

DISPUTE RESOLUTION SERVICE

D00016650

Decision of Independent Expert

Flowercard Limited

and

Ms Emma Fletcher

1. The Parties:

Complainant: Flowercard Limited
11 New Street
St Peter Port
GY1 2PF
Guernsey

Respondent: Ms Emma Fletcher
Fresh Flower Cards
120 Kingston Road
Wimbledon
London
SW19 1LY
United Kingdom

2. The Domain Name(s):

fresh-flowercards.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 of the parties.

11 November 2015 08:02 Dispute received
11 November 2015 14:20 Complaint validated
11 November 2015 14:42 Notification of complaint sent to parties
30 November 2015 10:37 Response received
30 November 2015 10:37 Notification of response sent to parties
03 December 2015 01:30 Reply reminder sent
03 December 2015 16:05 Reply received
08 December 2015 16:03 Notification of reply sent to parties
08 December 2015 16:03 Mediator appointed
14 December 2015 17:32 Mediation started
04 January 2016 15:24 Mediation failed
07 January 2016 12:01 Close of mediation documents sent
07 January 2016 12:01 Expert decision payment received

4. Factual Background

The following facts appear from the documents submitted to me and which I find as proven and form the basis of my Decision:

- i. The Complainant is a Guernsey company originally incorporated in 2001.
- ii. It is the owner of the domain name, www.flowercards.co.uk, which was first registered in 1999.
- iii. It has traded using the name “Flowercard” and sells products which incorporate cut flowers into greetings cards.
- iv. The Complainant is the owner of two CTM trade marks: No 008622995 registered on 26 April 2010 and No 013766605 registered on 23 June 2015, in each case in respect of the word or mark “FLOWERCARD” prominently displayed in combination with a device.
- v. The Complainant has made use of “FLOWERCARD” in connection with marketing, including by its use within a catalogue and print advertisements.
- vi. The Complainant has some competition for its products, although the Complainant’s particular market consists of relatively elderly people.
- vii. The Respondent registered the Domain Name on 19 September 2013 and launched its business shortly thereafter in 2014.
- viii. The Respondent is selling a line of products which are similar to those of the Complainant, consisting of cut flowers in a box design, although there are differences in the detail.
- ix. The Respondent initially used the term “FLOWERCARDS” in its website but ceased doing so after complaint from the Complainant.
- x. The Respondent used the term “FLOWERCARDS” for the purpose of using Google’s adwords service, but ceased doing so as a direct search term after complaint from the Complainant.

5. Parties’ Contentions

The Complainant makes the following submissions:

- i. The Complainant markets its products through a variety of channels, including the press, online, catalogue mailings and email advertising.

- ii. The Complainant spends considerable sums on marketing each year.
- iii. The Respondent has attempted to divert business away from the Complainant by bidding on adwords on Google.
- iv. These practices give rise to a likelihood of confusion, as some 50% of the Complainant's business is done online and its clientele is elderly; the Complainant cites evidence that some individuals have been confused as between the Complainant and the Respondent.
- v. The Complainant has been assiduous in protecting its brand by registering many domain names including the elements "flowers" and "cards", and obtaining trade mark protection.
- vi. There are many other names that could have been used to describe the products sold by the Respondent: the Complainant believes that the Respondent has changed its name from "Living Cards" so as to imitate the Complainant's name.
- vii. The Respondent's practice of using "FLOWERCARDS" as an adword on Google's search engine has adversely affected the Complainant's cashflow.

The Respondent makes the following submissions:

- i. She set up the Respondent from new around two years ago.
- ii. The idea behind the products sold by the Respondent is not new, but the Respondent has sought to distinguish them from those of the Complainant.
- iii. The Domain Name is entirely descriptive of the Respondent's products.
- iv. The Complainant does not own a patent over its products, and the mode of manufacture of the Respondent's products is different leading to a different appearance.
- v. The Respondent's products are aimed at a younger audience and have brighter, more modern designs.
- vi. While the Respondent may have taken custom from the Complainant, this has been done fairly.
- vii. Having regard to paragraph 3 of the DRS Policy, the Domain Name was registered for the purpose of the Respondent's business, not to disrupt the Complainant's business, and is entirely descriptive of the actual product.
- viii. Any competition has been fair, although it is possible that the use of the term "Flowercard" was ill-advised, and it has been removed from the Respondent's website.
- ix. The Respondent has no other domain names and the Respondent has used the Domain Name for its website and email.
- x. The Respondent has not passed itself off as "Flowercard" and has since stopped using this term as a direct keyword for the purposes of the Google adword.
- xi. There may have been confusion, but the Respondent knows of only two similar incidents.
- xii. The ownership of many other domain names to similar effect is irrelevant.
- xiii. The Respondent's products are different in design and make a feature of how the flowers are firmly affixed to the card.
- xiv. The Complainant is not the only business selling such products, though they are generally known as "living cards".
- xv. Using the Google adword service is not illegal, and the term "flowercard" is descriptive.

- xvi. The Respondent has removed the Complainant's trade mark "FLOWERCARDS" and replaced it with "FRESH FLOWERCARDS".
- xvii. The Respondent has also faced increasing competition in the marketplace, including with Google.
- xviii. It is common to have confusion where a business' clientele are elderly, but it has not in fact happened frequently.
- xix. The Respondent was never known as "Living Cards".

The Complainant merely replied to the effect that it had considered the Response.

6. Discussions and Findings

It is worth stressing at the outset that I am only concerned with coming to a decision about the Domain Name. At times, the parties' respective submissions strayed into other areas including trade marks, ownership of intellectual property rights in the Complainant's products, design of the parties' respective products, use of Google adwords and passing off. The parties may, or may not, have other grievances outside the scope of the DRS, but it is no concern of mine to consider and come to a conclusion on such grievances, as my only concern is with the Domain Name and whether the Complainant has made out its case to have it transferred.

With that by way of context, any complainant in the Nominet DRS procedure must prove, on the balance of probabilities, that he has Rights and that the respondent's registration or continued registration of a domain name, is an "Abusive Registration". I shall look at each of these concepts in order.

Rights

"Rights" are defined in the DRS Policy as "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*".

Under paragraph 2(a) of the DRS Policy, a complainant must show that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*".

While the Complainant has provided some evidence regarding the use of the trade mark "FLOWERCARDS", it is limited to a few items comprising a catalogue and two advertisements. The Complainant has asserted that it spends considerable sums on advertising, but it has declined to provide full information.

However, it has provided copies of two CTM's¹, one of which dates back to 2010. That CTM clearly includes the word "FLOWERCARDS", albeit coupled with a device consisting of a decorative pattern. The word is prominent and the device is decorative only. This ownership of the earlier CTM alone gives the Complainant "Rights" as defined in the DRS Policy.

The next question is whether those Rights are identical with or similar to the Domain Name. It is normal to exclude the suffix ".co.uk" and have regard only to the rest of

¹ Community Trade Marks

the Domain Name. It is obvious that the Rights are not identical with the Domain Name, as it includes the prefix “fresh-”: are the Rights sufficiently similar to the Domain? Reference to paragraph 2.3 of the Expert Overview² show that “[a]dditional elements rarely trouble experts. For example, in DRS 06973 veluxblind.co.uk the expert commented “The Domain Name consists of the Complainant’s distinctive trademark and the descriptive word “blind”, which does nothing to distinguish the Domain Name from the mark, since the mark is associated in the public mind with the Complainant’s blinds.”

In my view the facts of the present case fall within a similar category: “fresh-” is simply a description, and one commonly applied to cut flowers. In my judgment the name or mark in which the Complainant has proven Rights is similar to the Domain Name.

I am satisfied that the Complainant has satisfied the condition in paragraph 2(a) of the DRS Policy.

Abusive Registration

The DRS 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;”*

The Respondent seeks to head off any criticism by dealing with various matters which are provided in paragraph 3 of the DRS Policy. That paragraph provides various factors which may be evidence of an Abusive Registration – I say “may”, because it is expressly not an exhaustive statement of which cases fall within the category of Abusive Registration, nor are the various considerations intended to be applied inflexibly.

I accept straightaway that some of the examples cited in paragraph 3 do not apply to the Respondent: this includes paragraphs 3(a)(i)(A) and (B), 3(a)(iii), 3(a)(iv), 3(a)(v), 3(b) and 3(c). This leaves for consideration paragraphs 3(a)(i)(C) and 3(a)(ii).

The relevant facts here are that both the Complainant and the Respondent are engaged in very similar businesses. I accept that there are some minor distinctions that can be made between their respective products: the Respondent asserts, and I accept, that its cut flowers are more firmly affixed to their packaging and that the packing itself is more solid than that of the Complainant’s products, giving a more rounded appearance. However, they are to my mind plainly occupying the same niche market and anyone

² This is a document summarising important Decisions made under the DRS Policy published by Nominet.

seeking to send a novelty greetings card could choose either of the parties' respective offerings.

Paragraph 3(a)(ii) provides as follows:

"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; "

Paragraph 3(a)(ii) does not require me to find that there has been actual confusion, although the Complainant has asserted that there has been some such: indeed, the Respondent concedes that she knows of two cases of confusion over a period of two years. The presence of admitted confusion rather confirms my view that the similarity of the Domain Name with the Complainant's Rights is such that confusion is "likely", and so paragraph 3(a)(ii) is engaged. I find that the Complainant has made out its case under this paragraph.

Paragraph 3(a)(ii) provides as follows:

" Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily ... for the purpose of unfairly disrupting the business of the Complainant "

Turning to paragraph 3(a)(i)(C), there is no direct evidence about the Respondent's intentions at the time of registering the Domain Name. However, I take into account the Respondent's admitted use of the Complainant's CTM "FLOWERCARDS" in its website (since ceased) and its admitted use of Google adwords service including "FLOWERCARDS". I take account of the fact that it could have used a variety of different descriptions, and that it could have used the term "living flowers" which, the Respondent states, is the more common term used for its products ("... they have existed a long time, mainly known as "living cards"."). I accept the Respondent's assertion that the addition of "fresh-" is only adding a level of description. However, on the balance of probabilities, I find that the Respondent registered the Domain Name for the purpose of causing confusion in the minds of internet users, and enabling it to use its business' name, as used in the Domain Name, for the purpose of availing itself of Google's adwords service. This would likely have the consequence of diverting business away from the Complainant. I therefore find Abusive Registration also made out under paragraph 3(a)(i)(C).

The matter does not end there for paragraph 4 of the DRS Policy provides a further non-exhaustive list of matters which may be evidence that the Domain Name is not an Abusive Registration. Paragraphs 4(b) to (e) do not apply on the facts. Similarly, paragraphs 4(a)(iii) and (iv) are not applicable.

I accept the Respondent's assertion that her business was newly established in 2014. For that reason, I do not accept that any of the reasons in paragraph 4(a)(i) apply in this case. I do not accept that there has been a genuine offering or goods or that the Respondent has made fair use of the Domain Name for the reasons given above: I find that the Respondent has in fact knowingly made use of the Complainant's Rights for

the purposes of diverting business to herself, and her registration of the Domain Name was part of that policy.

When it comes to paragraph 4(a)(ii), I accept that the Domain Name is descriptive, but I do not find that fair use has been made of it for the reasons given above.

In my view there are no other factors in paragraph 4 on which the Respondent can rely to prevent a finding of Abusive Registration.

For all these reasons, I am satisfied that the Complainant has proven on the balance of probabilities that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7. Decision

I find that the Complainant has Rights identical to the Domain Name and that the registration and/or use of the Domain Name by the Respondent is an Abusive Registration.

I direct that the Domain Name be transferred to the Complainant.

Signed Richard Stephens

Dated 25 January 2016