

DISPUTE RESOLUTION SERVICE

D00021098

Decision of Independent Expert

Mr Andrew Zacharias

and

DazCom Limited

1. The Parties:

Complainant: Mr Andrew Zacharias
Chelmsford
Essex
United Kingdom

Respondent: DazCom Limited
Chelmsford
Essex
United Kingdom

2. The Domain Name:

fluxuator.co.uk (“the Domain Name”)

3. Procedural History:

08 February 2019 Dispute received
08 February 2019 Complaint validated
18 February 2019 Notification of Complaint sent to parties
23 February 2019 Trade mark document submitted by the Complainant
07 March 2019 Response reminder sent

08 March 2019 Response received
08 March 2019 Notification of Response sent to parties
12 March 2019 Reply received
12 March 2019 Notification of Reply sent to parties
15 March 2019 Mediator appointed
15 March 2019 Mediation commenced
22 March 2019 Mediation failed
22 March 2019 Close of mediation documents sent
26 March 2019 Expert decision payment received
28 March 2019 Further Statement filed by the Complainant

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 into question my independence in the eyes of either of the parties.

4. Factual Background

The following account is derived from the parties' submissions, the websites to which the parties have drawn the Expert's attention and searches that the Expert has made of the publicly available databases at the United Kingdom Intellectual Property Office, the United States Patent and Trademark Office and Companies House. It represents what appears to the Expert on the balance of probabilities to be the factual background insofar as relevant to this administrative proceeding under the Policy.

On a date prior to 6 February, 2015 Dominic Fowls, a plumbing engineer, disclosed to the Complainant an invention he had made, being a device for applying flux to copper pipes. Dominic Fowls and the Complainant entered into an agreement whereby they would develop the product and bring it to market. They branded it FLUXUATOR.

On 6 February, 2015 Dominic Fowls and the Complainant applied jointly for registration of FLUXUATOR as a United Kingdom trade mark in classes 1 and 20 for fluxes and flux containers. Registration came through on May 1, 2015. Trade mark protection has since been extended to Europe, the United States of America and elsewhere, all in the joint names of Dominic Fowls and the Complainant.

On 15 September, 2015 Dominic Fowls and the Complainant incorporated the Respondent, holding all the shares between them. As at 11 November, 2015 the sole director was Mark Capon, who resigned his directorship on 9 January, 2019.

On 21 October, 2015 the Respondent registered the Domain Name

In April 2016 Dominic Fowls and the Complainant brought in a third shareholder, Desmond Evans.

On 24 October, 2016 the Complainant registered the domain name, <fluxuator.com>, which is currently connected to a website operated by him, promoting and selling the FLUXUATOR.

On 14 December, 2016 the Respondent applied for a patent for an applicator device, identifying the inventors as Stefan Knox of Bang Products Limited and Theodore Davies of Bang Creations Limited. From the description of the invention it is clear that it relates to the FLUXUATOR. That application has not yet proceeded to the grant of a patent.

On 17 October 2017, the Complainant renewed registration of the Domain Name in the name of the Respondent, but giving his name as the contact name and paying for the renewal, using his personal contact details and his wife's account.

On 12 December, 2018 at a shareholders meeting at which the Complainant was not present Dominic Fowls and Desmond Evans appointed themselves directors of the Respondent.

On 19 December, 2018 the Complainant incorporated The Official Fluxuator Limited and on 21 December 2018 incorporated The Official Fluxuator Store Limited

On a date unknown to the Expert, but likely to have been in late 2018 or early 2019 the Respondent was able to change the contact details for the Domain Name transferring control of the registration from the Complainant to the Respondent.

On 9 January, 2019 Mark Capon resigned his directorship of the Respondent.

On 21 January 2019 the registered office of the Respondent was changed from an address in Wickford, Essex to its current address at Howe Green, Essex.

5. Parties' Contentions

The Complaint

In the Complaint the Complainant contends that his rights in respect of the Domain Name stem from the fact that he renewed the registration of the Domain Name in October, 2017 using his personal contact details and at his own expense.

His claim that the Domain Name is an Abusive Registration is very brief: *"In my opinion the above domain name was taken as an opportunistic action which at its best is mischievous and at its worse fraudulent as they cannot prove all the above is incorrect, they are well aware the domain does not belong to them and that is why*

it was taken secretly." The 'they' to whom the Complainant refers are not identified in the Complaint, but are the current directors of the Respondent (see section 4 above).

On 23 February, 2019 the Complainant submitted to Nominet a document detailing trade mark rights in the word mark FLUXUATOR held jointly in the names of the Complainant and Dominic Fowls (see section 4 above).

The Response

Much of the Response is devoted to alleged wrongdoings of the Complainant about which the Expert has no detailed information and on which the Expert has found it unnecessary to attempt to come to a concluded view.

The Respondent claims that the Domain Name, which has always been held in the name of the Respondent and is still held in the name of the Respondent, is the property of the Respondent, a company formed to develop and sell the FLUXUATOR device. The Respondent contends that the Complainant's personal renewal of the Domain Name (albeit in the name of the Respondent) was an illegitimate attempt by the Complainant to take control of the Domain Name. The Respondent contends that the Complainant recovered the costs of renewal of the Domain Name by way of an expenses claim made to the Respondent.

The Respondent was able to 'retrieve' the Domain Name "*from a NamesCo account by way of our directors following the identity reestablishment procedure with Nominet.*"

The Reply

The Complainant denies the Respondent's allegations of wrongdoings on the part of the Complainant. He counters by making allegations of criminal behaviour on the part of the Respondent's officers, which he has reported to the police. The Complainant contends that the appointment of Messrs. Fowls and Evans as directors of the Respondent, thereby enabling them to take control of the Domain Name registration, was not in accordance with the Articles of Association of the Respondent.

The Complainant refers to his communication with Nominet on 23 February, 2019 (see under 'The Response' above), which demonstrates that he has trade mark rights in respect of FLUXUATOR. He states further that he has "*a trading company and trading website for the Fluxuator.*"

Complainant's Further Statement of 28 March, 2019

The Expert accepted this Further Statement into the proceeding on the basis of the Complainant's assertion that it comprised 'new evidence'. In fact, most of it

was available to the Complainant when filing the Complaint and could have been included in the Complaint. Some of it supports bare assertions in the Reply. It draws attention to the fact that the Complainant registered the domain name, <fluxuator.com>, in October 2016 and operates the website to which that domain name is connected. It also identifies the companies, The Official Fluxuator Limited and The Official Fluxuator Store Limited, which the Complainant incorporated in December, 2018.

The Complainant expands his claims as follows:

“The Respondent (Dazcom Ltd) registered the fluxuator.co.uk Domain Name in January 2019 by dishonest means and in full knowledge of my rights, the registration post-dates all Fluxuator Trademark registrations also it post-dates my registration of fluxuator.com and fluxuator.co.uk Domain Names which were both registered in my name. The Respondent was fully aware of the trademark registrations and aware of my domain name registration when they registered the fluxuator.co.uk Domain Name.

I believe the Respondent registered the fluxuator.co.uk Domain with the intention of unfairly disrupting my business and to confuse consumers as to the identity of the entity behind the Domain Name leading them into believing that the Domain Name was operated, connected, authorized and controlled by me and sought to trade on my goodwill by using my trademark and showing familiarity with its brand and business. I submit evidence of confusion, in the form of a communication which I have recently received from a victim of the Respondent’s fraud.”

The evidence of confusion is an email exchange dated 17/18 March, 2019 between “Chuck Jnr.” and The Official Fluxuator Ltd..

“Chuck Jnr.” writes: *I am a HVAC engineer. I was looking for your website and there seems to be 2. There is no contact available from other one. I found this email [‘cs@fluxuator.com>’] on one of your sites. Can you tell me witch [sic] one ships to the USA? And why are the prices different.”*

Carli Savill of The Official Fluxuator responds: *“Hi Chuck. Thank you for your enquiry. We are the Official Fluxuator Ltd and we ship worldwide. Our prices are also cheaper if you would like to order please visit www.fluxuator.com.”*

Chuck responds: *“Hi Carli. Thanks for the kind reply. I will place an order today. But why is there 2 websites?”* The Expert does not know whether or not that question was answered.

6. Discussions and Findings

Introduction

As can be seen from section 4 above, the Complainant founded the Respondent in

partnership with Dominic Fowls, they having jointly registered the FLUXUATOR trade mark for use in relation to the flux applicator device demonstrated by Dominic Fowls in the video accessible at '<https://vimeo.com/211504114>', a link provided by the Respondent. The Complainant features in the video, endorsing the product as Dominic Fowls' idea, he himself knowing nothing of flux. It is clear to the Expert that the Respondent was formed by the two of them to bring the FLUXUATOR to market.

At that time in 2015, Dominic Fowls and the Complainant were clearly on friendly terms, but at some stage they fell out. The Expert does not know the date of the fall-out, nor does he know the reasons for the fall-out.

As will be seen below, the scope of the Policy is narrow. The limit of the Expert's remit is to assess whether the Complainant has rights in the FLUXUATOR trade mark and, if so, whether the registration and/or subsequent use of the Domain Name has taken unfair advantage of or been unfairly detrimental to the Complainant's trade mark rights.

General

Pursuant to paragraph 2 of the Policy for the Complainant to succeed in this Complaint he must prove to the Expert on the balance of probabilities that:

- 2.1.1 *He has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- 2.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration*

"Abusive Registration" is defined in paragraph 1 of the Policy 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. *is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

Rights

The Complainant clearly has rights in respect of the FLUXUATOR trade mark, being a co-owner of the various trade mark registrations of the mark (see section 4 above) along with Dominic Fowls, his co-founder of the Respondent and now a director of

the Respondent. The FLUXUATOR trade mark is identical to the Domain Name at the third level.

Abusive Registration

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration. Of potential relevance here are sub-paragraphs 5.1.1.3, 5.1.2 and 5.1.5, which read as follows;

“5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 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;”

5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

5.1.5.1 has been using the Domain Name registration exclusively; and

5.1.5.2 paid for the registration and/or renewal of the Domain Name registration;

Sub-paragraph 5.1.1 concerns the Respondent’s motive at time of registration or acquisition of the Domain Name. For any of the circumstances set out in this sub-paragraph to apply, the evidence must support the proposition that the Respondent was targeting the Complainant from the outset. Sub-paragraph 5.1.2 concerns the Respondent’s subsequent use of the Domain Name, which has led or is likely to lead to confusion with the Complainant. Sub-paragraph 5.1.5 concerns the relationship between the parties, the use of the Domain Name, which has to have been made exclusively by the Complainant, and the payment for its registration and/or renewal, which also has to have been made by the Complainant.

As to sub-paragraph 5.1.1, the Domain Name was registered in the name of the Respondent on 21 October 2015. There is nothing before the Expert to indicate that the registration was made other than in good faith for the benefit of the Respondent. Thus, to the extent that the Complaint can be said to claim Abusive Registration under sub-paragraph 5.1.1 of the Policy it fails.

As to sub-paragraph 5.1.2, it is the case that the Respondent is using the Domain Name to promote and sell the FLUXUATOR flux applicator. It is also the case that

from a date unknown following his registration of the <fluxuator.com> domain name in October, 2016 the Complainant has been marketing the FLUXUATOR through a website connected to that domain name.

The Expert has not been informed as to the circumstances behind the Complainant's registration and use of the <fluxuator.com> domain name. Was it with the agreement of the Respondent? The Expert does not know. Whatever may have been the position originally, it is clearly the case that the parties are now at odds with each other and the scope for confusion with the Respondent's website connected to the Domain Name is obvious.

Who is responsible for that potential for confusion? On the evidence before the Expert, which is far from complete, the Expert finds on the balance of probabilities that the Respondent's use of the Domain Name preceded the Complainant's use of <fluxuator.com>, that the Respondent's use of the Domain Name has not undergone material changes in the meantime and that any confusion arising between the parties' commercial operations under the "Fluxuator" name has resulted from the Complainant's adoption of the <fluxuator.com> domain name and no doubt exacerbated by the Complainant's incorporation in December 2018 of companies, not associated with the Respondent, under the names The Official Fluxuator Limited and The Official Fluxuator Store Limited. On the evidence before the Expert, responsibility for any confusion cannot fairly be laid at the door of the Respondent.

Thus, to the extent that the Complaint claims Abusive Registration under sub-paragraph 5.1.2 of the Policy it fails.

Nowhere does the Complainant formally place his claim under sub-paragraph 5.1.5 of the Policy, but he plainly regards the Domain Name as his, because he paid for its renewal through his personal account with the registrar and not through the Respondent's account. It may also be, but the Expert has no evidence on the matter beyond bare assertion, that he also paid for registration of the Domain Name back in October 2015. In the Reply he states: "*... the fact remains that I am the original and subsequent subscriber/owner of the fluxuator.co.uk domain registered under my name, private address, private email, private telephone number and under my personal namesco account also I am the registered owner of the Fluxuator Trademark and have a trading company and trading website for the Fluxuator.*"

The Expert has nothing before him to show that the Domain Name was ever registered under the Complainant's name. His name merely appears as the contact name for the renewal in October 2017.

For sub-paragraph 5.1.5 to apply the Complainant needs to satisfy the Expert that the Domain Name was registered as a result of an association between the parties. Any part that the Complainant played in the registration and/or renewal of the Domain Name must have stemmed from his position as a shareholder in the Respondent and as a co-owner of the FLUXUATOR trade mark. However, the

Complainant also needs to show that he has been using the Domain Name exclusively as well as having paid for its registration/renewal. There is nothing before the Expert to demonstrate that anyone other than the Respondent has been using the Domain Name. Thus there is no scope for a claim under sub-paragraph 5.1.5. The Expert notes in addition that in neither the Reply nor his Further Statement did the Complainant respond to the Respondent's evidence appearing to show that the Complainant reclaimed his domain name expenses from the Respondent.

The factors listed in Paragraph 5 of the Policy, which may be evidence that the Domain Name is an Abusive Registration are expressly stated to form a non-exclusive list. However, the Expert is unable to come up with any possible basis upon which the Domain Name could be said to be an Abusive Registration.

The Complainant objects to the manner in which his co-shareholders in the Respondent appointed themselves directors of the company, but that is not a matter for determination under the Policy. The Expert has no information enabling him to determine that there was anything improper about their appointment as directors of the company.

The Complainant also objects to the manner in which those directors were able to change the contact details for the Domain Name, depriving the Complainant of the ability to control the Domain Name registration. However the Complainant makes no attempt in the Reply to counter the Respondent's contention set out in the Response that the Respondent was able to remove "*from a NamesCo account by way of our directors following the identity reestablishment procedure with Nominet.*" There is nothing before the Expert to indicate that there was anything improper in that manoeuvre.

In summary, it appears to the Expert that the Domain Name was registered in good faith with the intention that the Respondent should use it for the purpose of promoting and selling the FLUXUATOR product and that the Respondent has been using it consistently for that purpose.

The Complaint has failed to satisfy the Expert that the Domain Name in the hands of the Respondent is an Abusive Registration.

7. Decision

The Complaint is dismissed.

Signed [TONY WILLOUGHBY]

Dated 2 April, 2019