

## DISPUTE RESOLUTION SERVICE

D00013741

### Decision of Independent Expert

Stationery Direct Ltd

and

Direct Healthcare Limited - Stationery Direct

#### 1. The Parties:

Complainant: Stationery Direct Ltd  
Address: 22 Hallam Drive  
Berwick Grange  
Shrewsbury  
Shropshire  
SY1 4YE  
Country: United Kingdom

Respondent: Direct Healthcare Limited - Stationery Direct  
Address: Unit 8, Junction 2 Industrial Estate  
Oldbury  
B69 4LT  
Country: United Kingdom

#### 2. The Domain Name(s):

stationerydirect.co.uk("Domain Name")

#### 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.

15 January 2014	Dispute received
15 January 2014	Complaint validated and notification of complaint sent to parties
06 February 2014	Response received and notification of response sent to parties

06 February 2014	Reply received and notification of reply sent to parties
11 February 2014	Mediation started
18 February 2014	Mediation failed
18 February 2014	Expert decision payment received
10 March 2014	Respondent non-standard submission received

The Respondent made a non-standard submission pursuant to §13b of the Procedure. Having considered the brief explanatory paragraph that was provided to me in accordance with the Procedure, I determined that it did not justify an exceptional need for me to see the non-standard submission. Nominet notified the parties of my decision by email on 11 March 2014.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

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

The Complainant trades online as Stationery Direct providing services such as the printing of business cards, letterheads and flyers. Stationery Direct Ltd was incorporated on 24 November 2008.

The Respondent trades online as Chemist Direct.

The Domain Name was registered on 13 May 2003. The registrant’s status is “UK Individual”.

#### **5. Parties’ Contentions**

##### **The Complaint**

The Complainant contends that it has Rights in the name STATIONERY DIRECT and that the Domain Name is identical to this term, on the basis of the following submissions:

1. We have been trading online as Stationery Direct since 2005 using the domain [www.stationery-direct.co.uk](http://www.stationery-direct.co.uk).
2. We are registered at Companies House as Stationery Direct Ltd (pdf supplied).
3. We have a Trademark for our company (<http://www.ipa.gov.uk/tmcase/Results/1/UK00003023540>).
4. Over the last 10 years we have built up a large customer base (in excess of 40,000) and are well known in this sector.
5. We have over 250 recent 5 star reviews on Trustpilot <http://www.trustpilot.co.uk/review/www.stationery-direct.co.uk>. This gives an indication as to the type of business we are and hopefully shows how well respected we are within this sector.

The Complainant contends that the Respondent’s registration and/or use of the Domain Name is an Abusive Registrations on the basis of the following submissions:

1. The owner of the [www.stationerydirect.co.uk](http://www.stationerydirect.co.uk) domain, Mr Soma, has for over 2 years been trying to sell the domain on SEDO (pdf supplied). Despite trying to purchase the domain

through SEDO at a very fair price our offers have not been successful as we have not bid the minimum he is prepared to accept, which is an extortionate EUR 7,999 (pdf supplied).

2. Our complaint is that Mr Soma is using a holding page that is advertising our direct competitors by means of a pay-per-click page (pdf supplied) and possibly earning money as a result.
3. Anyone searching for Stationery Direct may accidentally click on Mr Soma's Google listing (pdf supplied). Anyone typing our domain into their browser could easily miss out the hyphen (this is unfortunately common) and go straight to Mr Soma's homepage where he will benefit from our already established good name. We could also lose out on sales to one of our direct competitors as a result.
4. We were in contact with Mr Soma in March 2013 after we filed a DRS case (D00012515) against him for the exact same issue as in this complaint. However he removed the links on the agreement that we would close the DRS case and we took it no further. We now find ourselves in the exact same position again and feel that Mr Soma is deliberately doing this as a tactic to force us to pay the extortionate EUR 7,999 for the domain.
5. We did offer to buy the domain from Mr Soma in 2012 so he knows that we would like it. However, he declined and stated that he was looking to launch a store on the domain. 2 years have passed and the domain is still for sale with the holding page and links being live again since September 2013, despite our agreement made in March of 2013. We feel that anyone serious about developing a domain would have done so within a 2 year period.
6. Obviously we now once again have an issue as Mr Soma is again advertising our direct competition and therefore feel that although the initial registration may not have been abusive there is definitely unfair conduct/passing off now and during last year.
7. We have emailed Mr Soma asking him to remove the links again (emails supplied) but we have had no response whatsoever. Hence we are using the DRS process to sort this out once and for all.

## The Response

The Respondent submitted the following Response:

*"Mr Soma is not the legal owner of the domain name www.stationerydirect.co.uk. Direct Healthcare Limited (trading as chemistdirect.co.uk) owns the domain name. We logged into Nominet today to understand the dispute and respond in the deadline. This is the first we have heard of anyone trying to sell www.stationerydirect.co.uk. We were of the understanding that traffic was being forwarded to www.stationery-direct.co.uk, per our internal URL register. We do not defend the complaint D00013741 although we wish to remain the legal owners of the URL."*

## The Reply

The Complainant replied:

1. Chemistdirect.co.uk was founded by Mr Soma and as far as I am aware he is still the owner and involved with the company. Mr Soma is the person I liaised with directly when we tried to buy the Domain Name and also when the 'links' page was removed in March 2013. Mr Soma's email address was the registered owner's contact email address that Nominet contacted with regards to this complaint.
2. Whoever the owner is, the company has been contacted via Nominet using various methods such as email and recorded delivery to the head office address on the 15th

January. They have had 20 days to defend the complaint and have chosen to give a short reply at 5pm on the final day.

3. To state no knowledge of the specifics of my claim are farcical, when I have been emailing and phoning their head office numerous times for the last 3 months asking for someone to contact me with regards to this issue. Even in the last 20 days when they could have removed the domain from sale, or, removed the links page, they have chosen not to do this. See the attached pdf screen grabs from 5/2/2014 supplied.
4. They have chosen not to state their intentions for the Domain Name going forward. As mentioned we have been trading online as Stationery Direct Ltd since 2005, if anyone was to try and launch a store selling stationery on the stationerydirect.co.uk domain (really all it could be used for) then we would look to take matters further with regards to trademark infringement and 'passing off', which we feel we have a strong case of winning due to the time we have been in operation as Stationery Direct. We have recently won a trademark infringement case against a store trading on Amazon using the Stationery Direct name. We take our name and brand (which have taken years of hard work to build) very seriously.
5. As mentioned in our initial complaint, the 'links' page was removed by the owners last March when we filed a DRS complaint. We came to an agreement and we withdrew the case, although in September 2013 the links were back online. Our complaints by email and numerous telephone requests to speak with the person in charge of the domain were ignored. The Domain Name was left for sale on SEDO for all that time and the owner has not done anything constructive with the domain during the 4 years or so it has been owned by them. Even if the owner now states once again that they will remove the 'links' page unfortunately we would no longer trust their promises having broke them once already and we certainly don't want to have to file a DRS complaint for a 3rd time in the future.
6. The owners are brazenly taking advantage of our already established name and trying to force us to pay an extortionate amount of money for the domain to stop them advertising to our direct competitors.
7. I feel that my complaint with proof supplied is justified, with no valid contest or explanation from the owners. I believe that the Domain Name registration is abusive as there is something 'unfair' going on now and their continued ownership of the Domain Name is inherently 'unfair'.

### **Respondent's Non Standard Submission**

The Respondent submitted the following explanatory paragraph pursuant to §13b of the Procedure:

*"Direct Healthcare Ltd, the owners of the domain name [www.stationerydirect.co.uk](http://www.stationerydirect.co.uk), wish to explain the relationship between Direct Healthcare Ltd ("DHL") and Mr Soma. We want to disassociate ourselves from Mr Soma's actions. Mr Soma was a founder of DHL however he resigned as director of the company on 22<sup>nd</sup> June 2013. DHL subsequently updated the relevant web hosting account with the current CEO's details on 26<sup>th</sup> February 2014."*

## **6. Discussions and Findings**

### **General**

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2 of the Policy, both limbs of the test 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, in the hands of the Respondent, is an Abusive Registration.*

### **Complainant's Rights**

Rights is defined in §1 of the Policy as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

The wholly generic suffix “.co.uk” is discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The words “stationery” and “direct” are two dictionary words in everyday use. There is no evidence before me that the Complainant's use of the two words together has acquired a secondary meaning. Nevertheless, I am satisfied on the papers before me that the Complainant has established registered trade mark rights in the name and mark STATIONERY DIRECT but I note that there is no evidence that such rights predate the registration or acquisition of the Domain Name.

Accordingly, I find for the purposes of the first limb of the test in §2 of the Policy that the Complainant has Rights in the mark STATIONERY DIRECT which is substantially identical to the Domain Name.

### **Abusive Registration**

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

1. *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*
2. *has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3 of the Policy.

Over a month after the response deadline, and a week after the notification of the Expert's appointment, the Respondent submitted a non-standard submission for the purposes of explaining its relationship with Mr Soma and disassociating itself from Mr Soma's actions. It said that Mr Soma was a founder of Direct Healthcare Limited but that he resigned as a director on 22 June 2013. The Respondent changed the contact name in its registration details from Mr Soma to its CEO on 26 February 2014. In its response, the Respondent stated that Direct Healthcare Limited is the owner of the Domain Name and not Mr Soma.

I declined to consider the Respondent's non-standard submission on the grounds that it did not indicate any exceptional need as required by the Procedure. The Respondent was and remains Direct Healthcare Limited. Mr Soma was a director at the time of the first complaint and it was he who made the agreement with the Complainant to remove the offending links from the parking website. Whether the links were restored before or after the resignation of Mr Soma, or whether Mr Soma acted with the Respondent's authority, is immaterial here. The use of the Domain

Name is ultimately the Respondent's responsibility (see §4e.iii of the Policy). Furthermore, it is the Respondent's responsibility to maintain its contact details up to date.

For the purposes of this discussion, references to the Respondent include Mr Soma.

The Domain Name was registered two years before the Complainant says that he commenced trading as Stationery Direct. It could not have been registered 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. The Complainant says that the Respondent has owned the Domain Name for around 4 years but there is no evidence presented of an acquisition at that time.

The Complainant tried to buy the Domain Name from the Respondent in 2012 but was not prepared to pay what he asserts is an extortionate price. It is not abusive per se for a registrant to register a domain name and find at a later date, to his good fortune, that he can sell it for a sum of money which greatly exceeds his cost of registration. There has to have been an intention, with knowledge of the complainant's Rights, to register or acquire the domain name for the purposes of selling it for a sum which exceeds the registrant's out of pocket expenses. There could not have been any such intention or knowledge at the time of registration, and there is no evidence of a later acquisition with such knowledge and intention.

One of the factors which may be evidence of Abusive Registration is stated in the §3a.ii of the Policy:

*"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."*

The Complainant commenced a previous DRS complaint against the Respondent in relation to the Domain Name around the beginning of 2013 because it was being used as a parking page directing traffic to websites offering competing products and services to those of the Complainant. There is no evidence before me which indicates when the Domain Name was first used in this way and whether it was a change of use as a result of the Respondent becoming aware of the Complainant's Rights or as a result of an acquisition of the Domain Name.

Whether or not the Respondent was aware of the Complainant's Rights beforehand, it became aware at the time of first complaint. The outcome of that complaint was that the Respondent agreed to stop using the Domain Name to link to websites offering products and services in competition with the Complainant.

Around September/October 2013 the Complainant became aware that the use of the Domain Name had changed back to providing links to websites offering products and services in competition with the Complainant.

The Complainant is entitled to rely on his agreement with the Respondent that the offending links would be removed from the web site. Despite the attempt to disassociate the actions of Mr Soma, the Respondent indicates that it knew of this agreement since it states in its response that it believed that traffic to the Domain Name was being routed to the Complainant's website at stationery-direct.co.uk.

I am satisfied that many internet users who are looking for the Complainant's website and type "stationery direct" into a search engine would visit the Respondent's website in the expectation that they are in fact visiting the Complainant's website. Some visitors might not be aware that it

is a parking site and click on the pay-per-click links to other stationery sites not operated by the Complainant.

This constitutes both initial interest confusion, as the visitor has been deceived by the Domain Name, and actual confusion for those who continue with the links believing that they are obtaining products and services from the Complainant.

Accordingly, I find that the Respondent's use of the Domain Name has caused confusion and has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights, which is an Abusive Registration.

## **7. Decision**

In light of the foregoing findings, namely that the Complainant has Rights in a name which is similar to the Domain Name, and the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name (stationerydirect.co.uk) be transferred to the Complainant.

**Signed: Steve Ormand**

**Dated: 20<sup>th</sup> March 2014**