

# **DISPUTE RESOLUTION SERVICE**

**D00021283**

## **Decision of Independent Expert**

**Macsween of Edinburgh Limited**

and

**Hillhead Hampers (Scotland) Ltd**

### **1. The Parties:**

Complainant: Macsween of Edinburgh Limited  
Macsween of Edinburgh Limited  
Dryden Rd, Bilston Glen  
Loanhead  
Lothian  
EH20 9LZ  
United Kingdom

Respondent: Hillhead Hampers (Scotland) Ltd  
Hillhead Farm  
Pirnhall Road  
Bannockburn  
Stirling  
FK7 8EX  
United Kingdom

### **2. The Domain Name(s):**

macsweenshaggis.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.

04 April 2019 12:22 Dispute received  
04 April 2019 13:39 Complaint validated  
04 April 2019 13:50 Notification of complaint sent to parties  
10 April 2019 09:51 Response received  
10 April 2019 09:51 Notification of response sent to parties  
15 April 2019 02:30 Reply reminder sent  
15 April 2019 11:46 Reply received  
15 April 2019 11:47 Notification of reply sent to parties  
15 April 2019 11:48 Mediator appointed  
17 April 2019 16:52 Mediation started  
18 June 2019 15:52 Mediation failed  
18 June 2019 15:52 Close of mediation documents sent  
20 June 2019 09:49 Expert decision payment received

### **4. Factual Background**

- 4.1 The Complainant, Macsween of Edinburgh Limited, is a Scottish food producer.
- 4.2 Since 1953 the Macsween family have been running a successful business producing food products. In the early days, the business focused on butchery. However, since 1983, the business has focused in particular on the manufacturing and sale of haggis. The business is now run by its third generation of the Macsween family.
- 4.3 The Complainant was incorporated as a private limited company on 12 April 1994. Its original name of Macrocom (266) Limited was changed to Macsween of Edinburgh Limited on 26 April 1994. It carries on the Macsween family's business.
- 4.4 The Complainant owns the domain name macsween.co.uk and its products can be viewed and ordered online through the website at [www.macsween.co.uk](http://www.macsween.co.uk).
- 4.5 The Complainant is the registered proprietor of a number of trade marks in the United Kingdom, European Union, United States, Japan, Singapore, Australia, China and a pending registration in Canada. These include registrations for the word mark MACSWEEN and are summarised below.

<b>Territories</b>	<b>Mark</b>	<b>Trade Mark Number</b>	<b>Date of Filing</b>	<b>Class(es)</b>
UK	MACSWEEN	UK00002423896	08 June 2006	29, 30
UK	EST. 1953 MACSWEEN OF EDINBURGH (figurative)	UK00002107547	13 August 1996	29, 30
UK	MACSWEEN (figurative)	UK00002512560	30 March 2009	29, 30
EU	MACSWEEN	014895692	09 December 2015	29, 30, 32, 33, 35
EU	EST. 1953 MACSWEEN OF EDINBURGH (figurative)	001188259	27 May 1999	29,30
US	MACSWEEN	014895692	09 December 2015	29, 30
Japan, Singapore, Australia and China	MACSWEEN	1384395	30 June 2017	29
Canada	MACSWEEN	1785994-00	07 June 2016	29, 30, 33, 35

- 4.6 The Respondent, Hillhead Hampers (Scotland) Limited, was incorporated on 6 March 2012. The Respondent uses the Domain Name to link internet users to an online shop which sells the Complainant's products and which also contains links to sites selling other Scottish themed food products including haggis.
- 4.7 The Respondent registered the Domain Name on 17 January 2014. It also registered the domain name macsweenhaggis.co.uk in the same year.
- 4.8 On 22 January 2015, MacRoberts LLP, on behalf of the Complainant, wrote to the Respondent requesting transfer of the domain name macsweenhaggis.co.uk. Following negotiations between the parties, the Respondent agreed to transfer this domain name to the Complainant for £400.

## **5. Parties' Contentions**

### **Complainant's Submissions**

The Complainant's submissions in its Complaint can be summarised as follows:

#### **Rights**

- 5.1 The Complainant has a long-running business manufacturing well-established haggis products. The products are currently available for sale to customers in the EU, Canada and Singapore.
- 5.2 The Complainant submits that it has Rights in the Domain Name because:
  - 5.2.1 it is the registered proprietor of a number of trade marks including word marks for MACSWEEN in various territories for classes including registrations in class 29 (specifically including traditional haggis and vegetarian haggis);
  - 5.2.2 it has used the MACSWEEN mark "for a not insignificant period and to a not insignificant degree", in particular in relation to its business that has been focused on the manufacture of haggis since 1983 . This is demonstrated by reference to the Complainant's website which sets out a history of the Complainant. Highlights have included presenting Macsween Haggis at a Scottish food fair in 1983 at Selfridges which paved the way for UK-wide sales, manufacturing the first vegetarian haggis for the opening of the Scottish Poetry Library in 1984, opening the world's first dedicated haggis factory in 1996 which was subsequently opened by HRH Prince Andrew when it was expanded in 2003 and winning the, "Morrisons Award for Outstanding Business" at the IGD Food Industry Awards in 2012; and
  - 5.2.3 it has acquired common law rights in the form of substantial goodwill acquired over a significant period of time in and to the marks MACSWEEN (when used in connection with haggis and haggis products) and MACSWEEN HAGGIS.
- 5.3 The Domain Name, with the exception of the addition of the letter "s", is identical to the Complainant's common law rights in the MACSWEEN HAGGIS mark and contains the Complainant's registered trade mark MACSWEEN followed by one of the goods for which that trade mark is registered.
- 5.4 The Complainant submits that it has Rights in the Domain Name and that the Respondent has no such Rights.

#### **Abusive Registration**

- 5.5 The Complainant submits that this is an Abusive Registration because the Domain Name:
  - 5.5.1 was primarily registered to unfairly disrupt the Complainant's business;

- 5.5.2 is being used by the Respondent in a way which has already confused people into thinking the website was controlled by the Complainant as is evidenced by an email from a customer to the Complainant's mail order partner who had ordered one of the Complainant's products from the Respondent believing that the product had been supplied by the Complainant; and
- 5.5.3 is one of a series of domain name registrations that the Respondent has made, which because of their number, type and pattern prove that the Respondent is in the habit of making registrations of domain name which correspond to trade marks or other well-known names in which the Respondent has no apparent interest. In this regard the Complainant points to the Respondent's previous registration of the domain name macsweenhaggis.co.uk.
- 5.5 The Complainant also points to the fact that a combination of the Domain Name, the numerous references to Macsween Haggis on the Respondent's website and the prominence of the Complainant's products on the Respondent's website are very likely to exacerbate the confusion.

### **Respondent's Submissions**

The Respondent's submissions are very brief and can be summarised as follows:

- 5.6 The Complaint is tantamount to corporate bullying and is vexatious.
- 5.7 The Respondent submits that its website makes it very clear to the internet user that it is not related to the Complainant. The Respondent submits that on each page of its website it has a notice which clearly states that it is an "online retailer of MacSween haggis".
- 5.8 The Respondent registered two domain names in 2014: macsweenhaggis.co.uk and the Domain Name.
- 5.9 In 2016, when contacted by the Complainant to purchase the macsweenhaggis.co.uk domain name, the Respondent offered to sell the Domain Name to the Complainant and the Complainant refused this offer.

### **Reply**

The Complainant's submissions in its Reply can be summarised as follows

- 5.10 The Respondent's claim that the Complaint is tantamount to corporate bullying is unfounded and irrelevant.
- 5.11 When the Complainant wrote to the Respondent about the domain name macsweenhaggis.co.uk in January 2015 (not 2016 as the Respondent contends) the Complainant was not aware that the Respondent was making any use of the Domain Name so there was no need to buy it.

## **6. Discussions and Findings**

6.1 Paragraph 2 of the Nominet’s Dispute Resolution Service Policy (“DRS Policy”) requires that the Complainant must prove, on the balance of probabilities, 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*

## **Rights**

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 DRS 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 It is clear that the Complainant has Rights in both the word and mark MACSWEEN and MACSWEEN HAGGIS. The Complainant is the registered proprietor of a series of trade marks across the UK, EU, US, Japan, Singapore, Australia and China for MACSWEEN and the Complainant has been using MACSWEEN and MACSWEEN HAGGIS, in relation to traditional haggis and vegetarian haggis for at least 20 years.

6.5 The Domain Name differs from the word or mark MACSWEEN by the addition of (i) the letter “s” which I take to be indicating that the haggis belongs to Macsween, i.e. if it was not for the fact that apostrophes cannot be used as part of domain names the Domain Name would likely be “Macsween’s Haggis”, and (ii) the word “haggis” which describes the goods for which the Complainant is best known. Neither therefore serves to distinguish the Domain Name from the word or mark in which the Complainant has Rights i.e. MACSWEEN.

6.6 Similarly the Domain Name differs from the name or mark MACSWEEN HAGGIS by the addition of the letter “s” and as above I cannot see that the addition of the letter “s” in this context does anything to distinguish the Domain Name from MACSWEEN HAGGIS.

6.7 I therefore find, on a balance of probabilities, that the Complainant has Rights in a name or mark which is similar to the Domain Name.

## **Abusive Registration**

6.8 The definition of Abusive Registration in the DRS Policy is 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights*

- 6.9 This definition requires me to 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.
- 6.10 Paragraph 5 of the DRS Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 8 of the DRS Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.
- 6.11 The Policy requires 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.
- 6.12 In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, 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, this would 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.
- 6.13 The current case falls closer towards the former category, i.e. the name or mark in which the Complainant has Rights, i.e. MACSWEEN and MACSWEEN HAGGIS, is well established and has been extensively used and there is no doubt at all that the Respondent knew about those Rights when it registered and used the Domain Name. Indeed, the very nature of the Respondent's website linked to the Domain Name, i.e. the sale of the Complainant's products, is evidence of that.
- 6.14 Here, however, the question is not one of the Respondent's knowledge of the Complainant's Rights, but more a question of whether the Respondent is taking unfair advantage of or was being detrimental to the Complainant's Rights because, for example, visitors to the Respondent's website will be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, i.e. whether the Domain Name is an Abusive Registration under Paragraph 5.1.2 of the Policy.

- 6.15 This, or at least a similar issue, has been the subject of a number of decisions under Nominet's DRS and it is convenient to quote from Nominet's DRS Experts' Overview on this point, as follows:

*Commonly, Internet users will visit web sites 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 up on its list the URL for the web site 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 web site will use the domain name for that purpose.*

*In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "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, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name. In the High Court decision *Och-Ziff Management Europe Ltd v Och Capital LLP* [2010] EWHC 2599 (Ch), the court quoted the International Trade Mark Association definition of initial interest confusion as being "a doctrine which has been developing in US trademarks cases since the 1970s, which allows for a finding of liability where a plaintiff can demonstrate that a consumer was confused by a defendant's conduct at the time of interest in a product or service, even if that initial confusion is corrected by the time of purchase". In that case the court held that initial interest confusion is legally actionable under European trade mark legislation.*

*In DRS 07991 (toshiba-laptop-battery.co.uk) an aspect which the appeal panel regarded as being indicative of abusive use was the fact that the Respondent was using the domain name featuring the Complainant's trade mark to sell in addition to the Complainant's goods, goods competing with the Complainant's goods.*

*Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix). See for example DRS 00658 (chivasbrothers.co.uk).*

*The further away the domain name is from the Complainant's name or mark, the less likely a finding of Abusive Registration. However, the activities of typosquatters are generally condemned - see for example DRS 03806 (privalege.co.uk) - as are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity. See for example the Appeal decisions in DRS 00248 (seiko-shop.co.uk) and DRS 07991 (toshiba-laptop-battery.co.uk).*

- 6.16 The Respondent is effectively reselling the Complainant's goods and it is therefore also convenient to look at the Decision of the DRS Appeal Panel in the Toshiba-



Laptop-Battery case where the principles to be followed in this kind of case were neatly summarised as follows:

1. *It is not automatically unfair for a re-seller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.*
2. *A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.*
3. *Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the website.*
4. *Whether or not a commercial connection is implied, there may be other reasons why the re-seller's incorporation of the domain name is unfair. One such reason is the offering of competitive goods on the Respondent's website.*

6.17 The Respondent points out that its site makes it clear that it is an "online retailer of MacSween Haggis". The Respondent's site itself also only seems to sell the Complainant's products although it does link through to other sites which sell Scottish themed products from other companies.

6.18 These are therefore factors which I must bear in mind when assessing whether or not the Domain Name is an Abusive Registration and specifically in deciding whether the Respondent's use of the Domain Name falsely implies a commercial connection with the Complainant. In other words, would someone visiting the website of the Respondent believe that it is in some way connected with the business of the Complainant (in the sense of being authorised by the Complainants)? In making this assessment it is open to me to consider both initial interest confusion (as discussed above in the Expert's Overview) and the content of the website.

6.19 A relevant factor here is the nature of the Domain Name. It includes the names or marks in which the Complainant has Rights (MACSWEEN and MACSWEEN HAGGIS) with the addition of an "s" in the case of MACSWEEN HAGGIS and with the addition of "s" and "haggis" in the case of MACSWEEN. As I have said above the "s" is used in the sense of describing that the haggis belongs to Macsween as in Macsween's Haggis and "haggis" describes the goods for which the Complainant is best known.

6.20 When taken as a whole, this is the kind of domain name which the public are likely to see as being something official and connected to (authorised by) the Complainants. In other words an internet user is likely to look at the Domain Name and believe it is owned by or connected to the Complainant. It feels to me like the kind of Domain Name that a business such as the Complainant would naturally have and I think that an internet user would come to the same conclusion.

6.21 I find therefore, on the balance of probabilities, that the nature of the Domain Name is such that it is likely to be either typed into a browser by an Internet user guessing what the Complainant's official site may be or, alternatively, an

Internet user may arrive at the site having typed words such as “Macswen” and “Macswen’s haggis” into a search engine. In each case, “initial interest confusion” would occur.

6.22 Having found that initial interest confusion is likely to have occurred, I do not find it necessary to go on to look at the content of the site to decide whether or not the user would continue to be confused, indeed, as the DRS Appeal Panel said in *Rayden Engineering Limited v Diane Charlton DRS 06284*, “....*by the time the user reads the disclaimer, or realises from the content of the website that it is not what he was looking for, the damage is done and the advantage sought by the respondent is achieved*”.

## **7. Decision**

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. Further, on a balance of probabilities, I find that the Complainant has established that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Complainant.

**Signed .....**

**Dated .....**