

**DISPUTE RESOLUTION SERVICE**

**D00015408**

**Decision of Independent Expert**

Novatus Ltd.

and

Mr Andy Mitchell

**1. The Parties:**

Complainant: Novatus Ltd.

29 Woodland Avenue

Brentwood

Essex

CM13 1EA

United Kingdom

Respondent: Mr Andy Mitchell

19 Appin Terrace

Perth

PH1 2LT

United Kingdom

## **2. The Domain Names:**

<centralflush.co.uk> (“the First Domain Name”)

<edinburghpowerflush.co.uk> (“the Second Domain Name”)

<scottishpowerflushassociation.co.uk> (“the Third Domain Name”)

(together “the Domain Names”)

## **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.

26 January 2015 12:21 Dispute received

26 January 2015 13:29 Complaint validated

26 January 2015 13:57 Notification of complaint sent to parties

12 February 2015 01:30 Response reminder sent

16 February 2015 11:54 Response received

16 February 2015 11:55 Notification of response sent to parties

17 February 2015 09:33 Reply received

17 February 2015 09:35 Notification of reply sent to parties

17 February 2015 09:35 Mediator appointed

23 February 2015 12:40 Mediation started

26 February 2015 12:44 Mediation failed

26 February 2015 13:07 Close of mediation documents sent

10 March 2015 01:30 Complainant full fee reminder sent

10 March 2015 11:27 Expert decision payment received

## **4. Factual Background**

The Complainant is the registered proprietor of the following UK trade mark registrations:

No. 2568320 dated 5 January, 2011 (registered 6 May, 2011) THE POWERFLUSH ASSOCIATION (words) for a wide variety of goods and services in classes 9, 11, 16, 35, 37, 41, 42 and 45.

No. 2641954 dated 12 November, 2012 (registered 3 May, 2013) STANDARD POWERFLUSH (words) in class 11 for apparatus for lighting and refrigerating.

The Complainant has formed an association named the Power Flush Association, whose members are practitioners in the power flushing industry who have satisfied the Complainant that they have the requisite expertise to conduct power flushing safely and effectively.

The Complainant operates a website connected to its domain name, <powerflushassociation.com>. It explains that a power flush is “a cleaning procedure” and goes on to state: “Power flushing cleans the inside surfaces of your central heating system.”

The Respondent runs a number of plumbing businesses trading under a variety of business names including Power-flush Scotland, Mitchell Plumbing and Heating Engineers, Andy Mitchell Plumbing and Heating Eng.

The Respondent was a member of the Power Flush Association until 25 August, 2013. There is a dispute as to the reason for the Respondent’s departure from the Association. The Complainant states that it kicked the Respondent out of the Association following customer complaints. The Respondent states that he ceased to be a member because he stopped his Paypal payments to the Association. The Expert is unable to resolve that factual dispute, but finds it unnecessary to do so in order to come to a decision under the Policy.

On 15 April, 2013 His Honour Judge Birss QC (as he then was) gave summary judgment in favour of the Complainant in a case involving *inter alia* the domain name, <britishassociationofpowerflush.co.uk>, registered in the name of an unconnected third party, holding it to be an infringement of the first of the Complainant’s registered trade marks detailed above. Judgment was given at a case management conference at which the defendant failed to attend.

The First Domain Name was registered on 15 April, 2013. The Second Domain Name was registered on 13 April, 2014. The Third Domain Name was registered on 26 November, 2014. The Domain Names are each connected to a website offering services consistent with the Domain Name in question. Thus, the First Domain Name is connected to a website offering powerflushing services in central Scotland (from Edinburgh in the south to Inverness in the north); the Second Domain Name is connected to a website offering power flushing services in Edinburgh; and the Third Domain Name is connected to a website of The Scottish Power-flush Association, which describes itself as an “Association for Powerflush heating engineers in Scotland”.

On 23 December, 2014 the Complainant sent an email to the Respondent drawing attention to its trade mark rights, asserting trade mark infringement and passing off, contending that the Respondent had been posing as one of the members of the Complainant’s Association and offering to settle the dispute for £9,500 and transfer of the Domain Names.

The Respondent replied the same day denying the Complainant's allegations. The Complainant then by return email accused the Respondent of lying and stated that the Respondent had 7 days within which to comply with the Complainant's demands.

## **5. Parties' Contentions**

### **The Complainant**

The Complainant does not expressly claim that its trade mark registrations are identical or similar to any of the Domain Names, but the Expert assumes that in asserting those trade mark registrations it meant to do so.

The Complainant asserts that the Domain Names are Abusive Registrations on *inter alia* the following bases:

- (a) The Domain Names and the websites to which they are connected constitute infringement of the Complainant's trade marks and passing off;
- (b) the website connected to the Third Domain Name falsely claims to have many members doing power flushing work, when it only has one member, the Respondent who is "piggybacking and profiting off [the Complainant's] trade marks";
- (c) The Respondent claims to be the Managing Director of Power-Flush Scotland, "but there is no such company";
- (d) Through the use of Google AdWords links to the Respondent's websites appear on the same page as links to the Complainant's website;
- (e) The Respondent has registered '.com' equivalents of some of the Domain Names;
- (f) "Abuse of WHOIS: Andy Mitchell has over 9 addresses listed for him, with different domain names listed to different addresses to make it hard to find his home address.";
- (g) The Respondent's websites have similarities with the Complainant's website, such as "Frequently Asked Questions";

Further details of the Complainant's specific allegations appear in section 6 below.

### **The Respondent**

The Respondent contends that his original 'power-flush' site was connected to the domain name, <power-flushscotland.com>, from 15 November, 2011 (this date was verified to the Expert by Nominet) when that domain name was registered by his web designer and it remained connected to that domain name until his website designer's business failed and the domain name lapsed. Thereafter the website was connected to the First Domain Name.

The Respondent contends that "The Scottish Power-flush Association" is not a registered trade mark. The Respondent asserts that if this dispute ends up in court he will seek to have the Complainant's trade mark registrations revoked. He asserts that the expression "standard powerflush" is as descriptive as "standard plumbing" or "standard bathroom".

In response to the Complainant's allegations as to the various addresses used by the Respondent, the Respondent asserts that "they are correct for the individual websites and to which area they cover".

## 6. Discussions and Findings

### General

This dispute falls to be decided by reference to the Version 3 of the Nominet DRS Policy, which came into force on 29 July, 2008 ("the Policy").

In order for the Complainant to succeed it must (pursuant to Paragraph 2 of the Policy) prove to the Expert, on the balance of probabilities, **both** that:

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

*the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.*

Accordingly, the Complainant is required to prove two matters: first, the existence of relevant rights and, secondly, that in the hands of the Respondent the Domain Names are Abusive Registrations.

### Rights

The meaning of 'Rights' is clarified and defined in the Policy in the following terms:

**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;

In this case the Complainant relies upon two trade mark registrations, namely:

No. 2568320 dated 5 January, 2011 (registered 6 May, 2011) THE POWERFLUSH ASSOCIATION (words) for a wide variety of goods and services in classes 9, 11, 16, 35, 37, 41, 42 and 45.

No. 2641954 dated 12 November, 2012 (registered 3 May, 2013) STANDARD POWERFLUSH (words) in class 11 for apparatus for lighting and refrigerating.

The first point to note is that 'powerflush' (whether in that form or hyphenated or as separate words) is a descriptive term. The short passage from the Complainant's website quoted at section 4 leaves no scope for doubt on that point. It is a term commonly used to describe a cleaning process applied to central heating systems.

That point may have significance when assessing whether or not a Domain Name is an Abusive Registration (the second element under the Policy), but the test under this the first element is not a trade mark infringement test. It is a low-threshold test designed to establish whether the Complainant has a *bona fide* basis for making the Complaint.

While the Expert is in no doubt that ‘powerflush’ *per se* has not acquired a secondary meaning, it is not inconceivable that, as evidently recognized by the United Kingdom Intellectual Property Office, that term in combination with other words is capable of acquiring a secondary meaning in relation to the goods and services for which the above mentioned trade marks are registered.

The Expert is satisfied that the Complainant’s rights in respect of the above-mentioned trade mark registrations constitute Rights for the purposes of this element of the Policy.

Taking each of the Domain Names in turn:

The First Domain Name, <centralflush.co.uk>, is not identical to either of the Complainant’s registered trade marks and does not feature any of the elements of the Complainant’s trade marks. The only similarity is the word, ‘flush’. In the view of the Expert neither of the Complainant’s trade marks is similar to the First Domain Name. The Complaint in respect of this Domain Name fails at the first hurdle.

The Second Domain Name, <edinburghpowerflush.co.uk>, is not identical to either of the Complainant’s registered trade marks and can only be said to be similar in that it features within it the word ‘powerflush’, which is a descriptive term commonly used in the central heating industry. On the basis that the test under this element of the Policy is one of similarity and not confusing similarity, the Expert finds that the presence of the word ‘powerflush’ in the Complainant’s trade marks and the Second Domain Name just about renders the Complainant’s trade marks similar to the Second Domain Name.

The Third Domain Name, <scottishpowerflushassociation.co.uk>, is not identical to either of the Complainant’s trade marks, but is certainly similar to the first of the Complainant’s trade marks, the only difference being the substitution of the definite article in the trade mark with the word ‘Scottish’ in the Domain Name.

Thus the Complaint succeeds under the first element of the Policy in respect of the Second and Third Domain Names and it now falls to the Expert to assess whether in the hands of the Respondent those Domain Names are Abusive Registrations.

### **Abusive Registration**

An Abusive Registration is defined in the Policy as follows:

**Abusive Registration** means a Domain Name which either:

*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*

*has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights;*

Paragraph 3 of the Policy contains a non-exhaustive list of factors, which may be evidence that a domain name is an Abusive Registration.

The Complainant has not stated its case under this head by reference to paragraph 3 of the Policy, but from a reading of the Complaint the Expert identifies the following provisions of paragraph 3 as being potentially applicable:

3.a.i.C Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Names primarily for the purpose of unfairly disrupting the business of the Complainant.

3.a. ii Circumstances indicating that the Respondent is using or threatening to use the Domain Names in a way which has confused or is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant;

3.a.iv It is independently verified that the Respondent has given false contact details to us;

Paragraph 4 of the Policy sets out a non-exhaustive list of factors, which may be evidence that a domain name is not an Abusive Registration. The only potentially relevant one of those factors is that appearing in sub-paragraph a.ii, namely that the Domain Names are generic or descriptive and the Respondent is making fair use of them.

The Expert now deals with these paragraphs of the Policy one by one as follows:

#### Paragraph 3.a.i.C of the Policy

The Expert has found nothing in the case papers to support a contention that the Respondent registered or otherwise acquired the Second and Third Domain Names primarily for the purpose of unfairly disrupting the business of the Complainant. In the Expert's view the Respondent's primary purpose has been to promote his own businesses.

#### Paragraph 3.a.ii of the Policy

Under this head the Expert is required to consider whether the Second and Third Domain Names (or either of them) have been used or are likely to be used in a way which will lead people to believe that those Domain Names are in some way associated with the Complainant.

The Complainant expresses its claim under this head in terms of trade mark infringement and passing off and provides evidence to show that a Patents County Court judge in a case management conference, which the defendant did not attend, gave summary judgment in favour of the Complainant finding that the domain name, <britishassociationofpowerflush.co.uk>, infringed the Complainant's THE POWERFLUSH ASSOCIATION trade mark.

The Expert acknowledges that if the Complainant is able to satisfy a judge that the Third Domain Name is likely to lead to confusion in the marketplace and/or that the Respondent is making unfair use of it, it will constitute an infringement of the Complainant's trade mark. However, that fact does not necessarily mean that the Third Domain Name in the hands of the Respondent is an Abusive Registration under the Policy. For trade mark infringement the motive of the defendant may be

irrelevant; whereas for the purposes of the Policy some form of culpability on the part of the Respondent is generally required to lead to a finding of Abusive Registration.

The only evidence produced to support the confusion claim relates to the Third Domain Name (see below). There is no evidence in relation to the Second Domain Name (<edinburghpowerflush.co.uk>). Indeed, on its face the Second Domain Name appears to the Expert to indicate clearly that it is a domain name associated with a powerflushing business operating in Edinburgh, which is precisely the purpose for which the Respondent appears to be using the Second Domain Name.

In the terms of paragraph 4.a.ii of the Policy it appears to the Expert (and the Expert so finds) that the Second Domain Name is generic or descriptive and the Respondent is making fair use of it.

As to the Third Domain Name the position is not so straightforward in that the Third Domain Name indicates a powerflush association as does the first of the Complainant's above-mentioned trade mark registrations, THE POWERFLUSH ASSOCIATION. Will people believe or be likely to believe that this Domain Name (<scottishpowerflushassociation.co.uk>) is "registered to, operated or authorised by, or otherwise connected with the Complainant"? Or will the fact that the Third Domain Name indicates a Scottish entity be sufficient to dispel the risk of confusion? It would have been helpful to know, for example, the extent to which Scottish entities are or are perceived to be associated with their English counterparts; bodies such as The National Trust and the National Trust for Scotland, the National Gallery and the Scottish National Gallery, the Premier League and the Scottish Premier League. There is no evidence of substance before the Panel, which addresses the issue.

The only 'evidence' on this point is provided in Scan 0035 which is exhibited to the Complaint and labelled "*Confused member of public: email sent to our Association asking about the Scottish power flush association.*" However, on referring to the exhibit it is found to be an email from a member of the public to the Complainant asking the question: "*Is there a Scottish Powerflush Association, please*" followed by a reply from the Complainant: "*No, there is only one Power Flush Association for the UK and that is us. Why do you ask?*" It would have been interesting to know the answer, but the exhibit stops there. On the face of it, this exchange does not establish that the member of the public was confused.

The Expert accepts that some form of confusion is possible, but is by no means certain that it is probable. Moreover, it is generally accepted that if a trader chooses for his trading name a name descriptive of his goods or his service offering, he may reasonably have to accept a level of confusion resulting from others in the same industry seeking to describe their service offerings by reference to the same or similar terms.

In circumstances such as these where the *onus* is on the Complainant to prove its case on the balance of probabilities, any doubt as to probability must be decided in favour of the Respondent. The Expert is not satisfied that the Complainant has proved its case under paragraph 3.a.ii of the Policy.

#### Paragraph 3.a.iv of the Policy

The Complainant has expressed his complaint in this regard in the following terms:

*“Abuse of WHOIS: Andy Mitchell has over 9 addresses listed for him, with different domain names listed to different addresses to make it hard to find his home address.”*

And:

*“www.centralflush.co.uk , www.mitchellheating.co.uk and http://www.edinburghpowerflush.co.uk All of these names have different WHOIS addresses for the same person none of them could be verified to be correct”*

For the purposes of paragraph 3.a.iv of the Policy it is insufficient to assert, as the Complainant has asserted, that none of the Respondent’s addresses “could be verified to be correct”. The *onus* on the Complainant is to produce independent verification that the addresses are incorrect. The Complainant has produced no supporting evidence of any kind independent or otherwise. One of the addresses cited by the Complainant is a Parisian address, which is verifiably the address of the Respondent’s registrar.

#### The Complainant’s specific allegations

The fact that the Complainant has failed to satisfy the Expert on the above-mentioned provisions of the Policy is not the end of the matter, because, as indicated, the factors listed in paragraph 3 of the Policy constitute a non-exhaustive list.

The Complainant has advanced a number of matters, which it contends demonstrate that the Domain Names are Abusive Registrations. To the extent that they have not been dealt with above, they are set out below and the Expert deals with them as follows:

1. *“We own and operate www.powerflushassociation.com since 2011 and we have over 700 members across the UK, including members in Scotland that do power flushing, a plumbing procedure.”* The Expert has been given no evidence as to the Complainant’s membership, but agrees that the Complainant’s rights in respect of its trade mark are senior to those of the Respondent in respect of the Third Domain Name. The Expert is also prepared to accept that the Complainant is likely to have members operating in Scotland. None of this helps to answer the question as to whether the Respondent’s registration and use of the Third Domain Name constitutes unfair competition.
2. *“The disputed domain name was registered by the defendant on the 26 Nov 2014 after he was kicked out of our Association for excessive complaints by customers. He did not provide them with receipts, after care or certificates.”*. As indicated above, there is a dispute between the parties as to the reason for the Respondent’s departure from the Complainant’s association. Neither party has produced any supporting evidence for their claims. Insofar as this dispute is concerned, even if the Complainant’s version of the story is correct, this does no more than confirm that the Respondent was aware of the Complainant’s association and registered the Domain Name with the benefit of that knowledge, which is not in dispute, and had been the subject of many customer complaints, which is in dispute. The quality of the Respondent’s service offering is an irrelevance insofar as this dispute over the Domain Names is concerned.

3. *“The website simply claims to be the “Scottish power-flush association” and claims to have many members doing power flushing work. This is incorrect, there is only one member/owner piggybacking and profiting off our trademarks.”* From the evidence filed by the Complainant the Expert suspects that the Respondent may indeed be the only member of his association and is using the association as a funnel for work i.e. as a marketing ploy. However, even if he is the only member of his association (a matter on which the Complainant has produced no concrete evidence), the question still remains as to whether the ‘false’ claim as to the size of the membership is anything more than advertising puff. The claim that the Respondent is profiting from the Complainant’s trade marks is not supported by any evidence of any substance and begs the question as to whether Internet users are likely to believe that the Respondent’s association is associated with the Complainant.
4. *“He quotes for work under the name “Andy Mitchell” claiming to be the managing director of “Power-Flush Scotland”. There is no such company”.* The Complainant’s evidence establishes that the Respondent trades under the name “Power-Flush Scotland”. Even if there is no limited company of that name (as to which there is no evidence e.g. a company registry search showing the absence of such a company in the alphabetical listing), it is perfectly acceptable for the owner of an unincorporated business to give himself the title of Managing Director. Even if it were unacceptable behaviour, it is not of any relevance to this domain name dispute.
5. *“He advertises his website on Google AdWords on the same page as where our website is shown.”* In the Expert’s experience it is not uncommon for competitors’ links to appear in close juxtaposition on advertising webpages.
6. *“He also registered many other versions of our trademarks, like [www.scottishpowerflushassociation.com](http://www.scottishpowerflushassociation.com).”* This takes the dispute no further. It is common for companies to secure their names as domain names in more than one top level domain.
7. *“The website has many similarities to our main site, like “faq” (frequently asked questions) section and mentions versions of our trademarks in many places.”* The example quoted of “faqs” is a feature common to most commercial websites. The Complainant does not clarify what is meant by “versions of our trade marks”. The Expert assumes that it is referring to the usage of the Domain Names and, in one case a textual reference to “substandard power-flushes”. That reference needs to be seen in context. It is not a side-swipe at the Complainant’s STANDARD POWERFLUSH trade mark registered for lighting and refrigeration apparatus. It appears on a webpage connected to the Third Domain Name. The full sentence reads *“The Scottish Power-flush Association was established to protect the public from sub-standard power-flushes”*, which seems unobjectionable to the Expert. True, it appears that until receipt of the Complainant’s pre-action letter the Respondent was wrongly using the Complainant’s logo on his website connected to the First Domain Name, but that usage appears to have ceased and the complaint in relation to the First Domain Name failed at the first hurdle.

The Expert is not persuaded that any of these specific allegations of the Complainant leads to a finding of Abusive Registration.

## Summary

In summary, the Expert's findings are as follows:

1. The complaint in relation to the First Domain Name (<centralflush.co.uk>) fails on the Expert's finding that the names or marks in which the Complainant has rights are not similar to that Domain Name.
2. The complaint in relation to the Second Domain Name (<edinburghpowerflush.co.uk>) fails on the Expert's finding that that Domain Name is generic or descriptive and the Respondent is making fair use of it.
3. The complaint in relation to the Third Domain Name fails on the Expert's finding that the case has not been proved to his satisfaction on the balance of probabilities.

## **7. Decision**

For the reasons given above the Expert directs that no action be taken in respect of any of the Domain Names.

**Signed** Tony Willoughby

**Dated** 20 March, 2015