

.nz Dispute Resolution Service

DRS Reference: 113

Barfoot & Thompson v Domain Admin

Key words –

Domain name <wwwbarfoot.co.nz>

Rights - well-known mark – abbreviation of mark - misspelling - typosquatting
– likely to confuse, mislead or deceive – pattern of registration

1. Parties

Complainant:

Barfoot & Thompson Limited
Level 5
50 Kitchener Street
Auckland

Respondent:

Domain Admin
536 Leavenworth St
San Francisco
San Francisco
United States

2. Domain Name/s

<wwwbarfoot.co.nz> ("the Domain Name")

3. Procedural history

The Complaint was lodged on 17/07/2006 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 20/07/2006. The domain was locked on 17/07/2006, 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 21/08/2006 for a decision of an Expert, pursuant to Paragraph 9 of the InternetNZ Dispute Resolution Service Policy ("the Policy").

Mr Clive Elliott, the undersigned, (“the Expert”) confirmed to InternetNZ on 21/08/2006 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.

4. Factual background

The Complainant has traded under the name Barfoot & Thompson since it was incorporated in 1968. Its main business relates to real estate services.

The Complainant has used and is known in New Zealand by the name Barfoot & Thompson and the shortened version “Barfoots”. It has applied for but not obtained (as yet) registration of the following trade marks:

Trade mark Number: 737958
Trade mark: BARFOOT & THOMPSON
Use Statement: being used by the proprietor/applicant
Application Date: 31 October 2005
Class: 36
Specification of Services:
“Real estate services including property sales, rentals and management”

Trade mark Number: 737959
Trade mark: Barfoot & Thompson (see device below)



Use Statement: being used by the proprietor/applicant
Application Date: 31 October 2005
Class: 36
Specification of Services:
“Real estate services including property sales, rentals and management”

The full identity of the Respondent is unclear as is the exact nature of its business. It does however appear to operate one or more websites in the nature of portals. The Domain Name was registered on 27 June 2006.

5. Parties' contentions

a. Complainant

Rights

The Complainant asserts that it has a substantial reputation and goodwill in New Zealand in the full name Barfoot & Thompson and the shortened version

Barfoots, as a result of its extensive use of the trade mark/name. The Complainant annexed to its Complaint an extract from its current website.

That extract states (in paraphrased form) that:

- Barfoot & Thompson is a family owned business.
- It has traded for approximately 80 years
- It is New Zealand's largest privately owned real estate company
- In the 12 months to March 2006 it sold more than \$5.7 billion worth of property in Auckland and Northland
- It has 52 branches and more than 950 salespeople
- During the 2005 financial year it dealt with approximately 13,600 residential homes.

Unfair Registration

The Complainant contends that the registration of the Domain Name is unfair for a number of reasons. First, that it is formulated to capture people seeking the Complainant's website. In other words, that Internet users inaccurately entering the Complainant's domain name, by omitting a full stop, are directed to the Respondent's site.

A printout of the front page of the Respondent's website is annexed to the Complaint. As at 6 September 2006 the front page reads as follows:

[Wwwbarfoot.co.nz](http://www.barfoot.co.nz)

What you need, when you need it

September 6, 2006

[Bookmark this page](#) | [Make this your homepage](#)

Popular Links

- **Real Estate**
- **Home Loans**
- **Home Refinancing**
- **House For Sale**
- **Houses For Sale**
- **Home For Sale**
- **Residential Property**

- **Home Buying**
- **Real Estate Listing**
- **Property For Sale**

Popular Categories

Real Estate	Home Loans	Home Refinancing
House For Sale	Houses For Sale	Home For Sale
Residential Property	Home Buying	Real Estate Listing
Property For Sale	House For Rent	Buy A Home
Rentals	Italy Vacation Rental	House
Real Estate Agent	Houses For Rent	Real Estate Marketing

Also annexed to the Complaint is a copy of the page arrived at by clicking on the above "Real Estate" link. As at 6 September 2006 the relevant part of this page reads as follows:

Search results for:

real estate

What you need, when you need it

September 6, 2006

[Bookmark this page](#) | [Make this your homepage](#)

Popular Links

- **Home For Sale**
- **Commercial Real Estate**
- **Foreclosure**
- **Houses For Sale**
- **Real Estate Investing**

- **Georgia Real Estate**
- **Real Estate Marketing**
- **Phoenix Real Estate**
- **Home Buying**
- **Condos For Sale**

Sponsored Links

[Searching for property](#)

Go to the site with the largest New Zealand property sales listings

<http://www.realestate.co.nz>

[Real Estate](#)

Find your dream home on iShow. View houses & apartments in New Zealand.

<http://www.ishow.co.nz>

[Real Estate Ads](#)

Search **Real Estate** classifieds All your property needs Online

<http://www.AllRealEstate.co.nz>

[#1 Property Site-Trade Me](#)

NZ9s Top Property Site. Hundreds of Houses For Sale & Rent

<http://www.trademe.co.nz>

It is apparent from the above that by clicking on the "Real Estate" link that a user is offered a range of "Sponsored Links" relating to, amongst other things, real estate in New Zealand.

The Complainant contends that people seeking the Complainant's website are likely to be confused as to whether they have arrived at the right place. This confusion, it says, is likely to reflect badly on the Complainant's brand and is as a result disruptive of the Complainant's business.

The Complainant asserts that it is likely that people will be confused and mislead into believing that the site is in some way related to the Complainant.

The Complainant states that given the way the Respondent has used the Domain Name and set up its website that the Complainant is likely to lose traffic on its website and thereby suffer a loss of leads and thus revenue.

The Complainant notes that the Respondent's website is further misleading, in that it includes a link to the Complainant's own site, in the "Sponsored Links" section. It suggests that this again implies the Complainant is in some way related to the Respondent's site.

Finally, it states its belief that the Respondent has made other applications for similar domain names, including by way of example, <wwwasb.co.nz> and <wwwbnz.co.nz>.

The Complainant thus contends that the Domain Name registration is deleterious to the Complainant's business and should be transferred to it.

b. Respondent

No response was received.

6. Discussion and findings

In terms of paragraph 4.1 of the Policy, where a Complainant asserts that:

*The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; **and***

The Domain Name, in the hands of the Respondent, is an Unfair Registration

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

Paragraph 3 of the Policy (Definitions) defines “Unfair 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) 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.

As noted above, the Respondent did not reply to the Complaint. This requires the Expert to assess, as best as possible, the evidence and submissions filed by the Complainant. Likewise, in the absence of any contrary assertion or dispute those assertions and submissions are presumed, at least on the face of it, to be correct.

7. Decision

Rights

The Complainant asserts that it has used the trade mark/name Barfoot & Thompson and its abbreviation Barfoots for a number of years and as a result has acquired protectable rights in the trade mark/name. It is common for well known marks and names to be abbreviated. It is reasonable to infer that by virtue of its extensive use the Complainant is known and recognised both by its full and shortened names.

The Complainant has applied for the registration of the trade mark BARFOOT & THOMPSON and for the similar trade mark in device form as particularised above. Even though these trade mark applications have not proceeded to registration, they indicate the nature of the Complainant's interest in the trade mark Barfoot & Thompson. The applications also indicate that both marks are currently in use. Relevantly, the trade mark applications predate the registration of the Domain Name.

It is clear from the information provided by the Complainant that the trade mark/name Barfoot & Thompson has been extensively used in New Zealand in relation to, inter alia, real estate services. It is found that the Complainant has protectable Rights pursuant to the Policy and that this includes not just the words Barfoot & Thompson but also the shortened version Barfoot(s), this being an obvious form in which the trade mark/name would be used.

It is clear that what the Respondent has done is to register the shortened/abbreviated trade mark/name of the Complainant and appended to it, as a prefix, the web symbol "www". "www" is internationally recognised and generic and is likely to be taken as part of the designation <http://www>, rather than an operative and unique identifier which is exclusively associated with the relevant party. It is reasonable to infer that this is a deliberate step taken by the Respondent to come up with a domain name which is very similar to and likely to be confused with the domain name of a well known local entity.

On this basis it is found that:

- (a) The Complainant has Rights in respect of the trade mark/name Barfoot & Thompson and Barfoot(s).
- (b) The Domain Name is similar to the Barfoot & Thompson and Barfoot(s) trade mark/name.

Accordingly, the Expert is satisfied that the first element of the Policy has been met.

Unfair Registration

Paragraph 3 of the Policy requires a complainant to establish that one of the necessary requirements is established, namely that the domain name was registered or otherwise acquired in a particular way or has been used in a manner which is unfair or unfairly detrimental to the complainant's Rights. These requirements are stated in the alternative, meaning that in order to succeed a complainant need establish one or the other.

The Expert considers that in this particular case the Complainant's concerns are justified. This appears to be a relatively clear case of "typosquatting" or otherwise conduct akin to it. This view is based on the way in which the Respondent has set up its website with "Sponsored Links", some of which relate to rival real estate sites in New Zealand. There is also merit in the contention that by linking to the Complainant's website that this is likely to

create a mistaken assumption of association between the Respondent and Complainant.

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may be regarded as evidence that the Domain Name is an Unfair Registration.

Paragraph 5.1.2 refers to:

“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;”

It is found that the conduct complained of, whether it be characterised as “typosquatting” or something similar to it, falls within the wording of the above paragraph.

The evidence suggests that the Respondent (or its associates) has registered as domain names the names of other well known New Zealand companies, albeit with the addition of the prefix “www”. This is suggestive of a pattern of unfair registration at the expense of other well known New Zealand organisations. In the absence of any denial or purported explanation the reasonable inference is that it is being done to benefit the Respondent in some way, but in the absence of apparent rights.

Paragraph 5.1.3 refers to a situation where:

“The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .nz or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;”

The Expert finds that the evidence filed is indicative of engagement in a pattern of registrations contemplated by that paragraph and accordingly that the conduct complained of is covered by Paragraph 5.1.3.

On this basis, it is found that the Respondent’s conduct is unfair and detrimental to the Complainant’s Rights namely, that in terms of the requirements of the Policy that the Domain Name, in the hands of the Respondent, is an Unfair Registration

Accordingly, the Expert is satisfied that the second element of the Policy has been met.

The Complainant has established both parts of paragraph 4.1 of the Policy and is entitled to the relief sought.

In the result, the Expert orders that the Domain Name be transferred from the Respondent to the Complainant.

Place of decision

Auckland

Date

8 September 2006

Expert Name

Mr Clive Elliott

Signature