

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

---

**Decision of Independent Specialist**

**Case Number: 602**

**1. The Parties:**

<b>Complainant:</b>	Superprof SAS
<b>Registrant:</b>	Laurence Patrick O'Neill

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

superprof.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	3 <sup>rd</sup> September 2020
Complaint validated	3 <sup>rd</sup> September 2020
Notification of complaint sent to Complainant	3 <sup>rd</sup> September 2020
Notification of complaint sent to Registrant	3 <sup>rd</sup> September 2020
Reminder sent to Registrant	29 <sup>th</sup> September and 5 <sup>th</sup> October 2020 – no response
Phone calls to Registrant	7 <sup>th</sup> September 2020 15:15 – No Reply 8 <sup>th</sup> September 2020 15:55 – Domain Holder will participate, name is Patrick Laurence O'Neill 7 <sup>th</sup> October 2020 16:00 – Woman answered, she will pass on message. Colm O'Neill returned call around 17:00 and stated that he will participate but it may be Friday afternoon before he posted his response.
Forum Opened	11 <sup>th</sup> September 2020
Complaint Form received	21 <sup>st</sup> September 2020

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

Action	Comment / date
Response Form received	9 <sup>th</sup> October 2020
Forum Closed	9 <sup>th</sup> October 2020. Extended to 13 <sup>th</sup> October 2020.
Adjudication Started	14 <sup>th</sup> October 2020
Adjudication Decision Posted	20 <sup>th</sup> October 2020
Adjudication Decision accepted / rejected	
Specialist Decision published	21 <sup>st</sup> October 2020

#### 4. Factual Background

The Complainant, SUPERPROF SAS is a French company operating in the educational technology sector, providing a portal called “superprof” where tutors and teachers can advertise and promote their services and connect with students in 29 or more countries. The Complainant was incorporated on 7 July 2011 and is the holder of the registered trademark “Superprof” in France, the European Union, the United States and Australia.

The Registrant, identified as Laurence Patrick O’Neill on the register, and represented in the Forum in these proceedings by Colm O’Neill, is a family business engaged in the import and sale of hand tools for use in the construction industry for 50 years.

The Complainant plans to launch a website expanding its services to the Irish market by the end of October 2020. Negotiations between the parties regarding purchase of the domain by the Complainant from the Registrant were not conclusive. The Complainant thus initiated these proceedings requesting that the domain be transferred to the Complainant.

#### 5. Parties’ Contentions

##### Complaint

A summary of the Complaint is as follows:

The Complainant argues that it would ordinarily be eligible to register the domain name in question if it was not already registered by the Registrant; that it 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 that the Registrant has registered or is using the domain name abusively or in bad faith.

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

---

**Response**

A summary of the Response is as follows:

The Registrant argues that registration was not abusive or in bad faith and that the domain was registered in connection with the distribution of Super Prof hand tools, which it distributes in Ireland on behalf of Super Prof BV, a Dutch company.

# **.ie Alternative Dispute Resolution**

## **NETNEUTRALS DISPUTE RESOLUTION SERVICE**

---

### **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></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>

#### **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>

## .ie Alternative Dispute Resolution NETNEUTRALS DISPUTE RESOLUTION SERVICE

---

### ***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>

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

	<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 it would ordinarily be eligible to register the domain name in question if it was not already registered by the Registrant; it has supplied certificates of incorporation to prove its name and identity, and it has furnished evidence of its activity in the Irish market to prove that it has a substantive connection with the island of Ireland.

The Complainant has further established that it has rights in the domain name or in marks or identifiers very similar to it; it has supplied copies of the “Superprof” trade-mark registrations in the European Union.

The Complainant has established that its rights have been negatively impacted by the registration or use of the domain name; it has supplied proof to show that the domain name registration or use is misleading or confusing to its customers, and that it will be costly for the Complainant to counteract such confusion.

The Complainant has not established that the domain name was registered by the Registrant abusively or in bad faith.

The Complainant has established, however, that the domain name is being used – as far as these proceedings are concerned - in bad faith; the Complainant has pointed to the Registrant’s failure to make any use of the domain name to link it to the Super Prof tool it was intended to promote, nor to take any steps to protect the brand in Ireland for such use, whilst maintaining the site as a showcase site of the type commonly presented for speculative sale.

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

---

**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>

**The Registrant has established:**

The Registrant has not established that it holds any rights in the domain name, nor in marks or identifiers very similar to the domain name.

The Registrant has not established that, prior to any notice of the dispute, the Registrant used the domain name in connection with a bona fide offering of goods or services or had made demonstrable preparations for such use.

The Registrant showed no evidence to support its professed plans to use the domain name to promote Super Prof tools, and the site linked to the domain remains a showcase site. The Registrant referred to other sites it operates in support of the contention that there was an intent to promote Super Prof tools using the domain name. However, those sites are not dedicated to any single brand in the way that the proposed site would be, they are tool sale websites offering tools across a range of brands – including Super Prof tools. The Respondent has not therefore shown a practice of establishing Irish domains for brands it sells, it has not provided evidence of any other brands it has acquired

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

---

domains for, and it has supplied no other evidence to prove its professed intent to use the domain to promote Super Prof tools, such as an agreement with Super Prof NL.

The Registrant has not established that it is known or identified with the Domain name, or that that it is making fair use of the Complainant's mark.

**I therefore readily conclude:**

The Registrant is using the domain name in bad faith so far as these proceedings are concerned. The domain name is comprised of the Complainant's Trade Mark and the Registrant, having no rights in the mark, has made no use of the domain name and has not supplied sufficient evidence of a legitimate existing or future use by the Registrant for the domain name, nor of a legitimate entitlement to use the Complainant's mark.

**7. Decision**

The domain name shall be transferred to the Complainant.

**Signed:      Brian Hutchinson**

---

**Dated:        20/10/2020**

---