

DISPUTE RESOLUTION SERVICE**D00016678****Decision of Independent Expert**

Liquidator of Officestar Ltd

and

Mr Garth Piesse

1. The Parties:

Complainant: Liquidator of Officestar Ltd
60/62 Old London Road
Kingston upon Thames
Surrey
KT2 6QZ
United Kingdom

Respondent: Mr Garth Piesse
PO Box 181
Palmerston North
4440
New Zealand

2. The Domain Name:

officestar.co.uk

3. Procedural History:

On 23 October 2015 the Dispute was received, validated and notification sent to both parties. On 11 November a Response reminder was sent, a Response was received and notification was sent to both parties. On 12 November 2015 a Reply was received and notification of this was sent to both parties.

Nominet appointed a mediator on 12 November and mediation started on 17 November. On 15 December the Dispute was resolved during mediation but negotiations subsequently broke down and finally failed on 21 December and the close of mediation documents were sent to both parties the same day.

On 05 January 2016 a Complainant full fee reminder was sent and on 11 January the Expert decision payment was received. The Expert, Tim Brown, was appointed on 14 January.

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 of the parties.

4. Factual Background

The Complainant is a liquidator appointed by the shareholders and creditors of a company incorporated in England and Wales called Officestar Limited with company number 3391669 ("Officestar"). The Respondent is an individual located in New Zealand.

From the submissions provided by the parties, it seems the timeline of events is as follows:

- 11 June 1997 – the Domain Name is registered by Officestar.
- 17 March 1999 – Officestar file trade mark number 2192063 in the United Kingdom Intellectual Property Office for the term OFFICE STAR.
- 11 June 2013 – the Domain Name is allowed to lapse.
- 11 September 2015 – the Domain Name is registered by the Respondent.
- 30 September 2015 – Officestar goes into creditors' voluntary liquidation and the Complainant is appointed.
- 23 October 2015 – the Complaint is received by Nominet (as outlined in the Procedural History above).

Nominet has provided me with a copy of the Domain Name's WhoIs and a screenshot which shows the Domain Name currently resolves to a page headed "*OfficeStar.co.uk / May be available / Complete this form to get a free quote on / OfficeStar.co.uk:*" and which invites viewers to complete a simple enquiry form.

5. Parties' Contentions

I have set out the Parties' primary contentions below.

Complainant: Rights

As outlined in the Factual Background above, the Complainant says that he is the liquidator for Officestar and has provided a link to the Companies House database to demonstrate this.

Officestar is listed as the registrant of a trade mark for the term OFFICE STAR and an extract from the Intellectual Property Office database for the mark has been exhibited. The Complainant avers that Officestar's assets, including the trade mark, are now under his control and that he is empowered in terms of the Insolvency Act 1986 to enforce these rights.

Complainant: Abusive Registration

The Complainant contends that the Respondent was aware of the impending liquidation of Officestar, suggesting that the Respondent monitors Gazette¹ notices, takes company's

¹ The London Gazette is one of the official journals of record of the UK government. It lists, among other things, company insolvencies. The Edinburgh and Belfast Gazettes publish materials pertaining to Scotland and Northern Ireland.

domain names and holds them to ransom to sell on at inflated prices. The Complainant says the Respondent has no legal interest in the OFFICE STAR name.

The Complainant states that the Respondent is a "*notorious Domain Squatter*", subject to "*discussions at the World Intellectual Property Organisation (WIPO)*" and "*has been trolled on internet fora*".

The Complainant avers that the registration of the Domain Name is in breach of Officestar's rights, which are now enforceable by the Complainant as its liquidator.

Respondent: Rights

While the Respondent does not deny that Officestar's trade mark exists he asserts that as Officestar's liquidator the Complainant does not own the mark and therefore cannot use it to assert Rights in terms of the Policy.

The Respondent says, firstly, that the Complainant has provided no evidence that he is indeed Officestar's liquidator and, secondly, that even if he was its liquidator the complaint should have been filed in the name of "*Officestar Limited (in liquidation) and not in the liquidator's own name.*"

Respondent: Abusive Registration

The Respondent says that he is in the business of buying, selling and monetising domain names and notes that Paragraph 4d of the Policy says that trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities.

The Respondent avers that he registered the domain name after he became aware that it was on a list of domains which were about to expire. The Respondent states that he assumed the previous owner no longer wanted the Domain Name and that he thought it was a potentially attractive domain name as it reflected an obvious term to use in relation to the office services or supplies industry.

The Respondent sets out that he intended to sell the Domain Name to "*someone with an interest in office-related domain names*". Since registration, the Respondent says he has redirected the Domain Name to a parking page at www.domainnamesales.com and has been inviting purchase enquiries.

The Respondent observes that he owns approximately twenty similar domain names that begin with the term "office" followed by another generic term. A list of these has been provided. Furthermore, the Respondent has exhibited a further list detailing domain names which he owns containing the term "star".

Referencing the appeal panel decision in Verbatim Ltd v. Michael Toth,² the Respondent says that for the Complaint to succeed the Complainant must show the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name.

The Respondent says that the Complainant has failed to show he was aware of the Officestar brand at the point of the Domain Name's registration and suggests there was no reason why he should have known of the brand. The Respondent has exhibited extracts from Companies House showing a number of active companies in the United Kingdom using the term OFFICE STAR. Three trade marks made up of the words OFFICE STAR owned by entities other than the Complainant are also listed by the Respondent. Finally, the results from a search for the

² DRS 04331

term OFFICE STAR via the search engine "Google", showing 574,000 results, have also been exhibited.

The Respondent denies that he was aware of the impending liquidation of Officestar, observing that the first notice relating to the liquidation of Officestar was given in the Gazette on 25 September 2015. The Respondent has exhibited an extract from the Gazette from the relevant date. The Respondent states that the Domain Name was registered two weeks before this notice on 11 September 2015 and therefore he could not have known of Officestar's approaching liquidation. In any event, the Respondent denies that he monitors the Gazette.

The Respondent takes umbrage at the Complainant's contentions that he is a "*notorious cyber squatter*" and denies that he holds domain names "*to ransom for inflated prices*".

Finally, the Respondent contends that the Complainant set out to mislead the Expert by not providing "*any evidence in support of the serious, not to mention insulting and offensive, allegations he has thrown at the Respondent*" and requests a finding of Reverse Domain Name Hijacking is made against the Complainant.

Complainant: Reply

The Complainant reiterates that he is indeed the liquidator of Officestar and says that this can be easily established via Companies House and that he is bringing the Complaint on behalf of said company.

The Complainant says that he did not "*set out to mislead*" anyone and avers that it is not credible that the Respondent, being in the business of monetising domain names, was not aware of Officestar at the time of the Domain Name's registration when Officestar had been the previous owner of the domain name for 16 years and was the holder of the OFFICE STAR registered trade mark.

The Complainant denies that the Complaint was an attempt to acquire a domain name to which there was never any entitlement and rejects the Respondent's allegations of Reverse Domain Name Hijacking.

6. Discussions and Findings

Rights

There is no dispute between the parties that Officestar is listed as the registrant of trademark number 2192063 for the term OFFICE STAR. However, the Respondent contends that the Complainant – as liquidator of Officestar – is not entitled to enforce this mark as he is not the "owner" of the mark and therefore it follows that he does not have Rights in terms of the Policy.

The Respondent has said that the Complainant has provided no evidence that he is Officestar's liquidator. However, the Complainant provided evidence from Companies House that shows he is indeed listed as Officestar's liquidator. Equally, the Respondent has asserted that the complaint should have been filed in the name of "*Officestar Limited (in liquidation) and not in the liquidator's own name.*" Nominet's systems show me that the Complainant in this matter has been brought in the name of "Liquidator of Officestar Ltd".

It is therefore clear to me that the Complainant is indeed the formally appointed liquidator of Officestar and that the Complaint has been brought properly in the name of the correct entity.

The Respondent has then said that "*while he [the Complainant] may control the assets of the company, he does not own them*". It is my understanding that a liquidator effectively steps into the shoes of a limited company on its liquidation. In the simplest legal sense, the liquidator *is* the limited company. Neither party has made any submissions on this point aside from mere assertion; no detailed legal arguments have been put before me and, even if they had been, the DRS is hardly a suitable forum for a discussion of the finer points of insolvency law.

Paragraph 1 of the Policy defines Rights as "*rights enforceable by the Complainant, whether under English law or otherwise...*" It is my view that the Complainant, as Officestar's liquidator, is entitled to enforce and rely on the rights derived from the OFFICE STAR trade mark.

As is customary, the .co.uk suffix is required only for technical reasons and as whitespace cannot be represented in the domain name space it can be ignored for the purposes of comparing the Domain Name to the Complainant's Rights. I therefore find that the Complainant has Rights in respect of a name which is identical to the Domain Name.

Abusive Registration

The Respondent has been open in describing himself as being in the business of buying, selling and monetising domain names. In general, as long as these activities do not cut across the rights of third parties then they are entirely permissible and proper. The Respondent has correctly noted that Paragraph 4d of the Policy says that "*trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities*".

The crux of this dispute is therefore whether the Respondent was aware of and cut across the OFFICE STAR brand, as proposed by the Complainant; or whether he registered the Domain Name for future resale unaware of the Complainant's activities, as suggested by the Respondent.

I note that Policy calls for a complainant to make its case on the balance of probabilities and that a respondent is not required to prove a negative. Some useful discussion is had on this point under Paragraph 4.1 of the Expert's Overview.³

The Complainant has made a number of assertions, the primary one being that the Respondent monitored the Gazette, anticipated Officestar's liquidation and thereafter registered the Domain Name to "*hold [it] as ransom to sell on at an inflated price*". The Complainant has provided no evidence to support these assertions. Furthermore, the timeline simply does not support the Complainant's allegations. The Complainant says the Domain Name was allowed to lapse on 11 June 2013, over two years before it was registered by the Respondent. Likewise, Officestar's liquidation was announced in the Gazette two weeks after the Domain Name's registration.

As a result of these anomalies, the Complainant's assertions regarding the Respondent's possible monitoring of the Gazette do not particularly help his case. But even so, did the Respondent have knowledge of the Complainant's Rights at the point of registration and did he intend to target those Rights?

The Respondent has said that the term OFFICE STAR is one that is generic and commonly used and has listed a number of unrelated companies and marks in the United Kingdom

³ The Expert's Overview is a document published at http://www.nominet.uk/wp-content/uploads/2015/08/Expert_Overview.pdf which deals with a range of issues that regularly come up in DRS disputes

which use the same term. I do not have to make a decision on whether the term OFFICE STAR is generic or not and on this point I have referred to Paragraph 4.10 of the Overview which asks "*Can use of a purely generic or descriptive term be abusive?*" and answers:

Yes but, depending on the facts, the threshold level of evidence needed to establish that this is the case is likely to be much higher. It may well often depend upon the extent to which such a term has acquired a secondary meaning, which increases the likelihood that any registration was made with knowledge of the rights that existed in the term in question. In many such cases where there is little or no evidence of acquired secondary meaning the Respondent is likely to be able to show that the domain name in question has been arrived at independently and accordingly cannot have been as a result of an Abusive Registration. A helpful discussion is found in DRS 04884 (maestro.co.uk) where the Appeal Panel observed "Where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive, if it is to be held to be an Abusive Registration under the DRS Policy".

The Complainant has put forward no evidence – persuasive or otherwise – to show that the term OFFICE STAR has acquired any sort of secondary meaning. In the absence of any evidence to the contrary, it is my view that it is more likely than not that the Respondent arrived at the Domain Name independently without knowledge of the Complainant's Rights and without the intention to target said Rights.

My view is supported by the Respondent's registration of a number of other domain names incorporating the terms "office" and "star" in various combinations. Equally, I have reviewed each of the seven previous disputes under the DRS in which the Respondent has been a party and find that that the Respondent has consistently been found to have registered generic domain names which do not cut across third party rights in order to resell them.

I therefore take the view that it is more probable than not that the Respondent registered the Domain Name in ignorance of the Complainant's and Officestar's Rights and conclude that the Domain Name is not an Abusive Registration in terms of the Policy.

Reverse Domain Name Hijacking

The Respondent has requested that I make a finding of Reverse Domain Name Hijacking, suggesting that the "*Complainant has plainly set out to mislead the Expert*" and that "*...he [the Complainant] has not seen fit to provide any evidence in support of the serious, not to mention insulting and offensive, allegations he has thrown at the Respondent... This can only be because he knows that the allegations are untrue.*"

Paragraph 1 of the Procedure defines Reverse Domain Name Hijacking as "*...using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name*".

I have carefully reviewed the Complainant's submissions in this light and consider that while the Complainant could be considered to have relied on a number of unsupported assertions and ill-advised conjecture, I do not think the Complainant brought the Complaint in bad faith.

Findings of Reverse Domain Name Hijacking under the DRS are rare and, in general, do not result merely from complainants presenting poorly supported or injudicious submissions; there commonly needs to be evidence of more nefarious motives at play. Given the existence of Officestar's mark and that it is identical to the Domain Name, it is my view that the Complainant had a *bona fide* reason for bringing the Complaint and there is no suggestion that the Complainant meant to do anything other than serve the interests of Officestar's shareholders and creditors by challenging the Respondent's registration. I note that if a complaint fails it does not naturally follow that it must have been brought in Bad Faith. I therefore decline to make a finding of Reverse Domain Name Hijacking.

7. Decision

Having determined that the Complainant has not demonstrated that the Domain Name was an Abusive Registration, I order that no action be taken regarding the Domain Name.

Signed Tim Brown

Dated: 27 January 2015