

.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE

Decision of Independent Specialist

Case Number: 598

1. The Parties:

Complainant:	Paul Colton for Screenguard Ireland Limited
Registrant:	Daithi O'Loughlin for The Other Side Limited

2. The Domain Name(s):

screenguard.ie	("the Domain Name")
----------------	---------------------

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	1 July 2020
Complaint validated	2 July 2020
Notification of complaint sent to Complainant	2 July 2020
Notification of complaint sent to Registrant	2 July 2020
Reminder sent to Registrant	21 and 28 July 2020 – no response
Phone call to Registrant	21 and 28 July 2020 – no reply Message received on 31 July looking for sign in details
Forum Opened	10 July 2020
Complaint Form received	10 July 2020
Response Form received	Response received 4 August
Forum Closed	Planned for 31 July 2020 but extended to 5 August to allow parties to participate fairly
Adjudication Started	6 August 2020
Adjudication Decision Posted	13 August

.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE

Action	Comment / date
Adjudication Decision accepted / rejected	
Specialist Decision published	14 August

4. Factual Background

The Complainant is an Irish registered company, number 73190, registered on 17 January 1980. On 16 January 1992 it registered the business name Screenguard but it has traded under that name since before that date. It is the owner of the domain name screenguard.com, registered on 23 October 2015, which it uses for the website of its business installing and maintaining security and access controls, including thermal scanning systems for detecting COVID-19.

On 6 June 2020 Paul Colton, the Managing Director of the Complainant, applied for a trade mark in its logo, which is a graphical representation of the term Screenguard (registration number 263207) and that trade mark has been accepted for registration in classes 9 (for security cameras; automatic security barriers; security control apparatus; security surveillance apparatus) and 10 (for fever thermometers).

The Registrant is an Irish registered company, number 653682, registered on 18 July 2019. On 27 April 2020 it registered the domain name screenguard.ie, which it uses for the website of its business supplying plexiglass screens, face visors and related products aimed at preventing the spread of COVID-19.

5. Parties' Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant states that there has been confusion between it and the Registrant, with customers contacting the Complainant to say that they have sent messages to screenguard.ie which have not been replied to, or have placed orders on screenguard.ie which have not been fulfilled. The Complainant states that the Registrant has infringed its trade mark and business name and that it is losing internet traffic to screenguard.ie. While the Registrant does not directly compete with the Complainant, the Complainant states that it has indirectly lost sales due to customers going to screenguard.ie by mistake.

Response

A summary of the Response is as follows:

The Registrant states its products are different to those of the Complainant, that it did not seek to benefit from the reputation of the Complainant, and that its logo and website are entirely different from those of the Complainant. It also states that screen guard is a commonly used and generic term for Perspex screens to prevent transmission of COVID-19.

6. Discussions and Findings

Matters to be proved:

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 company 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 “right”, so far as relevant, to provide that:

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 [...]
- Unregistered rights acquired through use.

Trade mark

In this case the trade mark relied upon by the Complainant has been accepted for registration but is not yet registered and therefore may not be relied upon for any infringement proceedings (section 13(4) Trade Marks Act 1996). Consequently, I find that the Complainant has not established that it has an enforceable right by virtue of the trade mark application.

In addition, I note that the application for the trade mark is in the name of its Managing Director rather than the Complainant itself and while the Managing Director has referred to the trademark as belonging to the Complainant there has been no evidence that the trade mark has been transferred to the Complainant or that the Complainant has been authorised to bring a complaint under the mark (compare Case No. DAE2017-0005, *Leminar Air Conditioning Industries LLC v. Husain Bhabhrawala*, noting that panels “expect parties to provide relevant evidence of authorization to file a UDRP complaint”).

.ie Alternative Dispute Resolution

NETNEUTRALS DISPUTE RESOLUTION SERVICE

Unregistered rights acquired through use

To establish an unregistered right, a complainant must show that it would be entitled to bring an action for passing off in relation to the disputed domain name. This in turn requires 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 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.

.ie Alternative Dispute Resolution

NETNEUTRALS DISPUTE RESOLUTION SERVICE

In this case the Complainant has provided evidence that it has traded under the name Screenguard since prior to 1992 and has provided evidence of its Google Business and LinkedIn pages, but has not provided any other evidence which would tend to show either distinctiveness or market reputation (such as evidence regarding volume of sales, extent of advertising, public recognition or consumer surveys).

Consequently, I find that the Complainant has not met its burden of showing that it would be entitled to bring an action in passing off in respect of the term Screenguard and therefore has not shown that it has an unregistered right acquired through use in the term.

(ii) Complainant's rights negatively impacted by registration

Although the Complainant has not established that it has rights in the domain name or in marks or identifiers very similar to it, I must consider the alternative ground that its rights (in a more general sense) have been negatively impacted by the domain registration.

"Negatively impacted" is defined in paragraph 1 of the ADRP to mean "an adverse effect on the Complainant or their commercial interests arising from the registration or use of the Domain Name to the existing Registrant". Para. 4.1.B.ii goes on to provide examples of negative impact. It provides, as far as relevant, that:

A Complainant may submit a complaint if it can show its rights are negatively impacted by the domain registration or use. It can do this by showing:

- The domain name registration or use is misleading or confusing to its customers, or
- The domain name registration or use is commercially damaging to its business through activities such as passing-off, content scraping or impersonation [...]

The Complainant has stated that:

We have been contacted by our customers complaining that they have left messages on the Screenguard.ie website for us to which we haven't responded. I also attach an email message chain from a PropMeUp client who came through to us complaining about not receiving products. This email chain clearly shows the company passing off as "Screen Guard Ireland". [...]

I cannot comment on how many of our potential clients have gone to the Screenguard.ie website on seeing our advertising either online or in print but I am sure this is happening to some extent.

While it is plausible that some customers may be confused between the websites at screenguard.com and screenguard.ie, the Complainant has provided evidence of only one case of confusion notwithstanding its statement that it has received complaints from several customers. In addition, the two websites are very different in their layout, colour scheme,

logos, and product range offered and there is no evidence of any passing off, content scraping or impersonation, nor any evidence of concrete commercial damage. I therefore find that the Complainant has not met its burden of proof to establish the alternative ground that its rights are negatively impacted by the domain registration or use.

C. Domain Used or Registered Abusively or in Bad Faith

As the Complainant has not established that it has “rights in the domain name or in marks or identifiers very similar to it”, or that its “rights have been negatively impacted by the registration” it is not strictly necessary to consider the final element of the ADRP regarding abuse or bad faith. Nevertheless, for the sake of completeness I will address this point briefly.

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 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 of abuse and bad faith, and so far as relevant provides as follows:

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 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 [...]

The Complainant alleges that the Registrant has acted wrongfully in choosing and operating an extremely similar domain name to its own:

- When the Registrant’s own company name was different; and
- Without carrying out a basic free Companies Registration Office search which was a “minimum level of due diligence for any investment and branding decision” and “would have highlighted trademark issues”.

However it must be stressed that the registration of a company name, business name or domain name does not in itself grant any proprietary rights (see Robert Clark, Shane Smyth, and Niamh Hall, *Intellectual Property Law in Ireland* (Bloomsbury Academic, 2016), pp. 673-675) and does not enable the registrant to veto any other use of that name. Similarly,

.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE

ownership of a domain name in one top level domain (such as .com) does not in of itself entitle a registrant to any rights over the same name in other top level domains (such as .ie) and it is common for the same term to be owned by different entities under different top level domains. Consequently it is not correct for the Complainant to say that the Registrant should have been aware of trade mark issues by carrying out a Companies Registration Office search, nor would use of the same name in itself constitute abusive or bad faith behaviour even if the Registrant was aware of the .com variant of the name.

In addition, it must be noted that the Complainant's trade mark was applied for only after the Registrant registered screenguard.ie. Consequently the trade mark must be disregarded in determining whether the registration was abusive or in bad faith. In any event, the trade mark is limited to products in classes 9 (specifically security cameras; automatic security barriers; security control apparatus; security surveillance apparatus) and 10 (specifically fever thermometers) – even if the trade mark were already registered, it is unclear on what basis the Complainant alleges that the Registrant could infringe a trade mark in those classes by selling products which appear to be from other trademark classes.

Apart from the statement that the Registrant should have carried out a Companies Registration Office search, the Complainant has not put forward any matters tending to show abuse or bad faith as exemplified in Paragraph 4.1.C of the ADRP. Nor is it inherently likely that the Registrant chose to register the domain name to “disrupt or interfere with the Complainant's business” or to “confuse people into believing that it is connected with the Complainant” in circumstances where the Complainant and Registrant sell very different products and the Registrant uses an entirely different logo and site design. The fact that both companies are involved in preventing COVID-19 is not in itself enough to show confusion, much less abuse or bad faith. The Complainant has therefore not shown either that the domain name was “registered or is being used with the primary purpose of unfairly disrupting or interfering with the Complainant's business” or that it 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”.

I therefore find that the Complainant has not met its burden of proof to establish that the domain name has been registered or used abusively or in bad faith.

.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE

7. Decision

For the foregoing reasons the Complaint is denied.

Signed: TJ McIntyre

Dated: 12 August 2020