

DISPUTE RESOLUTION SERVICE

D00020859

Decision of Independent Expert

Co-operative Group Limited

and

Lead Spark Ltd

1. The Parties:

Complainant: Co-operative Group Limited
Angel Square
Manchester
Greater Manchester
M60 0AG
United Kingdom

Respondent: Lead Spark Ltd
The Leeming Building, Ludgate Hill
Leeds
West Yorkshire
LS2 7HZ
United Kingdom

2. The Domain Name(s):

<comparefuneralcare.co.uk>

3. Procedural History:

- 3.1 I have confirmed to Nominet that I am independent of each of the parties and that 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.

3.2 The procedural chronology of this dispute is as follows:

22 November 2018 23:27 Dispute received
28 November 2018 10:15 Complaint validated
28 November 2018 10:28 Notification of complaint sent to parties
17 December 2018 01:30 Response reminder sent
18 December 2018 15:26 Response received
18 December 2018 15:27 Notification of response sent to parties
21 December 2018 15:31 Reply received
21 December 2018 15:32 Notification of reply sent to parties
07 January 2019 13:57 Mediator appointed
07 January 2019 14:23 Mediation started
18 January 2019 10:34 Mediation failed
18 January 2019 10:34 Close of mediation documents sent
29 January 2019 13:56 Expert decision payment received

3.3 On 8 February 2019 I asked the Respondent to file a further submission in relation to what appeared to be non-compliance of the website operating from the Domain Name with UK and European law. The Respondent provided further information in this respect on 12 February 2019.

4. Factual Background

- 4.1 The Complainant is a well known operator of funeral homes in the United Kingdom. It is responsible for over 1,000 such homes and provides other funeral related products and services, including funeral plans. Its turnover in 2017 was £343 million.
- 4.2 The Complainant operates this business under the name “Co-op Funeralcare”. It is the owner of a number of UK trade marks in respect of the term “Co-operative Funeralcare” in various forms. However, it is also the owner of UK registered trade mark 2286255 for the word mark FUNERALCARE in classes 36, 37 and 45 dated 22 November 2001.
- 4.3 The Domain Name was registered by the Respondent on 16 April 2018. It has been used since that date for a website that promotes funeral plans offered by various operators. The text of the website currently purports to “compare plans”, using a “free search tool” that will provide “Tailored results to you”. However, as at the date of this decision, clicking on one of the “compare now” buttons that appears on the front page of the website, simply displays details of a limited number of funeral plans.
- 4.4 The website also prominently displays the logo of the Funeral Planning Authority (the “FPA”). The Respondent would appear not to be a member of that authority. but the plans promoted would appear to be offered by FPA members.

- 4.5 On 16 July 2018 the Complainant's lawyers sent a letter before action to the Respondent complaining about the website operating from the Domain Name. The Respondent did not answer that letter.
- 4.6 In this letter the Complainant raised a multitude of different complaints. The Complainant's FUNERALCARE mark was listed among the various trade marks identified in that letter and IP infringement was alleged, but the letter appeared primarily directed to what was being displayed on the website and the way that the website operated, rather than to the use of the Domain Name itself. For example, the letter complained about the promotion of the Complainant's own products on the site. It also included an allegation to the effect that although the website at that time sought age information from users, no real comparison of plans using that information was actually being undertaken.
- 4.7 Initially, the website did not provide details of the identity of the Respondent contrary to the E-Commerce (EC Directive) Regulations 2002 and The Companies (Trading Disclosures) Regulations 2008. It did, however, provide a street name, City and post code that formed part of the registered address of the Respondent.
- 4.8 After I sought further submissions from the Respondent in this respect (as detailed in paragraph 3.3 of this decision above), the text at the foot of each page of the website was changed. "Comparefuneralcare.co.uk" is now described as "a trading style of Lead Spark Ltd" and the full registered address of the Respondent is now provided (although certain other information such as the registered number of the Respondent, is still missing).

5. Parties' Contentions

The Complaint

- 5.1 In its Complaint, the Complainant describes its business and registered trade marks. It also claims valuable goodwill and a significant reputation in its "Funeralcare brand". In this respect a Google search for the term "Funeralcare" is supplied and is said to be "Dominated by results for the [Complainant] and its products".
- 5.2 So far as "rights" under the Policy are concerned, the Complainant relies upon both its FUNERALCARE registered trade mark and claimed unregistered rights in that term.
- 5.3 The Complainant also submits that the use that has been made of the Domain Name demonstrates that the Respondent registered the Domain Name and operates the Website to take unfair advantage of the Complainant's rights to "dishonestly appropriate customers away from the [Complainant]". In this respect, the Respondent's activities are said to fall within the scope of paragraphs 5.1.2 and 5.1.6 of the Policy.

The Response

- 5.4 In its Response the Respondent accepts that the Complainant has registered trade mark rights in the term “Funeralcare”, but claims that although “funeralcare” appears in the Domain Name, this is simply because the Domain Name combines the separate words “compare”, “funeral” and “care”. In this respect, the Respondent claims that “funeral care” does not appear elsewhere on the website as a “single word”. It also claims that many others use “funeralcare” as part of their domain name, although only one example is given in this respect; i.e. <ashbyfuneralcare.co.uk>. The Respondent also claims that it chose the Domain Name because it “audited” various search terms and the two words “funeral care” produced the “best results”.
- 5.5 The Respondent claims that is operating “a mere comparison site that users can view and click on various plans free of charge” and that it is “not using the plans for any financial gain”.
- 5.6 However, the Respondent goes on to state that if the Complainant still wants a transfer, it believes that “the only fair and reasonable way to transfer is would be to pay a fee to [the Respondent]”. A figure of £25,000 plus VAT is mentioned, which is claimed to be the “appropriate fee” for “the hard work put into the site design and future income this site could potentially create for [the Respondent]”.

The Reply

- 5.7 In its Reply the Complainant contends that in its Response the Respondent is admitting that it would obtain the best results from including the Complainant’s trade mark in the Domain Name. It also goes on to contend that the reason why the Domain Name produces the best results is due to search engine optimisation work on the part of the Complainant.
- 5.8 The Complainant also relies upon the effective offer by the Respondent to sell the Domain Name to the Complainant for £25,000 plus VAT as a demand for “valuable consideration far in excess of the Registrant’s out of pocket costs directly associated with acquiring or using the [D]omain [N]ame”.

6. Discussions and Findings

- 6.1 To succeed under Nominet’s Dispute Resolution Service Policy, the Complainant must prove first, that it has Rights in respect of a "name or mark" that is identical or similar to the Domain Name (paragraph 2.1.1 of the Policy) and second, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2.1.2 of the Policy). The Complainant must prove to the Expert that both elements are present on the balance of probabilities (paragraph 2.2 of the Policy).
- 6.2 Abusive Registration is defined in paragraph 1 of the Policy 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 took unfair advantage of or has been unfairly detrimental to the Complainant's Rights."

Complainant's Rights

- 6.3 It is undisputed that the Complainant is the owner of a registered trade mark for the term "Funeralcare" as a word mark. It is also reasonably clear that the Domain Name can be read as the terms "compare", "funeral" and "care" in combination, followed by the ".co.uk" suffix.
- 6.4 The Complainant appears to go further and to contend that the "funeralcare" element of the Domain Name is a direct and deliberate reference to the Complainant's mark. However, regardless of whether this is so, the mark is clearly visible in the Domain Name and, as a consequence, the Complainant has a trade mark that is similar to the Domain Name. Accordingly, the Complainant has satisfied the requirements of paragraph 2.1.1 of the Policy.

Abusive Registration

- 6.5 At the heart of this case, as is often the case with cases under the Policy, is a dispute as to the motives of the Respondent when registering and using the Domain Name. However, on this occasion matters are significantly complicated by the nature of the mark relied upon by the Complainant and the way that both sides have put their case.
- 6.6 The Complainant is the owner of a word mark FUNERALCARE. At first sight the mark appears to have a descriptive element, at least to the extent that the mark covers, inter alia, to "funeral services" in class 45. There is no evidence before me that the Complainant obtained registration of such a mark having shown acquired distinctiveness. If this is so, the fact that this mark covers such services may surprise some; although that mark appears to have remained unchallenged on the register for approximately 17 years and (at least in legal proceedings) is subject to a presumption of validity.
- 6.7 However, regardless of the history and the scope of this mark, the potentially descriptive meaning of the words "Funeral Care" is potentially important in the present proceedings. If the Respondent chose and has used the Domain Name because it is descriptive of its services rather than to take advantage of the Complainant's trade mark rights, then the Domain Name is unlikely to be abusive. In such a case, any discussion of whether the Respondent's activities

are or are not trade mark infringement is rarely likely to be useful (as to which see, for example, DRS19519 <tillysgardenpartyhire.co.uk>).

- 6.8 To be fair to the Complainant, although trade mark infringement is alleged, that claim is peripheral to its complaint. Instead, it claims that the Domain Name was deliberately chosen to take unfair advantage of its trade mark. The Respondent denies this, claiming that the Domain Name was chosen because of its potentially descriptive meaning. In this respect, it relies heavily on the fact that “Funeral Care” is only used on its website as two separate words.
- 6.9 The Respondent openly admits that it chose those two words as part of the Domain Name because it produced the best search engine results. The Complainant contends that this amounts to an admission on the part of the Respondent that it deliberately chose a domain name that incorporates the Complainant’s mark, but there is clearly no such admission.
- 6.10 The Complainant’s suggestion that these terms produce the best search engine results because of the Complainant’s SEO activities also raises more questions than it answers. Exactly what form those activities took is not described and how that demonstrates the Respondent taking advantage of the Complainant’s trade mark rather than any descriptive meaning of the terms “funeral” and “care” is not explained.
- 6.11 Nevertheless, and notwithstanding that this is not the clearest of cases, I have reached the conclusion that on the balance of probabilities the primary reason that the Domain Name has been registered is to take unfair advantage of the Complainant’s trade mark rights.
- 6.12 Particularly important here is the fact that even if “funeral care” is descriptive, it is not obviously descriptive of the Respondent’s services. The Respondent makes mention of others that use “Funeral Care” (as opposed to “Funeralcare”) as part of their name, but these would all appear to be businesses that operate as funeral directors. The Respondent refers to <ashbyfuneralcare.co.uk>, which is just such an example. The Respondent does not offer “funeral care” of this sort. Instead, it offers the financial products of others that are called “funeral plans”.
- 6.13 The content of the Respondent’s own website is instructive in this respect. The Respondent’s claim that “Funeral Care” is only used on its website as separate words, appears to be correct. But when those words are used together this is always as part of a reference to the Respondent and its website. For example, the website includes the text “Why use a site like Compare Funeral Care?”. In contrast, the products advertised are solely referred to as “Funeral Plans”. For example, the internet user is invited to “Compare funeral plans today”, and the Respondent claims that it is “a trusted and reputable website, comparing funeral plan providers throughout UK”.
- 6.14 In short, even if “Compare Funeral Care”, might be a descriptive name for a website comparing the relevant services of funeral directors, it is far less so for the website of the Respondent.

- 6.15 Further, there is little doubt that the Respondent was aware of the use of the term “Funeralcare” in connection with the financial services products of the Complainant. Leaving aside the fact that the FUNERALCARE mark is also registered in respect of “financial services” in class 36, there is no dispute that at least initially the Respondent directly mentioned the funeral plan products of the Complainant on its website. In the words of the Respondent, “[t]he claimant’s plans [were] mentioned on our results page, but ... merely used as point of reference to help the user view and compare funeral plans.”
- 6.16 Next, there is the offer by the Respondent in its Response to sell the Domain Name to the Complainant for £25,000. Care needs to be taken not to read too much into an offer to sell a domain name for large sums of money, particularly where the content of the domain name is arguably descriptive. If a domain name has been legitimately registered and used, the owner is entitled to set whatever price for that domain name that it wishes, no matter how unreasonable that price may seem to a prospective purchaser.
- 6.17 However, the Respondent’s contention that this price reflects “the hard work [that it has] put into the site design”, does not strike me as credible. No evidence is offered from the Respondent in this respect. That statement is also at odds with the nature of the website itself, which, although professional looking, does not appear to involve any real active comparison of funeral plans and which (at least initially) did not even mention who was behind that website.
- 6.18 So far as the claims of lost future revenue is concerned, on the Respondent’s own case it has earned nothing yet and no evidence is provided of such plans, notwithstanding that the Domain Name was registered over 10 months ago.
- 6.19 In the circumstances, the most sensible reading of that offer is as an attempt to take advantage of the Domain Name’s association with the Complainant and its rights and to try to justify the figure on other grounds are contrived. That is something that it is legitimate for me to take into account when it comes to assessing the Respondent’s real intentions when registering and using the Domain Name.
- 6.20 Given this, I conclude that the Domain Name in the hands of the Respondent is an abusive registration and that the Complainant has made out the requirements of paragraph 2.1.2 of the Policy.

7. Decision

- 7.1 I, therefore, find that the Complainant has Rights in a name which is similar to the Domain Name, and that the Complainant has shown that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.2 I, therefore, determine that the Domain Name be transferred to the Complainant.

Signed

Dated 22 February 2019

Matthew Harris