

# **DISPUTE RESOLUTION SERVICE**

**D00019389**

## **Decision of Independent Expert**

Innox Trading

and

Mr Mohammad Saeed Akhtar

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

Complainant: Innox Trading  
35 Greenhey Place  
Skelmersdale  
Lancashire  
WN8 9SA  
United Kingdom

Respondent: Mr Mohammad Saeed Akhtar  
7 Gainford Avenue  
Gatley  
Cheadle  
SK8 4QG  
United Kingdom

### **2. The Domain Name:**

pharmacy4u.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 in to question my independence in the eyes of one or both parties.

10 October 2017 Dispute received

10 October 2017 Complaint validated

10 October 2017 Notification of Complaint sent to parties

23 October 2017 Response received  
23 October 2017 Notification of Response sent to parties  
26 October 2017 Reply reminder sent  
26 October 2017 Reply received  
26 October 2017 Notification of Reply sent to parties  
31 October 2017 Mediator appointed  
31 October 2017 Mediation started  
09 January 2018 Mediation failed  
09 January 2018 Close of mediation documents sent  
19 January 2018 Complainant full fee reminder sent  
24 January 2018 No expert decision payment received  
05 February 2018 Respondent full fee reminder sent  
08 February 2018 Expert decision payment received

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

The Complainant is the owner of a pharmacy business trading as Chemist4u, an online pharmacy. It owns the trade mark, Pharmacy4U, in the UK (Registration No: UK3077139) filed on 15 October 2014, with a registration date of 10 April 2015.

The domain name in dispute, pharmacy4u.co.uk (the Domain Name) was registered by the Respondent on 11 May 2003. The Domain Name resolves to a landing page with links to other online pharmacy services.

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

The following is a summary of the main contentions of the parties.

##### The Complainant

The Complainant is the owner of the brand 'Chemist4U'.

It operates its pharmacy business from a fully licensed and regulated pharmacy premises.

Under UK Pharmacy law, it is illegal to use the name 'Pharmacy' or 'Chemist' in the title of a business or as part of a domain name, unless the user is a fully registered and licensed pharmacy with the relevant UK governing bodies, such as the GPhC (The General Pharmaceutical Council) or the RPSGB (Royal Pharmaceutical Society of Great Britain). The GPhC can bring criminal proceedings against anyone claiming to be a pharmacy or pharmacist without an appropriate registration.

The intention in registering the trade mark 'Pharmacy4U' was to use it for the prescription arm of the Complainant's business (whilst using 'Chemist4U' for its retail arm).

As the owner of the trade mark, 'Pharmacy4U', and being permitted to use the restricted titles 'Pharmacy' and 'Pharmacist', the Complainant seeks to demonstrate its right to ownership of the Domain Name. The Respondent has no registration with pharmacy bodies in the UK, as extensive checks have been undertaken in this regard. He will not therefore be able to use the restricted titles.

The registration of the Domain Name is an Abusive Registration because it was carried out by a non-pharmacist and the restricted title, 'Pharmacy', is being used illegally.

The Domain Name is not in use currently.

The Complainant's trade mark is being used illegally under the Trade Marks Act, and is being kept dormant, inhibiting the Complainant's brand from developing in the UK.

The Domain Name resolves to a landing page or default site which links to other online pharmacy services and to one of the Complainant's biggest competitors, Pharmacy2U. The Complainant feels that the Domain Name is being abused to steer traffic away from the Complainant to Pharmacy2U.

The Complainant's aim was to open dialogue with the Respondent, to explain its stand point regarding its trade mark, future use of the Domain Name and the implications of using the restricted title, 'Pharmacy'. However, it could only find a name, but no contact details.

### The Respondent

The Respondent's full name is Mohammad Saeed Akhtar.

He is a registered Pharmacist and legally entitled to use the titles, 'Pharmacy' and 'Pharmacist'. His GPhC registration number is 2025045.

The Domain Name was registered well before the Complainant registered its trade mark. It was registered with a view to setting up an internet pharmacy business, which the Respondent is lawfully entitled to do.

The Respondent runs three 'bricks and mortar' pharmacies and intends to set up an online pharmacy. Two previous attempts in setting up a website using the Domain Name have failed.

The Respondent is now preparing a shopping portal with the site, [thepharmacycentre.com](http://thepharmacycentre.com).

The Domain Name will be used to direct traffic to the Respondent's site if it is not used for the main site.

The Respondent still wishes to set up and use the Domain Name for his own retail pharmacy website. He asserts his right to the Domain Name and maintains that it is not an Abusive Registration.

### Complainant's Reply

Although a Reply was filed by the Complainant with Nominet, it does not address the submissions of the Respondent. It merely deals with methods of communication (with the Respondent).

## **6. A preliminary matter**

On reviewing the case file, the Expert noticed that the exhibits referred to in the Complainant were missing. Nominet were notified and on 15 February 2018, they wrote to the Complainant (copying the communication to the Respondent) stating, *'The Expert has asked, in accordance with section 17.1 of the DRS Policy, whether you could now provide the supporting evidence you intended to include from the outset?'*

The Complainant responded the next day, saying *'Hi team, my apologies these appear not to have loaded correctly to the portal please see attached. This contains all of the "Fig" references mentioned in the initial complaint'*.

The 'references' (exhibits) were attached to what at first sight looked like the filed Complaint (albeit in another format), but which on further review turned out to be an amended version of the Complaint. It appears that the Complainant has sought to revise its Complaint, most likely as a result of what the Respondent said in his Response regarding his registration with the GPhC and his right to use the titles, 'Pharmacy' and 'Pharmacist'. The revision involved removal of the following two sections of the Complaint:

*'The person currently in control of this domain has no registration with the pharmacy bodies in the UK as we have preformed (sic.) extensive checks on their details therefore they will be unable to use this restricted title'*.

and

*'The registration of this domain has been carried out by a non-pharmacist which indicates it the restricted title "Pharmacy" is being used illegally. The domain is not in use currently and as the owner of the trademark Pharmacy4U (Words), and under the trade marks act our trademark is being used illegally (restricted title) and is being kept dormant inhibiting our brand from developing in the UK'*.

The latter removed section has been replaced with the sentence:

*'The key element to the abuse of the domain is how a person is directed when they land on www.pharmacy4u.co.uk. They are linked to Pharmacy 2U which is our main competitor in this market'*.

The Expert did not ask for an amended Complaint, but just the exhibits to the original Complaint. The revised version of the Complaint would therefore appear to constitute a 'non-standard submission' under section 17.2 of the Policy, although the provisions governing non-standard submissions under section 17.3 have not been complied with. The Expert, in his discretion, has taken into account the revised submissions provided to Nominet on 16 February 2018, although they have made no difference to the outcome of this Complaint. The revised submissions have merely emphasised that the assertions of the Respondent concerning his entitlement to use the titles, 'Pharmacy' and 'Pharmacist' (because of his GPhC registration) are unchallenged.

## **7. Discussion and Findings**

As a preliminary comment, it should be made noted that disputes under Nominet's Dispute Resolution Service (DRS) are decided by reference to the terms of the DRS Policy (the Policy), not the law. Thus, for instance, whilst intellectual property law is often of assistance in relation to the question of enforceable 'Rights' (as to which see below), the fact that a domain name registration, or its use, may constitute trade mark infringement, does not necessarily lead to a finding of Abusive Registration under the Policy. Whatever analysis might be propounded in terms of intellectual property law, a Complainant must still satisfy the requirements of the Policy. The same can be said for any other contravention of law or regulations e.g. the Medicines Act 1968 which restricts the use of the title, 'Pharmacy'.

Turning to the provisions of the Policy then, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

### *Complainant's Rights*

'Rights' is defined in the Policy as follows: *'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'*.

As noted earlier, the Complainant owns the trade mark, Pharmacy4U, in the UK, filed on 15 October 2014, with a registration date of 10 April 2015. It clearly has Rights for the purposes of the Policy.

Ignoring the suffix '.co.uk.' as Experts are permitted to do under the Policy, the Domain Name and Complainant's trade mark are identical. Accordingly, the Expert is satisfied that the Complainant has Rights in a mark which is identical to the Domain Name.

The Expert must now therefore consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

### *Abusive Registration*

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either '*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 which '*is being or has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights*';.

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 5 of the Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name *primarily* 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; as a blocking registration against a name or mark in which the Complainant has rights, or for the purpose of unfairly disrupting the business of the Complainant.

Other factors suggesting an Abusive Registration include the Respondent 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; or where the Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the domain name is part of that pattern.

Where the domain name is an exact match for the name or mark in which a Complainant has rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for the registration, that too may be evidence of an Abusive Registration.

Also, there shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the two years before the complaint was filed (although this presumption can be rebutted).

A non-exhaustive list of countervailing factors is set out in paragraph 8 of the Policy. These are factors which may indicate that a domain name is not an Abusive Registration. These include circumstances suggesting that before being aware of the Complainant's cause for complaint, the Respondent used or made demonstrable preparations to use the domain name in connection with a genuine offering of goods or services. A Respondent being commonly known by a name or legitimately connected with a mark which is identical or similar to the domain name, or having

made legitimate non-commercial or fair use of the domain name, will also be indicative of a registration that is not abusive. Further, if the domain name is generic or descriptive and the Respondent is making fair use of it, that too may indicate that it is not an Abusive Registration.

At the heart of the Policy, is the requirement to prove unfairness and thus for a registration to be considered 'abusive', there should be something unfair in the object or effect of the Respondent's behaviour. It is perfectly possible for a Respondent to make fair use of a domain name that incorporates a Complainant's trade mark (and which also, for that matter, causes confusion) if, for instance, before being aware of the Complainant's cause for complaint, the Respondent has used or made demonstrable preparations to use the domain name in connection with a genuine offering of goods or services.

However, before one even gets to an analysis of whether a Respondent has an answer to a Complaint (whether by reference to the non-exhaustive list of circumstances postulated in paragraph 8 of the Policy, or otherwise), there must be a *prima facie* case made out by the Complainant of Abusive Registration. Knowledge of a Complainant and/or its rights is a crucial element in most cases. The importance of knowledge on the part of a Respondent is illustrated by the 2007 DRS Appeal Panel decision in *Verbatim Limited v Michael Toth (DRS 4331)*, in which it was said:

*'... the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 [now paragraph 5 of version 4] of the Policy:*

*(1) First, some knowledge of the Complainant and/or its brand/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) [now paragraph 5.1.4] (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.'*

It should be noted that *Verbatim* was decided by reference to version 2 of the Policy. The current version of the Policy (4) is different and indeed the jurisprudence in relation to DRS proceedings in some respects may have moved on. But there must still be something unfair in the object or effect of the Respondent's behaviour and it is to this issue that the Expert now turns.

The Complainant (in its Complaint as originally filed), alleges 'illegal' use in the Domain Name of the restricted title, Pharmacy. That assertion was based on its '*... extensive checks...*' on the Respondent showing that he has '*...no registration with the pharmacy bodies in the UK...*'. This assertion is said by the Respondent to be incorrect. The Respondent asserts that he is indeed registered with the GPhC and entitled to use the titles, Pharmacy and Pharmacist. His assertion is unchallenged by the Complainant. This is no doubt why the Complainant sought to re-focus its

Complainant in its submissions on 16 February 2018, and emphasise its assertions concerning the landing page to which the Domain Name resolves and the link on that page to its competitor, Pharmacy2U.

Were the Respondent using the title, 'Pharmacy', contrary to the Medicines Act 1968 (or otherwise), that would have been a relevant factor. But it seems clear that, from a regulatory point of view at least, he is just as entitled to use that title as the Complainant. It follows, particularly given the Respondent's profession and plans for an online presence, that he has a perfectly plausible explanation for registering the Domain Name in the first place.

The Respondent registered the Domain Name over 11 years before the Complainant filed its trade mark application. There is no evidence that the Complainant had any kind of interest in the name 'pharmacy4U' at the time the Domain Name was registered, let alone 'rights'. Similarly, there is no evidence that the Respondent knew anything of the Complainant, its interest in the name, 'pharmacy4U' or its trade mark registration, until he saw the Complaint. The Respondent had a perfectly legitimate and obvious interest in registering the Domain Name. Whilst he has had some disappointments to date in developing an online presence using the Domain Name, he maintains an interest in doing so in the future. There is no evidence to suggest that the Respondent's plans, past or future, were or are, a result of (or were influenced by) the Complainant's interest in the name, 'pharmacy4U', or its trade mark registration.

As to the Respondent's present use of the Domain Name, i.e. the landing page with a link to the Complainant's main competitor, it can readily be seen how such use might not be helpful to the Complainant who wishes to build a brand around its trade mark. But there is nothing unfair *per se* in directing a domain name to a landing page containing links to online businesses. If, for instance, the Complainant could show that the Respondent discovered the Complainant's trade mark registration and/or plans to build an online presence using its trade mark and then, on doing so, directed the Domain Name to the landing page (so there was at least a suggestion that the Respondent was exploiting whatever reputation the Complainant had in the name, 'pharmacy4U'), there would be a *prima facie* case to answer. But the reality is, there is no evidence of any intention to exploit the Complainant or that the Respondent had the Complainant in mind at any relevant time. Moreover, the Complainant has not advanced any evidence that it has any reputation in the name, 'pharmacy4U' to be exploited. Thus, whilst Internet users may well be steered to the landing page and from there to the Complainant's competitor, it is unlikely (given the lack of evidence that the name 'pharmacy4U' is in fact associated with the Complainant) that they will have been confused into believing that the Domain Name (or for that matter the landing page or any online pharmacy to which it is linked), is registered to, operated or authorised by, or otherwise connected with the Complainant (one of the examples of circumstances suggesting Abusive Registration under paragraph 5 of the Policy).



The reality appears to be that neither the Complainant nor the Respondent have done that much with the name, 'pharmacy4U', despite the Respondent having registered the Domain Name back in May 2003 and the Complainant having made a somewhat bigger investment, far later, in obtaining an identical trade mark. Regardless of what the parties have or haven't done, however, the Respondent has not (on the evidence in the case) in any way acted unfairly in relation to the Complainant and the Respondent has failed to make out a *prima facie* case of Abusive Registration.

## **7. Decision**

For the reasons given, whilst the Complainant has made out its case in relation to Rights for the purposes of the Policy, it has not done so in relation to Abusive Registration and the Complaint therefore fails. Accordingly, the Expert directs that no action be taken in respect of the Complaint.

**Signed** ..... ..      **Dated** .....

**Jon Lang**