

DISPUTE RESOLUTION SERVICE

D00011744

Decision of Independent Expert

J C Micro Limited t/a Simply Ink

and

Mr Martin Horsfall

1. The Parties:

Complainant: J C Micro Limited t/a Simply Ink
Simply Ink
2 White Hart Yard
Newark
Nottinghamshire
GB241DX
United Kingdom

Respondent: Mr Martin Horsfall
Simply Ink Limited
Unit 4 Jessop Way
Newark
Nottinghamshire
NG24 2ER
United Kingdom

2. The Domain Name:

simply-ink.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.

07 March 2014	09:31	Dispute received
07 March 2014	10:52	Complaint validated
12 March 2014	08:55	Notification of complaint sent to parties
24 March 2014	09:16	Response received
24 March 2014	09:17	Notification of response sent to parties
26 March 2014	14:05	Reply received
26 March 2014	14:06	Notification of reply sent to parties
26 March 2014	14:06	Mediator appointed
01 April 2014	10:25	Mediation started
29 April 2014	10:59	Mediation failed
29 April 2014	11:09	Close of mediation documents sent
12 May 2014	02:30	Complainant full fee reminder sent
12 May 2014	10:46	Expert decision payment received

4. Factual Background

I have taken the following factual background from the Parties' submissions and supporting documents:

- Both Parties trade online and from retail premises in the sale of printer ink and associated goods and services.
- Both Parties' retail premises are based in Newark, Nottinghamshire and are approximately 1.4 miles apart.
- The Complainant trades as 'J C Micro Limited t/a Simply Ink' and uses the domain name jcmicro.co.uk to resolve to its principal website. I have visited that website which has a separate section headed 'Simply Ink' with a link through to www.simplyink.net.
- The Respondent is the sole director and owner of Simply Ink Limited which uses the Domain Name to resolve to its website and also trades from retail premises in Newark.
- The Complainant purchased its 'Simply Ink' business in March 2006 from a Mr Phil Darkin, who had previously run the business under that name from the same retail premises in Newark.
- The Complainant registered a UK trade mark with effect from 3 October 2007 for a logo device comprising the words 'Simply Ink' superimposed

over the top right hand quarter of a circular 'target' device (as shown below) and which is used prominently on its www.simplyink.net website and over its retail shop premises.



- The Domain Name was registered by the Respondent on 7 July 2007 and his company, Simply Ink Limited, was incorporated on 19 September 2007. The Respondent says he has used the Domain Name and traded through his company since then, but the Complainant says (and has demonstrated with documents from Companies House) that the company was dormant until at least 30 September 2009.

5. Parties' Contentions

In summary, in its Complaint the Complainant says that:

- It has been trading using the Simply Ink name since 2002.
- It has a UK registered trade mark for "Simply Ink" (No. 2468459) covering inks, toners and print media.
- The Respondent claims to be the Complainant to most of the customers who ring on the number which the Respondent's business has on its website and claims that the Complainant is an imposter masquerading under his name.
- The Respondent's business operates a few hundred metres away from the Complainant and is using the Complainant's trade name to benefit from its reputation in the area.
- The website of the Respondent's business is selling the same products and services covered by the specification of the Complainant's registered trade mark.
- The Respondent's business is operating with the intention to confuse the Complainant's loyal customers by selling the same products under the Complainant's brand name.
- The Respondent's limited company is dormant and never traded.
- The Complainant has been trading as Simply Ink for many years, as shown from the photograph exhibited to the Complaint of the outside of its retail shop premises taken in 2007 and the fact that it has been taking credit and debit card payments using the name.

- The 'Simply Ink' business now operated by the Complainant was originally set up by Mr Phil Dakin at the same retail premises in 2004.
- The Respondent's business using the Domain Name is clearly using the Complainant's name to take business away from the Complainant and is infringing the Complainant's registered trade mark.
- The Complainant has had complaints from customers who bought products from the Respondent's business online and came to the Complainant's shop to return them and found it was not the Complainant with whom they had traded online.

In summary, in his response, the Respondent says that:

- He has used the Domain Name and other similar domain names since the purchase of the Domain Name in 2007 and the incorporation of Simply Ink Ltd on 19 September 2007.
- Prior to this period, Simply Ink Ltd was traded by others as a company in Morden, London.
- He is the sole director of and trades as Simply Ink Ltd (company registration number 6375132 and VAT registration number 986457164) at 55 London Road, New Balderton, Newark, NG24 3AG.
- These details show that he is the legal owner of and is trading in the UK as 'Simply Ink' with a thriving local and ecommerce business.
- The Complainant's complaint is without foundation because its Companies House details and VAT registration details do not have any notification that they trade as 'Simply Ink'.
- The Complainant's Complaint fails to advise Nominet or the Expert of the above, even though the Complainant has previously been involved with legal action taken against it by the Respondent for use of the Simply Ink name.
- The Respondent asks Nominet under the DRS to transfer to the Respondent's ownership '*any simply ink style*' domain names that the Complainant is using.

In summary, in its Reply the Complainant says that:

- Simply Ink Ltd was formed by the Respondent with the intention to benefit from the Complainant's reputation in the area having been trading since 2003 in its current premises and before that in the Market Square as 'Simply Ink'.
- The Complainant purchased its 'Simply Ink' business in 2005 and paid a huge amount for the goodwill and reputation of the name. Since then, the Complainant has been trading as Simply Ink.

- Records with HMRC and the local Council show that Mr Phil Dakin traded as Simply Ink at the same premises at 2 White Hart Yard, Newark from 2003 onwards, some 4 years prior to the Respondent forming Simply Ink Ltd.
- The Respondent's response relates to 2007 when he formed the company with the intention to pass off. The Complainant challenges the Respondent to provide any documentary evidence that he used 'Simply Ink' as a trading name prior to 19 September 2007 and to explain the reasons he formed Simply Ink Limited when there had been a local shop trading with this name since 2003.
- The Respondent's Simply Ink Ltd company never traded before 2009 which is evident from the accounts submitted to Companies House as it filed 'dormant company' accounts for two years and then after 2009 it filed nominal abbreviated accounts, which was 'a legal cover' to use the Complainant's trade name to benefit from its reputation.
- The Respondent's business is trading online and there is no evidence that its premises are branded as Simply Ink. The Simply Ink Ltd company trades mainly as 'M&R Systems' and uses the Simply Ink Ltd name to trade online only.
- The Respondent's Simply Ink Ltd company is registered at Companies House with a stated nature of business that is totally different to what it is selling online. The description from Companies House states that Simply Ink Ltd's 'Nature of Business' is "47410 - Retail sale of computers, peripheral units and software in specialised stores", whereas the Complainant's trade name registration clearly states that it is selling inks, toners, media and paper.
- The Respondent has not submitted any documentary evidence to prove that Simply Ink Ltd ever traded before 2009 rather than having just registered a company which stayed dormant until 2009.
- The Complainant has numerous items of evidence to prove that it existed since 2003. It is still using a card payment terminal setup in 2006 which clearly states 'JC Micro Ltd trading as Simply Ink'.
- Mr William Jackson (a previous director of the Complainant) instructed local solicitors Larken & Co to write to the Respondent requiring him to cease using the Complainant's trade mark. The Respondent since then stopped using the Complainant's logo but carried on his online activities. The matter would have ended up in court but Mr Jackson fell ill and later died giving the Respondent 'a free hand to use [the Complainant's] name online'.
- Unless the Respondent provides documentary evidence to prove his statements in his Response the Complainant intends to start legal proceedings against him to claim for the financial damage he has caused the Complainant.

- It is quite evident from the proof the Complainant has submitted that the name Simply Ink belongs to it. The Complainant has invested a lot in the Simply Ink name and the Respondent clearly formed Simply Ink Limited to unlawfully benefit from the Complainant's investment.
- The Complainant therefore requests Nominet to transfer '*all domains ending with .uk*' to the Complainant.

6. Discussions and Findings

General

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, i.e. that:

1. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. The Domain Name is, in the hands of the Respondent, an Abusive Registration.

These terms are defined in the Nominet DRS Policy 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;
- **Abusive Registration** means 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Complainant's Rights

The name 'Simply Ink' as a trading name for a business selling printer ink starts out as being a somewhat descriptive term. However, the Complainant also sells toners, media and printer paper and the like under the same name and has been trading under the name for a number of years, both online and from retail shop premises in White Hart Yard, Newark.

The Complainant has given conflicting dates as to when its business first started trading under the name through the Complainant itself and its predecessor in title. However, the documents exhibited by the Complainant, which include letters and an invoice from its solicitors relating to the

Complainant's acquisition of the 'Simply Ink' business from Mr Dakin, show that it was acquired by the Complainant in March 2006 and, at that time, Mr Dakin had been trading from the same shop premises in White Hart Yard, Newark.

There are no documents to show how long before March 2006 Mr Dakin had been trading using the 'Simply Ink' name, but the Complainant says, variously, it was from 2002, 2003 or 2004. But the Complainant has provided documentary evidence, in the form of letters from suppliers, to show that it was trading under the Simply Ink name as soon as it acquired the business in March 2006. In addition, it has the benefit of a registered trade mark which includes the 'Simply Ink' name as a prominent part, which was registered with effect from 3 October 2007.

The Respondent has made a point based upon the name of the Complainant company as recorded at Companies House and for VAT purposes. However, that is not relevant. What counts for the purposes of establishing Rights in a name is not necessarily the registered corporate name but also the trading name and style that has been adopted and used by the Complainant.

In the circumstances, I am satisfied that the Complainant does have Rights in the name 'Simply Ink'. That name is clearly identical or similar to the Domain Name, ignoring the hyphen between "simply" and "ink" and the .co.uk suffix.

The matter therefore falls to be decided on the issue of whether or not the Domain Name is, in the hands of the Respondent, an Abusive Registration.

Abusive Registration

The Respondent claimed that he had used the Domain Name and other similar domain names since he registered it on 2 July 2007 and incorporated Simply Ink Ltd on 19 September 2007. He also claimed that prior to this period, '*Simply Ink Ltd was traded by others as a company in Morden, London*'.

However, he provided no further details or evidence to support the claim that he had used other similar domain names. In addition, even assuming he was talking about a previous different company with the same name, he provided no further details or evidence to support the claim of previous use by others in London, nor did he explain how any such use was linked to the Respondent so that he could claim to benefit from it for the purposes of the DRS. In the circumstances I will disregard his claim in relation to any use of the Simply Ink name prior to the July / September 2007 period.

The Respondent might have referred to Paragraph 4 of the Nominet DRS Policy, being a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration, and, in particular, Paragraph 4 a i) A and B, which states as follows:

i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

A. 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;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.

However, the Complainant has demonstrated in its Reply that Simply Ink Ltd filed annual accounts at Companies House stating that it was a dormant company for the years to 30 September 2008 and 30 September 2009. It filed small company abbreviated accounts for the following three years to 30 September 2010, 2011 and 2012. The Respondent's claimed use of the Domain Name from July / September 2007 was clearly not through his company Simply Ink Ltd any time before at least October 2009, and he put forward no other details or evidence of how he claimed to have used it at that time.

In any event, the Complainant has established use of the 'Simply Ink' trading name since at least March 2006, and for some time prior to that through the previous owner of the business.

The Complainant alleged in its Complaint that the Respondent claims to be the Complainant to most of the customers who ring on the number shown on the website of the Respondent's business and that the Complainant has had complaints from customers who bought products from the Respondent's business online and then came to the Complainant's shop to return them and found it was not the Complainant with whom they had traded online.

It is notable that the Respondent did not deny those allegations or make any comment about them at all in his Response.

The Parties' respective shop premises are both in Newark, being approximately 1.4 miles apart. It is inconceivable that the Respondent was not aware of the Complainant's existing local business trading as Simply Ink when he registered the Domain Name in July 2007 and then commenced using it in a directly competing business, whether that was in July 2007 or later through his company sometime after 30 September 2009.

The Complainant might have referred to Paragraph 3 of the Nominet DRS Policy, being a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration, and, in particular, Paragraph 3 a i) B and C and Paragraph 3 a ii), which state as follows:

i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

B. as a blocking registration against a name or mark in which the Complainant has Rights; or

C. for the purpose of unfairly disrupting the business of the Complainant;

ii. 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;

In the circumstances, I am satisfied on the balance of probabilities that the Domain Name was registered by the Respondent in a manner which, at the time when the registration took place on 7 July 2007, took unfair advantage of or was unfairly detrimental to the Complainant's Rights and that it has subsequently been used by the Respondent in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

As a final point, in his Response, the Respondent asked Nominet under the DRS to transfer to the Respondent's ownership '*any simply ink style*' domain names that the Complainant is using. The Complainant countered in its Reply with an even wider request that Nominet '*transfer all domains ending with .uk*' to the Complainant, although I presume it was actually intended as a 'tit for tat' mirror request to that of the Respondent relating to '*simply ink style*' .uk domain names. In any event, if the Parties wish to complain about and seek a transfer of any other domain name registered by the other Party they must file a separate DRS complaint with Nominet. It cannot be dealt with as part of this DRS Complaint.

7. Decision

For the reasons outlined above I find that the Complainant has proved, on the balance of probabilities, that it has Rights in respect of the name 'Simply Ink' being 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.

In the circumstances I order that the Domain Name be transferred to the Complainant.

Signed

Dated 6 June 2014

Chris Tulley