

DISPUTE RESOLUTION SERVICE

D00020886

Decision of Independent Expert

RoundShield Partners LLP

and

Carmine Bonacci

1. The Parties:

Lead Complainant: RoundShield Partners LLP
41-46 Piccadilly
London
London
W1J 0DS
United Kingdom

Complainant: Mr Driss Benkirane
41-46 Piccadilly
London
London
W1J 0DS
United Kingdom

Respondent: Carmine Bonacci
4 Linkway
Ditton
Aylesford
Kent
ME20 6DS
United Kingdom

2. The Domain Names:

roundshield.co.uk
roundshieldfund.co.uk
roundshieldllp.co.uk

3. Procedural History:

I 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.

03 December 2018 13:58 Dispute received
03 December 2018 14:47 Complaint validated
03 December 2018 14:53 Notification of complaint sent to parties
27 December 2018 10:25 Response received
27 December 2018 10:25 Notification of response sent to parties
02 January 2019 01:30 Reply reminder sent
03 January 2019 18:04 Reply received
03 January 2019 18:04 Notification of reply sent to parties
10 January 2019 14:26 Mediator appointed
10 January 2019 15:03 Mediation started
14 January 2019 10:59 Mediation failed
14 January 2019 10:59 Close of mediation documents sent
24 January 2019 01:30 Complainant full fee reminder sent
29 January 2019 09:36 Expert decision payment received

4. Factual Background

- 4.1. The Lead Complainant, RoundShield Partners LLP, is an independent investment firm. It was incorporated on 17 October 2013 by the second Complainant, Mr Driss Benkirane and two of his business partners.
- 4.2. Mr Benkirane is the registered proprietor of, *inter alia*, United Kingdom trade mark number 00003026425 for “ROUNDSHIELD”. This registered mark was registered as of 16 October 2013 and covers the following services in Class 36: “*Financial services, namely investment and asset management services, investment advisory services, principal investments and other merchant banking services, capital markets and other investment management services, and investment fund management services*”. The Lead Complainant uses this trade mark under licence from Mr Benkirane.
- 4.3. The Lead Complainant is well-known in the private-equity market and has been successful at raising funds for investment and management.
- 4.4. The Respondent is an individual called Carmine Bonacci. The Respondent registered the Domain Names on 16 January 2018. The Respondent has not used the Domain Names to date.
- 4.5. Amongst the investments made by the Lead Complainant was a substantial loan to Les Bordes Golf International SAS (“Les Bordes”) in 2014. The Respondent was contracted to Les Bordes on a consultancy basis to provide services as its Finance Director and Planning Gain Manager.
- 4.6. Towards the end of 2017 the Lead Complainant and Les Bordes had discussions about the loan to Les Bordes. These discussions culminated in the

Lead Complainant replacing much of the management of Les Bordes. This decision led to the Respondent leaving Les Bordes.

- 4.7. Subsequently, in October 2018, the Respondent offered to sell a number of domain names, including the Domain Names, to the Lead Complainant for £500,000.

5. Parties' Contentions

Complainants' Submissions

- 5.1. The Complainants' submissions in their Complaint can be summarised as follows:

Rights

- 5.2. The Lead Complainant's business is well known in the private-equity market and it has built up a significant reputation and goodwill in relation to raising funds, investment and management, worldwide and including the UK.
- 5.3. The Lead Complainant is listed as the first hit amongst several hundred thousand results on popular search engines, such as Google, when you enter "ROUNDSHIELD" or "ROUND SHIELD".
- 5.4. The second Complainant is the owner of a Registered Trade Mark for ROUNDSHIELD which he licenses to the Lead Complainant.
- 5.5. The Complainants therefore submit that they have Rights in the name ROUNDSHIELD for two main reasons:
- 5.5.1. The Lead Complainant's extensive use of the mark ROUNDSHIELD in its private equity business for a significant period; and
- 5.5.2. the Registered Trade Mark "ROUNDSHIELD" which is owned by the second Complainant and licensed to the Lead Complainant.

Abusive Registration

- 5.6. The Respondent has never had authority to act on the Complainants' behalf including, in particular, to register the Domain Names.
- 5.7. The Respondent was well aware of the Lead Complainant because he worked as the Finance Director and Planning Gain Manager at Les Bordes. The Lead Complainant had made a substantial loan to Les Bordes in 2014 and there were discussions about that loan through 2015 and 2016. In 2017 negotiations were held between Les Bordes and the Lead Complainant and the combination of these negotiations was a meeting on Friday, 10 November 2017 following

which the Lead Complainant replaced the management of Les Bordes, which included the Respondent.

5.8. On 6 November 2017 the Respondent registered in his own name the following domain names:

<lesbordesgolf.com>
<lesbordesproperties.com>
<lesbordesgolfproperty.com>
<lesbordesproperty.com>

5.9. Subsequently, on 16 January 2018 (and well after the Respondent became aware of the restructuring of the management of Les Bordes) the Respondent registered the Domain Names together with the Domain Name <roundshieldfund.com>.

5.10. Given this background, the Domain Names are clearly Abusive Registrations for the reasons set out below.

5.11. The Respondent registered or otherwise acquired the Domain Names for the purpose of selling the Domain Names, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Names.

5.12. The Respondent did not disclose to the Complainants that he had registered any of the Domain Names. On 13 October 2018 the Respondent offered to sell the Domain Names (together with a number of other domain names that he owned) for the sum of £500,000 to the Lead Complainant.

5.13. The Respondent offered the Domain Names for sale in bad faith as the offer came shortly after the Lead Complainant received substantial publicity due to the restructuring of Les Bordes. It should be inferred from this that the Respondent had in mind the possibility of entering into such a transaction for financial gain at the time he registered the Domain Names.

5.14. The email address used by the Respondent to contact the Complainants contained the Respondent's initials and the word "ROUNDSHIELD" followed by a generic suffix. This use of an email address containing the Lead Complainant's name and mark would likely cause confusion to third parties and businesses as it suggests that the Respondent is writing for or on behalf of the Lead Complainant. The likelihood of confusion can only be increased because of the Respondent's previous connection with Les Bordes and the publicly known fact that Les Bordes is now owned by the Lead Complainant.

5.15. The Complainants rely on a number of different paragraphs of Nominet's DRS Policy ("the Policy"). These are summarised below.

5.16. The Respondent registered the Domain Names for one or more of the purposes:

- 5.16.1. selling or transferring them to the Complainants' for valuable consideration in excess of his documented out-of-pocket expenses (Policy paragraph 5.1.1.1); or
 - 5.16.2. as a 'blocking registration' against a name or mark in which the Complainants have Rights (Policy paragraph 5.1.1.2).
- 5.17. By using the Domain Names to provide e-mail addresses which falsely represent that the Respondent or associates of his are connected or associated with or acting on behalf of the Lead Complainant, the Domain Names cause confusion and deception contrary to Paragraph 5.1.2 of the Policy.
- 5.18. The Domain Names and each of them are an exact match for the name ROUNDSHIELD and the Respondent has no reasonable justification for having registered the Domain Names contrary to Paragraph 5.1.6 of the Policy.
- 5.19. The Respondent has also registered a number of other domain names connected to the Lead Complainant, including:

- <lesbordesgolf.com>
- <lesbordesgolfproperties.com>
- <lesbordesgolfproperty.com>
- <lesbordesproperty.com>
- <lesbordes.com>

Accordingly, the registration of the Domain Names is part of a pattern of registrations by the Respondent of domain names which correspond to well-known names and/or trade marks in which the Respondent has no legitimate rights contrary to Paragraph 5.1.3 of the Policy.

Respondent's Submissions

- 5.20. The Respondent's submissions in its Response can be summarised as set out below.
- 5.21. The Respondent takes issue with a number of the facts set out in the Complaint. These factual disputes can be summarised as follows:
- 5.21.1. The Respondent was never a shareholder, Director or part of the management team of Les Bordes and his engagement at Les Bordes was purely as a consultant under a consultancy agreement;
 - 5.21.2. Everything that the Respondent did whilst contracted by Les Bordes was under direct instruction from the management of Les Bordes and this includes any communication that he had with the Lead Complainant;

- 5.21.3. Any suggestion that the Respondent was acting in his own capacity or that he was part of the management of Les Bordes is wilfully misleading and known to the Complainants to be completely untrue;
- 5.21.4. It is a blatant lie that the Respondent knew that the Lead Complainant intended to terminate the Respondent's consultancy agreement upon taking management control of Les Bordes. At no time did the Complainants tell the Respondent that this would be the case as part of the restructure and as far as the Respondent was concerned, it was only the President and the Board of Directors that was going to be changed;
- 5.21.5. The Complainants have not provided any evidence in support of the assertions on these points;
- 5.21.6. The Respondent does not own the domain names, <lesbordesproperty.com> or <lesbordes.com.>
- 5.22. The Domain Names have not yet been used but were acquired with a clear and defined purpose.
- 5.23. The Respondent's intention was for legitimate use in an area completely separate to that in which the Complainants are engaged. This proposed use will not be similar to the Complainants and will cause no disadvantage or harm to the Complainants' business.
- 5.24. The Respondent registered the Domain Names for promotion and commercial activity within a sexual sub-culture which involves extreme anal violation. The Respondent therefore chose the Domain Names as the word "ROUNDSHIELD" describes the anal orifice.
- 5.25. The Domain Names were therefore registered with the intention to use them in relation to this area of interest with <roundshieldfund.co.uk> being envisaged to raise money to assist those who often go too far and tear their "roundshield" that require medical or other assistance that has to be paid for.
- 5.26. No hard evidence has been provided by the Complainants to prove or even vaguely suggest that any disadvantage or harm has been caused to them in nearly one year since the Respondent registered the domain Names. It is clear that extreme anal violation and financial services do not conflict in any way.
- 5.27. The Respondent has held the Domain Names for nearly a year without the Complainants raising an objection. It was only after the Respondent found himself lacking sufficient time to progress his plans for the Domain Names that he sent an email from cb@roundshieldllp.co.uk to the Complainants on 13 October 2018 offering to sell the Domain Names to the Complainants for £500,000. The Respondent sent a further reminder email on 29 October 2018. These are the only two emails sent from this email address and this was done for the purposes of demonstrating his ownership of the Domain Names.

5.28. Since then, the Respondent has decided to retain the Domain Names to use as originally intended when the Respondent can find time to progress his plans.

5.29. Pursuant to paragraph 8.4 of the DRS Policy, “trading in domain names for profit” is a lawful activity and each case will be reviewed on its merits. It was not the Respondent’s primary aim to sell the Domain Names otherwise he would have acted on the sale just after he had bought them rather than waiting nearly a year. Furthermore, if the Complainants really contended that the Domain Names were abusive and disruptive they should have opposed the registrations sooner.

5.30. The Domain Names were not registered to sell to the Complainants nor were they registered to stop the Complainants from using them. The Respondent highlights that, previous to his emails (referenced above), the Complainants showed no interest in the Domain Names.

Reply

In Reply to the points raised in the Response the Complainants have made the following submissions :

5.31. The Respondent does not challenge the Complainants’ assertion of Rights.

5.32. There can be little doubt that the Respondent was part of the management team at Les Bordes. The Complainants point to the terms of the Respondent’s consultancy and also produce a number of articles in which the Respondent is referred to as “Director of Finance”.

5.33. The Respondent does not challenge the sequence of events relating to the loan by the Lead Complainant to Les Bordes nor does he challenge the fact that the Respondent no longer works for Les Bordes.

5.34. The Respondent’s claim as to the meaning of ROUNDSHIELD should be rejected. No evidence of this has been produced and it is surprising and outlandish. The Complainants produce extracts from “Urban Dictionary” on which no mention of the term ROUNDSHIELD is made.

5.35. The Complainants say that it is well-established in the jurisprudence of the DRS that claims which are “inherently improbable” require clear and convincing evidence to support this (see Paragraph 2.1 of version 3 of the Expert’s Overview). The absence of any evidence is accordingly a sufficient reason to reject the claim on the balance of probabilities.

5.36. The Respondent’s claims in relation to the functions of “LLP” and “fund” in two of the Domain Names lack credibility and this in itself casts further doubt on the credibility of the Respondent’s explanation.

5.37. The Respondent provides no explanation for his registration of the various Les Bordes domains and, in relation to the two Les Bordes domains which the

Respondent claims not to own, the Complainants find it strange that the Respondent was able to offer these for sale to the Complainants if he does not own them.

5.38. The coincidence in time between the restructuring of Les Bordes (in early November 2017) and the Respondent's registration of the Domain Names relating to Les Bordes and ROUNDSHIELD requires some form of explanation by the Respondent. None has been provided and the inferences that the Complainants say should be drawn should therefore be drawn.

5.39. It is inevitable that association with a sexual fetish site will harm the Lead Complainant's reputation and if the Respondent was to implement his alleged proposals, the damage to the Complainants' reputation would be immediate and likely to be substantial.

6. Discussions and Findings

Rights

6.1. Paragraph 2 of Nominet's Dispute Resolution Policy requires that the Complainants must prove, on the balance of probabilities, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration

6.2. As a first step, I must therefore decide whether the Complainants have Rights in respect of a name or mark which is identical or similar to the Domain Names.

6.3. The definition of Rights in the DRS Policy is 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.

6.4. I have no doubt that the Complainants have Rights in the word or mark, ROUNDSHIELD. The second Complainant is the registered owner of a trade mark for ROUNDSHIELD and the Lead Complainant has been granted a licence to use the Registered Mark.

6.5. Additionally, the Lead Complainant has been using the name or mark, ROUNDSHIELD in relation to its investment business since 2013.

6.6. The name or mark in which the Complainants have Rights, i.e. ROUNDSHIELD, is identical to the first of the Domain Names i.e. roundshield.co.uk, (ignoring the "co.uk" suffixes for this purpose).

6.7. Of the other two Domain Names, these differ from ROUNDSHIELD only by the addition of the words "fund" and "lp" respectively, (again ignoring the "co.uk" suffixes for this purpose). The addition of "fund" and "lp" do little or nothing to distinguish the Domain Names from the name or mark in which the Complainants have Rights and the word "roundshield" is the distinctive or trade mark part of the Domain Names.

6.8. I therefore conclude that the Complainants have Rights in a name or mark which is similar to each of the Domain Names.

Abusive Registration

6.9. Under Paragraph 1 of the DRS Policy, "Abusive Registration" is defined 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.*

6.10. This definition requires me to consider whether the Domain Names were Abusive Registrations either at the time of registration/acquisition or subsequently through the use that was made of them. Paragraph 5 of the DRS Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Names are Abusive Registrations and Paragraph 8 of the DRS Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Names are not Abusive Registrations.

6.11. The DRS Policy requires the Complainants to prove, on the balance of probabilities, that the Domain Names are Abusive Registrations. The burden of proof is therefore, firmly placed on the Complainants.

6.12. In order to make a finding of Abusive Registration it is common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainants' Rights.

6.13. In this Complaint, knowledge is not an issue. It is common ground that the Respondent was well aware of the Lead Complainant when he registered the Domain Names.

6.14. The general rule that has been applied under Nominet's DRS is that where the respondent uses the name or mark of another without any adornment that will usually amount to an Abusive Registration. This was set out in the Appeal decision in GuideStar UK v Wilmington Business Information Limited (DRS 02193) in which the Panel stated:

“Registering as a domain name the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is”.

This rule has come about largely because where the respondent is making such unadorned use of the name or mark in which the complainants has Rights it will usually follow that there will be confusion or a likelihood of confusion.

6.15. The Domain Name <roundshield.co.uk> comprises the name or mark in which the Complainants have rights, i.e. ROUNDSHIELD, without adornment.

6.16. The other two Domain Names, <roundshieldllp.co.uk> and <roundshieldfund.co.uk> differ only from the name in which the Complainants have rights by entirely descriptive suffixes, i.e. “llp” and “fund”. These additions do nothing to change the nature of the Domain Names. Indeed, the dominance of the word or mark ROUNDSHIELD within these two Domain Names is in fact enhanced by the words “fund” and “llp” which follows it, being descriptive or generic words often associated with the Lead Complainant's type of business.

6.17. On this basis, I have little doubt that people seeing the Domain Names will immediately call to mind the Lead Complainant's business and therefore there will be a likelihood of confusion.

6.18. Given this, I think it more appropriate to look first at the reasons that the Respondent has given for registering the Domain Names.

6.19. Essentially, the Respondent says that the Domain Names were all registered with the intention of using them in relation to a particular sexual fetish. Unfortunately, apart from his assertions in the Response, the Respondent has provided no evidence whatsoever of this intended use or, indeed, of the alternative meaning of the name ROUNDSHIELD that his intended use relies on. I am therefore not inclined to accept the Respondent's explanation and if there was any truth in it at all I am sure that the Respondent could have provided some evidence of this intended use.

6.20. There are also a number of other factors which make what the Respondent contends extremely unlikely. These include the following:

- 6.20.1. The Respondent provided services to a company, Les Bordes, that became owned by the Lead Complainant. The Respondent was therefore well aware of the Lead Complainant;
 - 6.20.2. As a direct result of this Lead Complainant taking over at Les Bordes, the Respondent was no longer required to provide services to Les Bordes;
 - 6.20.3. The Respondent registered the Domain Names just a few months after the Lead Complainant reorganised the management structure at Les Bordes which appears to have led to the Respondent's contract with Les Bordes being terminated;
 - 6.20.4. The Respondent's explanation for its registration of the Domain Name, roundshieldfund.co.uk, is particularly implausible;
 - 6.20.5. The Respondent makes no attempt to explain why he came to own a number of other domain names, all of which contain the name of the company for which he was providing services and the Lead Complainant came to own, i.e. Les Bordes;
- 6.21. It is difficult to discern quite what motive the Respondent had for registering the Domain Names, but given his implausible explanation, I am in no doubt that it was either with a view to extracting a substantial sum from the Complainants or to disrupting the Complainants business.
- 6.22. I would add that even if I was minded to accept the Respondent's explanation for his registration of the Domain Names (which I am not) then given both the use he intended to make of them and his undisputed knowledge of the Complainants and the Complainants' Rights in ROUNDSHIELD, I would have concluded that the Domain Names were Abusive Registrations as the Respondent's intended use would clearly have been unfairly detrimental to the Complainants' Rights.
- 6.23. I think given all this, I need not go any further. I am satisfied on the balance of probabilities that the Domain Names are Abusive Registrations and the Respondent's explanations for registering them have not persuaded me otherwise.

7. Decision

I find that the Complainants have Rights in a name or mark which is identical or similar to the Domain Names. I also find that, on the balance of probabilities, the Complainants have established that the Domain Names in the hands of the Respondent are Abusive Registrations. I therefore direct that the Domain Names should be transferred to the Lead Complainant.

Signed

Dated

Nick Phillips