

DISPUTE RESOLUTION SERVICE

D00022937

Decision of Independent Expert

Amigo Loans Limited

and

Mr Thomas Holland

1. The Parties:

Lead Complainant: Amigo Loans Limited
Nova, 118-128 Commercial Road
Bournemouth
Dorset
BH2 5LT
United Kingdom

Respondent: Mr Thomas Holland
Cheshire
United Kingdom

2. The Domain Name(s):

myamigoclaim.co.uk

3. Procedural History:

The Expert can confirm that he is 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 his independence in the eyes of one or both of the parties.

19 August 2020 14:13 Dispute received
19 August 2020 15:57 Complaint validated
19 August 2020 16:06 Notification of complaint sent to parties
08 September 2020 02:30 Response reminder sent
11 September 2020 11:09 Response received
11 September 2020 11:09 Notification of response sent to parties
16 September 2020 02:30 Reply reminder sent
21 September 2020 11:46 Reply received
21 September 2020 11:46 Notification of reply sent to parties
24 September 2020 15:11 Mediator appointed
01 October 2020 11:36 Mediation started
08 October 2020 14:54 Mediation failed
08 October 2020 14:55 Close of mediation documents sent
16 October 2020 15:03 Expert decision payment received
19 October 2020 Keith Gymer appointed Expert with effect from 22 October 2020

4. Factual Background

The Complainant, Amigo Loans Limited, operates a business offering loans, including loans subject to a loan applicant having a guarantor. It has a business website using the domain name amigoloans.co.uk.

It uses the trade mark AMIGO on its website in the slightly stylised form



It is the proprietor of various trade mark registrations for AMIGO marks, including, in particular, UK2602775 for the plain text mark AMIGO in classes 9, 16 & 36, and with rights dating from 28 November, 2011.

The Respondent registered the Domain Name as a private individual, but the Domain Name is used for a website at www.myamigoclaim.co.uk, where it is stated that "MyAmigoClaim is a trading style of Match Me Legal Limited". Companies House records show that the Respondent is a director of this business. The website offers

claims management services for making claims against loan companies. The website header refers to

The logo for 'amigo claims' features the word 'amigo' in a lowercase, sans-serif font with a purple-to-pink gradient, followed by the word 'claims' in a smaller, lowercase, sans-serif font in a solid purple color.

The Nominet WhoIs record shows that the Domain Name was registered on 10 July, 2020.

5. Parties' Contentions

Complainant:

The Complainant asserts briefly that the Domain Name is using the word AMIGO and in doing so is thereby infringing on Amigo Loans Limited UK Trademark, as identified above.

The Respondent's website itself is using the mark AMIGO in the "Amigo Claims" logo, which is being displayed on the home page, as well as in other references to MyAmigoClaim throughout the site.

The Respondent's organisation, Match Me Legal Limited, is regulated by the Financial Conducts Authority and so clearly sits in the same business category, 36, as Amigo Loans Limited.

Amigo Loans Limited is not unique in the financial services it provides and the Respondent's website using the Domain Name is unfairly targeting the Complainant by using the AMIGO mark in relation to its services.

Respondent:

The Respondent claims that the rights that are being asserted by the Complainant are not applicable.

Whilst Amigo Loans Ltd holds a trademark on the word Amigo they utilise a specific font/design of their logo, and whilst the Respondent has used the word Amigo, it has in no way copied the logo and/or font of the Complainant's logo.

The Respondent further states that it would not be in breach of the Complainant's Class 36 registration merely due to the fact that the Respondent's business is authorised by the FCA. It says that the business of a claims management company would not fall within the terms of the trademark. Clients engaging with the Respondent's website are clearly informed that Match Me Legal Ltd, is the business which is operating as a claims management company under the trading style "MyAmigoClaim".

A client cannot take any financial product from Match Me Legal Ltd, and would purely instruct Match Me Legal Ltd to work with them in pursuing a complaint against Amigo Loans Limited.

As a claims management company, the Respondent's business seeks to assist clients that could have been affected by a multitude of different problems arising from the practices of other firms. Whilst the Respondent's business is directly targeting Amigo Loans Limited clients via the website using the Domain Name, this is not in breach of any regulatory or legal obligations.

Therefore, the Respondent believes the Complainant's trademark does not apply in this situation and refutes the allegations of abuse put forward by the Complainant.

Complainant's Reply to Response:

The Complainant reiterates that, as stated in the Complaint, it is not that the Respondent's business, Match Me Legal Ltd is regulated by the Financial Conduct Authority that is key, but that it is operating in the same business sector as Amigo Loans Limited.

The Complainant again asserts that use of the Domain Name with the trademarked word AMIGO, which MYAMIGOCLAIM clearly is, is an infringement of the Complainant's registered trademark. It is the word, not font or style that is trademarked and the reason for the Complaint stands.

Remedy Requested:

The Complainant requests suspension of the Domain Name.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both 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

Under Paragraph 18.1 of the Policy, the Expert is required to decide a complaint on the basis of the Parties' submissions and the Policy.

Complainant's Rights

The Complainant has satisfied the Expert that it is the proprietor of the registered trademark as identified above for the mark AMIGO, with rights established well before the registration of the Domain Name.

The Domain Name differs from the AMIGO mark by the addition of "my" before "amigo" and "claim" after it, together with the domain suffices ".co.uk", these latter not being relevant for the purposes of comparison with the AMIGO mark for the purposes of the Policy.

In the Expert's opinion, the additions, forming the composite "myamigoclaim", clearly render the Domain Name readily distinguishable from the AMIGO mark, *per se*. However, to an English eye, even without spaces, the Domain Name will easily be readable as "my amigo claim". A reference to the making of a personal claim in relation to and "amigo" entity would therefore be likely to be construed by the reader. The "amigo" is essentially the distinctive identifying element of the Domain Name. This must make it appropriate to consider the potential relevance for owners of rights in AMIGO as a trade mark.

Consequently, for the purposes of the Policy the Expert considers that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name. The requirement of Paragraph 2.1.1 of the Policy is met.

Abusive Registration

The Complainant also must show that the Domain Name is 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 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 are set out in Paragraph 5 of the Policy. However, the factors listed in Paragraph 5 are only intended to be exemplary and indicative. They are not definitive. It is Paragraph 1 of the Policy, which provides the applicable definitions as indicated above.

Examples from Paragraph 5 which may be relevant to the Complainant's case include:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

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;

Paragraph 8.1 of the Policy conversely provides a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration, including:

8.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

8.1.1.1 used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

...

8.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it;

The Complainant has based its Complaint on an assertion that the Respondent's use of the Domain Name necessarily amounts to an infringement of the Complainant's registered trade mark rights. Conversely, the Respondent claims those rights are not applicable.

Decisions under the Policy must be decided on the basis of the requirements of the Policy as stated above, which are not the same as those applicable to trade mark infringement.

In the present case, it is accepted that the Complainant has registered trade mark rights in its AMIGO mark.

However, the existence of such rights does not mean that use of the mark by others would necessarily amount to an infringement, nor that a Domain Name incorporating the mark would necessarily be an Abusive Registration under the Policy.

The Respondent has explicitly admitted that its claims management company is using the Domain Name for its website intentionally to target potential clients, who may have grounds to make financial claims against the Complainant's business. The website header refers to "amigo claims" and elsewhere to "MyAmigoClaim", but

does not specifically identify the Complainant by its company name. It does unequivocally identify the Respondent's claims management business as operator of the website and clearly describes the nature of its services.

The question for the Expert to determine is whether or not the registration and use of the Domain Name for such use is taking unfair advantage of or is unfairly detrimental to the Complainant's Rights.

The Complainant is in the business of making loans. The Respondent's business is in providing support services for clients who might have grounds to make claims for compensation against the Complainant.

In the Expert's view, it is not inappropriate for the Respondent's business to want to refer to the Amigo business by name in this context. It is simply using the name of a loans business to assist potential clients who might wish to pursue a claim against that business.

As it stands the use of the AMIGO name and mark in the Domain Name and on the website would appear to be simply a nominative fair use for the purposes of identification. There does not appear to the Expert to be any denigratory or unfair content on the Respondent's website, nor is there anything inherently derogatory or unfair in the Domain Name itself. The composite nature of the Domain Name appears sufficiently distinctive overall that internet users are unlikely to be confused or misled into perceiving any commercial connection between the Respondent's business and the Complainant's business, other than the reality that the one is providing services in relation to claims against the other.

For the purposes of the Policy, therefore, the Expert concludes that the Complainant has not shown that the Domain Name is an Abusive Registration, and the requirements of Paragraph 2.1.2 of the Policy are not met. The Complaint therefore falls to be dismissed on this basis.

7. Decision

Having found that, although the Complainant has relevant Rights, it has failed to prove that the Domain Name is an Abusive Registration under the Policy, the Complaint is hereby dismissed. No action is to be taken.

Signed: Keith Gymer

Dated: 27 October, 2020