

## **DISPUTE RESOLUTION SERVICE**

**D00020412**

### **Decision of Independent Expert**

Zoetis Services LLC

&

Zoetis, Inc.

v.

Trifega Ltd

#### **1. The Parties:**

Lead Complainant: Zoetis Services LLC  
10 Sylvan Way  
Parsippany  
New Jersey 07054  
United States

Co-Complainant: Zoetis, Inc  
10 Sylvan Way  
Parsippany  
New Jersey 07054  
United States

[Except where expressly distinguished, in this Decision, references to the Complainant are to the lead Complainant and co-Complainant jointly.]

Respondent: Trifega Ltd  
Sovereign House  
14-16 Nelson Street  
Douglas  
IM1 2AL  
Isle of Man

## **2. The Domain Name:**

equest.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.

17 July 2018 10:46 Dispute received  
17 July 2018 14:59 Complaint validated  
17 July 2018 15:07 Notification of complaint sent to parties  
27 July 2018 17:07 Response received  
27 July 2018 17:07 Notification of response sent to parties  
01 August 2018 02:30 Reply reminder sent  
03 August 2018 11:07 Reply received  
03 August 2018 11:09 Notification of reply sent to parties  
08 August 2018 15:39 Mediator appointed  
10 August 2018 15:46 Mediation started  
24 September 2018 15:16 Mediation failed  
24 September 2018 15:16 Close of mediation documents sent  
28 September 2018 15:51 Expert decision payment received  
01 October 2018 Keith Gymer appointed Expert with effect from 4 October 2018

## **4. Factual Background**

The lead Complainant, Zoetis Services LLC, is one of the companies in the Zoetis group of which the co-Complainant, Zoetis, Inc., is the principal entity. The Zoetis group develops and manufactures a diverse portfolio of animal health medicines and vaccines for pets and livestock, complemented by diagnostic products, genetic tests, biodevices and a range of services for veterinarians and livestock farmers and companion animal owners. It markets equine antihelmintic treatments under the EQUEST mark.

The lead Complainant holds trade mark rights, including UK trade mark registration no. 2019798, filed on 4 May 1995 and EUTM registration no. 2738250, filed on 18 June 2002, for the EQUEST mark in Class 5 for antihelmintics.

The Complainant provides a website at [www.zoetis.com](http://www.zoetis.com), with information on its EQUEST products at [www.zoetis.com/products-services/companion-animals/horses.aspx](http://www.zoetis.com/products-services/companion-animals/horses.aspx).

The Respondent, Trifega Ltd, is a company registered in the Isle of Man. It holds a large number of domain names, which are offered for sale. According to the Nominet Whois records, the Respondent registered the disputed Domain Name, [equest.co.uk](http://equest.co.uk) on 6 July, 2006. A website page, hosted by Sedo, was accessible via the Domain Name, displaying an invitation to “Buy this domain” with a link to enable visitors to “make an offer” to purchase the Domain Name.

## **5. Parties’ Contentions**

### **Complainant**

The Complainant asserts that it owns trade mark rights in the EQUEST mark, as specified in Section 4 above, predating the registration of the Domain Name.

It claims only recently to have become aware of the Domain Name registration.

It asserts that the Respondent knew of the Complainant and the Complainant’s trade marks and, registered the Domain Name to seek to capitalise on those rights by selling, renting or otherwise transferring the Domain Name to the Complainant or a competitor. The Complainant submits that the Respondent’s conduct in the present matter, and previously, demonstrates that the registration of the Domain Name is abusive.

The Complainant argues that the Respondent’s business model is to engage in the abusive predatory registration of domain names to which the Respondent has no legitimate rights or interests with the purpose of selling to the highest bidder in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the domain names. The Complainant refers to Nominet decision D00017732 of 18 October 2016 in this regard, in which it was found that the Respondent had abusively registered the domain name [jakks.co.uk](http://jakks.co.uk). The facts of that matter established that the Respondent demanded in excess of US\$12,000 for the said domain name, which was held to be an abusive registration.

Further, the Complainant alleges that the Domain Name is a blocking registration against a mark in which the Complainants have rights, and that it is the deliberate intention of the Respondent, to intercept internet traffic intended for the Complainant in relation to its EQUEST products.

The Complainant notes that the (Sedo hosted) website accessed via the Domain Name contained links to various weight loss products. It says such use of the Complainant’s trade marks by the Respondent is unauthorised and the Complainants

have no control over what is being offered to potential customers. The result is an inevitable interference with the Complainant's business because business is diverted and/or the Complainants' reputation is damaged or tarnished.

The intention of the Respondent in using the Complainants' trade mark as the Domain Name is to attract prospective customers to its website. The Domain Name was registered and is being used in a way which has confused or is likely to confuse customers into believing that the Domain Name is registered to, or operated or authorised by, or otherwise connected with the Complainant.

Additionally, the Complainant submits that the Respondent's registration of the Domain Name is part of a pattern of registrations incorporating trade marks to which the Respondent has no rights. The Complainants point to the previous Nominet decision D00017732 of 18 October 2016 (see above), against the Respondent, in support of this contention.

## **Remedy Requested**

Transfer of the Domain Name to the Lead Complainant.

## **Respondent**

The Respondent recognises that the Complainant may have registered trade mark rights, but asserts that a Trade Mark in Class 5 (for animal antihelmintics) isn't relevant to the internet, domains, marketing, sales, or business in general.

The Respondent notes that the Domain Name was registered in 2006, 12 years before the Complaint. In 2005 the Respondent says it was registering hundreds of generic domain names a day and had a portfolio of over 40,000 domains. It admits that checking for Class 5 Trade Marks on words with an "e" in front of them was not part of the process. For clarity, the Respondent states that it was unaware of the Complainant, or their Trade Mark until receiving the DRS Complaint, and that it is "unreasonable" to assume that the brand is recognisable beyond its own very niche Horse/Livestock Vaccination industry.

The Respondent acknowledges that it speculatively engages in registering generic word/phrase/expired domains with the objective of selling them for more than the purchase price to anyone who makes an acceptable offer – and asserts that this is a known and acceptable business practice. It says that the Domain Name is still for sale, and that this is not abusive.

With reference to the Complainant's citation of one adverse prior DRS decision against it as being evidence of a pattern of abusive registrations, the Respondent points out that one negative decision against a business which, at its peak owned over 40,000 domains, and has been registering them for over 15 years, is a very tiny

percentage, and certainly doesn't represent a "pattern" for the purposes of the Policy.

The Complainant's allegations that the Domain Name is held as a "blocking registration", to "unfairly disrupt the Complainant's business", or to attract the Complainant's prospective customers to the website, are all denied. The Respondent stresses the lack of any evidence to support the Complainant's assertions on these grounds. It notes that the Complainant itself does not appear to have any other domain name using the EQUEST mark, and that the Complainant's website itself makes very little reference to the EQUEST products. The Respondent also notes that the website accessed via the Domain Name is clearly a parking page, made no reference to the Complainant, and was very rarely accessed (as evidenced by Sedo's traffic figures).

The Respondent asserts that the assumptions, supposition and non-existent evidence presented by the Complainant are not enough to prove abuse.

It explains that the Domain Name was originally registered by the Respondent along with thousands of others at a time (2006) when "i" anything and "e" anything were buzzwords (see e.g. <https://en.wikipedia.org/wiki/IPod>). The Respondent registered and still owns over 100 other e<word> domains (of which examples were provided). It has also sold many and left many hundreds more to expire over the years.

The Respondent claims to have registered [equest.co.uk](http://equest.co.uk) as for possible use in connection with a MMORPG (Massively multiplayer online role-playing game) in view of the success of EverQuest (<https://en.wikipedia.org/wiki/EverQuest>) and subsequently EverQuest 2.

It provides a copy of the earliest archive.org website capture in 2008 (<https://web.archive.org/web/20080122140706/http://www.equest.co.uk:80/>), which is filled with references to games and computer games.

In the Respondent's view, its reasons for registration of the Domain Name were clearly not abusive. It reiterates that it had no knowledge of the Complainant prior to the DRS Complaint, that the Complainant has waited an unreasonably long time to make this claim via DRS, and that it has not proven that the Domain Name is an abusive registration.

## **Complainant's Reply**

The Complainant provided a Reply to the Response.

It dismisses the Respondent's assertion that trade marks are not relevant to the internet, pointing out that businesses are entitled to market their products or services over the internet using their trade marks.

It asserts that EQUEST is an invented word, and not a generic term as claimed by the Respondent, and provides results of an identical search for “EQUEST” marks using the UKIPO’s searching tool which returned six results. It asserts that the Respondent should have conducted at least such a search before registering the Domain Name, and restates its view that the Respondent was not entitled to register or own the Domain Name in light of the Complainant’s proven prior rights. The Respondent has thereby disrupted the Complainant’s business and prevented it from being able to register the Domain Name. It is self-evident that this is a blocking registration as the Complainant cannot register the domain in respect of a product whose trade mark was registered prior to the date of Domain Name registration.

The Complainant has registered rights in the mark EQUEST and ignorance of such rights is no defence. It is also submitted that the Complainant is not barred from bringing a complaint at this time and indeed, a complaint was brought as soon as the Complainant became aware of the domain.

The Respondent has not provided any evidence that it used or prepared to use the Domain Name in connection with a genuine offering of goods or services.

The Complainant considers that, despite denials, the Respondent has essentially admitted that engaging in what amounts to a pattern of abusive registrations, with a portfolio of over 40,000 domains, which the Complainant asserts are not all generic as alleged.

The Complainant submits that in any event, regardless of the situation and intention of the Respondent at the time of registration, the Domain Name was being used as an Abusive Registration at the time the Complaint was submitted with no reference to computer games.

The Complainant maintains its previous position and confirms its request that the Domain Name be transferred to it.

It also makes the statement that mediation [as offered by Nominet, without charge] is “not appropriate in this case”.

## **6. Discussions and Findings**

### **General**

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

## Complainant's Rights

As defined in the Policy, "**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 has proven rights in EQUEST as a registered trade mark in the UK and EU as indicated above. The nature of the goods or services to which such rights relate and their scope is irrelevant to the determination of the existence of a Complainant's Rights for the purpose of the Policy. If a Complainant has "Rights" as defined, then it is entitled to pursue a Complaint under the Policy.

In this case, the Domain Name is identical in its distinctive element "equest", apart from the standard suffices ".co.uk".

It is therefore quite clear to the Expert that the Complainant meets this first requirement under the Policy, and that it has Rights in respect of a name or mark which is identical or similar to the Domain Name.

## Abusive Registration

The Complainant also has to show that the disputed Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines "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) has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 5.1 of the Policy, of which the following are potentially relevant in this case:

- 5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - 5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
  - 5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or
  - 5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

- 5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;
- 5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;  
....
- 5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.

Paragraph 8.1 of the Policy additionally provides observations on "How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration", of which the following may be considered pertinent to the present Complaint:

- 8.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:
  - 8.1.1.1 used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
  - 8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or
  - 8.1.1.3 made legitimate non-commercial or fair use of the Domain Name.
- 8.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it;  
....
- 8.1.4 In relation to paragraphs 5.1.3 and/or 5.3; that the Domain Name is not part of a wider pattern or series of registrations because the Domain Name is of a significantly different type or character to the other domain names registered by the Respondent.



The factors listed in Paragraphs 5.1 and 8.1 of the Policy are only intended to be exemplary and indicative. They are not definitive either way. It is Paragraph 1 of the Policy, which provides the applicable definition, as indicated above.

In accordance with the Policy Paragraph 2b, it is for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration.

In view of the significant delay of over 12 years between the date of registration of the Domain Name by the Respondent and the filing of this Complaint by the Complainant, it is appropriate first to consider the Respondent's view that this is unreasonably long.

The question of whether delay (*laches* in legal terms) should exclude a Complainant from seeking a remedy under the Policy was addressed at some length in the Decision of the Appeal Panel of 7 December, 2016 in Jockey Club Racecourses Limited v. Moneta Communications Limited DRS 17490 (Cheltenham-festival.co.uk) with references to other earlier cases, which also considered the issues. The Expert does not intend to extract large sections from that Decision, which is available for further reference if desired. The key points (as also originally expressed by the earlier Appeal Panel in Lucasfilm Ltd., LLC v. Abcissa.com Limited DRS 15788 (starwars.co.uk)), of note, with Expert's emphasis added, are:

*“...the Panel notes that the Policy itself says nothing about delay, nor does it contain any provisions requiring a Complaint to be brought within a specific time limit after the registration of a domain name.*

*...The circumstances in which delay and other related considerations may operate as a defence to litigation are considered further below. Overall, however, the Panel considers that, where the use complained of is ongoing, then delay alone should not automatically preclude a Complaint being brought.*

*It is nevertheless the case that the list of factors which may lead to a finding that a domain name is not an Abusive Registration, as set out in Paragraph 4 [now 8] of the Policy, is said to be non-exhaustive. The Panel concludes that, in principle, depending upon the relevant facts, this means it is open to the Panel to reach a finding that, whilst delay does not automatically bar an action, delay in a specific case might be such as to mean that an otherwise Abusive Registration is acceptable. Whether in the particular circumstances of a given case that is the position would depend on the individual facts.”*

In the present case, the Respondent's use (and offer for sale) is ongoing, and the delay may simply have been due to that use not appearing on the Complainant's radar before. Indeed, The Complainant has explicitly

asserted that it only recently became aware of the Domain Name. The Expert takes the view that this is not a case where the delay between registration and Complaint should exclude the Complainant from seeking a remedy under the Policy.

Accordingly, the Expert has continued with consideration of the merits of the Complaint on its individual facts.

In essence, the Complainant's view is that, because it has prior rights in EQUEST and the Domain Name comprises the identical word, then the Respondent can have had no legitimate right to register or use the Domain Name, and consequently the Domain Name must necessarily be an Abusive Registration.

This view is as simplistic and unrealistic as the Respondent's claims that trade marks in Class 5 are not relevant to the internet.

The same trade mark may be registered by different parties for different goods and services, and even for the same goods and services in different jurisdictions.

That the Complainant had earlier registered rights in EQUEST is not in doubt. However, so did others, as the search results presented by the Complainant in its Reply also demonstrated. The mark is not unique to the Complainant, nor does it appear to be widely promoted, even on the Complainant's own websites - the Expert followed the Respondent's reported attempts to seek information there, but found very few appearances of the mark. It can hardly be considered to be a household name (as were the Claimants in the One-in-a-Million case cited by the Complainant in support of its case). Nor has the Complainant provided any evidence to demonstrate the extent of goodwill, recognition or reputation, which may have been associated with the mark in 2006, even in its niche market, when the Domain Name was registered.

Nominet's Terms and Conditions of Domain Name Registration do require a registrant to provide Nominet with various promises and an indemnity, including that:

- 6.1.3 by registering or using your **domain name** in any way, you will not infringe the intellectual property rights (for example, trade marks) of anyone else;

However, whilst it might well be prudent at least to carry out checks on the UKIPO trade marks register as the Complainant suggests, to see whether the rights of others might constrain its potential uses, there is no obligation on a prospective registrant to carry out such searches prior to applying to register a Domain Name. Indeed, given the wide scope of the reference to intellectual property rights in that paragraph (and of "Rights" under the Policy), which are not limited to UK National rights, or even registered rights alone, and may extend internationally and to unregistered common law rights as well, it would clearly be impractical to expect any registrant to conduct a worldwide clearance beforehand.

The Respondent has provided an explanation of its reasons for originally registering the Domain Name in 2006, and has provided evidence of the earliest web page using the Domain Name, as accessed from archive.org in 2008, which relates to computer games.

Although the Complainant claims that “EQUEST” is an invented word, in the context of the Complainant’s use, it seems more likely to have been conceived simply by truncating “EQUESTrian” from the target customer for the antihelmintic products concerned. The Respondent’s explanation that “e” and “i” prefix names were all the rage in the noughties rings true with the Expert. Trade mark registries (including the UKIPO) have adopted specific practices in relation to “e” and “i” prefix marks, because of just such popularity.

The Expert considers the Respondent’s explanation to be credible in the circumstances.

The Complainant argues that the fact that the Respondent has admitted to registering and holding thousands of domains for speculative purposes should condemn it automatically as being “engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern” (Policy 5.1.3).

However, whatever objections the Complainant or others might have against those who speculatively purchase and hoard potential assets like domain names, in the hope of profiting by selling them on later when a demand arises, this is a legitimate business, expressly recognised under the Policy:

- 8.4 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 fact that the Respondent has previously lost one domain name in one prior Complaint against all the domain names it has held does not, in the Expert’s opinion, provide sufficient evidence of abusive conduct consistent with paragraph 5.1.3. of the Policy.

The Complainant has also alleged that the Domain Name was registered as a “blocking registration”, and/or to “unfairly disrupt the Complainant’s business”, and/or to attract the Complainant’s prospective customers to the website using the Domain Name.

Any domain name will necessarily block registration of the identical string under the same SLD or TLD. That does not mean that if another party has “Rights” to the same string then the domain name must necessarily be an Abusive Registration. In the present case, the Expert does not find the Complainant’s unsupported assertions

persuasive. There is simply no convincing evidence that the Domain Name was originally registered with any knowledge of the Complainant's mark or business.

Neither is there any convincing evidence that the Respondent is using the Domain Name with the intention of disrupting the Complainant's business or attempting to drive the Complainant's customers to the Respondent's website.

That website is no more than a Sedo holding page (possibly automatically generated) with some links to various diet and weight loss products. At a stretch, such (unidentified) products might arguably be considered in a similar line to the Complainant's products, in that they might also fall in Class 5 of the trade mark classification, but it would be a long stretch. There are no references on the Sedo holding page to the Complainant or its products or those of possible competitors.

It seems unlikely that the Sedo parking page would generate any significant click-through income for the Respondent, but even if it did, this would not necessarily mean the Domain Name should be considered an Abusive Registration. Paragraph 8.5 of the Policy states:

- 8.5 Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:
  - 8.5.1 the nature of the Domain Name;
  - 8.5.2 the nature of the advertising links on any parking page associated with the Domain Name; and
  - 8.5.3 that the use of the Domain Name is ultimately the Respondent's responsibility.

If there were evidence that the website and links were targeting the Complainant and its products or those of competitors, then the Respondent would be held responsible and have to face the potential adverse consequences.

As it is, in the Expert's view, the Respondent was entitled to register the Domain Name and is making notional fair-use of it in relation to its business of dealing in Domain Names. As the Expert in DRS 4769 (rileys.co.uk) summarised such business in an analogous situation:

"One acquires 'likely' domain names (i.e. domain names, which are likely to be desirable to others) and sells them at the best possible price. As 'likely' names become rarer, those such as the Respondent holding large numbers of 'likely' domain names registered back in the 1990s, when 'likely' names were easier to come by, will be able to obtain higher prices for their names. That is of itself a perfectly legitimate practice. It only becomes offensive if it takes unfair advantage of a rights owner's rights. It is unfortunate for the Complainant that the Respondent got to the Domain Name first, but there is nothing before the Expert to satisfy the Expert that the Respondent in so doing has taken unfair advantage of or caused unfair detriment to the Complainant's rights. Had there been any evidence to suggest that the

Respondent had been specifically targeting the Complainant, the result would have been different.”

In conclusion, therefore, the Expert finds that the Complainant has failed to show that the Domain Name, in the hands of the Respondent, is an Abusive Registration, and the Complaint must fail on that ground.

Additionally, the Expert wishes to specifically deprecate the presumptuous and dismissive attitude, expressed in the Complainant’s Reply, to the effect that mediation was “not appropriate in this case”. Just as it would be seen as desirable for parties to explore the options for negotiated settlement of a dispute before commencing legal action in the Courts, so it should be for DRS disputes. The services of Nominet’s experienced and professional mediators are available to the parties to a DRS dispute without charge, and result in settlement in many cases, without need for a formal decision and with a saving in costs and aggravation.

After a Response has been filed to a Complaint, it is strongly to be recommended that the parties should avail themselves of Nominet’s free mediation services to try to avoid escalating their dispute, wherever possible.

## **7. Decision**

The Complaint is dismissed. No action is to be taken.

**Signed .....**  
**Keith Gymer**

**Dated: 5 October, 2018**