

DISPUTE RESOLUTION SERVICE

D00019906

Decision of Independent Expert

Harper Macleod LLP

and

The Hair Centre London Ltd

1. The Parties:

Complainant: Harper Macleod LLP
The Ca'd'oro
45 Gordon Street
Glasgow
Lanarkshire
G1 3PE
United Kingdom

Respondent: The Hair Centre London Ltd
REGUS
50 Broadway
London
SW1H 0RG
United Kingdom

2. The Domain Name:

harpermacloed.co.uk

3. Procedural History:

- 3.1 I 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.

27 February 2018, the Dispute was received.

28 February 2018, the Complaint was validated.

12 March 2018, the Notification of Complaint was sent to the Parties.

02 April 2018, a Response reminder was sent.

05 April 2018, a Notification of no Response was sent to the Parties.

09 April 2018, the Expert decision payment was received.

4. Factual Background

- 4.1 The Respondent registered the Domain Name on 21 February 2018.
- 4.2 The Complainant is the registered proprietor of the UK trade mark for the words "HARPER MACLEOD" (UK0000261923), registered on 7 September 2012.
- 4.3 The Complainant is a Scottish law firm with offices in Glasgow, Edinburgh, Inverness, Lerwick and Thurso, offering a full range of commercial and personal legal services.

5. Parties' Contentions

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Parties but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

- 5.1 In summary, the Complainant submitted that the Complaint should succeed for the reasons below.

The Complainant's Rights

- The Complainant submitted that it has Rights in respect of a name or mark which is identical or similar to the Domain Name in that it is the registered proprietor of the UK trade mark "HARPER MACLEOD" (the 'Mark'), and that it has traded under the name "HARPER MACLEOD" (the 'Name') since February 2004.

- The Complainant submitted that it has *“accumulated substantial goodwill and reputation from trading under the name, throughout Scotland, the United Kingdom and internationally, in relation to the provision of legal services and business advice, to business clients and consumers.”*
- Accordingly, the Complainant submitted, it has rights to prevent third party unauthorised use of the Name and confusingly similar variations under the law relating to passing off.

Abusive Registration

- The Complainant submitted that the Domain Name, in the hands of the Respondent, is an Abusive Registration as the Domain Name has been used and/or was registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.
- The Complainant contended that the Domain Name is a *“deliberate misspelling of the [N]ame”*, which was registered as the Mark to take advantage of the goodwill and reputation associated with the Name, which accrues to the Complainant.
- Further, the Complainant contended that the Domain Name has no natural meaning, nor does it reflect the name of the Respondent, and that the Domain Name *“can therefore only have been registered due to its similarity with the name in which we have rights.”*
- The Complainant submitted that the use of a *“name [by the Respondent] which is identical or confusingly similar to Harper Macleod in relation to any of these (or related) areas [the provision of legal services and business advice]”* would constitute a misrepresentation to consumers that the user was the Complainant, or in some way approved by, endorsed by or having an association with the Complainant.
- The Complainant further submitted that the Domain Name has been *“applied by the [Respondent] in attempted fraudulent activities, whereby emails have been sent using the [D]omain [N]ame to customers or potential customers of the complainant, seeking payment from the recipient, purporting to be a payment due to the complainant, and purporting to be from persons engaged by the complainant.”*
- The Complainant concluded that the Domain Name was registered with the primary purpose of disrupting the Complainant’s business, and has been used to confuse internet users.

The Respondent's Response

5.2 The Respondent did not submit a response to the Complaint.

6. Outstanding formal/procedural issues

6.1 Although Nominet sent the Complaint to the Respondent, as mentioned in paragraph 3.1 above, no response has been provided by the Respondent to the Complaint.

6.2 While noting paragraph 24.8 of the Policy (which states that, in such circumstances, where a Party does not comply with any provision in this Policy, "*the Expert will draw such inferences from the Party's non-compliance as he or she considers appropriate*"), the Expert has drawn no inferences from the Respondent's failure to respond in this case, and has based the Decision on the facts and evidence before him.

6.3 It is important to note that the Complainant does not automatically receive the remedy it has requested merely because the Respondent has not responded to the Complaint (see, for example, Nominet DRS *equazen.co.uk* (DRS 02735) decision).

7. Discussions and Findings

General

7.1 To succeed in the Complaint, the Complainant has to prove that, pursuant to paragraph 2 of the Policy, on the balance of probabilities:

i. [it] 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.

7.2 Addressing each of these limbs in turn:

Rights in respect of a name or mark which is identical or similar to the Domain Name

7.3 The Expert considers that, for the reasons set out below, the Complainant has shown it has Rights in a name or mark which is similar to the Domain Name.

7.4 Paragraph 1 of the Policy defines 'Rights' 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;

- 7.5 Noting the Complainant's Mark, the Expert considers that, at the time of the Complaint, the Complainant had Rights in the Mark which is similar to the Domain Name (the Domain Name being a mis-spelling of the Mark word "**MACLEOD**", by swapping the "EO" letters in that word to read "**MACLOED**"). In concluding the above, the Expert has disregarded the Domain Name suffix "co.uk".

Abusive Registration

- 7.6 For the reasons set out below, the Expert considers that the Domain Name is an Abusive Registration as understood by the Policy.

- 7.7 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;

- 7.8 In relation to the definition of Abusive Registration in sub paragraph (i), the Policy, at paragraph 5, sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Specifically, the Expert considers that the factor set out at paragraph 5.1.1.3 (*registered for the purpose of unfairly disrupting the business of the Complainant*) is relevant.

- 7.9 The Expert notes that the Domain Name is the same as the Complainant's Mark, save for there being a 'typo' in relation to the spelling of the word "**MACLEOD**" (as mentioned, that word has been spelt in the Domain Name by swapping the "E" and "O", to read "**MACLOED**"). Given the closeness of the Domain Name to the Mark, the Expert considers that the Respondent had knowledge of the Complainant and/or its Rights when registering the Domain Name.

- 7.10 Indeed, on the balance of probabilities, the Expert considers that the Respondent specifically chose to register the Domain Name with the intention of benefitting from the Complainant's reputation and goodwill – in order among other things to use the Domain Name to send emails purporting to be from the Complainant (see paragraph 7.13 below), the purpose of which would be to disrupt unfairly the business of the Complainant.

- 7.11 Therefore, for the reasons set out above, the Expert considers that the registration of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 7.12 So far as the definition of Abusive Registration in sub paragraph (ii) is concerned, the Expert considers that the Domain Name was and is an Abusive Registration as a result of its manner of use by the Respondent, for the reasons explained below. Specifically, the Expert considers that the factor set out at paragraph 5.1.2, 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)*, is relevant.
- 7.13 As evidenced by an email provided to the Expert by the Complainant, the Domain Name has been used to send an email to a third-party purporting to be from the Complainant requesting the payment of money. The Expert considers that those receiving such emails would likely be confused that the sender of that email, and the request for payment, is the Complainant.
- 7.14 The Expert considers that the use of the Domain Name as described, for the reasons set out above, has taken unfair advantage of and was also unfairly detrimental to the Complainant's Rights by seeking to rely on the Complainant's goodwill and reputation in this way.
- 7.15 The Expert has considered whether there is any other evidence before him to demonstrate that the Domain Name is not an Abusive Registration but does not consider there is.
- 7.16 Therefore, for the reasons set out above, the Expert considers that the use of the Domain Name took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

8. Decision

- 8.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. Therefore, the Expert directs that the Domain Name be transferred to the Complainant.

Signed: 

Dated: 3 May 2018