

**.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE**

Decision of Independent Specialist

Case Number: 574

1. The Parties:

Complainant:	Births Deaths Marriages Limited
Registrant:	Patricia McManus

2. The Domain Name(s):

births-marriages-deaths.ie	"the domain name"
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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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

The procedural history is as follows:

Action	Comment / date
Dispute received	8 th January 2020
Complaint validated	8 th January 2020
Notification of complaint sent to parties	10 th January 2020
Forum Opened	2 nd February 2020
Complaint Form received	29 th January 2020
Response Form received	No Response Received
Forum Closed	1 st March 2020
Adjudication Started	2 nd March 2020
Adjudication Decision Posted	9 th March 2020
Adjudication Decision accepted / rejected	
Specialist Decision published	9 th March 2020

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4. Factual Background

The Complainant is an Irish limited company, registered number 323168. The Complainant registered the domain name birthsmarriagesdeaths.ie (“the BMD domain name”) on 28 July 2000. That domain redirects to birthsdeaths marriages.ie (“the BDM domain name”) which was registered by the Complainant on 27 April 2000. Since 2004 the Complainant has operated a website on the BDM domain name allowing individuals to order birth, death, marriage and other Irish civil certificates.

The Registrant is an individual. The Registrant registered the domain name birthsmarriages-deaths.ie (“the B-M-D domain name”) on 2 February 2012. The Registrant operates a website on the B-M-D domain name which similarly allows individuals to order Irish civil certificates.

5. Parties’ Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant states that:

- The B-M-D domain name was primarily registered to unfairly disrupt its business.
- The Registrant learned of its business while working on a temporary basis in the General Register Office (the state body responsible for issuing civil certificates), acquired inside knowledge regarding its business, and owed it a duty of confidentiality in relation that information.
- The B-M-D domain name and website is confusingly similar to the Complainant’s BMD domain name and BDM domain name and website.
- There have been numerous complaints of poor service and unprofessionalism to the General Registration Service and to the Complainant itself from people under the impression that they were dealing with the Complainant when in fact they were dealing with the B-M-D website.

Response

The Registrant did not file a Response or otherwise take part in these proceedings.

6. Discussions and Findings

Matters to be proved:

Under paragraph 4.1 of the Alternative Dispute Resolution Policy (“ADRP”) the burden of proof is on the Complainant who must prove three elements, specifically that:

- A. the Complainant would ordinarily be eligible to register the domain name in question if it was not already registered by the Registrant, and
- B. the Complainant
 - (i) has rights in the domain name or in marks or identifiers very similar to it, or
 - (ii) that the Complainant’s rights have been negatively impacted by the registration, and
- C. the registration of the domain should be revoked as it has been registered or used abusively or in bad faith.

A. Complainant Eligibility to Register the Domain Name

The Complainant is an Irish company and would be eligible to register the domain name if it was not already registered.

B. Complainant’s Rights in the Domain Name

(i) Rights in the domain name or in marks or identifiers very similar to it

Paragraph 4.1.B(i) of the ADRP defines the term “rights” as follows:

Any legal or other enforceable right can be considered, including but not limited to:

- Trade and service marks protected in the island of Ireland, or
- Personal names (including pseudonyms) by which the Complainant is commonly known or has acquired a reputation in on the island of Ireland, or
- Geographical indications that can prima facie be protected in the island of Ireland,
- Unregistered rights acquired through use.

In this case the Complainant does not have a trade mark, service mark, personal name or protected geographic indicator. In order to succeed the Complainant must therefore establish an “unregistered right acquired through use” or some “legal or other enforceable right”.

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Unregistered rights acquired through use

To establish an unregistered right (also known as an unregistered trademark or a common law trademark) a complainant must show that it would be entitled to bring an action in tort for passing off in respect of use of the disputed domain name. This requires proof that:

- it runs a business on the island of Ireland,
- it has goodwill in this business, and
- the unregistered trademark on the basis of which it brings the complaint is a distinctive identifier of that business. (See Case No. DIE2013-0002, *Budget Energy Limited (Budget Energy ROI) and Budget Energy Limited (Budget Energy NI) v. Prepay Power Limited.*)

For guidance regarding whether there is the necessary goodwill and whether an unregistered trademark is a distinctive identifier the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) is helpful. While that deals with the Uniform Dispute Resolution Policy, a number of decisions under the .IE Dispute Resolution Policy have had regard to the Overview except where the .IE policy or Irish law differ (see e.g. Case No. DIE2019-0001, *Puma SE v. Stephen Connell, Puma Transport Ireland Limited*).

Paragraph 1.3 of the WIPO Overview 3.0 states as follows:

What does a complainant need to show to successfully assert unregistered or common law trademark rights?

To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

(Particularly with regard to brands acquiring relatively rapid recognition due to a significant Internet presence, panels have also been considering factors such as the type and scope of market activities and the nature of the complainant’s goods and/or services.)

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a

greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.

In this case the expressions “births, marriages, deaths” and “births, deaths, marriages” are not inherently distinctive and these terms commonly appear together in descriptions of civil registration services, including in Irish legislation such as the Vital Statistics and Births, Deaths and Marriages Registration Act, 1952 and the Births, Deaths and Marriages Registration Act, 1972.

While the Complainant states that it has provided services using the BDM and BMD domain names since 2004, it has not provided any evidence of other factors which would tend to show either distinctiveness of these names or reputation (such as the volume of sales, extent of advertising, public recognition or consumer surveys).

Consequently, I find that the Complainant has not shown that it has rights in the B-M-D domain name or in marks or identifiers very similar to it.

(ii) Complainant’s rights negatively impacted by registration

Having found that the Complainant does not have rights in the domain name itself it is necessary to consider the alternative ground that the Complainant’s rights (in a more general sense) are negatively impacted by the domain registration or use.

“Negatively impacted” is defined in paragraph 1 of the ADRP to mean “an adverse effect on the Complainant or their commercial interests arising from the registration or use of the Domain Name to the existing Registrant”.

Para. 4.1.B.ii goes on to provide examples of negative impact. It provides, as far as relevant, that:

A Complainant may submit a complaint if it can show its rights are negatively impacted by the domain registration or use. It can do this by showing:

- The domain name registration or use is misleading or confusing to its customers, or
- The domain name registration or use is commercially damaging to its business through activities such as passing-off, content scraping or impersonation [...]

The Complainant has stated that both it and the General Register Office have received “countless complaints” based on confusion between the Complainant’s and Registrant’s sites. This statement has gone unchallenged by the Registrant and it is entirely credible that the BMD and B-M-D domain names would be confused as they are so similar. Consequently, while I note that the websites themselves are quite different in colour schemes and layouts, on balance I find that the Complainant has established that the domain name registration is misleading and confusing to customers.

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C. Domain Used or Registered Abusively or in Bad Faith

Under paragraph 4.1 of the ADRP the Complainant must also prove that “the registration of the domain should be revoked as it has been registered or used abusively or in bad faith”. These terms are defined in paragraph 1 of the ADRP which provides that:

“Abusively registered” refers to a domain name which was registered or used to take unfair advantage of or was unfairly detrimental to the Complainant's Rights; [and]

“Bad Faith” means a domain name which was registered or used without legitimate intent, and/or to engage in deceptive conduct and/or to act in a way which is in breach of the Registrant’s contractual obligations (as stated in the Registrant Terms and Conditions)

Paragraph 4.1.C of the ADRP includes a non-exhaustive list of examples of abuse and bad faith, and so far as relevant provides as follows:

A Complainant can demonstrate that the domain has been registered or is being used Abusively or in Bad Faith by the Registrant if it can provide evidence that [...]

- The domain name was registered or is being used with the primary purpose of unfairly disrupting or interfering with the Complainant’s business, or
- The domain name is being used in a way that is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant [...]

The Complainant alleges that the Registrant acted in bad faith in breaching a duty of confidentiality owed to it; however in the absence of any details of this alleged duty of confidentiality I do not consider this point any further.

The Complainant further alleges that the Registrant has acted abusively and in bad faith in that the Registrant chose an extremely similar domain name “to confuse website visitors” and to “financially affect our business for their own fiscal gain”.

The uncontradicted evidence that the Registrant is a direct competitor to the Complainant, knew of the Complainant’s business, and registered a name identical (except for the addition of hyphens) to a domain name used by the Complainant. In these circumstances I accept that the Registrant registered and used the domain name abusively and in bad faith.

In reaching this conclusion I keep in mind that the Registrant has not taken part in these proceedings and have considered the factors in paragraph 4.2(A) of the ADRP which it might have put forward as countering bad faith. The only one of these factors which might apply is that “[t]he domain name is generic or descriptive and the Registrant is making fair use of it”. The phrase “births, marriages, deaths” is largely generic and descriptive; however the use of hyphens to create a domain name otherwise identical to that of the Registrant is not compatible with fair use. (UDPR panels have frequently noted that hyphens “hyphens do not

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"serve to dispel Internet user confusion" – see e.g. Case No. D2003-0214, *Six Continents Hotels, Inc. v. Georgetown Inc.*)

I therefore find that the Complainant has met its burden of proof to establish that the domain name has been registered or used in bad faith.

7. Decision

For the foregoing reasons the Complaint is upheld and I direct that the domain name be transferred to the Complainant.

Signed: **Dr. TJ McIntyre**

Dated: **9 March 2020**