

DISPUTE RESOLUTION SERVICE

D00014939

Decision of Independent Expert

ANDERSON MAGUIRE LIMITED

and

Mr Greig McKean

1. The Parties:

Lead Complainant: ANDERSON MAGUIRE LIMITED
Anderson Maguire Limited
15-17 Hamilton Street
Glasgow
G42 0PL
United Kingdom

Respondent: Mr Greig McKean
12 Ochil Drive
PAISLEY
PA2 8AT
United Kingdom

2. The Domain Name(s):

maguirefunerals.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 a such a nature as to call in to question my independence in the eyes of one or both of the parties.

24 October 2014 12:11 Dispute received
24 October 2014 12:48 Complaint validated
24 October 2014 14:22 Notification of complaint sent to parties
29 October 2014 12:35 Response received
29 October 2014 12:36 Notification of response sent to parties
03 November 2014 01:30 Reply reminder sent

06 November 2014 11:17 No reply received
06 November 2014 11:17 Mediator appointed
11 November 2014 09:48 Mediation started
19 November 2014 12:12 Mediation failed
19 November 2014 12:13 Close of mediation documents sent
21 November 2014 10:38 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is a Scottish company which is based in Glasgow and which provides funeral services throughout the Glasgow area.
- 4.2 The Complainant is the owner of two UK trade mark registrations. UK registrations number 2424053 for ANDERSON MAGUIRE and number 2424054 for MAGUIRE'S. These were both registered on 10 June 2006 and both relate to funeral services as well as other related services.
- 4.3 The Complainant has been trading for over 30 years albeit that it has only been incorporated as a limited company since 1997.
- 4.4 The Respondent is an individual who works (or at least at the time that the Domain Name was registered worked) as a website developer.
- 4.5 The Domain Name was registered on 8 August 2012.
- 4.6 The Domain Name links to a Glasgow based funeral services business called Desmond Maguire Limited ("DML"). DML provide funeral services in the Glasgow area and their main website uses the domain name desmondmaguire.co.uk.

5. Parties Contentions

Complainant's Submissions

Rights

- 5.1 The Complainant contends that it has Rights in a name or mark which is similar or identical to the Domain Name for the following reasons;
 - 5.1.1 The Complainant owns UK trade mark registrations for ANDERSON MAGUIRE and MAGUIRE'S. Both of these date from 2006.
 - 5.1.2 The Complainant was founded in 1982 and has been trading in the Glasgow area providing funeral services for the past 32 years. During that time it has built up substantial goodwill and reputation.
 - 5.1.3 The Complainant has always been referred to as ANDERSON MAGUIRE or MAGUIRE or MAGUIRE'S.
 - 5.1.4 The founder of the complainant Dominic Maguire is a very well-known figure and often appears in the media giving opinion on matters relating to funerals. He is a former president of the National Association of Funeral Directors and a member of a cross party group at the Scottish Parliament advising on funerals and bereavement. Dominic Maguire's personal reputation is inextricably linked with that of the Complainant.

- 5.1.5 Dominic Maguire received an Outstanding Achievement accolade at the Herald Family Business of the Year Award 2013.
- 5.1.6 The Domain Name differs from the name MAGUIRE'S only by the omission of the "s" and the addition of the word "funerals" and does not render the Domain Name distinctive from the name Maguire's. The Complainant relies on a number of previous DRS decisions which demonstrate that the addition of a purely descriptive word does not render a domain name distinctive.
- 5.1.7 The Complainant also contends that as the Complainant has operated in the funeral service business for the past 32 years it is likely that the public might reasonably be expected to associate the word, "funerals" with the Complainant's name and registered trade marks.
- 5.1.8 The Complainant spends on average £100,000 per annum on advertising and promoting its business and name and its average turnover for the last 5 years has been approximately £2.5 million.
- 5.1.9 The Complainant ran an advertising campaign on ASTV between 2000 and 2012 which involved regular TV appearance by Dominic Maguire.
- 5.1.10 In some of the Complainant's advertising literature the names MAGUIRE/MAGUIRE'S as opposed to "ANDERSON" appear in larger and more dominant font because this is the part of the Complainant's name that the public are more likely to associate with the Complainant's business.

Abusive Registration

- 5.2 The Complainant contends that the Domain Name is an Abusive Registration for the following reasons;
 - 5.2.1 The Respondent is using the Domain Name in a way likely to confuse people or business into believing that the Domain Name is registered to, operated for, authorised by, or otherwise connected with the Complainant.
 - 5.2.2 There have been a number of instances of the public confusing DML with the Complainant's business and indeed DML has positively encouraged this confusion.
 - 5.2.3 Until very recently DML has traded under the name Desmond Maguire and not Maguire funerals or Maguire.
 - 5.2.4 Members of the public who associated the Complainant with the Maguire or Maguire's name are likely to use search engines or guess the URL for the Complainant in order to find the best website on the internet. There is therefore a substantial risk that such searches would be conducted in the name Maguire or Maguire's funerals or variations of these and therefore the results would throw up the Respondent's business and website at the Domain Name. The Complainant also relies on a number of Google searches which show DML's business being shown high on search results when the results when the search term, "Maguirefunerals" is entered.
 - 5.2.5 The Domain Name has been registered or otherwise acquired primarily for the purposes of unfairly disrupting the Complainant's business. The Respondent as the user of the Domain Name is in the business of providing

identical services to the Complainant and was well aware of the Complainant's brand and business when it registered and first used the Domain Name. This is clear from the following:

- The Director of the Respondent Mr Desmond Maguire was previously employed by the Complainant;
- The Complainant and Respondent operate in the same market;
- The market in which both operated is relatively specialised and relatively few participates;
- The Respondent's business premises are set up in close proximity to those of the Complainant in Glasgow. Given that both the Complainant and Respondent's target customers are located in and around Glasgow this enhances the prospects of confusion and thus unfair disruption to the business of the Complainant.
- The Complainant since 1982 has been trading under the names ANDERSON MAGUIRE and MAGUIRE/MAGUIRE'S and filed its relevant trade mark applications in 2006. By 2006 it was already very well known as a market leader with a vast amount of reputation and goodwill in those names;
- The Respondent has deliberately been causing confusion in the market to attract the Complainant's customers to it;
- Whilst the Respondent may have a valid reason to adopt the term Maguire as part of its trading name, trade mark or domain name given that this is the surname of the principal of the Respondent, Mr Desmond Maguire as part of its corporate name it has no need to adopt and use the Domain Name.

Response

5.2.6 The Respondent (who it should be noted is not DML) submits the following

To whom it may concern.

In response to the above complainit my response is as follows:

I am an impartial party in this dispute as I am not employed by Desmond Maguire Funerals. My only affiliation with Desmond Maguire Funerals is that I developed their legacy website in April 2013 when I purchased the domain name maguirefunerals.co.uk on their behalf. I was working under my own company Eclipse Digital at the time of this development.

I currently still have this domain name registered to myself. Desmond Maguire Funerals have since had a new website developed in which I was not involved I was fully aware of the new development as I set up the redirect from maguirefunerals.co.uk to their current desmondmaguire.co.uk domain name. All matters of this case should be dealt [sic] between the two funeral companies involved as I acted only as a domain name provider to Desmond Maguire funerals. I have no connection to either party involved in this matter.

I am more than happy to comply with any outcome, such as domain ownership transfer, once the decision of this complaint has been made.

6. Discussions and Findings

Rights

6.1 Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainants must prove, on the balance of probabilities, 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.

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 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 This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.5 The Complainant has two UK registered trade marks for ANDERSON MAGUIRE and MAGUIRE'S. There is therefore no doubt that the Complainant has Rights in these two marks.

6.6 The closest of these two marks to the Domain Name is the Complainant's trade mark for the word mark MAGUIRE'S. This differs from the Domain Name only by the omission of, "s" in the Domain Name and the addition of the word "funerals" in the Domain Name. The only other difference is the addition of the first and second level suffix .co.uk which I must ignore when assessing similarity.

6.7 The word MAGUIRE is the distinctive part of the Domain Name i.e. it is the bit that is serving the trade mark function. The omission of the, "s" is immaterial and the addition of the word, "funerals" simply serves to describe the nature of the services. MAGUIRE'S and "Maguirefunerals"/maguirefunerals.co.uk are therefore at least similar.

6.8 In addition to its registered rights the Complainant also asserts that it has unregistered rights in the names MAGUIRE or MAGUIRE'S. In support of this the Complainant relies on a witness statement from a Michael Collins who is a funeral director at an independent firm of funeral directors in Glasgow i.e. not the Complainant and not DML albeit that Mr Collins did use to work for DML. Mr Collins confirms that when he or colleagues refer to "Maguire's" they are referring to the Complainant.

6.9 It does also seem to be the case that the Complainant places more emphasis on the MAGUIRE part of its name (which is taken from the name of its founder Dominic Maguire) and less emphasis on the ANDERSON part of its name albeit that this comes first and is always included in the literature I have seen.

- 6.10 Having decided that the Complainant has Rights in the name MAGUIRE'S based on its registered rights I do not necessarily have to decide whether it also have Rights in the name Maguire/Maguire's based on its unregistered rights. However, on the balance of probabilities I do believe that the Complainant has established that it has Rights in the names MAGUIRE/MAGUIRE'S based on its unregistered rights.
- 6.11 I therefore conclude that on the balance of probabilities the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

Abusive Registration

- 6.12 Abusive Registration is defined in Paragraph 1 of the Policy as a domain name which either:
- (a) 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
 - (b) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.
- 6.13 This definition requires me to determine 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.
- 6.14 Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.
- 6.15 The Policy provides that it is for 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.
- 6.16 This is an unusual case because it is not the Respondent which is actually using the Domain Name. Instead, this is a case where the Respondent has registered the Domain Name for its client and it is the client's use of the Domain Name that the Complainant is objecting to.
- 6.17 I do not think that this changes the way that I need to approach this case in the sense that I will take into account the use that is being made of the Domain Name albeit that that use is not being made directly by the Respondent but by a third party, DML with the Respondent's permission. It does however lead to the slightly unsatisfactory position that while there has been a Response from the Respondent the actual user of the Domain Name i.e. DML has not put forward its position and indeed as far as I am aware may not even be aware of this Complaint. I do not think there is anything I can do about this. The Complaint is properly addressed to the registrant of the Domain Name who is the Respondent and I must decide the case on this basis. In retrospect it would obviously have been better if the Domain Name had been registered in the name of DML or even if the Respondent had passed a copy of the Complaint onto DML (which as far as I am aware it did not do) and given DML an opportunity to comment.
- 6.18 In order to make a finding of Abusive Registration under the Policy it has been said in a number of previous cases under Nominet's DRS that 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 it should 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.

6.19 In this case it is clear that the company that has ended up using the Domain Name i.e. DML if not the Respondent was well aware of the existence of the Complainant and of the name in which the Complainant has Rights both at the time that the Domain Name was registered and subsequently when the Respondent began to use the Domain Name to point towards the main site of DML. I say this because the Complainant is clearly a well-known business in the Glasgow area which has been trading for over 30 years and which has 11 offices in or around Glasgow. The founder of DML Mr Desmond Maguire also used to work for the Complainant. It is therefore inconceivable that DML which was founded by an ex-employee of the Complainant and which carries on the same business in the same locality as the Complainant did not know about the Complainant and the Rights it had in Maguire/Maguire's at the time at which it asked the Respondent to register the Domain Name and at the time at which the Domain Name started to be used to redirect traffic to the main website of DML.

6.20 Part of the Complainant's case on Abusive Registration is that the Respondent/DML is using the Domain Name to redirect internet users to a website that competes with the Complainant in relation to funeral services and that the Respondent's/DML's use of the Domain Name is misleading.

6.21 Evidence of Abusive Registration includes the following under Paragraph 3(a)(ii) of the Policy:

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.

6.22 The Experts' Overview states in relation to confusion under Paragraph 3(a)(ii) of the Policy:

...Commonly, Internet users will visit websites 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 on its list the URL for the website 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 website will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's website will be visiting it in the hope and expectation that the website is a website "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...

6.23 In this case the Domain Name contains (with a very small alteration) the name or mark in which the Complainant has Rights. Further, the Respondent/DML is using the Domain Name to re-direct users to its own site which provides details of the services offered by DML which compete with the Complainant's own services. Given these facts it is reasonably clear to be that potential customers of the

Complainant will arrive at the Respondent's/DML's site by using the Domain Name (or a URL containing the Domain Name). Having done this they will either simply leave or go elsewhere having realised that it is not the Complainant's site or, perhaps more likely, they will use the services being advertised on the Respondent's site perhaps not being aware of the difference or not caring. In both scenarios so called initial interest confusion will have occurred although in the second scenario the confusion will go further than that. In either scenario (absent any defence that the Respondent may have) the Respondent's actions amount to an Abusive Registration.

- 6.24 I am also supported in reaching this conclusion by the various witness statements that the Complainant has produced to support its case. These witness statements suggest that DML has either encouraged the public to believe that it is in some way connected with or associated to the Complainant or that it has done nothing to disabuse the public where any such confusion exists. One must of course be very careful of such witness statements and in a process such as the DRS there is very limited opportunity to test the veracity of these statements. I do however find them persuasive and they give me a degree of comfort that the conclusion that I have reached above in the preceding paragraph is the correct one.
- 6.25 Given all of the above, I am satisfied that the Complainant has established a prima facie case that on the balance of probabilities the Respondent's use (in this case the use that the Respondent has allowed) of the Domain Name has been in the manner which takes unfair advantage of and/or which is unfairly detrimental to the Complainant's Rights. Unless the Respondent is able to show the existence of the kind of fact as listed under paragraph 4 of the Policy it follows that the Complainant will have established, on the balance of probabilities, that the Domain Name is an Abusive Registration.
- 6.26 I do not of course have the benefit of any arguments from DML and the Response which has been submitted does not take matters any further in terms of establishing any of the factors listed under paragraph 4 of the Policy. It is however worth considering that DML is named after its founder and owner Desmond Maguire. I am conscious therefore that the Domain Name could be argued to be simply referring to the legitimate funeral business of Desmond Maguire. i.e. a funeral business run by a Maguire.
- 6.27 Ultimately however, I come back to the point that it does look, on the basis of the submissions that I have had the benefit of, as if the Complainant has been known as Maguire's or Maguire for a fairly lengthy period of time and that DML would have likely known about this when the Domain Name was registered/when the use of the Domain Name commenced. Therefore and regardless of whether or not DML is entitled to call itself Desmond Maguire Funerals it does seem to me, again based on what I have seen, that the use of the Domain Name is calculated to take an unfair advantage of the Complainant's Rights and/or is detrimental to the Complainant's Rights. While it goes beyond the scope of this decision I think it is likely that DML would have some good arguments in order to defend its use of the name Desmond Maguire when used in relation to funeral services. Similarly, this would be a much more difficult decision if the domain name in issue was desmondmaguire.co.uk and not the Domain Name.
- 6.28 There is therefore nothing in the Response that would lead me to change my prima facie conclusion that the Complainant has established, on the balance of probabilities, that the Domain Name is an Abusive Registration.

6.29 Finally, I wish to make the following further observations about the outcome of my decision. There are two firms of funeral directors in Glasgow, one trading as Anderson Maguire Limited and the other as Desmond Maguire Limited. As far as I am aware no objection is made by either of them to the other's trading under its own full name. The Domain Name, if viewed in the abstract, and without reference to the relevant history and background as described above, could be equally applicable to either business. The consequence of my decision is that the Domain Name will be transferred from its present owner, a third party unconnected with either party (but who registered the Domain Name on behalf of his client Desmond Maguire Limited) to Anderson Maguire Limited. This will occur without my having heard any submissions from Desmond Maguire Limited, who are not a party to this DRS proceeding and may not even be aware it is taking place. It follows that my knowledge of the relevant history and background has been derived entirely from the material that Anderson Maguire Limited has filed. In these circumstances I should make clear that nothing in my decision prevents Desmond Maguire Limited, if it so wishes, initiating a further DRS Complaint relating to any subsequent use that Anderson Maguire Limited may make of the Domain Name. Any such Complaint would need to be determined by an Expert on its merits having regard to the submissions of the parties at that time, and my decision in this case should not be regarded as predetermining the outcome of any such Complaint.

7. Decision

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

Signed: Nick Phillips

Dated 23rd December 2014