

DISPUTE RESOLUTION SERVICE

D00022253

Decision of Independent Expert

Npower Limited

and

Mantas Simkus

1. The Parties:

Complainant: Npower Limited
Windmill Hill Business Park, Whitehill Way
Swindon
Wiltshire
SN5 6PB
United Kingdom

Respondent: Mantas Simkus
Harrogate
North Yorkshire
United Kingdom

2. The Domain Name:

npower.uk

3. Procedural History:

I 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.

21 January 2020 13:26 Dispute received
22 January 2020 12:54 Complaint validated
22 January 2020 12:58 Notification of complaint sent to parties
10 February 2020 01:30 Response reminder sent
12 February 2020 11:30 Response received
12 February 2020 11:31 Notification of response sent to parties
17 February 2020 01:30 Reply reminder sent
19 February 2020 16:01 Reply received
19 February 2020 16:02 Notification of reply sent to parties
19 February 2020 16:05 Mediator appointed
20 February 2020 16:30 Mediation started
09 March 2020 15:58 Mediation failed
09 March 2020 15:58 Close of mediation documents sent
13 March 2020 09:25 Expert decision payment received

4. Factual Background

- 4.1. The Complainant, Npower Limited, is one of the UK's "Big Six" energy suppliers.
- 4.2. The Complainant was incorporated on 21 October 1998 and changed its name to Npower Limited on 1 December 2000. The Complainant has traded as a private limited company in the UK since incorporation.
- 4.3. The Npower brand is commonly associated with the generation of electricity and the supply of electricity and gas to homes and business in the UK. In addition, the Complainant has provided, amongst other things, central heating systems, boiler installation and repair services.
- 4.4. The Complainant owns numerous domain names containing the term "*npower*" and is the registered proprietor of a number of UK trade mark registrations, including but not limited to No. 2214325A for the word mark NPOWER dating from 15 November 1999, No 3084590 for the stylised work mark NPOWER dated from 4 December 2014 and No. 3361654 NPOWER TODO dated from 18 December 2018.
- 4.5. The Respondent, Mr Mantas Simkus, is an individual who resides in Harrogate, North Yorkshire.
- 4.6. The Respondent registered the Domain Name on 4 July 2019 but has not used it in relation to a live website.
- 4.7. On 10 September 2019 the Respondent applied for a UK trade mark for the mark *npower.uk* under UK trade mark application no. 3427645. That has not been granted yet and has been opposed by the Complainant.

5. Parties' Contentions

Complainant's Submissions

The Complainant's submissions in its Complaint can be summarised as follows:

Rights

- 5.1.1. It is the registered proprietor for a number of UK trade marks which consist of or include the mark NPOWER for a range of goods and services;
- 5.1.2. In addition to its registered rights the Complainant has unregistered rights in passing off due to the goodwill generated by its use of the mark NPOWER across the UK for 20 years.

Abusive Registration

- 5.2. The Complaint submits that the Domain Name is an Abusive Registration because:
 - 5.2.1. The Domain Name is identical to the trade mark NPOWER which is protected by Npower Limited in respect of various goods and services;
 - 5.2.2. The Complainant recites Sections 10(1) (2) and (3) of the Trade Marks Act 1994 in relation to trade mark infringement but points out that as the Respondent has not yet used the Domain Name in relation to an operational website it is difficult to know which part of section 10 it will rely on.
 - 5.2.3. The Complainant submits that "NPOWER" is not a dictionary word and therefore there is no reason for the Respondent to use the word "NPOWER" other than to take unfair advantage of the Complainant's reputation and considerable goodwill.

Respondent's Submissions

The Respondent's submissions can be summarised as follows:

- 5.3. The Respondent submits that the Domain Name is not an Abusive Registration because:
 - 5.3.1. the Respondent is not infringing any of the Complainant's trade mark rights;
 - 5.3.2. the Complainant should purchase an alternative domain name and the Respondent lists many that are available which incorporate NPOWER;
 - 5.3.3. the word "NPOWER" is not a unique word and is used all around the world with more than 50 companies around the world called "NPOWER" (as taken from the website 'opencorporates.com) and 14 unrelated and active companies in the UK also using this name;
 - 5.3.4. the fact that the Complainant has trade marks registered in the UK, specifically in the gas and electricity sphere, does not mean that they have rights in respect of all goods and services worldwide;
 - 5.3.5. the Respondent is not advertising or selling any goods related to the supply of gas and electricity on the Domain Name;
 - 5.3.6. there are 12 active trademarks not related to the Complainant around the world which consist of or include NPOWER and indeed the first

trade mark for NPOWER was registered back in 1993 and it wasn't registered by the Complainant;

- 5.3.7. "NPOWER" consists of two dictionary words, being "N" and "Power" both of which have very different meanings;
- 5.3.8. the Respondent intends to use the Domain Name in relation to a business selling hand tools and other metal fixtures. The trade marks that he has applied to register are consistent with that.

Reply

5.4. The Complainant's submissions in its Reply can be summarised as follows:

- 5.4.1. The Complainant and its affiliated companies are the only companies which own trade mark rights in the mark "NPOWER" in the UK;
- 5.4.2. It is not necessary for a business to own every possible domain name and trade mark rights can be asserted when there is considered to be a conflict in respect of a domain name and the goods or services on offer;
- 5.4.3. There is a risk of confusion because the Domain Name only contains the Complainant's name "NPOWER" which is well-known in the UK and there is nothing else in the Domain Name to differentiate from the Complainant;
- 5.4.4. The situation in the UK is the only situation relevant to these proceedings which concern a UK domain name;
- 5.4.5. The Complainant has identified two active companies in the UK, not the 14 referred to by the Respondent, and the Complainant has been aware of the activities of these two companies in different fields to the Complainant;
- 5.4.6. The Complainant has carried out some research on the third party trade marks that the Respondent refers to. That research has revealed that the 1993 trade mark which the Respondent has referenced was in fact a US trade mark application that never proceeded;
- 5.4.7. Since 1999 the Complainant has filed 156 trade marks in the UK and 20 EU trade marks which include the name NPOWER;
- 5.4.8. The Complainant or an affiliated company owns all the UK trade marks containing the mark "NPOWER" aside from the mark which the Respondent is applying for. The Complainant filed a notice of threatened opposition to the this trade mark application on 22 November 2019;
- 5.4.9. The word "NPOWER" is not a dictionary word and the Complainant has enclosed dictionary extracts to evidence this.

6. Discussions and Findings

6.1 Paragraph 2 of the Nominet's Dispute Resolution Service Policy ("DRS Policy") requires that the Complainant must prove, on the balance of probabilities, that:

2.1.1 The Complainant 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*

Rights

6.2 As a first step, I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name.

6.3 The definition of Rights in the DRS Policy is as follows:

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.

6.4 It is clear that the Complainant has Rights in both the word and mark NPOWER. The Complainant is the registered proprietor of a series of trade marks which include the mark NPOWER and the Complainant has been using this mark for at least 20 years.

6.5 The Domain Name differs only from the mark in which the Complainant has Rights by the addition of the top level suffix .uk.

6.6 I therefore find, that the Complainant has Rights in a name or mark which is identical to the Domain Name.

Abusive Registration

6.7 The definition of Abusive Registration in the DRS Policy is as follows:

Abusive Registration means 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*

6.8 This definition requires me to consider whether the Domain Name is an Abusive Registration either at the time of registration/ acquisition or subsequently through the use that was made of it.

6.9 Paragraph 5 of the DRS Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration. and Paragraph 8 of the DRS Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.

- 6.10 The Policy requires the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.
- 6.11 In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant's Rights. In some cases, where the name in which the Complainant has Rights is particularly well known, this would be fairly obvious and straightforward, while in other cases, where the name in which the Complainant has Rights is less well-known and/or where there are other meanings or uses which can be made of the name, this will require substantial evidence from the complainant.
- 6.12 The approach that I intend to take in this case is to look at the overall question of whether the Respondent's registration or use of the Domain Names constitutes an Abusive Registration. Bound up with that, and indeed central to it, will necessarily be the question of the Respondent's knowledge of the Complainant's Rights.
- 6.13 In making this overall assessment the nature of the name or mark in which the Complainant has Rights is also clearly a factor here. The more descriptive or generic that name or mark is then the more likely it is that the Respondent simply happened upon the Domain Name as a "good domain name" without necessarily having any knowledge of the Complainant's Rights. Obviously the more well-known and unique that name or mark is then the less likely it is that the Respondent did not register the Domain Name with the Complainant's Rights in mind.
- 6.14 The current case falls closer towards the former category, i.e. the name or mark in which the Complainant has Rights, i.e. NPOWER, is well established and has been extensively used by the Complainant. As a result, I find it inconceivable that the Respondent would not have known about those Rights when he registered the Domain Name.
- 6.15 In addition, a relevant factor in this instance is the nature of the Domain Name. It consists entirely of the name or mark in which the Complainant has Rights without any addition. It is the type of domain name which the public are likely to see as being connected and related to, and maybe authorised by, the Complainant. It is apparent that the Domain Name is one which the Complainant might well own and this view would be shared by an ordinary member of the public looking to find the Complainant's website .
- 6.16 Indeed Paragraph 5.1.6 of the Policy lists the following as one of the factors which may evidence that the Domain Name is an Abusive registration:

The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.

- 6.17 In his Response the Respondent is silent about whether he was aware of the Complainant when he registered the Domain Name but rather he says that he had every right to do so essentially because the Complainant has no monopoly in the mark NPOWER and there are many third parties that use NPOWER. Unfortunately, the Respondent fails to support what he says with evidence and I do not think I can give this submission much weight given the extensive use that the Complainant has made of the mark NPOWER and number of trade mark registrations it has which include NPOWER .
- 6.18 The Respondent also says that he intends to use the Domain Name in an area which is nothing to do with the Complainant although that use has not commenced yet. Unfortunately, the nature of the Domain Name is such that given the Rights the Complainant has the public are likely to be misled into thinking the Domain Name links to the Complainant's website.
- 6.19 Put another way, there is likely to be "initial interest confusion" which may not have been the case if the Respondent had adopted a domain name which contained more than just the mark in which the Complainant has Rights. Nominet's DRS Experts' Overview explains this as follows:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

*In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name. In the High Court decision *Och-Ziff Management Europe Ltd v Och Capital LLP* [2010] EWHC 2599 (Ch), the court quoted the International Trade Mark Association definition of initial interest confusion as being "a doctrine which has been developing in US trademarks cases since the 1970s, which allows for a finding of liability where a plaintiff can demonstrate that a consumer was confused by a defendant's conduct at the time of interest in a product or service, even if that initial confusion is corrected by the time of purchase". In that case the court held that initial interest confusion is legally actionable under European trade mark legislation.*

*In DRS 07991 (*toshiba-laptop-battery.co.uk*) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods.*

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).

The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privalege.co.uk) - as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decisions in DRS 00248 (seiko-shop.co.uk) and DRS 07991 (toshiba-laptop-battery.co.uk).

6.20 The nature of the Domain Name is such that it is likely to be either typed into the web address bar by a consumer guessing the correct website of the Complainant or a website linked to the Domain Name might be arrived at by searching for the Complainant's name on an internet search engine. This will be the case regardless of what the Respondent does or intends to do with the Domain Name.

6.21 I therefore find that on the balance of probabilities that the Domain Name is an Abusive Registration.

7. Decision

I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name. Further, on a balance of probabilities, I find that the Complainant has established that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Complainant.

Signed

Dated 6th April 2020

Nick Phillips