



NOMINET

DISPUTE RESOLUTION SERVICE

D00018931

Decision of Independent Expert

DIGNITY FUNERALS LIMITED

and

Steve Dale

1. The Parties:

Complainant: DIGNITY FUNERALS LIMITED
4 King Edwards Court, King Edwards Square,
Sutton Coldfield,
Birmingham
West Midlands
B73 6AP
United Kingdom

Respondent: Steve Dale
5 Beach Way
Tynemouth
North Shields
Tyne & Wear
NE30 3ED
United Kingdom

2. The Domain Name(s):

dignity.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.

The procedural history of this dispute is as follows:

25 May 2017 17:35 Dispute received
30 May 2017 08:54 Complaint validated
30 May 2017 09:03 Notification of complaint sent to parties
16 June 2017 02:30 Response reminder sent
21 June 2017 09:57 Response received
21 June 2017 09:59 Notification of response sent to parties
26 June 2017 02:30 Reply reminder sent
27 June 2017 09:40 Reply received
06 July 2017 09:47 Notification of reply sent to parties
06 July 2017 09:47 Mediator appointed
11 July 2017 12:32 Mediation started
24 July 2017 10:12 Mediation failed
24 July 2017 10:12 Close of mediation documents sent
28 July 2017 17:23 Expert decision payment received
2 August 2017 08.46 Complainant filed a Further Statement
2 August 2017 15.47 Full Statement provided to Expert

4. Factual Background

The Complainant has been using DIGNITY in relation to funeral related services since at least 1997 when the parties to this dispute or their predecessors entered into a coexistence agreement to govern the relationship between them and to allow them both to trade under the DIGNITY name going forward.

The Complainant owns the registered mark DIGNITY plus tree logo registered in the UK for funeral related services as of 08 January 1997.

The Respondent is the registered owner of the mark DIGNITY in logo form in the UK registered as of March 1996 and predating in priority the Complainant's registration discussed above.

The Respondent is using the Domain Name which was registered before August 1996 for e mail.

5. Parties' Contentions

The Complainant's contentions can be summarised as follows:

The Complainant owns the domain name dignityuk.co.uk. The Respondent owns the Domain Name. The parties are not in dispute that these domain names are confusingly similar. A coexistence agreement was entered into with the Respondent who provided financial and insurance services through his companies. Unfortunately the Complainant has continued to experience difficulties with the Domain Name and has suffered customers and trade suppliers using the incorrect e mail address of the Respondent and sending confidential personal and financial information to the Respondent instead of the Complainant. The Complainant seeks a transfer of the Domain Name due to this ongoing confusion and due to the fact that Dignity (UK) Limited is a dormant company.

Dignity (UK) Limited, the Respondent's company has not traded since at least 31 March 2005. The Respondent has refused to transfer or sell the Domain Name and fails to answer

correspondence. By continuing to re-register the Domain Name the Respondent is acting in bad faith by passively holding the Domain Name for no legitimate purpose and this is an abusive registration.

The Respondent's contentions can be summarised as follows:

This Complaint has been brought in bad faith and is tantamount to a reverse domain name hijack.

The coexistence agreement shows that the Complainant waived their rights to the Respondent's trade mark twenty years ago and the Respondent similarly waived rights in the Complainant's trade mark to allow coexistence.

The Domain Name was registered pre Nominet before August 1996. The Respondent applied for the mark DIGNITY for marketing protection solutions on 29 March 1996 and this was registered on 14 April 1998. There is a clear demarcation between the Respondent's services and the prepayment funeral services of the Complainant.

The Domain Name registration and trade mark application for DIGNITY by the Respondent both predate the coexistence agreement which was designed to avoid unfair advantage or detriment between the parties and abusive behaviour at the time of registration can be comprehensively refuted. Dignity (UK) Limited is currently dormant so there is no abusive use of the Domain Name. Dignity (UK) Limited will not be dormant in the future.

Renewal of the Domain Name is not Abusive Registration.

The Complainant asked the Respondent to sell the Domain Name but when this attempt failed has brought this Complainant in a Reverse Domain Name Hijacking attempt.

The Complainant's public facing websites are www.dignityfunerals.co.uk and www.dignityfuneralplans.co.uk and invite contact with the public via an online submission form and not the e mail addresses. The Complainant only registered www.dignityuk.co.uk in August 2001 and only uses it internally. If there is any confusion from this internal use it derives from the Complainant's decision to register and use a 'confusingly similar' domain name years after the Domain Name was registered. Its decision to do this does not appear coincidental as it occurred approximately a year after the formation of the company Dignity (UK) Limited in March 2000.

The Complainant's Further Statement and Submission

This details various kinds of internal confidential or sensitive e mails which had been incorrectly sent to e mail addresses based on the Domain Name causing the Complainant delay, confusion and inconvenience and points out that the Respondent's linked in profile does not mention Dignity (UK) Ltd.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy). Right is defined 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'.

Complainant's Rights

The Complainant has been using DIGNITY in relation to funeral related services since at least 1997 when the Complainant or its predecessors entered into a coexistence agreement with the Respondent to govern the relationship between them to allow them both to trade under the DIGNITY name going forward.

Rather unusually the evidence of the Complainant's rights in the DIGNITY mark has been provided by the Respondent by way of a printout relating to the mark DIGNITY plus tree logo registered in the name of the Complainant in the UK for funeral related services as of 08 January 1997. The Complainant does not even mention its trade mark rights in the Complaint although it does provide a copy of a coexistence agreement dated 4 September 1997 with a schedule of marks attached whereby it appears that a predecessor of the Complainant or the Complainant under a different name at this date had a series of applications for or including the word DIGNITY in the UK and elsewhere one of which has matured into this registration. No evidence has been given as to the current status of the other applications.

The Respondent has also supplied a printout showing that he is the registered owner of the mark DIGNITY in logo form in the UK registered as of March 1996 and predating the Complainant's registration discussed above. From the schedule to the coexistence agreement it seems that at least in 1997 the Respondent had other applications for the DIGNITY mark in other countries although no evidence as to the current status is given of these.

It seems clear without further investigation, however that upon the evidence before the Expert the Complainant does have trade mark Rights in the name DIGNITY as evidenced by the Complainant's registration as discussed above and due to the use of the mark DIGNITY by the Complainant or its predecessors in trade since 1997 so as to acquire secondary meaning for funeral services. Since the ccTLD .co.uk is ignored for the purposes of comparison it therefore appears that the Complainant has Rights in a mark which is identical to the Domain Name. It does appear, however, that those Rights came into existence partly as a result of a coexistence agreement whereby the Complainant to this dispute or its predecessors and the Respondent allowed each other's trade mark applications to proceed under an agreement that they would both use the DIGNITY name to trade going forward albeit for slightly different funeral related services and that the Respondent also has Rights in the DIGNITY name.

Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines "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. Is being or has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration, is set out in paragraph 5 of the Policy. There being no suggestion that the Respondent registered the Domain Name to sell it, to block or disrupt the Complainant, has given false contact details, has a pattern of registrations or has registered the Domain Name on behalf of the Complainant or had no reasonable justification for registration of the Domain Name the only possible relevant example in paragraph 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’.

The Complainant also makes the point that the Domain Name is not being used and says that this passive use and re-registration is abusive.

It should be noted that although there has been some correspondence where the Complainant tried to buy the name from the Respondent and the Respondent asked for clarification of a point made in that correspondence the Respondent has not indicated any willingness to sell the Domain Name.

It is clear from the DRS Experts’ overview that a renewal of a domain name does not count as ‘registered or otherwise acquired’.

Under the coexistence agreement between the Complainant or its predecessors and the Respondent expressed to bind successors and assigns those companies agreed mutually to allow each other’s trade mark applications to proceed and not to object and to facilitate use of each other’s trade marks anywhere in the world. The parties to this dispute now both own trade mark registrations the subject of this agreement and are therefore successors or assigns to this agreement.

The Respondent has simply ceased use of the Domain Name except for e mail purposes. However it is still using the name for this purpose and made more extensive use of the Domain Name in the past which is not passive use.

It is no doubt unfortunate for the Complainant that e mail correspondence is addressed incorrectly to e mail addresses related to the Domain Name, but it seems the Complainant is bound not to object and to facilitate the use of the DIGNITY name by the Respondent under the coexistence agreement. The coexistence agreement does not mention a situation where either party ceases or reduces its use of the DIGNITY name. However the Respondent does not appear to have changed its behaviour in using the Domain Name for e mail purposes and it would appear to be entitled to use the DIGNITY name to trade under the coexistence agreement by agreement of the Complainant or its predecessor which does not exclude e mail use. It seems that the Respondent’s holding of the Domain Name falls within paragraph 8.1.3 of the Policy in that it is consistent with an express term of a written agreement entered into by the Parties or their predecessors.

Further, it does not appear the Respondent is doing anything that is confusing Internet users it seems simply that they are making a mistake of their own accord as to the correct e mail address of the Complainant. The Respondent is not accountable for these mistakes.

It, therefore, appears to me that the use of the Domain Name for e mail by the Respondent is not abusive.

Further as it appears that the Complainant knew it or its predecessors had agreed not to object to the Respondent's use of the DIGNITY name it appears that this is a case of reverse domain name hijacking and the Complaint has not been brought in good faith.

7. Decision

The Expert, therefore determines that the Domain Name dignity.co.uk shall remain with the Respondent and that this Complainant has not been brought in good faith being a case of reverse domain name hijacking.

Signed Dawn Osborne

Dated 16th August 2017