

Nominet UK Dispute Resolution Service

DRS 00205

M. E. Mail Order –v- Starlight

Decision of Independent Expert

1. Parties:

Complainant: M. E. Mail Order
Contact: Mr Frank Foster
Address: PO Box 20
71 Willsheres Road
Biggleswade
Bedfordshire
Postcode: SG18 0QS
Country: GB

Respondent: Starlight
Contact: Mr Alan Horswill
Address: PO Box 10
Buckhurst Hill
Essex
Postcode: IG1 5EU
Country: GB

2. Domain Name:

memailorder.co.uk (“the Domain Name”)

3. Procedural Background:

The Complaint was lodged by email with Nominet on January 17, 2002. Hardcopies were received in full on January 18, 2002. Nominet validated the Complaint and notified the Respondent of the Complaint on January 18, 2002 and informed the Respondent that he had 15 days within which to lodge a Response. The Response was received by Nominet on February 11, 2002 and in hardcopy form on February 12, 2002 (beyond deadline). The Response was sent by email to the Complainant on February 11, 2002. A Reply was received by email from the Complainant on February 11, 2002. On February 12, 2002 hardcopies of the Reply were received by Nominet and ‘initiate mediation’ documents were generated.

Mediation failed and Nominet so informed the Complainant. On March 6, 2002 the Complainant paid Nominet the appropriate fee for a decision of an expert pursuant to paragraph 6 of the Nominet UK Dispute Resolution Service Policy (“the Policy”).

On March 8, 2002, Tony Willoughby, the undersigned, (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. The Facts:

The Complainant is a mail order business based in Bedfordshire which has been selling condoms by mail order since 1996 and over the internet via its website www.memailorder.com since 1997.

The Respondent is another mail order business engaged in the sale of condoms. It is based in Essex and has been in business since 1992. It has conducted business over the internet via its website at www.memailorder.co.uk since registration of the Domain Name on January 14, 2002.

5. The Parties’ Contentions:

Complaint

The Complainant claims that the Domain Name is identical or similar to a trade mark in which the Complainant has rights (ie its trading name M. E. Mail Order and its domain name memailorder.com). The Complainant further claims that the registration of the Domain Name by the Respondent is an abusive registration in that the Respondent’s motive in effecting the registration can only have been “to hijack any of M. E. Mail Order customers who mistakenly type in the.co.uk suffix.”

The existence of the Respondent’s site was drawn to the Complainant’s attention by a customer who entered the wrong suffix when seeking to visit the Complainant’s site.

Response

The Response is very short and reads as follows:-

“Starlight have been established in the mail order condom business since 1992 and have been actively involved in the gay market since this time. The disputed site is being marketed as Male Exclusively condom service and is specifically branded to a separate market to that of the Complainant. We are members of the GBA, Gay Business Association. We do not intend to make a long statement here but will vigorously defend our rights through your procedure and if necessary the legal system. Since we have been established longer and operate in a totally different market, we consider that this information is sufficient.”

Reply

The Complainant brands the Response as disingenuous in that it does not begin to address the issue over the name. The fact that the Respondent may have been trading since 1992

(presumably under the name Starlight) does not give the Respondent any right to trade under the Complainant's name, M E Mail Order.

The Complainant asserts that it also sells condoms to the gay community. It draws attention to the fact that the Respondent's website has changed from time to time, sometimes overtly targeting the gay community and sometimes not. The Complainant observes that the Respondent's site links to a site at www.condomsuk.com. The Complainant further contends that on February 11, 2002, the site was linked to www.gayvidshop.com containing pornographic material.

6. Discussion and Findings:

General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and secondly that the Domain Name in the hands of the Respondent is an abusive registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

The Complainant's trading name is M. E. Mail Order and the Respondent does not appear to dispute that the Complainant has traded under that name since 1996 as a merchant in condoms. Further, it does not appear to be in dispute that the Complainant has traded for the last five or so years over the internet via its website at www.memailorder.com.

The Respondent's defence simply seems to be that it has been trading for longer and that its business is directed to "a totally different market".

Accordingly, the Expert has little difficulty in finding on the balance of probabilities that the Complainant has common law rights in its trading name and in its domain name, memailorder.com, sufficient to restrain a competitor from trading in the same field of activity (ie the same market) under the same or similar names. In other words, M. E. Mail Order and memailorder are common law trade marks of the Complainant.

In coming to this conclusion, the Expert is conscious that there is little evidence as to the extent of the Complainant's reputation and goodwill under its names. However, the Expert has been influenced by the fact that there is no evidence to suggest that the Respondent has conducted any trade under the name M. E. Mail Order or Memailorder prior to the registration of the Domain Name in January this year, still less at any time prior to the Complainant's adoption of those names. If, as the Expert finds (see below), the Respondent registered the Domain Name with a view to attracting the Complainant's customers, it does not lie in the mouth of the Respondent to assert that the Complainant has no relevant rights in its trading name or domain name. On that premise the Respondent's use of the Domain Name presupposes that the Respondent is known and recognised by its names.

Manifestly, the Domain Name is identical or similar to the Respondent's common law trade marks, being its trading name and its domain name. Accordingly, the Expert finds that the Complainant has rights in respect of names or marks which are identical or similar to the Domain Name.

Abusive Registration

This leaves the second limb: is the Domain Name, in the hands of the Respondent, an abusive registration? Paragraph 1 of the 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) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

A non-exhaustive list of factors, which may be evidence that the Domain Name is an abusive registration is set out in paragraph 3(a) of the Policy, but in the particular circumstances of this case, the Expert does not find it necessary to go into the detail of that non-exhaustive list of factors.

The Expert is in no doubt that the registration is an abusive registration. The factor, which has led the Expert to this conclusion is the Respondent’s claim that its reason for selecting the Domain Name was that it is a mail order business directed to “Male Exclusively”. The Expert has visited the Respondent’s website and found a home page identical to the version printed up by Nominet for inclusion in the papers. The home page gives no indication whatever that it is geared to any particular sector of the community. Far from being directed exclusively to males, there is a section of the website marked “for ladies”.

That ‘justification’ having been removed, it is difficult to come to any conclusion other than that the Respondent fabricated the ‘excuse’ because it had deliberately registered and has used the Domain Name, being a name identical or similar to a name or names of one of its competitors in the field of mail order provision of condoms, in the hope that it would attract for itself business intended for that competitor, ie the Complainant.

The Expert finds that the Domain Name is an abusive registration within the definition of that term in paragraph 1 of the Policy on the basis that it was registered in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant’s rights and that it is being used in a manner which has taken unfair advantage of and has been unfairly detrimental the Complainant’s rights.

7. Decision:

In light of the foregoing findings, namely that the Complainant 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 the Expert directs that the Domain Name, memailorder.co.uk be transferred to the Complainant.

Tony Willoughby

March, 13, 2002