 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
	<ul style="list-style-type: none">• 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
	<ul style="list-style-type: none">• The domain name was registered or is being used with the primary purpose of unfairly disrupting or interfering with the Complainant's business, or
	<ul style="list-style-type: none">• 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
	<ul style="list-style-type: none">• 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
	<ul style="list-style-type: none">• The domain name is registered to a company which currently has a dissolved company trading status, or
	<ul style="list-style-type: none">• The domain name is being used to facilitate the circulation of defamatory or racist material, or
	<ul style="list-style-type: none">• The domain name is registered to a Registrant which does not have (and never had) a connection to the island of Ireland, or

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	<ul style="list-style-type: none">• 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">a) has been using the Domain Name registration exclusively; andb) paid for the registration and/or renewal of the Domain Name registration; or
	<ul style="list-style-type: none">• 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.

The Complainant has established:

Complainant has proved its identity and has proved through its VAT registration and other evidence including advertising that it has a substantive connection with and business on the island of Ireland. It has proved therefore that it would be eligible to register the domain name had it not already been registered by Respondent.

Complainant has proved, through its registered trade mark and its established brand, that it has rights in the domain name or in marks or identifiers very similar to it.

Complainant has also established that its rights to exploit its trademark have been negatively impacted by the registration of the domain name by Respondent.

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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">• 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:
	<ul style="list-style-type: none"><ul style="list-style-type: none">○ Trade and service marks protected in the island of Ireland, or
	<ul style="list-style-type: none"><ul style="list-style-type: none">○ Personal names (including pseudonyms) by which the Complainant is commonly known or has acquired a reputation in on the island of Ireland, or
	<ul style="list-style-type: none"><ul style="list-style-type: none">○ Unregistered rights acquired through use.
	<ul style="list-style-type: none">• 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
	<ul style="list-style-type: none">• 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
	<ul style="list-style-type: none">• The domain name is generic or descriptive and the Registrant is making fair use of it, or
	<ul style="list-style-type: none">• The domain name is being used solely for tribute or criticism, or
	<ul style="list-style-type: none">• The domain name contains or references the Complainant's mark but the Registrant is making fair use of it.

The Registrant has established:

The Registrant / Respondent has established that it holds a Registered Business Name identical to the domain name since 23 August 2019.

Registrant / Respondent has not established that it had any other rights in the name prior to that apart from those it enjoyed as registered holder of the domain name.

Registrant / Respondent has admitted that the name was and is covered by the Complainant's trade mark for adult toys and lingerie sales activities.

Registrant has not established a bona fide offering of goods or services connected to the use of the name prior to notice of the dispute. Registrant has admitted directing the domain name to its online adult toys and lingerie sales site prior and immediately up to notice of the dispute.

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Registrant / Respondent has not supplied convincing evidence of an activity or business outside of the online adult toys and lingerie sales area, apart from expressing an aspiration and intention to establish a subscription wellness service.

However, even if Respondent / Registrant did provide further evidence of such activity, Respondent has already admitted to using the domain name in a manner which constitutes use in bad faith – namely, directing the name to its own online adult toys and lingerie sales site at a time when it could not credibly have not known of the Complainant's existence and brand in a market or activity in which they had contemporaneously traded for up to 6 years previously.

I therefore readily conclude:

I conclude on the evidence before me that the Registrant / Respondent has registered and used the domain name bondara.ie, in which the Complainant has rights, abusively and in bad faith, either with the primary purpose of preventing the Complainant registering the name; or with the primary purpose of unfairly disrupting or interfering with the Complainant's business, or 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 in a combination of all of the above.

Critically, and by its own admission, Respondent / Registrant used the domain name to direct traffic to its own site in the same area of activity as the Complainant. Complainant has further proved that this redirect occurred.

It stretches credibility too far to believe that the Respondent could not have known about the existence of or brand of the Claimant at the time of registration; indeed, Respondent admits searching Google at the time leading up to registration for the words Bon Dara which would likely have returned the Complainant's website in the search results ahead of any Hebrew phrases. Even if that search did not return the Complainant's brand, the proposition that the Respondent, through no more than naïve coincidence, registered a domain identical to the Complainant's brand, on the basis that it means "Live Well" in Hebrew, and then redirected the name to its own online adult toys and lingerie sales site, is too far-fetched to believe.

When confronted with the Complainant's EU trade mark in the domain name it appears that the Registrant / Respondent then sought to continue keep the domain name out of the Complainant's reach by arguing that it was and is intended for a bona fide use in a different business. However, this business has not been established; scant evidence of plans for its establishment has been supplied; and Registrant / Respondent's earlier use of the domain name to direct traffic to its own site strongly suggests a different intent for the domain name.

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7. Decision

The domain bondara.ie shall be transferred to the Complainant.

Signed: G Brian Hutchinson BCL LLM DAL FCI Arb BL

Dated: 17 October 2019
