DISPUTE RESOLUTION SERVICE

D00016948

Decision of Independent Expert

Nordic ID Oy

and

Ms Camilla Danks

1. The Parties:

Lead Complainant: Nordic ID Oy
Myllyojankatu 2 A
FI 24100
Salo
Finland

Respondent: Ms Camilla Danks
79 Western Hill Close
ASTWOOD BANK
REDDITCH
B96 6BY
United Kingdom

2. The Domain Name:

<nordicid.co.uk>

3. Procedural History:

3.1 The procedural history in this case is as follows:

12 January 2016 15:28 Dispute received
13 January 2016 11:12 Complaint validated
13 January 2016 11:17 Notification of complaint sent to parties
25 January 2016 10:16 Response received

25 January 2016 10:16 Notification of response sent to parties
28 January 2016 01:30 Reply reminder sent
03 February 2016 10:06 No reply received
03 February 2016 10:06 Mediator appointed
08 February 2016 11:36 Mediation started
25 February 2016 12:58 Mediation failed
25 February 2016 12:59 Close of mediation documents sent
08 March 2016 01:30 Complainant full fee reminder sent
08 March 2016 13:35 Expert decision payment received

3.2 I have confirmed to Nominet that I am independent of each of the parties and that 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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

4. Factual Background

4.1 The Complainant is a company that was established in Finland in 1986 and deals in wireless data collection terminals and software. As at 30 November 2015, the Complainant has sold nearly 200,000 mobile data collectors and mobile radio frequency identification ("RFID") readers worldwide. Approximately 28 % of those sales have been to customers in the UK.

4.2 The Complainant is the registered proprietor of Community Trade Mark No. 42441117 for the word mark NORDIC ID. The mark proceeded to registration on 28 March 2006 in respect of the various goods and services in classes 9, 37, 41 and 42.

4.3 The Domain Name was registered on 17 November 1999 by World Wide Solutions, which at that time was a reseller of the Complainant's products in the UK. The Domain Name was later transferred to Nordic ID Limited, a UK company of which the Complainant held a majority shareholding.

4.4 The Complainant sold its shares in Nordic ID Limited to one Mark Tailford in October 2013 and at the same time entered into an authorised reseller agreement with Nordic ID Limited. At about that time Nordic ID Limited changed its name to Nordic Plus Limited.

4.5 The Complainant terminated its reseller agreement with Nordic Plus Limited by notice dated 24 September 2014 and on 29 September 2014 that company entered into a creditors' voluntary liquidation.

4.6 In early September 2015, the Complainant discovered that the Domain Name had been transferred into the name of the Respondent.

4.7 On 28 September 2015 the Complainant's solicitor sent a letter to the Respondent demanding, inter alia, the transfer of the Domain Name to the Complainant. On 14 October 2015 the Respondent replied by email as follows:

> "I would be prepared to sell [the Domain] to your client (happy for you to make me an offer on their behalf) but if I deem it not an acceptable offer, then I will not be forced into giving it away or selling it at a price, against my will, that I'm not happy with and will wait for the right offer, from whoever, in the future."

4.8 The Domain Name is not currently being used for an active website.

5. Parties' Contentions

Complaint

5.1 The Complainant provides details of its trading activities and its historic dealings with Nordic Plus Limited. It annexes what it claims to be a copy of the authorised reseller's agreement entered into with Nordic Plus Limited, but all but three clauses in that agreement have been redacted.

5.2 The Complainant asserts that is apparent form the these three un-redacted clauses that Nordic Plus Limited agreed that the Domain Name could only be used in relation to the Complainant's products and that the licence said to be granted by this agreement was non-transferable.

5.3 The Complainant asserts that the Respondent's email of 14 October 2015 demonstrates that the Domain Name was acquired primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, and/or for the purposes of unfairly disrupting the business of the Complainant. It also claims that the Respondent is using or threatening to use the Domain Name in a way which 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.

Respondent

5.4 The Respondent asserts that the previous owners of the Domain Name held it for 16 years and substantially invested in the "Nordic ID" business in the United Kingdom during that period. According to the Respondent, the Complainant did not invest in the UK business.

5.5 She claims that she "bought the website legally and [is] therefore covered by the Administration of Justice Act of 1970". The letter of the Complainant's solicitor is characterised as "threatening and bullying" and she claims that she is "protected from this unacceptable behaviour by the Protection from Harassment Act".

6. Discussions and Findings

General

6.1 To succeed under the Policy, the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2(b) of the Policy).

6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

> *"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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

Complainant's Rights

6.3 The Complainant is clearly the owner of a registered trade mark for "Nordic Id" as a word mark. The Domain Name can only be sensibly read as that term in its entirety with addition of the ".co.uk" suffix. The Complainant has therefore established, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name.

Abusive Registration

6.4 The Respondent provides no explanation in her Response as to why she acquired the Domain Name or what she intends to do with it. However, what does appear to be clear from the statements in that Response that she acquired the Domain Name from Nordic Plus Limited with knowledge of how that Domain Name was historically used.

6.5 Further, although the authorised reseller's agreement provided by the Complainant has been so heavily redacted as to make it difficult to understand the full nature and scope of that agreement, what remains is consistent with, and I am prepared to accept, the Complainant's contention that Nordic Plus Limited was unable to assign any rights under that agreement to a third party without the Complainant's consent. Indeed, it is noteworthy that the Respondent does not appear to assert that she was the beneficiary of any such assignment.

6.6 Instead, the Respondent's position appears to be simply that she is entitled to retain the Domain Name because she has purchased it and has not used it subsequently.

6.7 The mere fact that someone has purchased a domain name does not provide any right to retain that domain name if it has been registered or held in an abusive manner. Also it is possible for an Expert to make a finding that a domain name has been abusively registered and/or abusively used notwithstanding that the registrant has merely held the domain name and done nothing else with it (see paragraph 3.3 of the Dispute Resolution Service – Experts' Overview v.2). Whether the registration is abusive will depend upon why that domain name was registered and for what purpose it is being retained.

6.8 In this case, a combination of the facts that the Domain Name takes the form of the Complainant's mark alone without any qualifying addition and the Respondent's knowledge of how the Domain Name has previously been used, leads me to conclude that the Domain Name was most likely acquired and has been held to take some unfair advantage of the Complainant's trade mark rights. I also accept that the Respondent's email of 14 October 2015, strongly suggests that the Domain Name was acquired primarily for the purpose of its sale to the Complainant (and therefore under paragraph 3.a.i.A of the Policy constitutes evidence of abusive registration and use).

6.9 In the circumstances, the Complainant has demonstrated on the balance of probabilities that the Domain Name is an abusive registration.

6.10 Given the Respondent's allegations of harassment, I would also add (although this is an aside and not part of my formal decision in this case) that there is nothing in the Complainant's solicitors letter of 28 September 2015 that would appear to me to amount to inappropriate threatening or bullying behaviour.

7. Decision

7.1 I find that the Complainant has Rights in a mark, which is similar to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

Signed: Matthew Harris **Dated** 1 April 2016