

## DISPUTE RESOLUTION SERVICE

D00012579

Decision of Independent Expert

Graphics and Print (Telford) Ltd

and

Mr Mark Phillips

### 1. The Parties:

Lead Complainant: Graphics and Print (Telford) Ltd  
Unit A13  
Stafford Park 15  
Telford  
Shropshire  
TF3 3BB  
United Kingdom

Respondent: Mr Mark Phillips  
47 Conistone Way  
London  
N7 9DD  
United Kingdom

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

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

11 March 2013 11:11 Dispute received  
11 March 2013 11:46 Complaint validated  
11 March 2013 11:47 Complaint validated  
11 March 2013 13:03 Notification of complaint sent to parties  
11 March 2013 16:54 Response received  
11 March 2013 16:54 Notification of response sent to parties  
14 March 2013 01:30 Reply reminder sent  
15 March 2013 08:38 Reply received  
15 March 2013 08:38 Notification of reply sent to parties  
15 March 2013 08:39 Mediator appointed  
20 March 2013 14:51 Mediation started  
10 April 2013 13:42 Mediation failed  
10 April 2013 13:42 Close of mediation documents sent  
12 April 2013 13:55 Expert decision payment received

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

4.1 The facts set out in this section are taken from the parties' submissions. Where there appears from those submissions to be a conflict between the parties, I indicate their rival positions. Otherwise the facts do not appear to be contested.

4.2 The complainant is a company based in Telford, Shropshire. It has been in business since 1980 as a commercial printer and has a turnover of £2,500,000. It provides employment for 25 staff and operates from a 3500 sq.ft. unit in Stafford Park. The company's design studio is located in an office block elsewhere in the town. The company is a family owned private limited company. The company and 14 staff members use the domain graphicsandprint.com. The company has launched an internet site which will enable potential clients to view its offerings, order and pay for items over the internet. The complainant says that it has had a website for some years, that the website was overhauled in mid-2011 and became a transactional site in the autumn of 2012.

4.3 The registered name of the complainant is as shown in section 1 above but it has traded under the name Graphics and Print for 24 years. Before that it used the name Shropshire Supplies Graphics and Print Limited. It has a website at [www.graphicsandprint.com](http://www.graphicsandprint.com) and is registered as the owner of this domain. I have not been told when it first registered this domain but I assume that it was many years ago.

4.4 In March 2010 the complainant was negotiating to take over a print and design company in Shrewsbury called Livesey Limited. The existence of these negotiations was common knowledge in the industry. The negotiations were ultimately unsuccessful. On 9 March 2010 the domain graphicsandprint.co.uk (the Disputed Domain) was registered. A WHOIS search performed on 23 May 2012 showed the registrant to be “UKAS” and indicated that the registrant was a private individual who had opted to have his or her address omitted from the WHOIS service.

4.5 Subsequently, in early 2011, the complainant was discussing acquiring an e-commerce print supplier called Stationery Direct Limited. The managing director of that company is called Damon Trasetti who stated in an e-mail to the complainant’s managing director of 11 February 2011 that he owned many print-related domains including graphicdesignforums.co.uk and liveseyltd.com. However, he apparently denied owning the Disputed Domain at this time.

4.6 The date of 23 May seems to mark the commencement of hostilities over the Disputed Domain but I have not been told what provoked the WHOIS enquiry on that date. The complainant contacted Nominet who sent out an e-mail (which I have not seen) asking for the registrant’s details to be input. On 2 July 2012 the complainant made a further WHOIS enquiry. This showed the same registrant’s name with an address at 11 Western Road Lymington, Hampshire, SO41 9HJ. On 5 July the complainant wrote to “The Occupier” at this address. Someone calling himself “Julian” rang the complainant in response disclaiming any knowledge of the Disputed Domain. He indicated he had occupied the property since February 2012 and that the registration might relate to the former tenants.

4.7 The complaint says that a Julian Caile is recorded as the contact for New Forest Property Care Limited operating from this address and indicates that confirmation of this may be found at [www.checktrade.com/NewForestPropertyCare](http://www.checktrade.com/NewForestPropertyCare). My attempt to verify this on 23 April 2013 resulted in my being taken to the home page of the checktrade website so it would appear that this listing is no longer valid.

4.8 The complainant carried out a further WHOIS search on 6 August 2012. By this time the registrant’s name had been altered to Julian Caile. On the same day the complainant wrote to Mr Caile seeking an explanation from him of what it had found out. In

particular the letter asked whether it was possible that someone was impersonating Mr Caille for the purposes of registering the Disputed Domain. No reply has been received to that letter.

4.9 The complainant made a further WHOIS enquiry on 10 August 2012. By this date the name and address of the registrant had been changed to Mark Phillips of 47 Conistone Way, London N7 9DD. A further enquiry on 15 August showed that an e-mail contact address, [i\\_b\\_s\\_2000@hotmail.com](mailto:i_b_s_2000@hotmail.com) had been added.

4.10 On 10 August 2012 the complainant wrote to Mark Phillips at the address shown on the WHOIS search of that date indicating that it was interested in acquiring the Disputed Domain and asking him to contact Jeff King of the complainant. Mr Phillips, using the e-mail address in the previous paragraph, replied on 15 August in the following terms:

“Further to your letter received yesterday, unfortunately the domain graphicsandprint.co.uk isn’t for sale, I have spent considerable time and money on the brand for this domain and will be launching my website in the near future, sorry. If anything should change I will let you know.”

4.11 The complainant investigated the identity behind the e-mail address [i\\_b\\_s\\_2000@hotmail.com](mailto:i_b_s_2000@hotmail.com) and found that it is attributed by a directory ARBECEY to a graphic design forum [www.graphicdesignforums.co.uk](http://www.graphicdesignforums.co.uk). Arbecy gives the same e-mail address as the contact point for the operator of the forum and lists its owner as “Damon”. The complainant says that the forum is the property of Damon Trasatti of 22 Hallam Drive, Shrewsbury, SY1 4YE.

4.12 I have taken the above summary of the facts from the complaint. The respondent makes no specific challenge to the facts set out above but says that “The domain has been owned for over 3 years with no previous complaints”. He does not say by whom it has been owned but, as I explain below, I deduce that it is likely that it has been owned by whoever the respondent is since it was first registered.

4.13 The respondent also says that the Disputed Domain is entirely descriptive and that there are many other businesses which use the designation “graphics and print” in their names. He gives as examples Jaguar Graphics and Print, Boyall Graphics and Print and Hawksworth Graphics & Print. He says that the complainant markets itself as Graphics and Print Telford Limited. He says that he has verified this by

an online search but does not produce the results. He says that the complainant's business has hitherto been largely offline and that there would not be a case for passing off if he were to offer print and design services through the Disputed Domain.

4.14 The respondent says that he purchased the Disputed Domain (he does not say when) with no goal of making money by selling the domain or causing the complainant a problem by sitting on it. He has it merely because it is an excellent domain for the services that he already offers and that he has a financial interest in many other print-related domains such as [www.envelopeprinting.co.uk](http://www.envelopeprinting.co.uk), [www.companyletterheads.co.uk](http://www.companyletterheads.co.uk), [www.letterheadprinting.co.uk](http://www.letterheadprinting.co.uk), [www.graphicdesignforums.co.uk](http://www.graphicdesignforums.co.uk), [www.designforums.co.uk](http://www.designforums.co.uk) and a whole host of other design and print related domains.

## **5. Parties' Contentions**

5.1 The complainant says that it has rights in the name Graphics and Print as a result of many years of trading under that name. It says that it is being denied the Disputed Domain by some kind of subterfuge and that it wishes to acquire the Disputed Domain to assist in the promotion of its business. It also says that it is clear that the respondent wants to build a business using its name and reputation. In the reply the complainant says steps have been taken to hide the true identity of the owner of the Disputed Domain who is in fact Damon Trasetti and not Mark Phillips.

5.2 The respondent says that the Disputed Domain is entirely descriptive, that no-one can have rights in it and that he acquired and holds it innocently for his own purposes as noted above.

## **6. Discussions and Findings**

6.1 The version of the DRS Policy relevant to the present dispute is version 3 which relates to complaints lodged after 29 July 2008. Paragraph 1 of that policy defines an 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. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”

6.2 Paragraph 1 of the DRS Policy also defines “Rights” for the purposes of this procedure as including but not limited to those enforceable under English law. Under Paragraph 2 of the DRS Policy a complainant must show on the balance of probabilities

- (a) that it has Rights in a name or mark identical or similar to the Domain Name; and
- (b) that the Domain Name in the hands of the Respondent is an Abusive Registration.

6.3 Paragraph 3 of the DRS Policy identifies a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. The relevant factors for the purposes of the present case are

- “(a)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;
  - B. as a blocking registration against a name or mark in which the Complainant has Rights;
  - 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;
- ...
- (iv) It is independently verified that the Respondent has given false contact details to us.”

The remaining factors are not relevant in the present case. I have accordingly taken the above factors into account in reaching my conclusions.

6.4 Clause 4 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. These include the following which are relevant to the present case:

“(a)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 commercially known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

...

6.5 According to the Appeal Panel decision in the *Seiko* case (DRS 00248) whether a registration is an abusive registration under the DRS Policy is independent of whether a domain name registration is an infringement of trade mark and should be decided under the terms of the DRS Policy alone. The same decision also makes clear, however, that the Policy is founded on the principle of intellectual property rights which should be taken into account.

6.6 The first question in any DRS complaint is whether the complainant has Rights. This, as has been said in many cases, is a low threshold test. The present complaint, however, is one of those rare cases in which it is not immediately clear whether the complainant passes the threshold. As the respondent rightly points out, the Disputed Domain is essentially descriptive. However, that is not a bar to the acquisition of rights. It simply means that it is more difficult to establish rights and that a small variation from the precise descriptive name in which rights have been acquired will suffice to avoid confusion.

6.7 The complainant prays in aid a substantial turnover and long use of the name Graphics and Print as its business name. It says that it has had a website under that name for some years. It has produced a copy of its letterhead and a photograph of its premises bearing that name in which the sign is clearly not new and has the website address clearly printed at the bottom. Whilst the respondent says that he has found the complainant listed in directories under the name Graphics and Print Telford, he has produced no supporting evidence. Given my conclusions as to his veracity below I am not prepared to accept his unsupported word. Accordingly, I conclude that the complainant has established that it has made substantial long-term use of the name Graphics and Print and that it has used that name on the internet through the website [www.graphicsandprint.com](http://www.graphicsandprint.com) for some years.

6.8 Accordingly, I conclude that the complainant has made out its claim to have rights in the name Graphics and Print. As this a wholly descriptive name, any variation from it would be likely to distinguish a rival business. The names that the Respondent has cited are therefore distinct from the name in which the complainant has acquired rights. The Disputed Domain, however, is identical to the name in which the complainant has shown rights. It follows that the complainant meets the threshold test in the present case.

6.9 I have set out the historical facts above at some length because it seems to me that they are essential to understanding the current dispute. From those facts I deduce that the Disputed Domain is likely to be owned by Damon Trasatti and always to have been owned by him although he is now using the name Mark Phillips or corresponding through someone called Mark Phillips. The entry in the WHOIS register of a series of different names and addresses as the registrant of the Disputed Domain appears to be a deliberate attempt to conceal the fact that Mr Trasetti is the owner of the Disputed Domain and the fact that he registered the Disputed Domain (and I suspect liveseyltd.co.uk) to interfere with the complainant's business. Accordingly, I have concluded that I cannot rely on anything the respondent asserts unless it is independently corroborated.

6.10 It is clear that Mr Trasatti owns the domain graphicdesignforums.co.uk. He is registered as its owner and claimed to own it in 2011. His e-mail address for the forum hosted on that domain is the same as that used by Mark Phillips in this complaint. The respondent in his response claims to have a financial interest in that domain. He does not explain what that interest is. I deduce that he owns it. Mr Trasatti also claimed to own the domain liveseyltd.com. That indicates that he was aware of the complainant's interest in acquiring that company in 2010.

6.11 The respondent has not challenged the detailed history of the changes of name and address given for the registrant of the Disputed Domain. He has not explained why the name of the registrant was originally given as "UKAS" which is clearly not the name of a person. He has not explained who Julian Caile is or why he was briefly shown as the registrant. It is clear that the registrant is in contact with Julian Caile or whoever is at the address given for him when he was shown as the registrant. The respondent appears to claim to have owned the Disputed Domain at all times.



6.12 The complete absence of any challenge to the complainant's analysis of the ownership of the Disputed Domain, the clear connections between Mr Phillips and Mr Trasatti and the absence of any explanation from the respondent for what the complainant has shown leads me to the conclusion that the respondent is in fact Damon Trasatti.

6.13 The consequence of that conclusion is that Mr Trasatti registered the Disputed Domain when he was aware that the complainant was trying to take over related businesses in 2010 and has since sought to conceal what he did. In these circumstances I can only conclude that he registered it as a blocking or ransom domain to hold against the complainant.

6.14 It is possible that he subsequently decided to exploit the Disputed Domain to promote his or his business's services. However, he claimed that he was going to launch his website on the Disputed Domain "shortly" in August 2012. The domain currently resolves to a parking page. So even that claim appears to have been false. Were he to launch a graphic design and print service through the Disputed Domain, it seems to me to be likely that some of those who know of the complainant under its identical name would assume that they were the same business or that there was a relationship between them.

6.15 In these circumstances it seems to me that the Disputed Domain is an Abusive Registration under the DRS Policy. In particular it falls foul of at least paragraphs 3(a)(i)(B), (C) and 3(a)(ii) of the Policy.

6.16 The Disputed Domain is in my view also an Abusive Registration under the provisions of paragraph 3(a)(C)(iv) of the DRS Policy on the ground that the respondent has given false contact details. In my view my conclusion based upon the evidence presented to me by the complainant that the respondent is in fact Mr Trasetti and not Mr Phillips is sufficient to constitute "independent verification" for the purposes of that paragraph. As there is no prior decision on this point, however, and my approach would therefore be a novel one under the DRS I have not found it necessary to rely upon this factor in reaching my decision that the Disputed Domain is an Abusive Registration.

## **7. Decision**

7.1 I direct that the Disputed Domain be transferred to the complainant.

Michael Silverleaf

**Signed** .....

**Dated** 24 April 2013