

DISPUTE RESOLUTION SERVICE

D00015653

Decision of Independent Expert

Nilfisk-Advance A/S

and

Mr Mark Slater

1. The Parties:

Complainant: Nilfisk-Advance A/S
Sognevej 25
Brøndby
Brøndby
2605
Denmark

Respondent: Mr Mark Slater
Ankef
Connect 31, Pontefract Road
Normanton
West Yorkshire
WF6 1RN
United Kingdom

2. The Domain Name(s):

cfmindustrialvacuums.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.

16 March 2015 16:29 Dispute received
17 March 2015 12:37 Complaint validated
17 March 2015 12:46 Notification of complaint sent to parties
02 April 2015 15:44 Response received
02 April 2015 15:45 Notification of response sent to parties
09 April 2015 02:30 Reply reminder sent
10 April 2015 11:38 Reply received
10 April 2015 11:41 Notification of reply sent to parties
10 April 2015 11:41 Mediator appointed
15 April 2015 15:56 Mediation started
01 July 2015 10:24 Mediation failed
01 July 2015 10:24 Close of mediation documents sent
13 July 2015 02:30 Complainant full fee reminder sent
16 July 2015 10:19 Expert decision payment received

4. Factual Background

For the purposes of my decision and based on the parties' respective submissions and evidence, I find the following facts as proven:

- i. The Complainant is and has been for a substantial period of some 100 years a major manufacturer of industrial level cleaning machines and products, which it sells into professional cleaning businesses or for specialist cleaning operations.
- ii. The Complainant is active in manufacturing its products across Asia, the USA and Europe and sells its products into 44 countries.
- iii. The Complainant is an amalgamation of two businesses known as "Nilfisk" and "CFM" and it has a current CTM in respect of "CFM" enclosed in an oval shape registered on 24 May 2000.
- iv. The Respondent is an individual apparently working as or for a web designer known as "1creative" who on 3 April 2007 registered the Domain Name for and on behalf of a business known as Ankef Limited ("Ankef").
- v. The real dispute is therefore between the Complainant and Ankef, whose director, Mr Liffey, made submissions on behalf of the Respondent, which were adopted by the Respondent, and so became the Respondent's defence.
- vi. When I refer to the Respondent in this Decision, I am in effect referring to Ankef as any decision affecting the Domain Name ultimately affects Ankef most directly, though I will also use the term "Ankef" to make it clear when I am referring to that entity as distinct from the Respondent.
- vii. Ankef is a company registered in England and Wales which was incorporated on 1 March 2005.
- viii. Ankef's business is as a distributor in the UK of cleaning systems from a variety of manufacturers and it is likely that Ankef is the successor to another business of the same nature, as Mr Liffey's submissions say

that he left the Complainant's employment in 2000 to take part in a business which seems to have been merged into Ankef upon its incorporation.

- ix. Ankef had a non-exclusive distribution arrangement with the Complainant for the distribution of the latter's products in the UK, though it is unclear whether this was a formal legal contract or some sort of informal arrangement.
- x. In or about 2007, Ankef proposed to the Complainant that Ankef should make use of marketing by means of an online presence, of which the Complainant approved, and for that purpose and by means of the Respondent registered the Domain Name.
- xi. Ankef invested in producing and running a website accessed by the Domain Name ("Website") which was used to describe the Complainant's products and to be the basis for its marketing and selling efforts.
- xii. This strategy of using the Website was successful, though it had the undesired effect of allowing other persons, including the Complainant, to be the one to make the sale after Ankef had attracted the buyer by means of the Website.
- xiii. For reasons which neither party has fully explained, the distributor arrangement came to an end in December 2014: the Respondent suggests that this was some sort of unfair practice on the Complainant's part, allowing it to take advantage of Ankef's investment in online marketing, but whether this is so or not is not relevant for my decision.
- xiv. However, it is clear that as from December 2014 the Complainant stopped the direct supply of its products to the Respondent, leaving it to source such products as best it could from other dealers.
- xv. This meant that there ceased to be any direct commercial relationship between Ankef and the Complainant as of December 2014.

5. Parties' Contentions

The Complainant has made the following submissions:

- i. The Complainant has been engaged for over 100 years in the manufacture of commercial and professional level vacuum cleaning machines and equipment.
- ii. It is based in Denmark with sales across 44 countries.
- iii. It sells to the professional market with its products marketed under various brands.
- iv. The Complainant owns several trade marks containing "CFM", including European trademark CTM No. 001023878, which is used on many products.
- v. The trade mark "CFM" is well known.
- vi. The Complainant operates websites under the domain names nilfisk-cfm.dk and nilfiskcfm.com.
- vii. The letters "CFM" are the dominant element of the trade mark, with which the Domain Name is confusingly similar.

- viii. The addition of “industrialvacuums” does not distinguish the Domain Name from the Complainant’s trade mark.
- ix. There is a risk that the public will consider that there is a connection between the Complainant and the Respondent.
- x. The Domain Name is confusingly similar to the Complainant’s trade mark “CFM”.
- xi. The Domain Name was first registered in 2009.
- xii. The original registrant, the Respondent on behalf of Ankef Limited, was one of the Complainant’s distributors, but ceased to be so as of December 2014.
- xiii. The registrant therefore has no rights or legitimate interest in the Domain Name.
- xiv. The Complainant’s trade mark “CFM” predates the Domain Name and the Respondent has no trade or service marks similar to the Domain Name.
- xv. On the Website, there appears to be a sale of many of the Complainant’s products, though the Respondent no longer sells them.
- xvi. Through an enquiry, the Respondent offered competing products when contacted regarding the Complainant’s products.
- xvii. The Respondent is using the Website for commercial purposes, though he is not an authorised distributor of the Complainant’s products and has no licence to use the Complainant’s trade mark.
- xviii. The Respondent is using the Domain Name in a way likely to confuse third parties into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- xix. The Respondent’s use of the Domain Name is detrimental to the Complainant as he refers inquirers to competing products.

The Respondent has made the following submissions:

- i. Ankef as a business has had a long association with the Nilfisk brand and the Respondent was an employee of the Complainant for 14 years.
- ii. The Respondent left the Complainant’s employment to become a partner in Ankef in 2000: at that time Ankef was a distributor for Nilfisk products and is still one of the largest dealers in the UK for these products.
- iii. In 2002, Nilfisk acquired CFM, whereafter the CFM UK division operated independently until 2007, during which time Ankef was a leading distributor of CFM and Nilfisk products.
- iv. In 2008, the CFM branch closed and was incorporated into the Nilfisk brand.
- v. After 2008, Ankef proposed to the Complainant building a website to do the marketing which had previously been done by paper, to which the Complainant made no demur.
- vi. The Complainant approved the websites as built by Ankef.
- vii. Ankef invested in the Website, and was successful to the extent that it was recognised as such by the Complainant.
- viii. Ankef’s business started to suffer as it lost direct sales to the Complainant itself even though Ankef had invested in the Website.

- ix. Ankef has invested in marketing and stocking the Complainant's products and is still doing so as well as supporting existing customers of the Complainant's products.
- x. Ankef has as of 2013 re-oriented its website, ankef-cs.co.uk, to selling other manufacturers' equipment and has not sold the Complainant's products.
- xi. The Website has remained focused on the Complainant's range of products.
- xii. "CFM" is not distinctive and is an acronym in common use across a range of businesses and activities.
- xiii. The Respondent has removed from its websites the Complainant's particular representation of "CFM".
- xiv. The Complainant has in fact dropped the CFM element from its branding as of December 2014.
- xv. It is true that Ankef's direct account has been closed by the Complainant, although Ankef can obtain machines and parts from other distributors.
- xvi. However, Ankef is still distributing the Complainant's products and is doing so successfully.
- xvii. Ankef supplies many products from various manufacturers using four web platforms and its advice on the product will depend on the enquirer's specific needs.
- xviii. Ankef is providing genuine products by means of operating the Website.
- xix. Ankef has invested considerable sums in the Website and it is unfair of the Complainant to seek to have the Domain Name transferred.

The Complainant by its Reply has made the following submissions:

- i. The figurative elements of the Complainant's trade mark must be disregarded.
- ii. The Domain Name is confusingly similar with the Complainant's trade mark.
- iii. The remaining elements of the Domain Name other than "CFM" are purely descriptive matter.
- iv. The use of "CFM" with "industrialvacuums" creates an association with the Complainant's trade mark and products.
- v. There is therefore a risk of the public thinking there is a connection between the parties.
- vi. The Rights represented by the Complainant's trade mark have not disappeared.
- vii. The Domain Name has therefore been used in a way which has taken unfair advantage of or is detrimental to the Complainant's Rights.
- viii. The Respondent's use of the Domain Name confuses third parties into believing that the domain name is registered to and operated by the Complainant or an authorised distributor

6. Discussions and Findings

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*".

The Complainant has principally relied on a CTM in respect of "CFM" in a plain oval surround (CTM No. 001023878). It is true, as the Respondent contends, that the acronym "CFM" is capable of pointing to many businesses and activities in a great variety of different fields. However, the question I have to answer is that provided in paragraph 2(a) which I have just quoted. A CTM prominently incorporating the letters "CFM" undoubtedly gives the Complainant Rights as defined by the DRS Policy: the oval surround is a decorative feature which would distinguish the acronym from others which may be registered with other features and for other purposes, but the acronym is a sufficiently prominent feature of the CTM to allow the Complainant to show that it has Rights for the purpose of the DRS Policy.

The next question is whether the Complainant has satisfied the remainder of paragraph 2(a) of the DRS Policy. The Domain Name is clearly not identical with the Rights, but is it similar? The remainder of the Domain Name is descriptive matter, and descriptive matter, moreover, which suggests some sort of association with the Complainant as owner of the Rights – the Complainant is, after all, a global manufacturer of vacuum cleaning systems. While there are many decisions in this area made by other Experts, it comes down in the end to a question of feel and I have come to the conclusion that there is sufficient similarity.

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 important matter to note from the outset is that an Abusive Registration does not only refer to the initial moment of registration or acquisition of a domain name: an Abusive Registration might have been perfectly legitimate at the time of registration or acquisition, but its use since then may have changed such that it has become use which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

This is important as the Respondent has referred to the Complainant's initial enthusiasm for Ankef's use of the Domain Name and Website, but that is not necessarily decisive as regards later use. Equally, the Respondent has pointed to its other activities and other websites aimed at a variety of products, but this is again not decisive as I have to come to a decision on the Domain Name, not on the Respondent's business or marketing efforts in general. I have to answer the question whether the Respondent is now using the Domain Name in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Paragraph 3 of the DRS Policy sets out some examples of what can amount to evidence of an Abusive Registration; however, the introductory words to that paragraph say that the factors there listed are a non-exhaustive list and I do not take the list of factors as some sort of comprehensive code.

Turning to paragraph 3(a)(i), the factors there set out refer in particular to the act or initial registration or acquisition of the Domain Name by the Respondent, whereas I am satisfied that the Complainant approved, or at least made no demur to, the Respondent's registration of the Domain Name.

On a straight reading of the words, paragraphs 3(a)(iii) to (v) are not applicable to the facts of this case.

This leaves paragraph 3(a)(ii), which reads:

"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"

I attach at Annex A the copy of the Website included in my papers as at 17 March 2015.

I also attach at Annex B a copy of the Website which I acquired as at 1839 on 29 July 2015.

There is little obvious difference to the naked eye between the two other than that the Respondent has removed reference to “Nilfisk-CFM” in the top left hand corner. Other than that, I found the Website to be functional in that clicking on some of the Complainant’s products’ images led to more detailed descriptions of them. As the Complainant observes, there is no opportunity to purchase by clicking through to some sort of checkout, but a contact number is given and, from the ones I tested, each product’s page also leads to an online inquiry form, which provides Ankef’s contact details (phone number, physical address and an email address sales@cfmindustrialvacuums.co.uk).

It is worth noting in addition that clicking on the tab “Scrubber Dryers & Sweepers” takes one to www.ankef-cs.co.uk where a variety of machines is shown including a rotating graphic with images of Pressure Washers, Steam Cleaners, Carpet Cleaners, Pedestrian Scrubber Dyers, Industrial Sweepers, Ride on Scrubber Dryers and Commercial Vacuums. Reference was also made on that webpage to a variety of other products, including to three industrial vacuum products from Delfin, a competitor of the Complainant: the DG 300 SE Z21, DG 300 HD Z21 and the DG200 Z21. I also saw reference to various other products which could be described as some sort of vacuum cleaner. I attach as Annex 3 a copy of the foot of that webpage, showing the reference to these products as at 1914 on 29 July 2015.

The Complainant refers to an inquiry being made following the details given on the Website, leading to an offer of competing products, not those of the Complainant. The Complainant refers to “an inquiry” (singular) and so it is not possible to conclude that this is Ankef’s standard practice. The Respondent points to the fact that, as a responsible dealer, it would in each case make a recommendation of a product suitable to the particular inquirer’s purposes. This does not take the inquiry further forward in either direction.

However, whichever party is right on this matter, the reality is that paragraph 3(a)(ii) does not call for some sort of actual deception: in the absence of any evidence of confusion, it is enough that the Respondent’s use of the Domain Name 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”. The Complainant has interpreted this as being a “risk” of confusion, but I think the threshold is higher than just a risk: it has to be at the level of likelihood.

The Respondent freely admits that it is seeking to sell a variety of cleaning equipment from various manufacturers, including the Complainant. The Domain Name incorporates the name as contained in the Complainant’s Rights with a descriptive addition suggesting the business of vacuum cleaning.

There is a very large number of Decisions under the DRS Policy on this issue: reference to paragraph 3.3 of the Experts’ Overview version 2 shows some

discussion of this as well as reference to some of the cases. Without descending into extensive citation of other Decisions, I note that in DRS07991 (toshiba-laptop-battery.co.uk) the Appeal Panel observed that the domain name in that case was used to sell third party products in addition to those of Toshiba and it ordered transfer. Similarly, in DRS00248 (seiko-shop.co.uk), the Appeal Panel noted the addition of a descriptive addition to the basic trade mark and ordered transfer.

The question then is, in the absence of actual evidence of confusion, would a business (the Complainant's products not being aimed at consumers) visiting the Website be "likely" to be confused into believing that the Website was somehow "registered to, operated or authorised by, or otherwise connected with the Complainant"? Against the fact that its distribution arrangements with the Respondent came to an end in December 2014 I find on the balance of probabilities that the Complainant has satisfied this paragraph.

Paragraph 4 of the DRS Policy contains a non-exhaustive list of factors which may show that the registration is not an Abusive Registration. Those factors which possibly apply are paragraphs 4(a)(i)(A) and 4(a)(ii). Again, the discussion in the Experts Overview version 2 at paragraphs 4.2 to 4.9 is helpful.

I do not find that the Respondent can bring itself within paragraph 4(a)(ii) as the Domain Name includes the very letters included within the Complainant's Rights ("CFM") and so the Domain Name cannot be purely generic or descriptive.

When it comes to 4(a)(i), I accept that the Respondent is seeking to sell the Complainant's products, but alongside other manufacturer's products. The fact remains that it is no longer an authorised distributor and a business would be likely to conclude that the Respondent was in some way authorised by the Complainant such that there was some sort of connection or approval in place whereby the Complainant was representing to the world that it had some continuing relationship with the Respondent. I take into account that one tab on the Website leads to another website where products competing with those of the Complainant are being sold.

Paragraph 4 of the DRS Policy is not an exhaustive code, as I said above, and I also considered whether the Respondent could otherwise bring itself within that paragraph. I took account of its submissions in this area, including that it set up the Website with the Complainant's approval, that it has invested its own money in the Website and that its own business may well suffer in consequence of a transfer being ordered.

While it is finely balanced, I am satisfied that the Domain Name as being used by the Respondent is an Abusive Registration and that the Respondent cannot avail itself of any factors under paragraph 4 of the DRS Policy.

7. Decision

I find that the Complainant has Rights identical to the Domain Name and that the holding 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 31 July 2015

Annex A

CFM Industrial Vacuum Cleaners x +

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17 March 2015
Tuesday

Annex B

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Annex 3

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