



DECISION

Gianluca Lionetto and Tonic Consultancy Pte Ltd v. TENNIS TONIC

Claim Number: FA1708001744744

PARTIES

Complainant is **Gianluca Lionetto and Tonic Consultancy Pte Ltd** (“Complainant”), represented by **Zak Muscovitch of The Muscovitch Law Firm**, Canada. Respondent is **TENNIS TONIC** (“Respondent”), Singapore.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<tennistonic.com>**, registered with **eNom, LLC**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Kenneth L. Port as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on August 15, 2017; the FORUM received payment on August 15, 2017.

On August 17, 2017, eNom, LLC confirmed by e-mail to the FORUM that the **<tennistonic.com>** domain name is registered with eNom, LLC and that Respondent is the current registrant of the name. eNom, LLC has verified that Respondent is bound by the eNom, LLC registration agreement and has thereby

agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On August 17, 2017, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of September 6, 2017 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@tennisonic.com. Also on August 17, 2017, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

Having received no response from Respondent, the FORUM transmitted to the parties a Notification of Respondent Default.

On September 11, 2017, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed Kenneth L. Port as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the FORUM'S Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant is an organization which engages in a variety of tennis related activities. Complainant operates a website where users can find other tennis players for tennis matches, read tennis news, keep track of competitions, and also buy tennis related merchandise. Complainant registered the TENNIS TONIC mark with the Intellectual Property Office of Singapore ("IPOS") (e.g. Reg. No. T1008039G, registered October 21, 2010). *See* Compl., at Attached Annex B. Respondent's <tennistonic.com> domain name is identical to Complainant's mark as it contains the mark in its entirety and merely appends the generic top-level domain ("gTLD") ".com."

Respondent has no rights or legitimate interests in the <tennistonic.com> domain name. Respondent is not commonly known by the disputed domain name, nor has Complainant authorized, licensed, or otherwise permitted Respondent to use the mark. Further, the WHOIS information, after the privacy shield was lifted as a result of the current proceeding, indicates that the registrant of the disputed domain name is "Tennis Tonic," however that name is false and there is nothing in the record to support a finding that Respondent is commonly known by that name. *See* Amended Compl., at Attached Schedule 1 & 2 (prior and current WHOIS report). Respondent also does not use the disputed domain name in connection with a bona fide offering of goods or services or legitimate noncommercial or fair use. Rather, Respondent illegally hijacked the domain name, as Complainant used to own the domain name to engage in business. *See* Compl., at Attached Annex K (historical WHOIS registration information).

Respondent uses the domain name to pass off as Complainant, as the domain name resolves to the website Complainant's owned and operated prior to Respondent's theft. *See* Compl., at Attached Annex D.

Respondent registered and uses the <tennisonic.com> domain name in bad faith as Respondent hijacked the disputed domain name from Complainant. *See* Amended Compl., at Attached Annex K (historical WHOIS registration information) & Schedule 2 (current WHOIS registration information). Further, Respondent passively holds the domain name, as it hides the fact that it stole Complainant's domain name by not changing the website design. Finally, the fact that Respondent hacked Complainant's server and stole the registration rights of the disputed domain name from Complainant demonstrates a knowledge of Complainant's rights in the <tennisonic.com> domain name.

B. Respondent

Respondent failed to submit a Response in this proceeding. Respondent obtained the <tennisonic.com> domain name on or about May 23, 2017.

FINDINGS

The Panel finds that the disputed domain name is confusingly similar to Complainant's valid and subsisting trademark; that Respondent has no rights or legitimate interests in or to the disputed domain name; and that Respondent has engaged in bad faith use and registration of the disputed domain name.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Preliminary Issue: Multiple Complainants

In the instant proceedings, there are two Complainants. Paragraph 3(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") provides that "[a]ny person or entity may initiate an administrative proceeding by submitting a complaint." The FORUM's Supplemental Rule 1(e) defines "The Party Initiating a Complaint Concerning a Domain Name Registration" as a

“single person or entity claiming to have rights in the domain name, or multiple persons or entities who have a sufficient nexus who can each claim to have rights to all domain names listed in the Complaint.”

The two Complainants in this matter consist of Gianluca Lionetto (“Complainant Lionetto”) and Tonic Consultancy Pte Ltd. Complainants argues that they should be treated as one and the same Complainant for the purposes of this proceeding because the TENNIS TONIC trademark is registered to Complainant Lionetto, and is being used to further the Tonic Consultancy Pte Ltd business.

Complainant contends that the business is solely owned by Sarah Meisch, the wife of Complainant Lionetto, however Complainant Lionetto is the directing mind of the business. The Panel finds that a sufficient link exists between the two listed Complainants and, as such, Panel shall allow Complainant Lionetto to proceed as a single Complainant in this proceeding.

Identical and/or Confusingly Similar

The Panel finds that the disputed domain name, <tennistonic.com>, is confusingly similar to Complainant’s valid and subsisting trademark, TENNIS TONIC. Complainant has adequately plead its rights and interests in this trademark. Respondent arrives at the disputed domain name by merely deleting a space and adding the g TLD “.com.” This is insufficient to distinguish the disputed domain name from this trademark.

As such, the Panel finds that the disputed domain name is confusingly similar to Complainant’s trademark.

Rights or Legitimate Interests

Further, the Panel finds that Respondent has no rights or legitimate interests in or to the disputed domain name. Respondent has no authority or license to register the disputed domain name. Respondent is not commonly known by the disputed domain name.

The Panel also finds that Respondent does not use the disputed domain name in connection with a bona fide offering of goods or services or legitimate noncommercial or fair use. Rather, Respondent apparently illegally hijacked the domain name, as Complainant used to own the domain name to engage in business. *See* Compl., at Attached Annex K (historical WHOIS registration information). Respondent uses the disputed domain name to pass itself off as Complainant, as the disputed domain name resolves to the website Complainant's owned and operated prior to Respondent's theft. *See* Compl., at Attached Annex D.

As such, the Panel finds that Respondent has no rights or legitimate interests in or to the disputed domain name.

Registration and Use in Bad Faith

The Panel also finds that Respondent has engaged in bad faith use and registration of the disputed domain name. Complainant has not made any arguments that would fit within the bounds of Policy ¶ 4(b) elements; therefore, the Panel shall consider Respondent's actions under a nonexclusive inquiry of Policy ¶ 4(a)(iii).

Complainant alleges that Respondent hijacked the <tennisonic.com> domain name. The unauthorized transfer of a domain name held by a complainant can evince bad faith registration. *See LDW Software, LLC v. Stella Chang*, D2017-0430 (WIPO April 20, 2017) (It is well-settled that the unauthorized transfer of a

domain name (“hijacking”) is of itself evidence of the bad faith registration and use of a domain name.). Complainant provides the historical WHOIS information to show that it used to be the registrant of the disputed domain name prior to Respondent’s alleged illegal transfer. *See* Amended Compl., at Attached Annex K (historical WHOIS registration information). Accordingly, the Panel finds that Respondent transferred the domain name from Complainant without authorization, sufficient for a finding of bad faith.

Complainant next argues that Respondent simply passively holds the disputed domain name. Passively holding a domain name by not making an active use of that domain name can provide evidence of bad faith under Policy ¶ 4(a)(iii). *See VideoLink, Inc. v. Xantech Corporation*, FA1503001608735 (FORUM May 12, 2015) (“Failure to actively use a domain name is evidence of bad faith registration and use pursuant to Policy ¶ 4(a)(iii).”). Complainant claims that because Respondent simply transferred the domain name to itself and uses Complainant’s identical webpage, Respondent has engaged in passive holding. However, this argument, based on precedent, tends to lend itself to a claim of passing off rather than inactive use. *See Verizon Trademark Servs. LLC v. Boyko*, FA 1382148 (FORUM May 12, 2011) (“The Panel finds that Respondent’s registration and use of the confusingly similar disputed domain name, even where it resolves to Complainant’s own site, is still registration and use in bad faith pursuant to Policy ¶ 4(a)(iii).”). The Panel finds that Respondent makes use of the domain name as the resolving page and has content available on the webpage, however using the <tennistonic.com> domain name to pass itself off as Complainant evinces bad faith under Policy ¶ 4(a)(iii).

Finally, the Panel finds that Respondent had actual notice of Complainant and its rights in and to the trademark TENNIS TONIC. As it appears that Respondent took affirmative measures to take control of the disputed domain name and its

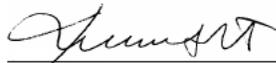
resolving web page, it is estopped from later claiming that it had no knowledge of the very domain name that it commandeered.

As such, the Panel finds that Respondent engaged in bad faith use and registration of the disputed domain name.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be granted.

Accordingly, it is Ordered that the <tennisonic.com> domain name transferred from Respondent to Complainant.



Kenneth L. Port
Panelist

Kenneth L. Port, Panelist

Dated: September 12, 2017