

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

Decision of Independent Specialist

Case Number: 688

1. The Parties:

Complainant:	Limelight Public Relations Limited
Registrant:	Tool Domains OOD

2. The Domain Name(s):

petsinthecity.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	14 th April 2023
Complaint validated	14 th April 2023
Notification of complaint sent to Complainant	17 th April 2023
Notification of complaint sent to Registrant	17 th April 2023
Reminder sent to registrant	16 th May 2023
Phone calls to registrant	
Letter sent to registrant	
Forum Opened	25 th April 2023
Complaint Form received	25 th April 2023
Response received	26 th April 2023
Forum Closed	24 th May 2023
Adjudication Started	25 th May 2023
Adjudication Decision Posted	26 th May 2023
Adjudication Decision accepted / rejected	
Specialist Decision published	26 th May 2023

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4. Factual Background

The Complainant is a public relations agency which has organised an annual Pets in the City festival in Dublin from 2014 onwards on behalf of Dublin City Council. It registered the business name "Pets in the City" (no. 525966) and the domain name in 2014 and has hosted an associated website each year thereafter with the exception of 2020, 2021 and 2022 which were disrupted by COVID. In August 2022 the Complainant inadvertently allowed the domain to lapse.

The domain name was then registered in November 2022 by the Registrant, which is a well known domain name trader and domain name research provider.

At the time of the complaint the domain name resolved to a landing page offering to sell the domain and containing generic pet related advertisements.

Following the complaint the Registrant offered to sell the domain name to the Complainant for "a cost covering fee" but this was not taken further by the parties.

5. Parties' Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant alleges that:

- The term pets in the city has been associated with its festival since 2014 with extensive media coverage each year.
- The domain name was primarily registered for the purpose of selling it to the Complainant at a price greater than the registration fee, as evidenced by the fact that it is listed for sale and is not being used for any purpose other than a generic pet advertising landing page.
- Individuals visiting the domain name are likely to be confused that it is affiliated with the Complainant.
- The Registrant has no connection with Ireland.
- The Registrant has previously been found to have acted in bad faith in numerous domain name dispute resolution procedures across a range of TLDs including in the .ie space.

Response

A summary of the Response is as follows:

The Respondent did not submit a substantive response.

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6. Discussions and Findings

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:

- Unregistered rights acquired through use.

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 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,

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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.

A registered business name does not itself satisfy this criterion. However the Complainant has provided evidence that it has organised the Pets in the City festival since 2014, including examples of flyers, sponsorship brochures and extensive media coverage in local and national newspapers. I accept the Complainant's evidence and find that it has the necessary goodwill. I also accept the term is a distinctive identifier so that consumers in the relevant market would associate the term with it, so that it has an unregistered right acquired through use.

(ii) Complainant's rights negatively impacted by registration

It is not necessary to consider the alternative ground that the Complainant's rights have been negatively impacted by the domain registration.

C. Domain Used or Registered Abusively or in Bad Faith

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 [...]

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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, 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, or [...]
- The domain name is registered to a Registrant which does not have (and never had) a connection to the island of Ireland, or

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 primarily argues that the domain was registered or used by the Registrant in bad faith for the purpose of reselling it to the Complainant at a profit.

In considering this argument I take into account the following factors:

- The Registrant did not contact or seek payment from the Complainant prior to the complaint. However it did offer to sell the domain through the hosting page, and, following the complaint, for costs incurred. While an offer to sell a domain for out of pocket costs would normally be evidence of good faith, in this case it should be given less weight as it came only after the complaint.
- Drop-catching expired domain names is not mentioned in the ADRP as a factor demonstrating bad faith and is not itself proof of bad faith. However a number of UDRP panels have found that in the case of drop-catching the registrant is necessarily aware that the domain name was previously held by another party and this should put

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the registrant on notice that the earlier registrant may still have rights. See e.g. Case No. D2018-0540, *Supermac's (Holdings) Limited v. Domain Administrator*, and Case No. D2020-0509 *Town of Secaucus, New Jersey v. Martina Zammit*. Without necessarily accepting the full extent of that argument, in the present case I accept that it is reasonable to infer that the Registrant was aware that the complainant might have rights particularly as the Registrant has not offered any evidence to the contrary. I take into account also the fact that the domain name is not generic and would most likely only have value to the Complainant.

- There is no evidence to show any use of the domain name in connection with a bona fide offering of goods or services.
- There is no evidence of any connection to the island of Ireland.
- The Complainant argues that the Registrant has an extensive track record of registering domain names in bad faith and that this should be taken into account. The Complainant refers to my earlier ADRP decision in *Seapointleisure.ie* in which I summarised a number of UDRP and other cases involving the Registrant as showing that: “these cases show a blatant and ongoing pattern of bad faith registration and use of domain names on the part of Tool Domains Ltd. including the registration of prominent international trademarks and the names of financial institutions, with the pattern of bad faith continuing even after the initiation of a dispute resolution process”. The Complainant also refers to other cases such as Case No. DNU2020-0001, *Skyscanner Limited v. Metodi Darzev, Tool Domains Ltd* which found a pattern of bad faith over a number of cases. While acknowledging that every case must be taken on its own merits, this past pattern of behaviour must be taken into account in assessing whether the Registrant acted in bad faith in this case, particularly as the Registrant has not offered any argument or evidence to the contrary.

While the Registrant has not made any submissions, I have taken into account the possible arguments which might be made in its favour under Article 4.2.A of the ADRP and have concluded that none of these apply.

For these reasons I find that the domain has been registered abusively and in bad faith.

7. Decision

For the foregoing reasons the Complaint is upheld and I direct that the domain name be transferred to the Complainant.

Signed: **Dr. TJ McIntyre**

Dated: **25 May 2023**