

**DISPUTE RESOLUTION SERVICE**

**D00014891**

**Decision of Independent Expert**

**Innox Trading Ltd**

and

**Mr Peter Mason t/a TheDomainmart**

**1. The Parties:**

Lead Complainant: Innox Trading Ltd  
35 Greenhey Place  
East Gillibrands  
Skelmersdale  
Lancashire  
WN8 9SA  
United Kingdom

Respondent: Mr Peter Mason t/a TheDomainmart  
Weatherill House  
New South Quarter  
23 Whitestone Way  
Croydon  
CR0 4WF  
United Kingdom

**2. The Domain Name:**

chemist4u.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 into question my independence in the eyes of one or both of the parties.

13 October 2014 11:12 Dispute received  
13 October 2014 14:07 Complaint validated  
13 October 2014 14:17 Notification of complaint sent to parties  
30 October 2014 01:30 Response reminder sent  
31 October 2014 10:37 Response received  
31 October 2014 10:37 Notification of response sent to parties  
05 November 2014 01:30 Reply reminder sent  
10 November 2014 10:12 Reply received  
10 November 2014 10:19 Notification of reply sent to parties  
10 November 2014 10:20 Mediator appointed  
13 November 2014 10:30 Mediation started  
13 November 2014 14:25 Mediation failed  
13 November 2014 14:25 Close of mediation documents sent  
14 November 2014 10:50 Expert decision payment received

### **4. Factual Background**

The Respondent registered the Domain Name, together with the domain names <chemist4you.co.uk> and <chemistforyou.co.uk>, on February 10, 2000. They are amongst about 2000 domain names that he registered in that year. The Domain Name has been used occasionally to display Pay-Per-Click advertising links unrelated to pharmacy or to display a statement that the Domain Name is for sale.

On March 29, 2009, April 1, 2010 and June 13, 2011 Shamir Patel, the Complainant's representative in this administrative proceeding, expressed interest in buying the Domain Name from the Respondent, in each case using an email address apparently unconnected with the Complainant and in the latter case offering £500. These overtures were rejected.

The Complainant was incorporated in the UK on May 21, 2010. It operates an online pharmacy through the domain names <chemist-4-u.com> and <onlinechemist4u.co.uk>, both of which were initially registered by others (in 2005 and 2008 respectively) and were subsequently acquired by the Complainant.

The Complainant registered the trademark CHEMIST4U in the UK (No. 00003011436) on June 27, 2014, upon application filed on June 25, 2013. It also registered in the UK the logo mark CHEMIST 4u (No. 00003011473) on October 4, 2013 upon application filed on June 26, 2013. Both marks are registered in classes 35 and 44.

### **5. Parties' Contentions**

## The Complaint

In full, the substance of the Complaint as filed reads as follows:

“Innox Trading Ltd holds the trademark for the words Chemist4U. Chemist4U is a multimillion pound turnover online pharmacy that has been trading for over 10 years. The domain hasn't been used for the last 10 years and the owner isn't a registered pharmacist, as is Innox Trading Ltd, so the domain wouldn't be allowed to trade in accordance with laws from the GPhC and MHRA

Why is the domain name an Abusive Registration?

Peter Mason has been domain squatting also known as cyber squatting which is the act of registering a domain name with the purpose of getting monetary benefit from the trademark belonging to someone else. The domain has been registered purely to try to sell it to the actual owner of business/trademark at hefty profit.”

## The Response

The Respondent says the Complainant's registration details show that it was incorporated in 2010 with no UK establishments associated with the company. On 26 August 2012 the website at <www.chemist-4-u.com> was being operated for online trading by a company called North Meols Pharmacy Ltd, with which Shamir Patel was associated. Notwithstanding that personal association, trading by the Complainant using the term “chemist4u” on the <www.chemist-4-u.com> website could not have started before 26 August 2012. Therefore the period of trading pertinent to these proceedings appears to be a maximum of 2 years and 2 months, not the 4 years since incorporation, not the 9 years since the domain name <chemist-4-u.com> was registered and not the “over 10 years” claimed by Shamir Patel.

The Respondent says having a portfolio of generic or descriptive domain names and trading in domains for profit is a lawful activity. Shamir Patel has been aware of the Respondent's ownership of the Domain Name since he contacted the Respondent in 2009 and possibly as early as 2005, when an anonymous approach was made to buy the Domain Name from the Respondent. Until notification by Nominet of this dispute the Respondent was unaware of the existence of the trademark because it is virtually unknown.

The Respondent denies Abusive Registration on the grounds that it was impossible for the Domain Name to have been registered to target the Complainant or any other business entity using the term “chemist4u” as none existed; the Domain Name has at no time been used to confuse or threaten to confuse any entity; and with about 2000 domain names, at no time has the Respondent engaged in a pattern of registrations corresponding to well-known names or trademarks. This is the first complaint the Respondent has received since 2000.

The Respondent says this is a case of Reverse Domain Name Hijacking. Shamir Patel must have read paragraph 3 of Nominet's DRS Policy before initiating this complaint and making the allegation: "The domain has been registered purely to try to sell it to the actual owner of business/trademark at hefty profit."

Further, the Complainant appears to be building a brand on a domain name created 14 years ago by the Respondent. The filing of the UK trademark by the Complainant had, as one of its primary purposes, if not the primary purpose, the use of Nominet's DRS to try to acquire <chemist4u.co.uk> and consequently the rights to <chemist4u.uk>.

The Respondent submits that the trade marking of words used in a good descriptive domain name which had been created long before a mark had been conceived or used by the trademark holder in trading via a less-descriptive and much less-desirable domain name; and then traducing the owner of the coveted domain name with allegations of cybersquatting in an attempt to use a registry's dispute resolution service to try to deprive the rightful owner of his domain, after having had offers of purchase rejected, is the exemplar tactic of a Domain Name Hijacker.

#### The Complainant's Reply

The Respondent freely admits that he operates as a seller of domains.

Evidence of any activity on the Domain Name did not exist until 2008 when the Wayback Machine Internet archive took its first snapshot of the website, which has been crawled only 7 times since 2008, suggesting little or no existence of an associated website during this period, whereas <Chemist-4-u.com>, having been archived 98 times since its launch, has been operating as an active website that provides legitimate services to the public, following commissioning in 2004.

Shamir Patel was trading on ebay years before any proven activity of the Domain Name. The Chemist4u ebay store now has more than 200,000 customer reviews, proving that chemist4u is a recognised and trusted brand.

Onlinechemist4u was registered in 2008 to catch any mis-spellings, typos, etc of our growing brand. Any traffic to this site is simply forwarded to chemist-4-u.com.

As the Respondent's comments show, Shamir Patel approached him on a number of occasions to purchase the Domain Name and each time he rejected the offer. The Respondent does not disclose how much he demanded for the domains <chemist4u.co.uk> and <chemist4you.co.uk> but it is clear that the figure was more than £1000.

To this day, the Domain Name remains for sale.

In 2013, the Chemist4U logo became a registered trademark and in 2014, the word CHEMIST4U was successfully registered as a trademark, reflecting the growing customer base and trust in our brand.

Further to the trust built over many years of trading as Chemist4U and following earlier attempts to purchase the Domain Name for a sensible price, Shamir Patel is now proceeding through Nominet DRS to protect the Complainant's rights in respect of the name and mark which is identical or similar to the Domain Name.

The Respondent has only ever used the Domain Name at various times for displaying pages with Overture/Yahoo keywords for PPC links, which include dating and gambling. The website has never offered any related chemist/pharmacy services and is, therefore, misleading to visitors who might otherwise be searching for the Complainant's recognised brand. This is potentially damaging to its good name and, as such, has become an abusive registration.

## **6. Discussions and Findings**

Under paragraph 2 of the Nominet DRS Policy, in order to succeed in obtaining the transfer to it of the Domain Name, the Complainant is required to prove on the balance of probabilities both that it has Rights in respect of 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, defined in paragraph 1 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) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights

Paragraph 3a of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The following are relevant to this complaint:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
- 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.

Paragraph 4 of the Policy sets out a non-exhaustive list of factors whereby a Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration. They are:

- 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;
  - C. made legitimate non-commercial or fair use of the Domain Name;

### *Rights*

The Complainant clearly has rights in the registered trademark CHEMIST4U. The Domain Name is identical to that mark, the ".co.uk" suffixes being inconsequential.

### *Abusive registration*

As to the Respondent's purpose in registering the Domain Name, I do not accept the Complainant's assertion that the Domain Name was registered "purely to try to sell it to the actual owner of business/trademark at hefty profit" because the Domain Name was registered many years before the Complainant and its trademark came into existence, and also years before the domain names <chemist-4-u.com> and <onlinechemist4u.co.uk> were registered by others and subsequently acquired by the Complainant.

Accordingly the Respondent could have had neither the trademark nor the Complainant in mind when he registered the Domain Name. There was then no "actual owner of business/trademark". His purpose in registering the Domain Name must have been to generate PPC revenue (discussed below) or to sell the Domain Name (no doubt at a profit) to anyone who might wish to buy it. Under paragraph 4d of the Policy, trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities.

As to whether the Domain Name has become an abusive registration, under paragraph 4e of the Policy, sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, I am required to take into account the following factors.

### *The nature of the Domain Name.*

The Domain Name conveys the meaning that it resolves to an online pharmacy website. This means that, following the Complainant's acquisition of rights in the CHEMIST4U trademark, the Domain Name could mislead or confuse visitors searching for the Complainant's recognised brand and, as claimed by the Complainant, this may be potentially damaging to the Complainant's reputation.

*The nature of the advertising links on any parking page associated with the Domain Name.*

I accept the Complainant's assertion that the Domain Name has only ever been used for displaying pages with PPC links, which include dating and gambling, and that the website has never offered any related chemist/pharmacy services. It is therefore clear that the Domain Name has never been used to compete with the Complainant or to divert Internet traffic to the Complainant's competitors.

*The use of the Domain Name is ultimately the Respondent's responsibility.* The Respondent does not question this.

Despite the potential for the Domain Name to mislead or confuse, I find that the Domain Name has not been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights, for the following reasons:

- the Domain Name was registered 10 years before the Complainant came into existence. Whether or not the Respondent was entitled lawfully to conduct an online pharmacy, he was entitled to register the Domain Name on a "first come, first served" basis;
- Shamir Patel, the Complainant's representative, was well aware of the Respondent's registration of the Domain Name before the Complainant applied to register its CHEMIST4U trademark. Hence, from the moment when it started to build its reputation in the mark, the Complainant must have been aware of the possibility that Internet users might be misled or confused by the similarity between the Domain Name and the mark; and
- there is nothing to indicate that the Respondent's use of the Domain Name has changed so as to take advantage of the establishment of the Complainant or of its trademark. In this regard the Expert notes the principle enunciated in paragraph 4.7 of the *Experts' Overview Version 2*:  
"Ordinarily, provided that the Respondent has done nothing new following the coming into existence of the Complainant's rights to take advantage of those rights, the Respondent's use of the domain name is unlikely to lead to a finding of Abusive Registration."

Accordingly I find that the Domain Name has not become, and is not, in the hands of the Respondent, an Abusive Registration.

*Reverse domain name hijacking*

This is defined in paragraph 1 of the DRS Procedure as using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name. Paragraph 16d of the Procedure provides that if, after considering the submissions, the Expert finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking, the Expert shall state this finding in the Decision.

Despite being fully aware that neither the Complainant nor its logo or word marks came into existence until many years after the Respondent registered the Domain Name, the Complaint asserts that the Respondent:

“has been domain squatting also known as cyber squatting which is the act of registering a domain name with the purpose of getting monetary benefit from the trademark belonging to someone else. The domain has been registered purely to try to sell it to the actual owner of business/trademark at hefty profit.”

There is no suggestion that, when he registered the Domain Name, the Respondent was privy to any plans to incorporate the Complainant and to apply to register its trademarks, a circumstance which, if established, could support a finding of cybersquatting where a domain name is registered prior to the existence of corresponding trademark rights.

It was only after the filing of the Response that the Complainant changed tack and claimed that the Domain Name had become an abusive registration. That proposition was arguable but because it did not form part of the Complaint when filed, I consider that it should be disregarded when determining the issue of Reverse Domain Name Hijacking.

Under these circumstances I find that the Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking.

## **Decision**

I find that the Complainant has Rights in a trademark which is identical to the Domain Name but I am not satisfied that the Domain Name, in the hands of the Respondent, is an Abusive Registration. No action should therefore be taken in relation to the Domain Name.

**Signed Alan Limbury**

**Dated: November 30, 2014**