

## **ADMINISTRATIVE PANEL DECISION**

Frank Simon and protectKiwi Ltd v. Domain Administrator, DVLPMNT  
MARKETING Inc.

Case No. D2024-4216

### **1. The Parties**

The Complainants are Frank Simon, New Zealand (the “First Complainant”), and protectKiwi Ltd, United States of America (“United States”) (the “Second Complainant”), represented by Frank Simon, New Zealand.

The Respondent is Domain Administrator, DVLPMNT MARKETING Inc., Saint Kitts and Nevis, represented by Glenn Gallagher, United States.

### **2. The Domain Names and Registrar**

The disputed domain names <petvilla.com> and <petvillas.com> are registered with DNC Holdings, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 14, 2024. On October 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 14, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (unidentified) and contact information in the Complaint. The Center sent an email communication to the Complainants on October 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. On the same date, the Complainants stated that they will not amend the Complaint.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 5, 2024. The Response was filed with the Center on October 26, 2024.

On October 28, 2024, the Complainants requested permission to submit a supplemental filing and filed it on October 31, 2024.

The Center appointed Assen Alexiev as the sole panelist in this matter on October 31, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainants operate in New Zealand. They provide goods and services in pet boarding, dog day care, pet retail, international pet transport, and transit boarding services. According to the Complainants, they started their business in 2016, under the brand “CatVilla”, and in 2017, they broadened their services to include other pets and changed their brand to “PetVilla”.

The First Complainant is the owner of the United States trademark PETVILLA with registration No. 6860805, applied for on April 2, 2021, and registered on September 27, 2022, for services in International Class 43, with claimed date of first use on February 10, 2022.

The Second Complainant is the owner of the New Zealand trademark PETVILLA with registration No. 1153622, applied for on July 15, 2020, and registered on January 19, 2021, for services in International Class 43.

The two trademark registrations above will be jointly referred to as the “PETVILLA trademark” below in this Decision.

The Second Complainant is the owner of the domain name <petvilla.co.nz>, registered on October 1, 2016, which currently resolves to the Complainants’ official website offering animal boarding services. The earliest Wayback Machine archived copy of the website associated to this domain name dates from December 21, 2018, when it redirected to the website at “http://petretreat.nz/”, which offered the animal boarding services provided by “Mary’s PetVilla”. The earliest Wayback Machine archived copy of the website at “http://petretreat.nz/” dates from December 18, 2018.

The Second Complainant is also the owner of the domain name <petvilla.us>, registered on November 21, 2017, which currently resolves to a website that appears to be identical to the website associated to the domain name <petvilla.co.nz>. The earliest Wayback Machine archived copy of the website associated to the domain name <petvilla.us> dates from August 10, 2018, when the website offered the animal boarding services provided by “Mary’s PetVilla”.

The disputed domain names were initially registered on September 28, 2003. The Complainant has submitted historical Whois records for the disputed domain names. The Whois records updated as of September 1, 2015, show that their registrant was an entity different from the Respondent, and the records updated as of October 28, 2016, show the Respondent as their registrant. The Respondent has submitted invoices dated September 17, 2014, September 1, 2015, and October 28, 2016, issued to it by the Registrar for the payment of the renewal fees for the disputed domain names.

The disputed domain name <petvilla.com> has the header “Discover the Ultimate Petting Zoo Experience at PetVilla.com” and a notice that the domain name is for sale. The disputed domain name <petvillas.com> has the header “Discover the Ultimate Pet-Friendly Getaways at Pet Villas” and a notice that the domain name is for sale.

The Wayback Machine records for the disputed domain name <petvilla.com> show that in 2016 it was inactive, and in 2017 and 2018 it resolved to a landing webpage with a notice that the domain name was for sale. The Wayback Machine records for the disputed domain name <petvillas.com> show that in 2016 it was inactive, and in 2018 it resolved to a landing webpage with a notice that the domain name was for sale.

## 5. Parties' Contentions

### A. Complainant

The Complainants state that the disputed domain names are confusingly similar to the PETVILLA trademark, because they fully incorporate the trademark.

According to the Complainants, the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainants state that for nearly all the time after their registration, the disputed domain names have been offered for sale or used to display pay-per-click ("PPC") advertising and links to competitors. According to the Complainants, the sporadic use and constant offering for sale of the disputed domain names indicate that they were never intended for legitimate business.

The Complainants note that their business started in 2016 under the brand "CatVilla" and expanded in 2017 to "PetVilla" as they broadened their services to other pets, and maintain that their business has gained a strong reputation locally and nationally. The Complainants submit that the disputed domain names have seen significant changes in both registrar and ownership, including a transfer to the Respondent in October 2016. The Complainants maintain that by 2016 their business CatVilla had gained recognition in a major pet magazine in the United States, and plans for expansion under the brand PetVilla were underway. According to the Complainants, the public registration of <petvilla.co.nz> on October 1, 2016, along with a public tender for a new website design, made their intended use of the PetVilla brand foreseeable, and given that the transfer of the disputed domain names to the Respondent occurred just four weeks after their PetVilla brand became public, the Respondent knew or should have known of it, as a simple Google Search or Whois search would have revealed the Complainants' activities.

The Complainants note that the cover story on Pet Boarding and Daycare Magazine (Volume 7, Edition 6, 2017) promoted their business in the United States and internationally. They acknowledge that there was a delay between launching their CatVilla and PetVilla brands, and explain that the local licensing and permit requirements are lower and for that reasons faster issued by the Council for cat boarding than dog boarding and as result the Complainants launched their business in stages.

The Complainants further maintain that the Respondent has been aware of their PetVilla business since at least October 2017, and note that offers to sell the disputed domain names were made to them at unreasonable prices on October 8, 2017, in March 2021, December 2022, May 2023, and June 2023. The Complainants point out that after they declined the Respondent's counteroffers and cited ownership of the PETVILLA trademark in 2023, the content of the websites at the disputed domain names was changed to include links to competitors and keywords targeting pet care, affecting the Complainant's Google rankings. According to them, this shift appears to be aimed at profiting from or targeting the Complainants' PETVILLA trademark for speculative purposes, particularly by creating confusion or diverting business.

The Complainants contend that the disputed domain names were registered and are being used in bad faith. They submit that the Respondent's actions, including offering the disputed domain names for sale at inflated prices, redirecting to a competitor or the posting of unrelated inappropriate content and retaliating with offensive material after receiving the Complainants' cease-and-desist letter, demonstrate a pattern of bad faith behavior.

The Complainants acknowledge that the disputed domain names predate the Complainants' PETVILLA trademark registrations, and submit that circumstances may evolve, and a domain name registered in good faith can later be used in bad faith, especially after the registrant becomes aware of a conflicting trademark.

The Complainants point out that after their business and trademark became known to the Respondent, the same inflated the disputed domain names' price from a "mid-four-figure" price in 2021 to USD 30,000 in 2023, and altered content to interfere with the Complainants' business. According to the Complainants, although the disputed domain names may have been initially registered or operated in good faith, including as a directory or PPC links, the Respondent showed its bad faith and speculative intent after it became aware of the Complainants' PETVILLA trademark. The Complainants submit that the Respondent is a "known domain grabber with a history of bad faith actions, as evidenced by their ownership of at least 39,640 domain names, including 100 beginning with 'pet,' indicating speculative intent".

The Complainants dispute the Respondent's claim of reverse domain hijacking, and claim that they have made consistent, good-faith efforts to resolve this matter fairly, that they have demonstrated transparency, cooperation, and respect for trademark rights with their repeated offers to purchase the disputed domain names and their reasonable cease-and-desist letter proposing alternative solutions to avoid market confusion. They add that the Respondent's uncooperative responses, concealment of its identity, fluctuating pricing, and escalation to harassing content, undermine any claim of hijacking and instead demonstrate the Respondent's lack of legitimate business interest.

## **B. Respondent**

The Respondent points out that the disputed domain names were registered in 2003, long before the Complainants' business "Mary's Cat Villa" was established in December 2016, before they registered the domain name <petvilla.co.nz> in 2016, and before they filed the application for the New Zealand trademark PETVILLA in 2020. The Respondent points out that the brand "Mary's Cat Villa" is not confusingly similar to the disputed domain names, and there is no evidence that the Respondent could have known about the Complainants' business when registering the disputed domain names, as their "Mary's Cat Villa" business did not open until December 2016, and the Respondent was unaware of this small cattery in New Zealand and only heard of the First Complainant when the latter inquired about purchasing the disputed domain name <petvilla.com> in 2017.

The Respondent submits the following timeline of events:

- the disputed domain names were registered in 2003 and have been continuously used in commerce for over 20 years;
- On September 17, 2014, the Respondent renewed the registration of the disputed domain names;
- in December 2016, the Complainants began their "Mary's Cat Villa" business in New Zealand;
- in 2017, the First Complainant contacted the Respondent about purchasing the disputed domain name <petvilla.com>, which was offered for USD 9,000, but the First Complainant declined;
- in July 2020, the First Complainant applied for the PETVILLA trademark in New Zealand;
- in April 2021, the First Complainant applied for the PETVILLA trademark in the United States;
- in 2022, the PETVILLA trademark was registered in New Zealand; and
- in 2024, the Complainants filed their Complaint for the disputed domain names.

The Respondent states that it has legitimate interests in the disputed domain names because it registered and has continuously owned and operated them focusing on pet-related content since 2003, well before the First Complainant's trademark application in 2020. According to the Respondent, "Pet Villa" is a common descriptive phrase that has been in use worldwide for as long as search trends have been tracked. This is why the Respondent acquired the disputed domain names. The Complainants' small cattery in New Zealand has no impact on the worldwide use of the phrase "Pet Villa" in the massive and growing pet industry. The phrase "Pet Villa" is returned in a search on Bing a total of over 10 million times with many "Pet Villa" businesses in the United States.

The Respondent states that the Complainant incorrectly asserts that ownership of the disputed domain names changed in 2016, alleging that the Respondent was not the prior owner. The Respondent maintains that it owned the disputed domain names prior to that time and submits billing records showing that the Respondent paid to renew the disputed domain names in 2014, 2015, and 2016. The Respondent notes that in their correspondence with the First Complainant, the latter admitted that the Respondent had owned the disputed domain names for over 20 years.

The Respondent states that the disputed domain names were neither registered nor used in bad faith. It submits that it has not acted in bad faith because it was impossible for it to have had knowledge of the Complainants' trademark 16 years in the future, that there is no evidence of bad faith at the time of registration and that the Complainants have not shown that the Respondent used the disputed domain names in bad faith. The Respondent states that the Complainants' claims about a public website tender in 2016 are unsupported by evidence, and the Respondent had no obligation to monitor non ".com" domain names. The Respondent maintains that the only country in the world where the Complainants' business is known is New Zealand, because only potential customers who live there would be interested in it.

According to the Respondent, the Complainants' actions suggest reverse domain name hijacking.

## **6. Discussion and Findings**

### **6.1. Procedural issue – Supplemental filing by the Complainant**

The Complainant has filed an unsolicited supplemental filing.

Paragraph 10 of the Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition, while Paragraph 12 of the Rules expressly provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.

The Panel decided to accept the Complainant's supplemental filing insofar as it addressed relevant issues raised for the first time in the Response, including the date when the Respondent became the owner of the disputed domain names, and the Respondent's allegation of reverse domain name hijacking.

#### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainants have shown rights in respect of the PETVILLA trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the PETVILLA trademark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the PETVILLA trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

#### **B. Rights or Legitimate Interests**

Since the Complainants have failed to establish that the disputed domain names have been registered in bad faith, it is not necessary to address the issue of rights or legitimate interests.

#### **C. Registered and Used in Bad Faith**

The evidence in the case file as presented does not indicate that the Respondent's aim in registering the disputed domain names was to profit from or exploit the Complainants' PETVILLA trademark.

The Panel finds that the Respondent did not register the disputed domain names in bad faith targeting of the Complainants or their trademark rights because the Complainants had no trademark rights at the time that the Respondent registered the disputed domain names. [WIPO Overview 3.0](#), section 3.8.1.

The Complainant has not submitted evidence that it had a registered trademark or even unregistered trademark rights at the time the Respondent registered or acquired the disputed domain names, and that the Respondent knew of the Complainants and targeted their trademark when registering or acquiring the disputed domain names.

The disputed domain names were registered in 2003, and the Respondent maintains that it was their owner from that time. It submits invoices for the payment of the renewal fees for the disputed domain names issued to it by the Registrar in 2014, 2015, and 2016. According to the Complainants, the Respondent acquired the disputed domain names only in October 2016, after the Complainants registered their domain

name <petvilla.co.nz>. The Complainants support this allegation with printouts of historic Whois records for the disputed domain names, showing that the Respondent was listed for the first time as their registrant with the update of these records made on October 28, 2016, and that a different entity was listed as their registrant prior to that update. The Complainant submits that the prior registrant was unrelated to the Respondent, but does not dispute the renewal fee invoices submitted by the Respondent, which appear to support a conclusion that the Respondent was the beneficial owner of the disputed domain names at least in 2014 to 2016.

In any case, even if the Complainants' allegation that the Respondent acquired the disputed domain names only in October 2016 is accepted, there is no evidence that the Complainants were carrying out any business at that time under the brand PetVilla. According to their own statements, the Complainants started their business in 2016 under the brand CatVilla, and adopted the brand PetVilla only in 2017. This is in line with the information in the cover story on "Pet Boarding and Daycare" Magazine cited by the Complainants, which states that they opened their Mary's CatVilla business in December 2016. The Complainants' domain name <petvilla.co.nz> was registered on October 1, 2016, but there is no evidence that it was active prior to 2018. The earliest Wayback Machine archived copy of the associated website dates from December 21, 2018, when it redirected to the website at "http://petretreat.nz/", which offered animal boarding services provided by Mary's PetVilla. The other domain name of the Complainants - <petvilla.us>, was registered on November 21, 2017. The evidence that there was an active project for the design of a website for the Complainants' PetVilla business is dated November 2017, and it refers to "PetVilla.US", which coincides with the date of registration of the <petvilla.us> domain name. The earliest Wayback Machine archived copy of the associated website dates from August 10, 2018, when it offered the animal boarding services provided by Mary's PetVilla. The Complainants' PETVILLA trademark was first applied for in 2020, and its United States registration has a claimed date of first use on February 10, 2022. The Complainants state that the Respondent had been aware of their PetVilla business since at least October 2017, when the Parties exchanged correspondence about a possible sale of the disputed domain name <petvilla.com>. The evidence about this correspondence submitted by the Complainants only shows that it was initiated by them and it contains no information about their activities apart the fact that they were interested to acquire the disputed domain name <petvilla.com>.

Considering the above, the Panel concludes that the earliest evidence in the case file that the Complainants had any active business under the brand PetVilla dates from 2018. There is no evidence that they have used this brand earlier. Therefore, if it is accepted that the Respondent became the registrant of the disputed domain names in October 2016, and even if the geographic distance between the Parties is not taken into account, there is no basis to conclude that at this point in time it could have somehow known of the Complainants and of their future PetVilla business, and that it could have targeted their PETVILLA trademark with the acquisition of the disputed domain names. This precludes a finding of bad faith registration or acquisition of the disputed domain names by the Respondent.

According to the Complainants, although the disputed domain names may have been initially registered or operated in good faith, including as a directory or PPC links, the Respondent showed its bad faith and speculative intent after it became aware of the Complainants' PETVILLA trademark. The Complainants submit in this regard that after they sent their cease-and-desist letter to the Respondent, the same inflated the disputed domain names' price and altered content to interfere with their business. Such conduct may be indicative of use of a domain name in bad faith, but it does not support a conclusion that the Respondent must have acquired the disputed domain names in bad faith seven years earlier. As submitted by the Complainants, circumstances may evolve, and a domain name originally registered in good faith can later be used in bad faith, especially after the registrant becomes aware of a conflicting trademark, but even if this is so, it does mean that the cumulative requirement for registration and use in bad faith has been established.

Based on these considerations, the Panel concludes that the Complainants have failed to establish that the disputed domain names have been registered in bad faith. Since the Policy contains a cumulative requirement for registration and use in bad faith, this necessarily means that the third element of the Policy has not been made out.

#### **D. Reverse Domain Name Hijacking**

The Respondent has sought a finding of Reverse Domain Name Hijacking (“RDNH”) be made against the Complainant.

Paragraph 15(e) of the Rules provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

In the Panel’s view, the Respondent’s RDNH allegations have not been made out. Without wishing to suggest that it will always be necessary for a party to respond to letters sent by potential complainants, the Panel observes that in this case the Respondent did not answer the Complainants’ cease-and-desist letter, increased the sale price of the disputed domain names, and altered the content of the associated websites. Although the Complainant has not succeeded in its Complaint, this is insufficient to support a finding that its conduct amounted to RDNH.

#### **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: November 14, 2024