

DISPUTE RESOLUTION SERVICE

D00017249

Decision of Independent Expert

Funeralbooker Limited

and

Jamie Hubbard

1. The Parties:

Complainant: Funeralbooker Limited
Address: 3 Loughborough Street
London
SE115RB
Country: United Kingdom

Respondent: Jamie Hubbard
Address: 7d Peterborough Villas
Fulham
London
SW6 2AT
Country: United Kingdom

2. The Domain Name:

funeralbooker.co.uk (“Domain Name”)

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.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 3, July 2008 (the “Policy”) and/or the Nominet UK Dispute Resolution Service Procedure Version 3, July 2008 (the “Procedure”) unless the context or use indicates otherwise.

The procedural history is:

22 March 2016	Dispute received
22 March 2016	Complaint validated and notification of complaint sent to parties
23 March 2016	Response received
23 March 2016	Notification of response sent to parties
23 March 2016	Reply received
4 April 2016	Notification of reply sent to parties
4 April 2016	Mediator appointed
8 April 2016	Mediation started
13 May 2016	Mediation failed and close of mediation documents sent
16 May 2016	Expert decision payment received

On 18 May 2016, the Respondent submitted an explanatory paragraph in relation to a non-standard submission pursuant to §13b of the Procedure. Having considered the explanatory paragraph, I determined that it did not present an explanation of exceptional circumstances, as required by the DRS Procedure, to convince me that I needed to see the full 13b submission. Furthermore, it was in itself a submission of assertions as to why the Domain Name is not an Abusive Registration.

Accordingly I declined to receive the full submission and I confirmed to both parties that I would not take into account the contents of the explanatory paragraph in my decision. I also noted that as I had only received the complaint papers on 17 May 2016, and consequently had not considered the parties submissions, I reserved the right to request to see the Respondent's full 13b submission should I wish to do so when I had properly considered the papers. I issued my decision to Nominet by email on 18 May 2016.

On 23 May 2016, I issued a request to the Respondent pursuant to §6b of the Procedure to comment on new evidence in the Complainant's Reply comprising a screenshot of a Twitter exchange dated 3 and 4 September 2015. I directed that the Respondent should provide a response by 5:00pm on 26 May 2016.

On 23 May 2016 I also issued a request to the Complainant under §13a of the DRS Procedure to provide evidence of Rights in the name 'funeralbooker' that existed prior to the registration of the Domain Name. I directed the Complainant to §1.7, §1.9 and §2.2 of the DRS Experts' Overview (version 2 November 2013 published on the Nominet website). I directed that the Complainant should provide a response by 5:00pm on 26 May 2016 and that the Respondent should provide any reply by 5:00pm on Tuesday 31 May 2016.

4. Factual Background

The Complainant operates a funeral comparison service under the name funeralbooker. The Complainant was registered at Companies House on 15 Jun 2015 with company number 09639436.

The Complainant filed a trademark (UK00003137688) on 24 November 2015 in the mark funeralbooker which was entered into the register on 19 February 2016.

The Respondent registered the Domain Name on 17 November 2015.

The Respondent uses the Domain Name to resolve to his own funeral comparison services at his firstfunerals.co.uk website. The Respondent registered firstfunerals.co.uk ("Website") on 10 March 2015.

5. Parties' Contentions

The Complaint

Complainant's Rights

The Complainant asserts Rights in the name funeralbooker arising from its:

1. registration of the company, Funeralbooker Limited;
2. operation of a funeral comparison service under the name funeralbooker operating from the domain funeralbooker.com; and
3. trademark UK00003137688 in the mark funeralbooker.

The Complainant also says that it advertises under the name funeralbooker, both digitally and in print across many funeral related publications. However, it provided no evidence of any such advertising.

Abusive Registration

The Complainant says that the Respondent started the Website and registered the Domain Name for the following reasons:

1. to stop the Complainant from registering the Domain Name despite the Complainant's rights in the name;
2. to unfairly disrupt the Complainant's business by redirecting the Domain Name to forward to the Website in order to trick customers searching for the Complainant's website into using the Respondent's services.

The Response

The Respondent says that the complaint should not succeed because:

1. he incorporated firstfunerals Limited in February 2014 and so was first to market before the Complainant;
2. he owns and continues to buy domains as investments related to the funeral industry, including:
 - a. funeralscanner.com
 - b. funeralbooker.co.uk
 - c. 1stfunerals.com
 - d. 1stfunerals.co.uk
 - e. firstfunerals.com
 - f. firstfunerals.co.uk
 - g. firstfuneral.co.uk
 - h. funeralsfirst.com
 - i. funeralsfirst.co.uk
 - j. funerals1st.com
 - k. funerals1st.co.uk

3. buying the above domains is an SEO strategy which is legal providing the domains are relevant to the business; all of them are related to the funeral industry;
4. the Complainant is trying to compete in the same space but the Respondent purchased the Domain Name and it was acquired legally;
5. it is the Complainant's responsibility to acquire the relevant domains to protect its brand;
6. there is nothing on the Website that is abusive or illegal; the content is related to the Respondent's business which he had already established when he acquired the Domain Name;
7. the Respondent is not tricking customers but simply acquiring more customers by a different methodology;
8. the Complainant may have a trademark and incorporated a company but there are numerous businesses that register domains but have company names that are different to their trading names;
9. he has not breached any trademark regulations because the Complainant trades under funeralbooker Limited or funeralbooker.com; he has not used the Complainant's logo or material and the Website is clearly independent from the Complainant;
10. the Complainant has copied the Respondent's website and business concept.

The Respondent says that he would not sell the Domain Name to a third party under any circumstances but he is willing to sell the Domain Name to the Respondent for a fee of £100,000 and that he will not accept any less.

The Reply

The Complainant picks out the following statement in the Response and says that this is the Respondent's attempt to deny knowledge of the Complainant's existence before registering the Domain Name despite the Complainant's alleged prolific and industry-wide national advertising:

"It has only come to my attention that funeralbooker is trying to compete in the same space however I purchased this domain and it is the property of firstfunerals Limited and acquired legally."

In response the Complainant refers to a screen shot of a tweet posted by the Respondent prior to registration of the Domain Name:

"@funeralbooker look forward to your launch but **@firstfunerals** was born before **#techstartup #raceison**"

1:49 PM – 3 Sep 2015

"funeralbooker @funeralbooker 4 Sep 2015

Thanks **@firstfunerals** – we've worked closely with independent FDs and customers to build funeralbooker and can't wait to launch this Autumn"

The Complainant says that this invalidates the Respondent's argument and reinforces the likelihood of the registration being abusive.

Furthermore, the Respondent has added a further abusive use by stating that he won't sell the Domain Name for less than £100,000 because this demonstrates that it was registered with the primary purpose of selling or renting it specifically to the Complainant for more than the Respondent paid for it.

The Complainant disputes the Respondent's first to market claim but offers no evidence.

The Complainant says that the Respondent's registrations of several domains are variants of a combination of "first" and "funerals" apart from funeralscanner.com. Thus, the Respondent did not buy the Domain Name as part of an SEO strategy but did so because he was aware of the Complainant's presence in the market. The Respondent has used the Domain Name to redirect traffic to the Website to take advantage of the Complainant's market presence and thus tricking customers.

The Complainant concludes that given that the Respondent was aware of the Complainant before registering the Domain Name, then it was registered with the primary purpose of disrupting the Complainant's business and it has been used to confuse internet users.

The Complainant dismisses the remainder of the Response as not relevant to the Complaint.

The Respondent's response to the Expert's §6b request

I invited the Respondent to file a further submission pursuant to §6b of the DRS Procedure to comment on:

1. the screenshot in the Reply of a Twitter exchange dated 3 and 4 September 2015;
2. the date of this exchange;
3. why the first part of the exchange (made by the Respondent) appears to have been deleted on-line;
4. the Complainant's interpretation that §3 of the Response is a statement by the Respondent that he was not aware of the existence of the Complainant before he registered the Domain Name, which the Twitter exchange shows is not true.

I directed that the Respondent to confine his submission to the above and not to submit the further assertions that he made in his §13b explanatory paragraph dated 18 May 2016.

In response to point 1, the Respondent simply repeated the Twitter exchange. As to point 2, the Respondent noted that he registered the Domain Name 74 days after the exchange but the Complaint was not issued until 201 days after the Twitter exchange, and that the Complainant made no attempt to purchase the Domain Name in this period (otherwise the Complaint would have been issued earlier).

The Respondent replied that point 3 is irrelevant as it is on the Complainant's feed and the evidence is submitted by the Complainant. As to point 4, the Respondent says that the Twitter exchange has no relevance but the crucial point is that the Complainant had the option to register the Domain Name when it registered funeralbooker.com on 27 August 2014 but opted not to do so. Furthermore, the Complainant only issued the Complaint when the Respondent pointed the Domain Name URL to the Website on 22 March 2016. This does not prevent the Complainant from trading.

The Complainant's response to the Expert's §13a request

In response to the §13a request to provide evidence of Rights in the name funeralbooker that existed prior to the registration of the Domain Name, and in doing so to consider §1.7, §1.9 and §2.2 of the DRS Experts' Overview, the Complainant acknowledged that the consensus view of recent Experts' meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for this purpose and in and of itself a trademark application will not constitute 'Rights' under the Policy. However, the Complainant asserts that taken together, along with the further evidence submitted, its registration of Funeralbooker Limited and its application for the trademark support the existence of Rights.

With reference to the Expert Overview (“What is required for a Complainant to prove that he/she/it “has rights” in paragraph 2(a)(i) of the Policy?”) the Complainant notes that this will ordinarily include evidence to show that (a) the Complainant has used the name or mark in question for a not insignificant period and to a not insignificant degree (e.g. by way of sales figures, company accounts etc) and (b) the name or mark in question is recognised by the purchasing trade/public as indicating the goods or services of the Complainant (e.g. by way of advertisements and advertising and promotional expenditure, correspondence/orders/invoices from third parties and third party editorial matter such as press cuttings and search engine results). Accordingly, the Complainant evidences that:

1. it received funding for funeralbooker in December 2014 and further funding in July 2015 (<https://www.crunchbase.com/organization/funeralbooker#/entity>);
2. it was signing up funeral directors from August 2015;
3. a Google search with a date range before 17 November 2015 shows the Complainant’s website live (as per the provided screenshot) as well as its advice centre for the public to get bereavement advice;
4. a Google search also shows the Respondent’s deleted tweet acknowledging that he was well aware of the Complainant’s presence before registering the Domain Name;
5. on 5 September 2015 the Complainant exhibited at the largest industry event “The Ideal Death Show” and recorded a television spot which was broadcast throughout Ireland (<https://twitter.com/funeralbooker/status/640200457307226112>);
6. on 27 September 2015 the Complainant published its advertisement video which was distributed to all funeral directors in the UK (<https://www.youtube.com/watch?v=VCKAkTFk-UY>);
7. in September, October and November 2015 the Complainant advertised in all of the trade magazines, every month, in highly visible and expensive spots such as back pages, inside back, inside front pages etc. including SAIF Insight, Funeral Service Times, Funeral Service Journal and NAFD (National Association of Funeral Directors) (copies provided);
8. in October 2015 the Complainant sent a direct mail campaign to all funeral directors and industry movers (promotional material provided with a receipt for the stamps).

In conclusion, the Complaint says that there is little chance that anyone in the industry could have failed to notice its wall of advertising through all the trade print magazines, direct mail, social media, video and trade-shows, all before the registration of the Domain Name on 17 November 2015. Further, the Respondent not only noticed the Complainant, but tweeted about them and then proceeded to buy the Domain Name and re-direct it to the Website.

The Respondent’s reply to the Complainant’s §13a response

In response the Respondent’s asserts that the Complainant trades under funeralbooker.com. If the Complainant had wanted to trade under funeralbooker.co.uk it would have printed its advertising campaigns using this and tried to acquire the Domain Name prior to 22 March 2016.

The Respondent says he could start a business tomorrow and name it funeralbooka Limited and begin trading under www.funeralbooker.co.uk. Thus, why should the Complainant have preferential rights over the URL just because it has funeralbooker.com? The only reason the Complainant wants the Domain Name is to add value to its business.

The Respondent says he could buy the Domain Name and start a business in the future called www.funeralbooker.co.uk and that the Complainant has no right to prevent him from doing so.

Furthermore, the Respondent says that the Complainant has not detailed any financial loss to the business or reputational damage or confusion from its clients. The Respondent says he has not caused any damage to the Complainant.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2a of the Policy, both limbs of the test that:

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

Complainant's Rights

Rights is defined in §1 of the 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”.

The wholly generic suffixes “.co.uk” and “.uk” are discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant evidences the incorporation of Funeralbooker Limited on 15 Jun 2015 and a trademark in the mark funeralbooker filed on 24 November 2015 and entered into the register on 19 February 2016.

The consensus view of recent Experts' meetings has been that mere registration of a company name at the Companies Registry does not of itself give rise to any rights for the purpose of §1 of the Policy (§1.7 of the DRS Experts' Overview). The Expert's Overview (§1.9) is also clear that the mere existence of a trade mark application cannot give rise to Rights since the validity of the application has not been determined.

In response to my request for the Complainant to provide more evidence by way of establishing unregistered rights, the Complainant duly provided evidence including prominent advertisements placed in trade journals in September 2015, a mailshot of approximately 167,000 in October 2015, exhibiting at a trade fair, national TV coverage and YouTube video launch in September 2015. Furthermore, the Respondent was clearly aware of the Complainant's entry into the market, using the name funeralbooker, as evidenced by the Respondent's tweet on 3 September 2015.

The standard of proof in the DRS is “on the balance of probabilities”, which is also referred to as “more probable than not”. I am satisfied on the papers before me that on the balance of probabilities the Complainant had made significant efforts, by way of raising funding, trade advertising and otherwise, to launch funeralbooker as a business in a period of around 3 months prior to the registration of the Domain Name. I am satisfied that the trade knew of the Complainant's presence in the market and its name and logo. Indeed, this is evidenced by the Respondent being aware as early as 3 September 2015 of the Complainant's entry to the market.

I also note the general practice under the Policy, and the stated aim of the Experts' Overview, which provides that paragraph §2 (a)(i) of the Policy should merely be a low-level test to ensure that the Complainant has a bona fide basis for making the Complaint.

Accordingly, for the purposes of the first limb of the test in §2a of the Policy, I find that the Complainant has Rights in the name funeralbooker which is identical to the Domain Name.

Abusive Registration

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

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §3a of the Policy:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;*
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or*
 - C. for the purpose of unfairly disrupting the business of the Complainant;**
- ii. 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;*
- iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the Respondent of domain names (under .uk or otherwise) which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;*
- iv. It is independently verified that the Respondent has given false contact details to us; or*
- v. The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:
 - A. has been using the Domain Name registration exclusively; and*
 - B. paid for the registration and/or renewal of the Domain Name registration.**

The Respondent was clearly aware of the Complainant's entry into the market some weeks before he registered the Domain Name. The Respondent's tweet on 3 September 2015, and the Response, indicate that he perceived the Complainant's business model and entry as a threat and/or challenge to his own business trading as funeralsfirst.

The Respondent says that one of his reasons for registering the Domain Name is that it is part of his SEO (Search Engine Optimisation) strategy and that this is entirely legal provided the domains are relevant to the business. In this case, he says, all of his domains, including the Domain Name, are related to the funeral industry. The Respondent is wrong; he may not register and/or use domains in which others have Rights and where such registration and/or use is Abusive.

The Respondent says that the Complainant chose to trade under funeralbooker Limited and funeralbooker.com and uses the latter in promotional material. Thus, says the Respondent, the Complainant does not want to use funeralbooker.co.uk. Again, the Respondent is wrong; it is immaterial whether or not the Complainant wants to use the Domain Name, it is the Respondent's registration and use of the Domain Name that determines whether the registration is Abusive.

It is clear from the Respondent's use of the Domain Name to point to its own funeral services website, that those internet users who are looking for the Complainant's website and type in funeralbooker.co.uk will be directed to the Respondent's competing services. The Respondent says that he is not tricking customers but simply acquiring more customers by a different methodology. I do not accept this argument; it is well established under the DRS that initial interest confusion is Abusive under §3a ii of the Policy and I am satisfied that on the balance of probabilities there has been and will be initial interest confusion in internet users looking for the Complainant's website and arriving instead at the Respondent's website.

The Respondent's claim that his use of the Domain Name is not Abusive since he has not used the Complainant's logo or material and that his website is clearly independent from the Complainant is not material to the fact that his registration and use of the Domain Name is likely to cause initial interest confusion.

The Complainant says that the Respondent's statement in the Response that he won't sell the Domain Name for less than £100,000 demonstrates that the Domain Name was registered with the primary purpose of selling or renting it specifically to the Complainant for more than the Respondent paid for it, which is Abusive under §3a i A of the Policy. Trading in domain names is not abusive per se and there is insufficient evidence presented to persuade me that the Respondent registered the Domain Name primarily for this purpose.

In respect of the Respondent's claim that the Complainant has copied his website and business concept, this is not an issue that is intended for determination by the DRS. The Respondent must seek resolution to this claim by other means.

In conclusion, I find that the Respondent's registration and use of the Domain Name has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights, and is therefore an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is identical to the Domain Name, and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, I direct that the Domain Name be transferred to the Complainant.

Signed: Steve Ormand

Dated: 9 June 2016