

ADMINISTRATIVE PANEL DECISION

ITWAY S.P.A. v. Sydney Wang, Arch Holdings, Inc.
Case No. D2025-1294

1. The Parties

The Complainant is ITWAY S.P.A., Italy, represented by Studio Legale Tributario EY, Italy.

The Respondent is Sydney Wang, Arch Holdings, Inc., United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <icoy.com> is registered with eNom, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 31, 2025. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on March 31, 2025, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Registration Private) and contact information in the Complaint.

The Center sent an email communication to the Complainant on April 7, 2025, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 9, 2025.

The Center verified that the Complaint together with the amended 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 April 22, 2025. In accordance with the Rules, paragraph 5, the due date for Response was May 12, 2025. The Response was filed with the Center on May 9, 2025.

The Center appointed Steven A. Maier as the sole panelist in this matter on May 20, 2025. 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 Complainant is a company registered in Italy. It is a provider of information technology solutions. Its products include a system branded ICOY, which is a health and safety solution designed to detect the presence of a person in the workplace and reduce accidents at work.

The Complainant registered the domain names <icoy.it> and <icoy.eu> on June 20, 2019.

The Complainant is the owner of trademark registrations for the mark ICOY, the earliest of which includes Italy trademark registration number 2019000095220 for the word mark ICOY, registered on September 3, 2020 with an application date of December 17, 2019.

The Complainant applied for an Italy patent in respect of its ICOY product on July 2, 2020.

The Complainant announced its ICOY product by way of a press release on its website at “www.itway.com” dated July 27, 2020.¹

The Respondent is a trader in domain names (or “domainer”) via a website at “www.namekeen.com”.

The Respondent registered the disputed domain name on March 28, 2000.

The disputed domain name has resolved to a webpage at “www.namekeen.com”, offering to lease the disputed domain name at the rate of USD 200 per month and inviting enquiries as to purchase.

The Complainant submits evidence that it enquired about the disputed domain name via “Sedo.co.uk” in around August 2023 and was quoted a price of USD 22,500.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant submits that the disputed domain name is identical to its ICOY trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has no relationship with the Respondent and has never authorized it to use its ICOY trademark, that the Respondent has not commonly been known by the disputed domain name, and that the Respondent is making neither bona fide commercial use nor legitimate noncommercial or fair use of the disputed domain name. The Complainant submits both that the disputed domain name has been “passively” held, and that the Respondent is seeking an excessive price for the disputed domain name, which cannot give rise to rights or legitimate interests on the Respondent’s part.

¹As discussed in paragraph 4.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It states that the disputed domain name is identical to its ICOY trademark, and that the Respondent is therefore seeking to profit from the goodwill attaching to that trademark. The Complainant asserts, in particular, that it is the Respondent's intention misleadingly to divert the Complainant's customers to its own website.

The Complainant submits that, in cases under the UDRP where the disputed domain name is identical to the complainant's trademark, and the disputed domain name has been used in bad faith, it may not be necessary for the complainant to demonstrate registration of the disputed domain name in bad faith (see e.g., *Ville de Paris v. Jeff Walter*, WIPO Case No. [D2009-1278](#)).

The Complainant contends that the passive holding of a domain name can be considered use in bad faith (see e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)). It further contends that the Respondent provided false contact details in connection with the registration of the disputed domain name.

The Complainant submits that the Respondent has sought to sell the disputed domain name to the Complainant for an excessive price of USD 22,500.

The Complainant contends that the Respondent was obliged to conduct a due investigation at the time of registration of the disputed domain name, and also that it is in breach of a representation and warranty given at the time of registration that it would not use the disputed domain name in violation of any laws or regulations in the future.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent contends that the disputed domain name comprises a non-exclusive, acronymic, four letter domain name, which it registered some 19 years prior to the Complainant's first use of any "ICOY" trademark. It contends that its website at "www.namekeen.com" includes numerous other similarly-constituted domain names (which contention is supported by evidence submitted by the Complainant). The Respondent submits that the Complainant's trademark is not famous or well known and asserts that it was completely unaware of the Complainant prior to the present proceeding.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

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

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of registered trademark rights for the mark ICOY. The disputed domain name is identical to that trademark. The first element functions primarily as a standing requirement, and it is immaterial for the purposes of that element (although potentially relevant to the second and third elements) that the disputed domain name was registered prior to the date of the Complainant's earliest trademark registration.

The first element is therefore established.

B. Rights or Legitimate Interests

The Respondent is a domain owner and offers a significant portfolio of domain names for sale or lease. Dealing in domain names is not illegitimate per se, and a domain owner may be also to establish rights or legitimate interests in the sale of a domain name comprising a dictionary term or acronym, which may potentially be used for a purpose related to that dictionary word or acronym, and which was not registered in order to target any third party trademark rights. A domain owner may, however, be under an affirmative duty to avoid the registration of trademark-abusive domain names.

The Respondent registered the disputed domain name in August 2000 and has offered it for sale alongside other similarly constituted domain names. The Complainant's ICOY trademark did not exist in 2000, and there is no evidence of any use by the Complainant of that term prior to June 2019 at the earliest. In the circumstances, the Panel finds both that the Respondent's explanation for its registration of the disputed domain name is credible, and that the Respondent could not have targeted the Complainant's (then non-existent) trademark at the date it registered the disputed domain name.

The Complainant has therefore failed to establish the second element under the Policy.

C. Registered and Used in Bad Faith

The third element of the Policy involves the conjunctive requirement that the disputed domain name must both have been registered, and is being used, in bad faith. Contrary to the Complainant's assertions, prior cases under the UDRP have comprehensively rejected the concepts either that bad faith registration need not be established in certain circumstances, or that bad faith registration may be retrospectively imputed from subsequent bad faith use (if established) (see e.g., section 3.2.1 of [WIPO Overview 3.0](#)).

In this case, the Complainant is unable to establish bad faith registration of the disputed domain name, since the disputed domain name was registered by the Respondent some 19 years prior to the Complainant's first use of the ICOY trademark. The Respondent cannot therefore have had the Complainant's trademark in mind, or have targeted that trademark, at the time the disputed domain name was registered.

Nor, for the record, does the Panel consider the Complainant to have shown that the Respondent has used the disputed domain name in bad faith. The Panel finds the Respondent's explanation for its registration and offer to sell the disputed domain name to be credible and finds no evidence that it has at any time conducted itself with the intention of taking unfair advantage of the Complainant's trademark rights. The price at which the Respondent may have offered to sell or to lease the disputed domain name does not, in the view of the Panel, support a finding that that the Respondent has sought to target the Complainant.

While the Complainant relies additionally on passive holding, this is not strictly a case of passive holding since the Respondent has actively offered the disputed domain name for sale. In any event, passive holding is not of itself an indication of bad faith but may not preclude a finding of bad faith where all the circumstances of the case point to that conclusion. Among the criteria to be considered in such cases (see e.g., the *Telstra* case, supra) is the question of whether there is any legitimate use that the Respondent could conceivably make of the disputed domain name, which the Panel finds to be in the affirmative in the present case. As to the Complainant's allegation that the Respondent provided false contact details, this appears to be based on the routine redaction of the Respondent's details from Whois information, and there is no evidence that the Respondent provided false contact details to the Registrar.

The Complainant has failed in the circumstances to establish the third element under the Policy.

D. Reverse Domain Name Hijacking

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.

The Panel finds this case to be a clear instance of Reverse Domain Name Hijacking. The Complainant is legally represented and should have been well aware that it could not establish registration of the disputed domain name in bad faith where such registration took place some 19 years before the Complainant's first use of the ICOY mark. It should similarly have been aware of the strict application of the conjunctive requirement for both registration and use in bad faith under the third element of the Policy. In addition, the Panel finds there to have been no reasonable grounds to assert that the Respondent has used the disputed domain name in bad faith.

In the view of the Panel, it is reasonable to infer that the Complainant discovered the disputed domain name to be unavailable at the time it registered the <icoy.it> and <icoy.eu> domain names in June 2019. It also appears to the Panel that the Complainant has sought to acquire the disputed domain name on a commercial basis since that date, as evidenced for example by its correspondence with Sedo.co.uk in August 2023. The Panel concludes, therefore, that the Complainant issued the present proceeding in the hope of obtaining a transfer of the disputed domain name in circumstances where it did not wish to pay the price demanded by the Respondent for the sale or lease of the disputed domain name. Such conduct constitutes a clear abuse of the UDRP.

7. Decision

For the foregoing reasons, the Complaint is denied. Moreover, the Panel finds that the Complaint has been brought in bad faith and constitutes an attempt at Reverse Domain Name Hijacking.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: June 3, 2025