

DISPUTE RESOLUTION SERVICE

D00020151

Decision of Independent Expert

Fitness Anywhere LLC/ Fitness Anywhere UK Ltd. (TRX)

and

Hey.co.uk Ltd

1. THE PARTIES:

Lead Complainant: Fitness Anywhere LLC/ Fitness Anywhere UK Ltd. (TRX)
Fitness Anywhere UK Ltd
6 St. Andrew Street 5th Floor
London
EC4A 3AE
United Kingdom

Respondent: Hey.co.uk Ltd
122 Chester Road
Wrexham
Wrexham
LL11 2SN
United Kingdom

2. THE DOMAIN NAME(S):

trx.co.uk

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.

30 April 2018 21:01 Dispute received

01 May 2018 10:41 Complaint validated

01 May 2018 10:46 Notification of complaint sent to parties

02 May 2018 15:15 Response received
02 May 2018 15:15 Notification of response sent to parties
03 May 2018 08:15 Reply received
03 May 2018 08:16 Notification of reply sent to parties
03 May 2018 08:28 Mediator appointed
09 May 2018 10:07 Mediation started
16 May 2018 15:17 Mediation failed
16 May 2018 15:17 Close of mediation documents sent
29 May 2018 02:30 Complainant full fee reminder sent
01 June 2018 12:06 No expert decision payment received
13 June 2018 02:30 Respondent full fee reminder sent
13 June 2018 12:07 No expert decision payment received
13 June 2018 12:08 No expert decision payment received
13 June 2018 16:53 Expert decision payment received

4. FACTUAL BACKGROUND

The Complainant asserts that it has over the last 11 years offered its products and services in the fitness sector under the trade mark 'TRX', including via the website located at www.TRXtraining.co.uk to UK consumers. It is the proprietor of the following trade mark registrations affording rights in the UK:

WE1204587	TRX	Class 42	8.04.2015
WE939207	TRX	Classes 28/41	8.08.2008

The Respondent asserts that it is in the business of buying, selling and monetising generic domain names. In 2006 the Respondent acquired nine three letter .co.uk domain names including the Domain Name. The Domain Name has been inactive since it was acquired, save for a message on a holding page that includes the following:

"trx.co.uk This is our generic holding page for all our & some client names. Hey.co.uk Ltd develops premium domain names & brands. Some of our names are for sale ..."

On 26 April 2018, the Complainant contacted the Respondent by email to ask whether it could acquire the Domain Name. This led to an exchange, which culminated in an offer by the Respondent to sell the Domain Name and TRX.uk for a combined price of £4,000. The offer was not accepted and the DRS Complaint in these proceedings was subsequently filed.

5. Parties' Contentions

a. The Complaint

The Complainant contends that it has Rights as a result of the registered trade marks that it owns and the extent of its trading, and that the Domain Name is an Abusive Registration because it is causing the Complainant's customers to mistakenly make an association with the Complainant when they search for it online and visit the page to which the Domain Name is directed.

There is no evidence that the Respondent has used the Domain name for any bona fide purpose, but rather they are cyber-squatting and intend to profit when the lawful trade mark owner or another interested party wants to purchase the Domain Name.

b. The Response

The Respondent contends that the Domain Name was registered prior to the trade marks that the Complainant relies upon and the first use of the Complainant's TRXtraining.co.uk domain name. The Domain Name was purchased legitimately and the Respondent had no knowledge of the Complainant at that time.

The letters TRX are used by numerous businesses as part of their name and are not specific to the Complainant.

The Respondent also contends that the Complainant has knowingly used the DRS in bad faith knowing that it had no proper grounds of complaint and seeks a finding of Reverse Domain Name Hijacking.

c. The Reply

The Complainant asserts that the Respondent has failed to establish a legitimate business interest in having an inactive domain name that includes the Complainant's trade mark or denied that the Complainant has such rights. It again asserts that the Respondent's unauthorised use impacts the Complainant's business adversely and that its offer to purchase the Domain Name was made in good faith.

6. Discussions and Findings

a. General

To succeed in this Complaint, the Complainant must, in accordance with Paragraph 2 of the Policy, prove to the Expert on the balance of probabilities that:

- (i) it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name; and
- (ii) the Domain Name in the hands of the Respondent is an Abusive Registration (as defined in paragraph 1 of the Policy).

b. Complainant's Rights

The DRS Policy defines Rights as follows:

"Rights means rights enforceable by the Complainant whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

The Complainant relies upon its registered trade marks and the use of its TRX mark, which in my view are sufficient to meet the definition identified above. For the purpose of analysing whether the Domain Name is identical or similar to the name or mark in which Rights are claimed, one should ignore the .co.uk suffix. In my opinion the Complainant has established that it has Rights in a mark identical to the disputed Domain Name.

c. Abusive Registration

I now go on to consider the extent to which the disputed Domain Name is an Abusive Registration.

The Complainant asserts that the Domain Name is an Abusive Registration for the reason identified above.

The Policy defines an Abusive Registration as -

"a Domain Name which either:

- i. *was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii *is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights"*

and goes on to set out a (non-exhaustive) list of factors which may be evidence that a domain name is an Abusive Registration (see paragraph 5), and sets out another (non-exhaustive) list of factors which may be evidence that a domain name is not an Abusive Registration (see paragraph 8), including at paragraph 8.4 that:

“Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits.”

The Respondent has asserted that it had no knowledge of the Complainant or its use of the TRX mark at the time that it acquired the Domain Name in 2006; that the extent of the Complainant’s use in the UK at that time is uncertain; and that the acquisition significantly predated the registered rights that the Complainant relies upon.

Notwithstanding how aggrieved the Complainant may feel that the Respondent is able to own a domain name that incorporates the Complainant’s trade mark, the Complainant has provided no evidence to contradict the Respondent’s assertion that it did not know of the Complainant at the time the Respondent acquired the Domain Name or that the Respondent has used the Domain Name in a manner that takes unfair advantage of or is detrimental to the Complainant’s Rights. In that respect the fact that the Respondent has pointed the Domain Name to a page which identifies that it trades in domain names for profit is not in my view such as to cause unfair advantage or detriment. Given that the letters ‘TRX’ are not unique to the Complainant, I am also unable to assume that the Respondent would have had such knowledge of the Complainant at the time the Domain Name was acquired.

I am not therefore persuaded that the Domain name is an Abusive Registration.

In light of that finding I must go on to consider if I should hold the Complainant responsible for Reverse Domain Name Hijacking, which the Policy defines as:

“using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name.”

I am not persuaded that the Complainant has acted in bad faith. My impression of the Complainant’s submissions is that it genuinely feels aggrieved that a third party is able to register a domain name that incorporates a trade mark that wholly reflects the mark that the Complainant has rights in and that it believes that the Domain Name in the hands of the Respondent is having an adverse impact on its business. I am also mindful that paragraph 8.4 of the DRS Policy affords the Expert quite wide discretion in so far as it allows each case to be determined on its merits and I do not believe that the Complainant considered that the case that it was presenting was without merit. I therefore decline to make a finding of Reverse Domain Name Hijacking.

7. Decision

For the reasons set out above, I find that the Complainant does have Rights in respect of a name which is identical to the Domain Name <trx.co.uk> but that the Domain Name in the hands of the Respondent is not an Abusive Registration. The Complaint therefore fails.

Signed Simon Chapman

Dated