



## **DISPUTE RESOLUTION SERVICE**

**DRS 18115**

**Decision of Independent Expert**

**FARMIGEA UK LTD**

and

**i2i Ophthalmics Ltd**

### **1. The Parties:**

Lead Complainant: FARMIGEA UK LTD  
FARMIGEA UK LTD  
88 Wood Street 10th Floor, C/O Ibc, London.  
London EC2V 7RS  
United Kingdom

Respondent: i2i Ophthalmics Ltd  
45 Beyer Close  
Tamworth  
Staffordshire B77 2DP  
United Kingdom

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

farmigeaophthalmics.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 a nature as to call in to question my independence in the eyes of one or both of the parties.

26 October 2016 16:05 Dispute received  
27 October 2016 11:33 Complaint validated  
27 October 2016 13:39 Notification of complaint sent to parties  
01 November 2016 10:39 Response received  
01 November 2016 10:39 Notification of response sent to parties  
04 November 2016 01:30 Reply reminder sent  
04 November 2016 13:47 Reply received  
04 November 2016 13:48 Notification of reply sent to parties  
09 November 2016 08:49 Mediator appointed  
09 November 2016 12:01 Mediation started  
01 December 2016 14:37 Mediation failed  
01 December 2016 14:43 Close of mediation documents sent  
02 December 2016 13:38 Expert decision payment received

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

The Complainant is the UK subsidiary of an Italian parent company, operating in the pharmaceutical sector.

The Respondent is a limited company which was contracted for a period of months during 2016 to provide consultancy services to the Complainant.

The Respondent registered the Domain Name on 6 March 2016. It resolves to a site promoting the Complainant and its products.

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

I set out below my summary of the Parties' submissions.

##### **Complainant**

##### **Complainant's Rights**

The Complainant manages the development, production and marketing of its products through its subsidiaries, operating in various specialised areas nationally and internationally. It is one of the largest ophthalmic groups in the Italian market, offering a range of ophthalmic and otolaryngology products. Farmigea UK Ltd was established in 2014 and Farmigea Ophthalmics Ltd was incorporated in 2015 to analyse the UK ophthalmic market and develop a marketing strategy to launch its eye care products.

FARMIGEA is a registered trademark throughout the European Union. Evidence is submitted of a Community trademark application dated 24th October 2007 and granted on 6th August 2008.

The Complainant's parent company is the current owner of several domain names incorporating its name in .uk, .it .com and other domains.

The Complainant's registered mark FARMIGEA is similar to the Domain Name. An earlier DRS case dated 6th October 2014 involving the Complainant's FARMIGEA mark was decided in the Complainant's favour.

### **Abusive Registration**

The Complainant recounts that after the establishment of Farmigea Ophthalmics Ltd, it approached i2i Ophthalmics Ltd to promote its products. The arrangement lasted only three months. The Complainant's relationship with the Respondent was thus short-lived and did not explicitly or implicitly authorise the Respondent to register the Domain Name, even less to create a website featuring the Complainant's business information. In November 2016 the Complainant discovered from a Whois search that the Respondent had registered the Domain Name and set up a new website featuring information about the Complainant without its authorisation.

The Complainant claims that the Domain Name in the Respondent's hands is abusive of its FARMIGEA trademark and it is worried the unauthorised and uncontrolled website content may damage its image. The Complainant argues that its online marketing strategy and brand reputation would be compromised by misunderstanding on the part of its stakeholders, visiting a website bearing its name, the content and accuracy of which is not under its control.

### **Respondent**

The Respondent states that he<sup>1</sup> was contracted to work for the Complainant in January 2015 by Mr A. John, becoming a consultant to the company on 1st March 2016. On 18<sup>th</sup> July 2016 the Respondent states that he was told in writing to stop work as the Complainant could not and would not pay the fees and costs incurred from 1<sup>st</sup> March 2016. The Complainant's assertion that the working relationship lasted only three months is therefore inaccurate.

The Respondent claims that he bought the Domain Name at the request of the above-mentioned Mr John. It was to have been paid for by the Complainant but, as of the date of termination of the consulting agreement, payment had not been made. The Respondent claims that he bought the Domain Name to protect the Complainant's interests as it had commenced trading and had not itself secured the Domain Name.

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<sup>1</sup> The response is drafted on the assumption that the Respondent is an individual, Mr Truelove, although in fact the Respondent is a limited company. This is discussed further below.

The Respondent states that the Domain Name website was created as part of its consultancy services. It was modified and updated as requested by the directors of the Complainant. The Respondent says that no payment has been received for these services or for any other work done for the Complainant. This non-payment is now the subject of separate legal proceedings.

The Respondent claims that in July 2016 he was informed by Mr John that the Complainant was unhappy with the Domain Name website and that they wanted it removed. As the Complainant had declared that it would not pay the amount already outstanding, the Respondent took no action to remove the site.

The Respondent states that the site remains at the Domain Name, hosted by I-page and paid for by Mr John as a director of the Complainant. The Respondent argues that as an independent consultant acting for the Complainant he cannot be responsible for the actions of Mr John as a director of that company in not having obtained permission from the parent company to buy the Domain Name.

The Respondent states that he is prepared to negotiate with the Complainant for the sale of the Domain Name if it is ready to pay the outstanding fees and expenses and to provide compensation for the damage caused and costs incurred in his dealings with the Complainant.

The Respondent attaches copies of emails to prove the request from Mr John to purchase the Domain Name and to maintain the website. They further document the Complainant's termination of his consulting activity. The Respondent points out that Companies House records show that Mr A John is a director of the Complainant, although he uses a private email address for all his communications.

### **Complainant's Reply**

The Complainant exercised its right to submit a reply to points raised by the Respondent in his Response. It agreed that it had indeed asked the Respondent to acquire the Domain Name using his own funds. The Complainant however points out and submits evidence to show that it reimbursed the Respondent for this purchase in the amount of £293.10 on 11<sup>th</sup> May 2016.

## **6. Discussions and Findings**

### **Procedural Matters**

1. This case is determined by reference to Version 4 of Nominet's Dispute Resolution Policy, governing disputes submitted after October 1<sup>st</sup>, 2016.

2. The Complainant in this matter is listed as the UK subsidiary of an Italian parent company. The UK subsidiary, in turn, formed a third company which is the entity that had dealings with the Respondent. The parent company is clearly the actual proprietor of the registered trademark upon which the Complainant bases its claim of rights relied on in this complaint. I will return to this matter in the below, but for

convenience the term Complainant should be taken to include whichever of the three companies mentioned the context dictates.

I take the Respondent company i2i Ophthalmics Ltd to be the legal vehicle through which Mr Truelove provides his consulting services. In my discussion below I use the term Respondent to refer to both i2i Ophthalmics Ltd and to Mr Truelove as the context requires.

3. On 8 December 2016 I extended an invitation to the Respondent, pursuant to paragraph 17.1 of the DRS Policy, to comment via a non-standard submission upon the content of the Complainant's Reply to the Respondent's earlier Response. No further submission has been received.

4. The Respondent refers to proceedings in the County Court which he has brought against the Complainant. To the extent that these proceedings form part of the Respondent's argument, I have alluded to them below. I emphasise however that my decision is reached solely in accordance with the DRS Policy; I offer no comment upon, and make no finding in respect of, this legal dispute.

## **Discussion**

Paragraph 1 of the DRS Policy defines Abusive registration 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. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

Paragraph 2 of the DRS Policy requires a complainant to show that

*2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

*2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration*

## **Complainant's Rights**

Paragraph 1 of the DRS Expert Overview, designed to assist parties to DRS disputes, states:

***1.1 (a) Who should the Complainant be and (b) when is it necessary or appropriate for there to be more than one Complainant?***

*(a) The Complainant should be the owner/licensee of the Rights in the name or mark, which the Complainant contends is identical or similar to the domain name in dispute. Surprisingly often, complaints under the DRS Policy (“the Policy”) are lodged in the names of persons and entities not demonstrably the proprietor of the relevant Rights.*

*(b) For example, when the Rights relied upon are owned or shared by one entity but used by a group or associate company whose business is disrupted or confusingly connected with the Respondent. Another example could be in circumstances where the Rights relied on have been licensed and, depending on the facts, it may be desirable for both the Licensor and Licensee to be Complainants. If more than one Complainant is named, it is important that the Complaint nominates one of them as the transferee of the domain name in the event that the Complaint succeeds.*

The parent company of the named Complainant should perhaps have been added as a further complainant as it is the actual proprietor of the trademark rights relied upon. However it is well established that the rights test in DRS cases should not be unduly onerous, and given the factual background (see above) I am prepared to infer a license to the trademark in question in favour of the named Complainant and thus to conclude that it has rights in that name.

The second question is whether the name in which the Complainant has rights is identical or similar to the Domain Name. The registered mark is exactly repeated in the Domain Name, conjoined with the word “ophthalmics” which is indisputably descriptive of the subject matter with which the Complainant is concerned. On this basis I find that the Complainant has the necessary rights to bring this complaint.

### **Abusive Registration**

The Parties have given widely varying accounts of the circumstances leading to this complaint. The material submitted in support of each party’s case is not especially persuasive on either side. Among other oddities, I note the inconsistency relating to the Complainant’s knowledge of the registration of the Domain Name by the Respondent. In the Complaint itself the Complainant says that it “discovered” this registration in November 2016 by reference to WHOIS. In its Reply to the Response the Complainant agrees that it asked the Respondent to acquire the Domain Name in March 2016 and paid for it the following May.

There is no statement from the Complainant concerning Mr A John, referred to several times by the Respondent. Does this gentleman exist? Is he a director of the Complainant, an employee or another outside consultant? Did he have authority, as the Respondent insists, to deal with the Respondent and request the purchase of the Domain Name? The Complaint is silent on these questions.

The Respondent has provided copies of email exchanges between himself and Mr John, but the layout of the email contents (they appear to have been cut and pasted into a single Word document) and the somewhat obscure nature of the narrative

which is disclosed in them makes it difficult for me to assess their probative value. In the end, while I think they broadly support the Respondent's version of events, I doubt that they materially affect the outcome of this dispute.

The Complainant does not contradict the Respondent's statement that Mr John or others associated with the Complainant are currently managing an active site at the Domain Name address. If this is correct, I struggle to see how the Complainant's rights are prejudiced. The Complainant says that it fears "misunderstandings" on the part of its customers or the ultimate users of their products, but no evidence of such misunderstanding is provided. The Complainant attached screenshots from the website and labelled them as "abusive" but it does not seem to me that there is misleading content on the site nor any attempt by the Respondent to deceive the public or draw its attention away from the Complainant or its products. So far as I can see, the Respondent draws no benefit as the registrant of the Domain Name

The Complainant did not address the Respondent's central argument – that he had his contract terminated, was not paid for his consulting services and therefore ceased all communication with the Complainant, including that relating to the Domain Name and the taking down of the associated website. Again, I make no comment upon the merits of the legal action for non-payment which the Respondent says he has initiated. However, whether he be right or wrong, the Respondent relies upon this reported state of affairs to justify his behaviour. In reply, the Complainant simply provides a brief statement showing it had paid the Respondent to register the Domain Name. This is the sole point upon which the Complainant can reasonably rely. Evidence of this payment is submitted by the Complainant which on balance I accept. On this basis it would be unreasonable to deny that the Complainant has a claim to the ownership of the Domain Name. The Respondent argues that he is entitled to ignore this claim because of the Complainant's alleged non-payment of his fees and expenses, but this is not an aspect of the Respondent's case that I can take into account. When invited to do so, as noted above, the Respondent did not make any further comment upon the evidence of payment submitted by the Complainant.

I am led therefore to Paragraph 5 of the DRS Policy, which sets out a non-exhaustive list of factors which may be evidence that a domain name is an abusive registration in a respondent's hands, including at sub-paragraph 5.1 a situation where

*5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:*

*5.1.5.1 has been using the Domain Name registration exclusively; and*

*5.1.5.2 paid for the registration and/or renewal of the Domain Name registration;*

This seems to me to describe the state of affairs between the Parties in this matter.

The DRS Policy does envisage situations where a Respondent may be able to show that the registration is not abusive. A non-exhaustive list is set out in paragraph 8 of the Policy. The Respondent has not invoked any of these possible defences and I do not think that they can assist him in this matter. I therefore conclude that paragraph 5.1.5 of the Policy applies and that in all the circumstances the Domain Name is an Abusive Registration.

## **7. Decision**

I find that the Complainant has rights in a name which is similar to the Domain Name and that the Domain Name is an Abusive Registration in the Respondent's hands. The Domain Name should be transferred to the Complainant.

**Signed Peter Davies**

**Dated 9 December, 2016**