

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

Decision of Independent Specialist

Case Number: 670

1. The Parties:

Complainant:	FTI Consulting Management Solutions Limited
Registrant:	All Island Media Limited

2. The Domain Name(s):

distinct.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	6 th January 2023
Complaint validated	6 th January 2023
Notification of complaint sent to Complainant	9 th January 2023
Notification of complaint sent to Registrant	9 th January 2023
Phone calls to Registrant	24 th January 2023 25 th January 2023
Forum Opened	10 th January 2023
Complaint Form received	11 th January 2023
Response received	6 th February 2023
Forum Closed	16 th February 2023
Adjudication Started	17 th February 2023
Adjudication Decision Posted	20 th February 2023
Specialist Decision published	20 th February 2023

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4. Factual Background

The domain was registered in 2005 by Distinct Business Consulting Ltd. which was subsequently acquired by the Complainant. The domain was used by the Complainant to host a website for some time, but at some point prior to 2021 was permanently redirected (HTTP 301) to the Complainant's website at fticonsulting.com.

The complainant continued to use the domain for email. The Complainant failed to renew its registration in November 2021 and the Registrant registered the domain in January 2022. The domain does not appear to have resolved to a website until October 2022. At that point it resolved to a default WordPress 'Hello World' page which has remained in place since.

5. Parties' Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant submits that:

- The domain was allowed to lapse by accident.
- The 'Distinct Intelligence Business' and Distinct brand are associated with its business.
- The domain is the primary email domain for all company related digital communications.
- There are privacy and data protection risks, security risks, and business retention risks due to email communications sent to @distinct.ie email addresses, which are no longer arriving to the Registrant.
- The Registrant has not demonstrated any legitimate relationship to the brand or name 'Distinct'.

Response

A summary of the Response is as follows:

The Respondent states that:

- 'The Domain Complaint Summary submitted is a total non-sequitur with respect to whether the 'Domain is Used or Registered Abusively or in Bad Faith'. It contains not one single specimen of evidence addressing any single of the nine points of the required consideration as set out at 1.2. of the Complaint Form.'

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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. I accept that it 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. 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.*)

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

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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 only very limited evidence of use of the term ‘Distinct’ in its previous website, in the form of one screenshot from 2007, and has not provided any evidence of current use. I therefore find that the Complainant has not established ‘rights in the domain name’ for the purpose of the ADRP.

(ii) Complainant’s rights negatively impacted by registration

Para 4.1.B(ii) of the ADRP provides 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
- The domain name is being used to circulate defamatory material relating to the Complainant, or

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- 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 provided any evidence on any of these points. It has stated that there is an impact on its business from the loss of email traffic to its previous @distinct.ie email addresses. However it has not provided any evidence of such impact beyond the assertion that there are potential 'privacy and data protection risks', 'service and brand disruption risks' and 'loss of business and customer communications'.

I therefore find that the Complainant has not shown that its rights are negatively affected by 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 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 relevant 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, 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'

The Complainant has not put forward any evidence tending to show abusive registration or bad faith. The Complainant relies on the fact that the Registrant has not made use of the domain name. However, I note that paragraph 4.1.C of the ADRP provides that this is not of itself evidence of abuse or bad faith. In addition, the Complainant states that 'the current owner of this domain has not demonstrated any legitimate relationship to the brand or name "Distinct".' However, this is to misunderstand the burden of proof under the ADRP. It is for the Complainant to demonstrate abuse or bad faith, not for the Registrant to demonstrate

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any particular entitlement to the domain name.

I therefore find that the Complainant has not established abuse or bad faith and I do not need to consider any further points which might be made by the Registrant under paragraph 4.2.A.

7. Decision

For these reasons the complaint is dismissed.

Signed: Dr. TJ McIntyre

Dated: 17 February 2023
