

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

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**Decision of Independent Specialist**

**Case Number: 611**

**1. The Parties:**

<b>Complainant:</b>	Skywire Ltd.
<b>Registrant:</b>	Sinisa Bonaca

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

skywire.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	5 <sup>th</sup> November 2020
Complaint validated	5 <sup>th</sup> November 2020
Notification of complaint sent to Complainant	6 <sup>th</sup> November 2020
Notification of complaint sent to Registrant	6 <sup>th</sup> November 2020
Reminder sent to Registrant	10 <sup>th</sup> November 2020 – re complaint posted 17 <sup>th</sup> November 2020
Phone calls to Registrant	24 <sup>th</sup> November 2020 – Phone call, domain holder agreed to engage and will post in the next few days
Letter sent to Registrant	
Forum Opened	9 <sup>th</sup> November 2020
Complaint Form received	9 <sup>th</sup> November 2020
Response Form received	27 <sup>th</sup> November 2020
Forum Closed	30 <sup>th</sup> November 2020
Adjudication Started	1 <sup>st</sup> December 2020

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Action	Comment / date
Adjudication Decision Posted	4 <sup>th</sup> December 2020
Specialist Decision published	4 <sup>th</sup> December 2020

#### 4. Factual Background

The Complainant is an Irish registered company, number 457661, specialising in website design and e-commerce. It held the domain name skywire.ie until July 2020 when it allowed the domain name to lapse. The domain name was registered later in July 2020 by the Registrant who is a taxi driver and buys and sells domains.

#### 5. Parties' Contentions

##### Complaint

A summary of the Complaint is as follows:

The Complainant submits that:

- Skywire Ltd. has been registered in Ireland since 2008 and has traded under the name Skywire since then.
- It has held a UK trademark on the term Skywire since 2009.
- It also holds the same term as a domain name in other TLDs including the corresponding .co.uk, .uk, .co, .eu and .info domains.
- Until July 2020 skywire.ie was used to redirect to the .co.uk domain.
- The Complainant allowed the domain to lapse due to inadvertence as a result of the COVID-19 pandemic.
- The domain name was registered by the Registrant for the purpose of reselling it to the Complainant at a profit.
- The Registrant listed the domain for sale after registering it and has a portfolio of other domains for sale.

##### Response

A summary of the Response is as follows:

The Registrant submits that:

- He has not had any contact with the Complainant.
- He purchased the domain for use in his public service vehicle/taxi business and has created a landing page for his business at skywire.ie.
- He did not attempt to resell the domain.
- The term skywire is generic and held by other registrants in other TLDs which shows that registrants can co-exist with similar names but different businesses.
- The Complainant is not running an active business in the Republic of Ireland.

## **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”, as far as relevant to this case, providing 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***

A UK trade mark would, ordinarily, be a mark “protected in the island of Ireland” even if not in the Republic of Ireland. In this case, however, of the two trade marks relied upon by the Complainant one has expired (UK00002522041) and the other is still under examination (UK00003553711). Consequently, I find that the Complainant has not established that it has an enforceable right by virtue of these trademarks.

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#### *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.

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The Complainant has provided evidence that it has traded under the name Skywire since 2008 and has provided evidence of its main website, online portfolio and LinkedIn page. However the Registrant argues that the term skywire is not inherently distinctive and notes that there is a wide range of businesses using this term online. This is supported by the Complainant's own evidence of a Google search on the term "skywire.ie" in which only 8 of the top 50 search results relate (directly or indirectly) to the Complainant, despite the search relating to a domain name which was until July 2020 owned by it. The Complainant has not produced specific evidence of sales, advertising, public recognition or surveys which would tend to show that the term is a distinctive identifier so that consumers in the relevant market would associate the term with it.

In addition, it is unlikely that the Complainant could maintain a passing off action *on the island of Ireland*. As Clark, Smyth and Hall note "[t]he basic principle upon which the courts traditionally operate is that the plaintiff must establish goodwill within the jurisdiction in which relief is sought" (Robert Clark, Shane Smyth, and Niamh Hall, *Intellectual Property Law in Ireland* (Bloomsbury Academic, 2016), p.639). While the Complainant is a company registered in Ireland, the evidence it has put forward indicates that its operations are based in London and it predominantly serves clients in Great Britain, and does not establish that it has clients in either jurisdiction in Ireland, or that it otherwise has goodwill amongst Irish businesses. It is significant in this regard that the Complainant used Skywire.ie to redirect visitors to its .co.uk site rather than as an independent website.

On balance, therefore, 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 the island of Ireland in respect of the term skywire and therefore the Complainant has not shown that it has an unregistered right acquired through use in the term.

#### ***(ii) Complainant's rights negatively impacted by registration***

I now turn to the alternative ground that the Complainant's rights more generally 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, or

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- The domain name is being used to circulate defamatory material relating to the Complainant, or
- 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 .

The Complainant has not put forward any evidence of customer confusion, commercial damage, defamatory material or unauthorised use of material and 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. However, as this point was argued by the Complainant and the Registrant at some length I will address it here.

Under paragraph 4.1 of the ADRP the Complainant must in every case 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 as far as is relevant to this case 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 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

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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 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 argues that the domain was registered by the Registrant in bad faith in that it was registered for the purpose of reselling it to the Complainant at a profit. In support of this the Complainant submits that the Registrant listed the domain for sale on Dan.com shortly after registering it, that his LinkedIn profile describes him as a “Domain Industry Publisher and dn Trader”, and that he holds a number of domains such as mango-tree.com, funeralhome.ws, advise.ie and rx.ie which are unrelated to any business he might run.

The Registrant argues that he purchased the domain for the purpose of his taxi business only and did not intend to resell it. He argues that the domain was held at Dan.com only until he was able to set up a landing page for his business, and that the domain does now show such a page. He argues that he has invested funds in the business by registering the domain and creating the landing page.

I do not find the Registrant’s submissions on these points credible. The term skywire does not bear any obvious relation to public transport and does not support his contention that the domain was purchased for his taxi business. By his own account he is an experienced domainer and I do not accept his apparent submission that he listed the domain for sale on Dan.com inadvertently. He has not provided any evidence as to how or when he invested any money in establishing a website and the fact that a basic landing page was put up after this dispute arose does not provide any support for his submissions.

Nevertheless it is important to note that offering a domain for resale is not itself evidence of abuse or bad faith unless the domain was registered or is being used “with the primary purpose of selling or renting it specifically to the Complainant” (ADRP, paragraph 4.1.C). The purchase and onward sale of valuable domains which have lapsed may appear to be sharp practice but is not in and of itself prohibited by the ADRP. In this case the Complainant was not contacted by the Registrant offering to sell the domain, and the Complainant has not provided any evidence that the Registrant intended to sell the domain to a competitor. The Registrant has provided evidence that the term skywire is a common one in several industries and I accept that there would be a range of possible purchasers for the domain, not merely

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the Complainant or a competitor. While the Complainant has provided evidence that the Registrant owns a range of domains for resale, the domains mentioned (such as advise.ie) are generic and do not support an inference that the Registrant has engaged in a pattern of purchasing domains for resale to their original owners. Even taking into account the Registrant's lack of candour in these proceedings, it is not possible to infer that the domain was registered either abusively or in bad faith within the meaning of paragraph 1 of the ADRP. Consequently the Complainant has not met its burden of proof of establishing that the Registrant registered the domain abusively or in bad faith.

## **7. Decision**

For the foregoing reasons the Complaint is denied.

**Signed:**      **TJ McIntyre**

**Dated:**      **3 December 2020**