.nz Dispute Resolution Service

DRS Reference: 108

B.O.P. Memorials v Jones & Company Funeral Services

Key words –

“Rights”; unregistered mark; descriptive business name; whether secondary meaning acquired by use; whether name “wholly descriptive” of Complainant’s business; Unfair Registration by use of Domain Name; use likely to confuse, mislead or deceive; effect of paragraph 5.4 of the Policy on evidence of the Respondent’s state of mind.

1. Parties

Complainant:
Mrs Fiona Marilyn McKenzie
B.O.P. Memorials
72 Grenada Street
Mt Maunganui
Tauranga

Respondent:
Mr David McMahon
Jones & Company Funeral Services
143 Thirteenth Avenue
PO Box 650
Tauranga

2. Domain Name

bopmemorials.co.nz ("the Domain Name")

3. Procedural history

The Complaint was lodged on 26/06/2006 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 29/06/2006. The Domain Name was locked on 26/06/2006, preventing any changes to the record until the conclusion of these proceedings.

There was no response filed by the Respondent.

The Complainant paid InternetNZ the appropriate fee on 31/07/2006 for a decision of an Expert, pursuant to Paragraph 9 of the InternetNZ Dispute Resolution Service Policy (“the Policy”).

Mr Warwick Smith, the undersigned, (“the Expert”) confirmed to InternetNZ on 31 July 2006 that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which

ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

The Expert was appointed by InternetNZ to decide the Complaint, on 31 July 2006.

By Procedural Direction No 1 dated 11 August 2006, the Expert invited the Complainant to correct certain procedural deficiencies in the Complaint, by providing a supplementary statement by 16 August 2006. That supplementary statement was duly provided by the stipulated date.

The Expert also requested from the Complainant, a Second Supplementary Statement, addressing certain issues going to the substance of the Complaint. That Second Supplementary Statement was to be provided by 18 August 2006. In view of the fact that the Complainant was being given an opportunity to supplement its Complaint, the Expert directed that the Respondent could file a Response to any such Second Supplementary Statement the Complainant might provide. Any such Response was to be provided by 25 August 2006. Provision was made for the Complainant to file a Reply in the event of the Respondent filing a Response.

In the event, the Complainant did file a Second Supplementary Statement by 18 August, but a question arose as to whether the Respondent had received certain annexures to the Second Supplementary Statement by that date. To avoid any procedural unfairness to the Respondent, the Expert extended the time for the Respondent to submit a Response, to 29 August 2006. To accommodate the various requests extensions of time, the time for the making of this decision was extended, first to 7 September 2006 and subsequently to 8 September 2006.

The Respondent did not take up the further opportunity to file a Response.

4. Factual background

The following statement of facts is taken from the Complaint and the Complainant's Second Supplementary Statement.

The Complainant

The Complainant, B.O.P. Memorials, is a partnership owned by Ms Fiona McKenzie and her husband Raymond McKenzie. Mr and Mrs McKenzie had been working for a firm of monumental masons in the Waikato prior to 1996, when they decided to set up their own monumental business (i.e. providing headstones for grave sites), based in Mt Maunganui. They moved into new premises in Mt Maunganui in November 1996, and they have operated their headstones business from that address ever since. According to the Second Supplementary Statement, the Complainant provides "a vast selection of headstones and plaques for local cemeteries", and carries out all work related

to the monumental mason industry. The Complainant is not a funeral director, however.

Mr and Mrs McKenzie say that they chose the name "B.O.P. Memorials" for their business, because they wanted to service the whole of the Bay of Plenty area, and they are "in the business of providing lasting memorials for lost loved ones".

B.O.P. Memorials is not a registered trade mark. However, the Complainant has provided with the Second Supplementary Statement a number of documents showing that it has operated its business under the name "B.O.P. Memorials" since 1996. An extract from the Bay of Plenty telephone director for 1996 shows an advertisement for "BOP Memorials", with telephone and fax details and the Mt Maunganui address. An invoice dated 30 June 1996 from Decra Art Limited addressed to "B.O.P. Memorials", and other invoices from 1996 which are similarly addressed, have been provided.

Extracts from Telecom's Yellow Pages for 2006 also show the business trading as "B.O.P. Memorials", with the same telephone number and business address in Mt Maunganui, and with an additional business address in Tauranga. The additional premises were opened in February 2006.

The advertisement in the 2006 edition of the Yellow Pages, refers to the Complainant as "the Bay's Headstone Shop". It advertises certain products, and goes on to say:

> *"Largest Selection in The Bay*
> *Servicing all Areas"*

The 2006 Yellow Pages advertisement also draws the reader's attention to the Complainant's website at www.bopmemorials.com.

The Complainant says that, so far as its owners can ascertain, no other business is operating in New Zealand under the name "B.O.P. Memorials".

The Respondent and the Domain Name

The Domain Name was registered by the Respondent on 21 September 2000. The registered proprietor is the Respondent David McMahon, of the firm Jones & Company Funeral Services. The Domain Name has been renewed by the Respondent at the appropriate stages since the original registration.

According to the Complaint, the Respondent purchased a funeral home called Te Puke Funeral Services in the year 2000. At the same time he purchased a business known as "Strongs Memorials". Both businesses operated from the same premises. However, the Respondent's firm (Jones & Company Funeral Services) did not have monumental mason skills, and it needed someone to operate the memorials side of the business. Mr McMahon approached the Complainant proposing an amalgamation of his business with the Complainant's business. That offer was declined.

About six months later, the Complainant learned that the Respondent had registered the Domain Name. Mrs McKenzie says that she contacted the Domain Name Commissioner's office at that stage, but was told that domain names were issued on a "first in first served" basis, and that there was nothing the Office could do.

Following receipt of that advice, the Complainant elected to establish a website at bopmemorials .com.

In the Complaint, the Complainant states that:

> *"… as soon as any person types in our name "bopmemorials" in the search line it immediately goes to the Jones & Company Web site. … and the Jones & company Web site is purely set up for funeral purposes, not monumental."*

And in the Second Supplementary Statement the Complainant said:

> *"… we are finding it very frustrating when clients type in "bopmemorials" into their search bar and it goes to the Jones & Company Funeral Services web page.*

The Expert has looked at the website to which the Domain Name resolves. It is indeed the website of Jones & Company Funeral Services. According to the website, Jones & Company operates three Bay of Plenty funeral homes, one in Tauranga, one in Mt Maunganui, and one in Te Puke. There is no mention of the provision of monumental mason or other memorials services. Jones & Company Funeral Services is said to be the oldest funeral services firm in the region, with "95 years of history". It is said to be "locally owned and operated".

5. Parties' contentions

a. Complainant

The Complainant contends:

(i) Because of its use of the name "B.O.P. Memorials" in business over the period of approximately 10 years since 1996, the Complainant has rights in the name "B.O.P. Memorials".

(ii) The Respondent is using "our name" (i.e. the Domain Name) to connect people to his business through the Jones & Company web site.

(iii) Internet browsers typing in the Complainant's name "B.O.P. Memorials" in the search line are immediately diverted to the Jones & Company website.

(iv) The Respondent acquired the Domain Name with malicious intent; the Domain Name serves no purpose in the Respondent's business of funeral directing, and the Jones & Company website is purely set up for funeral purposes, not monumental.

(v) The Domain Name is also being used by the Respondent to connect people to the Respondent's Strong Memorials business in Te Puke.

b. Respondent

The Respondent did not file any Response.

6. Discussion and findings

Relevant Provisions of the Policy

The Policy applies to Respondents when a Complainant asserts that:

> *"(i) The Complainant 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 Unfair Registration*." (Policy, paragraph 4.1)

The Complainant is required to prove on the balance of probabilities that both elements are present (Policy, paragraph 4.2).

The expressions "Rights" and "Unfair Registration", are both defined in paragraph 3 of the Policy.

The expression "Rights" includes, but is not limited to, rights enforceable under New Zealand law. The definition continues:

> *However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business.*"

The expression "Unfair 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) has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

At paragraph 5.1, the Policy contains a non-exhaustive list of factors which may be evidence that a domain name is an "Unfair Registration". The list includes the following:

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

(i) for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

(ii) as a blocking registration against a name or mark in which the Complainant has Rights; or

(iii) for the purpose of unfairly disrupting the business of the Complainant; or

5.1.2 Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant."

Paragraph 6.1 of the Policy sets out a list of factors which may be evidence that the Domain Name is *not* an Unfair Registration. This list, which is again non-exhaustive, contains the following:

"6.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the Complaint itself), the Respondent has:

(i) 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;

(ii) been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;

(iii) made legitimate non-commercial or fair use of the Domain Name; or

6.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character."

Application of the Policy in this Case

The first question is whether the Complainant has "Rights" in respect of a name or mark which is identical or similar to the Domain Name.

The Name relied on by the Complainant is Similar to the Domain Name

The name or mark in which the Complainant claims to have Rights, is "B.O.P. Memorials". That name or mark is at least similar to the Domain Name. The only differences are the use of lower case letters and the absence of full stops in the Domain Name, and the addition of the ".co.nz". The ".co.nz" is generic, and is not to be taken into account in the comparison. That is probably true also for the use of lower case letters in the Domain Name, and the absence of full stops in the Domain Name. If those minor differences are not to be taken into account, the name or mark asserted by the Complainant and the Domain Name are identical.

It is not necessary to decide whether there is identity in this case, or whether the two expressions are merely similar. It is enough that the name/mark asserted by the Complainant *is* clearly similar to the Domain Name. The sounds of the two expressions are identical, as are the impressions, or "ideas" which each conveys. Visually, they are hardly distinguishable.

Does the Complainant have "Rights" in "B.O.P. Memorials"?

The Complainant does not rely on any registered trade mark. The claim is based on alleged common law rights arising out of the Complainant's continuing business *use* of the name over the 10 year period since 1996. The Complainant says, in effect, that to a significant number of people the name "B.O.P. Memorials" has, by virtue of that continuing use, become distinctive of the Complainant's services, such that the Complainant would be entitled to sue anyone who used the name for a similar service without the Complainant's consent, under the law of passing off.

A right to sue for passing off is a "right enforceable under NZ law" within the meaning of the definition of "Rights" in the Policy. That such a right can qualify as a "Right" under the Policy is well established by a number of cases decided by English experts on the (identical) provisions of the Nominet UK Dispute Resolution Service Policy used in the resolution of disputes over domain names registered in the .uk space (see for example the decision of the three-member appeal panel in the United Kingdom in *Rugged Com Inc. v LANstore Inc;* Nominet Case No. DRS 02802)).

So the absence of any registered trademark is no bar to the present claim. The particular difficulty in this case, however, is that the definition of "Rights" in the Policy expressly states that a Complainant is unable to rely on rights in

a name or term "*which is wholly descriptive of the Complainant's business*". There are questions as to whether the name "B.O.P. Memorials" *is* descriptive of the goods and services supplied by the Complainant, and if so, whether it is *wholly* descriptive of that business. In the Expert's view, the name would not be *wholly* descriptive of the Complainant's business if the name had acquired a secondary meaning, designating the Complainant's *particular* business rather than merely describing the general nature of the business which the Complainant conducts.

Is the Name Descriptive of the Business? – The Law

The difference between purely descriptive trade names, and fancy, or "made-up" names, was discussed by Hill J in the Federal Court of Australia, in *Equity Access Pty Limited v Westpac Banking Corporation and Anor* (1989) 16 IPR 431. The Judge said at p 448 of the decision in that case:

> "*Just as the distinction between descriptive and fancy names is not a distinction of law so too it is wrong to see the distinction in black and white terms. The reality is that there is a continuum with at the extremes purely descriptive names at the one end, completely invented names at the other and in between, names that contain ordinary English words that are in some way or other at least partly descriptive. The further along the continuum towards the fancy name one goes, the easier it will be for a plaintiff to establish that the words used are descriptive [i.e. distinctive] of the plaintiff's business. The closer along the continuum one moves towards a merely descriptive name, the more a plaintiff will need to show that the name has obtained a secondary meaning, equating it with the products of the plaintiff (if the name admits of this – a purely descriptive name probably will not) and the easier it will be to see a small difference in names as adequate to avoid confusion*."

In the *Equity Acess* case, Justice Hill described the test for determining whether words were merely descriptive words as: "whether the words were equally applicable to any business of the like kind" (*Equity Access* at p 446, citing the judgment of McLelland J in *Select Personnel Pty Ltd v Morgan & Banks Pty Ltd* (1988) 12 IPR 167 at 170).

To similar effect is the following statement from the speech of Lord Parker in *Registrar of Trade Marks v W & G Du Cros Ltd* [1913] AC 624, at 635:

> "*The applicant's chance of success in this respect [i.e. in distinguishing his goods by means of the mark, apart from the effects of registration] must, I think, largely depend upon whether other traders are likely in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods. It is apparent from the history of trade marks in this country that both the legislature and the Courts have always shown a natural disinclination to allow any person to obtain by registration under the Trade Marks Act a monopoly in what others may legitimately desire to use.*"

In the Expert's view, the name "B.O.P. Memorials" is clearly towards the "descriptive" end of in Justice Hill's "continuum".

In another Australian case, *Clark Equipment Co v Registrar of Trade Marks* (1964) 11 CL 511, Kitto J noted (pp 514 to 515 of the report):

> "*... the more apt a word is to describe the goods, the less inherently apt it is to distinguish them as the goods of a particular manufacturer …*
>
> *The consequence is that the name of a place or of an area, whether it be a district or a county, a state or a country, can hardly ever be adapted to distinguish one person's goods from the goods of others when used simpliciter or with no addition save a description or designation of the goods, if goods of the kind are produced at the place or in the area or if it is reasonable to suppose that such goods may in the future be produced there. In such a case, the name is plainly not inherently, i.e. in its own nature, adapted to distinguish the applicant's goods.*"

That passage was cited with apparent approval by in the 1998 decision of the Full Court of the Federal Court of Australia in *Mid Sydney Pty Ltd v Australian Tourism Company Ltd and Ors* (1998) 42 IPR 561).

The legal position in New Zealand is summarised as follows by the authors of the text *Intellectual Property in New Zealand* (2002):

> "*In passing off it is by no means impossible to convince a New Zealand Court that a geographical designation has acquired a sufficient secondary meaning by dint of its association with an existing trader, so that the trader can prevent others from using that designation in relation to the same goods or services.*
>
> *Shotover Jet [Shotover Gorge Jet Boats Ltd v Marine Enterprises Ltd [1994] 2 NZLR 154] is a leading example. The name "Shotover Jet" was held to have become so associated with one jet boat operator on the Shotover River after 14 years that Hardie Boys J injuncted another jet boat operator from using the name "Lower Shotover Jet" or to even combining "Shotover" with its own trade name in the formula "Rout's Shotover Jet".*

Similarly, in *New Zealand Insurance Co Ltd v New Zealand Insurance Brokers Ltd* [1976] 2 NZLR 440 to 446, Moller J held that New Zealand Insurance Co Ltd could prevent insurance brokers from styling themselves "New Zealand Insurance Brokers". The expression "New Zealand Insurance" had acquired a secondary meaning that that went beyond merely describing the nature of the services (insurance products) provided by the plaintiff within New Zealand.

Application of the Foregoing Legal Principles to the Facts of this Case

According to the Shorter Oxford English Dictionary, the word "memorial" (used in the sense relevant here), means "sign of remembrance, memorial,

monument". The Complainant states in its Second Supplementary Statement that it provides "all work related to the monumental mason industry", and "we are in the industry of providing lasting memorials for lost loved ones". In the Expert's view, the word "memorials" is entirely apt to describe the goods and services provided by the Complainant. Indeed the word appears to have been chosen for that very purpose.

The letters "B.O.P" are an abbreviation for the Bay of Plenty Region of New Zealand, and that is the meaning the letters as used in the Complainant's name are intended to convey. (The Complainant says in its Second Supplementary Statement: "… we chose the name B.O.P. Memorials, as we wanted to service the whole of the Bay of Plenty area …")

Turning to the test used by Hill J in the *Equity Access* case for determining whether words are merely descriptive, are the words "B.O.P. Memorials", "equally applicable to any business of the like kind"?

In the Expert's opinion, they are. The Complainant provides its goods and services within the Bay of Plenty region. It appears from the Second Supplementary Statement that it does not supply its goods or provide its services in other parts of New Zealand. However, that does not mean that its market is limited to members of the public, funeral directors, or other referral sources, located in the Bay of Plenty. The Complainant's market must include all members of the public anywhere in New Zealand (or further afield for that matter) who have relatives interred (or about to be interred) in the Bay of Plenty region, and who have a need for someone in that region to provide "memorials" services.

It follows that every provider of memorials services in the Bay of Plenty region would have a legitimate interest in marketing its services beyond the region. One of the shortest and simplest ways of describing such services would be to use the expression "Bay of Plenty Memorials". "B.O.P. Memorials" might be used as an abbreviation of that expression.

In those circumstances, the Expert concludes that the expression "B.O.P. Memorials" *is* descriptive. It *would* be equally applicable to any party who provided (or wished to provide) memorials services in the Bay of Plenty region.

However that is not the end of the matter. There remains the question under the "Rights" heading, of whether, notwithstanding the substantially descriptive nature of its name, the Complainant has provided sufficient evidence to establish that the name has become so associated with its business in the minds of a significant number of consumers, that the name has acquired a secondary meaning (as a reference to the particular business operated by the Complainant) and is not therefore *wholly* descriptive of the goods and/or services provided in the conduct of that business.

The Complaint's Evidence of Use of the Name "B.O.P. Memorials" – Is it Sufficient to Establish Secondary Meaning?

The evidence of the Complainant's use may be summarised as follows:

1. Ten years' use of the name "B.O.P. Memorials" in the general conduct of its business in the Tauranga/Mt Maunganui area since 1996.

2. The Complainant's uncontradicted assertion that no other party operates under that name.

3. Four separate suppliers' invoices, all dated in 1996, addressed to the Complainant as "B.O.P. Memorials".

4. A copy of a Telecom Yellow Pages advertisement for "BOP MEMORIALS" published in the 1996 directory.

5. A copy of a Telecom Yellow Pages advertisement for "B.O.P MEMORIALS" published in the 2006 directory.

6. An April 1996 Telecom Directories Customer Proof Report, and a Telecom Advertising Order and Schedule form dated 19 April 2006, both naming the customer as "BOP Memorials"

7. The Second Supplementary Statement refers to business cards bearing the business name.

8. The name "B.O.P. Memorials" features prominently on the Complainant's business letterhead.

9. There is some limited evidence of confusion. The Complainant says in the Second Supplementary Statement that "we are finding it very frustrating when clients type in "bopmemorials" into their search bar and it goes to the Jones & Company Funeral Services web page.

There was no evidence of any advertising the Complainant may have conducted using the business name, apart from the Yellow Pages advertisements, nor was there any evidence of money spent on promoting the business name, or evidence from funeral directors or members of the public directed to the question of how the expression "B.O.P. Memorials" is perceived and understood by those groups.

The evidence of secondary meaning described above is not particularly strong. However, the Expert is mindful of the decisions of the appeal panels in the United Kingdom which have held that the requirement under the Policy to demonstrate "rights" is not a particularly high threshold test. See, for example, the decision of the appeal panel in *Seiko UK Limited v Designer Time/Wanderweb*; Nominet Case No DRS 00248. The purpose of the Policy is primarily to provide a quick and relatively cheap means of obtaining redress in circumstances of abusive or otherwise unfair registration of a domain name, and the level of proof required cannot reasonably be expected to be at the level which would be necessary to support a court claim for passing off, or an

application to register a trademark based on distinctiveness acquired through years of use.

Other factors in the Complainant's favour include the ten years' uninterrupted business use of the name, and the uncontradicted evidence that no-one else is using the name. In the Expert's view, it is also in the Complainant's favour that its name includes the abbreviated express "B.O.P., rather than the longer expression "Bay of Plenty". The three letters "B.O.P." are less obviously a descriptive geographical indicator than the longer expression "Bay of Plenty", and in the Expert's view they are more likely to have become distinctive of a particular trader's business (as a result of continuous use over a significant period of time) than the longer expression. The concern about granting a monopoly in the name of a geographical region to one particular trader for its services, is also significantly less where the expression used is not the name of the region itself but a three letter abbreviation of that name (which might not *necessarily* be a reference to the region - eg the letters "B.O.P." might be taken as the initials of the owner of the business; the expression "Bay of Plenty", on the other hand, leaves no room for any such interpretation).

Weighing all these factors, the Expert concludes that the Complainant has produced (just) sufficient evidence to show that, on the balance of probabilities, the name "B.O.P. Memorials" has become distinctive of the Complainant's *particular* services, and is not wholly descriptive of the general nature or characteristics of the service it provides. The Expert therefore concludes that the Complainant *does* have "Rights" in the expression "B.O.P. Memorials".

Unfair Registration

The Domain Name was registered as long ago as the year 2000. That is well over the three year period referred to in paragraph 5.4 of the Policy, so the Expert cannot take into account any of the evidence surrounding the registration of the Domain Name (or indeed any acts or omissions which occurred more than three years before the complaint was filed). The date of the complaint is 22 June 2006, so the Expert cannot consider evidence of acts or omissions prior to 22 June 2003.

The Domain Name has presumably been renewed since 22 June 2003, but a renewal is not a new registration.

The effect of paragraph 5.4 of the Policy in this case is that the Complainant must bring itself within the second limb of the definition of Unfair Registration, by proving that the Domain Name:

> "has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

The Expert is satisfied that the Complainant has proved this part of the Compliant, on the basis that, since 22 June 2003, the Respondent has used the Domain Name in a manner which has taken unfair advantage of the

Complainant's Rights and has been unfairly detrimental to those Rights. The reasons for that conclusion are as follows:

(i). The Complainant has Rights in the Domain Name, and, throughout the period since 22 June 2003, the Respondent has been well aware of those rights.

(ii) There is no evidence of the Respondent ever having used the expression "BOP Memorials" in trade, and the website to which the Domain Name resolves makes no mention of the provision of monumental masonry or other "memorial-type" goods or services.

(iii) With knowledge of the Complainant's Rights, the Respondent has continued during the period since June 2003 to link the Domain Name to the website operated by Jones & Company Funeral Services. In so doing, the Respondent must have known that a number of consumers looking for the Complainant's website would key in the Domain Name assuming it to be the Complainant's domain name, and be diverted to the Jones & Company Funeral Services website. According to the complaint, that very kind of confusion has occurred, and the Respondent must be taken to have known that it was likely to occur and is likely to continue to occur. In the Expert's view, the circumstances fall within paragraph 5.1.2 of the Policy, namely circumstances demonstrating that the Respondent is using the Domain Name in a way that 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.

(iv) The Respondent has not filed any response either during the initial period provided by the Policy or in the extended periods prescribed in the Expert's procedural directions. The Expert is entitled to draw such inferences from that failure as he considers appropriate, and in the circumstances described in this list of reasons, the Expert is prepared to draw the inference that the Respondent has no defence to the claim that he has been using the Domain Name in a manner which has been unfairly detrimental to the Complainant's rights in the manner described in subparagraph (iii) above.

(v) In the absence of any response, the Expert infers that, at the time it originally registered the Domain Name, the Respondent would have been aware of the Complainant's *cause for complaint*, and indeed intended to give the Complainant that cause for complaint. In those circumstances, the Respondent could not have brought himself within any of the circumstances described in paragraph 6.1.1 of the Policy (relating to the Respondent's use of the Domain Name at a time before the Respondent was aware of the Complainant's cause for complaint). In the Expert's view, paragraph 5.4 of the Policy does not preclude a finding about the Respondent's knowledge, or state of mind, prior to the three year period referred to in that paragraph. The Respondent's state of knowledge is neither an "act" nor an "omission".

(vi) Nor can the Respondent bring himself within paragraph 6.1.2 of the Policy (Respondent making fair use of the Domain Name in a way which is consistent with its generic or descriptive character). In the Expert's view, the Respondent's use of this Domain Name, by linking it to his company's website, has not been *fair*, having regard to the Complainant's Rights, the inevitability of consumers being confused into believing that the Domain Name must be that the Complainant, and the resulting detriment to the Complainant in having its clients or would-be clients diverted to the Jones & Company Funeral Services website.

7. Decision

For the foregoing reasons, the Expert finds that the Complainant has Rights in respect of the name or mark "B.O.P. Memorial Services", and that that name or mark is similar to the Domain Name. The Expert further finds that the Domain Name, in the hands of the Respondent, is an Unfair Registration.

Pursuant to paragraph 13 of the Policy, the Expert directs that the Domain Name be transferred to the Complainant.

Dated at Auckland the 8th day of September 2006

Expert Name Mr Warwick Smith

Signature