

.nz Dispute Resolution Service

DRS Reference: 145

Pacific Bereavement Solutions (NZ) Ltd v Clive Cooper and Andrew Breaker

Key words -

Registered mark – identical – similar – unfair registration – prior relationships between the parties – blocking registration

1. Parties

Complainant:

Mr Graeme Rhind
Pacific Bereavement Solutions (NZ) Ltd
Cnr Elliott & Wood Streets
Papakura
Auckland

Respondent:

Clive Cooper and Andrew Breaker
140 Old Main Road
Hastings

2. Domain Name

geeandhickton.co.nz (“the Domain Name”)

3. Procedural history

The Complaint was lodged on 18/10/2006 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 24/10/2006. The domain was locked on 18/10/2006, 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 22/11/2006 for a decision of an Expert, pursuant to Paragraph 9 of the InternetNZ Dispute Resolution Service Policy (“the Policy”).

Dr Clive Trotman, the undersigned, (“the Expert”) confirmed to InternetNZ on 23/11/2006 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 following information was provided by the Complainant, with supporting documentation.

The Complainant is the largest funeral service business operator in New Zealand, which includes the business (the “Business”) operating under the name “Gee & Hickton” (the “Name”) or similar. The Name has changed hands a number of times in its history and is now owned by the Complainant.

The Business continues to operate in the Upper Hutt and Lower Hutt region under the Name and has built up considerable reputation and goodwill in that Name since 1946.

The Complainant owns the trademark GEE & HICKTON, which has been in common law use since 1946. Formal registrations were made by BLENZ Limited (a related company of the Complainant) in September 1996 and September 2003 and the registrations were ultimately acquired by the Complainant for valuable consideration in May 2006 as part of an internal company restructure.

The Complainant became aware, when it attempted to register the Domain Name geeandhickton.co.nz, that it had already been registered by the Respondent.

The Respondent has not provided any factual information. According to the Complainant, the administrative contact of the Respondent is a former employee of the Business.

5. Parties’ contentions

a. Complainant

The Complainant contends that it has rights in a Name identical or similar to the disputed Domain Name and that it is the legal and beneficial owner of both the unregistered common law rights and the registered statutory rights in that Name. These rights trace back to unregistered common law rights to the trademark GEE & HICKTON from 1946 until 1996, and registered rights in and use of the trademark from 1996 until now. The trademark GEE & HICKTON is registered under number 267335 in class 42 (funeral services) and under number 701160 in classes 6, 19, 37, 43 and 44 (collectively monuments and certain funeral services).

The Complainant further contends that it has the Name in everyday use, and provides in evidence a selection of stationery, brochures, advertisements and directory listings featuring the Name.

The Complainant contends that registration of the disputed Domain Name by the Respondent is an unfair registration.

The Complainant says that the administrative contact of the registrant was, on 30 June 2005 when the Domain Name was registered, an employee of the Business but did not disclose to the Business his action in registering the Domain Name. Under his employment agreement he had a duty to act in the best interests of his employer and the employment agreement contained a provision that any original intellectual property arising from his employment remained the property of his employer. His action constituted registration in bad faith.

The Complainant contends that the Domain Name was registered by the Respondent either to offer it subsequently for sale to the Complainant or as a blocking registration, knowing of the Complainant's rights in the Name. The Respondent has not effectively used the website for more than a year but renewed its registration on 16 August, 2006.

The Complainant has cited as precedent a number of decisions of the Courts pertaining to domain names in the context of passing off and fraud, including *British Telecommunications PLC and Others v One in a Million Limited and Others* (English Court of Appeal); *Fletcher Challenge Limited v Fletcher Challenge Pty Limited* and *DB Breweries Limited v The Domain Name Company Limited & Ors*. WIPO Case No. D2000-0235 was also cited.

The remedy sought is the transfer of the disputed Domain Name from the Respondent to the Complainant.

b. Respondent

The Respondent has not made any submissions.

6. Discussion and findings

Procedural

The registrant is named in the formal Complaint document in the following form:

"Mr Clive/Andrew Cooper/Breaker
Clive Cooper - admin"

The NZ Domain Name Registry Ltd registration document records Andrew Breaker as the registrant and Clive Cooper as the administrative contact. In the body of the Complaint these two persons are designated as "together the "Registrant"" and Clive Cooper is referred to as "one of the Registrants". Section 3 of the Policy defines the Respondent as "the entity in whose name or on whose behalf a Domain Name is registered and against whom a Complainant makes a Complaint". Andrew Breaker is taken to be the formal Respondent.

The registrant and administrative contact provide a common physical address, a common telephone number and a common email address that in fact begins "cooper...". Copies of email and paper correspondence addressed to the Respondent were provided in the case file and the Expert is satisfied that all communications were properly addressed as required under the Policy, part B (Procedure) section B1 (Communication).

Paragraph 4.1 of the Policy requires the Complainant to prove both limbs of the following:

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

(4.1.2) The Domain Name, in the hands of the Respondent, is an Unfair Registration."

Whether the Complainant has rights in the Name

The trademark or Name in which the Complainant claims rights is "GEE & HICKTON". Copies of NZ Companies Office records submitted in evidence confirm that the Complainant as named is currently the owner of the trademark word GEE & HICKTON, and has been since 1996. Further documentation confirms a chain of ownership of the same Name through a succession of predecessor businesses spanning the previous 50 years.

Whether the Name is similar to the disputed Domain Name

The disputed Domain Name, geeandhickton.co.nz, is not exactly the same as the Complainant's trademarked Name. The level and country code identifiers ".co" and ".nz" respectively are to be disregarded, however, because they are inevitable parts of the Domain Name. That leaves the entity "geeandhickton", which is closely similar but not precisely identical to the Complainant's registered trademark because it contains "and" where GEE & HICKTON contains an ampersand, both in the deposited registration and in usage. The Domain Name is closer still to the pseudomark "Gee and Hickton" lodged in the Complainant's 1996 registration document.

For Internet purposes the disputed Domain Name directly corresponds to GEE & HICKTON because neither the ampersand nor space characters are accepted by the browser. Thus the Domain Name is as close to GEE & HICKTON as the technology has been configured to permit. It is at least confusingly similar, and in the context of Internet usage identical, to the Name in which the Complainant has rights. The Expert finds for the Complainant in the terms of Paragraph 4.1.1 of the Policy.

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

The cases decided in other fora cited by the Complainant were noted but in the event it has not been necessary to go outside of the comprehensive provisions of the Policy.

The Name GEE & HICKTON is distinctive. The probability of an unrelated company anywhere in the world having the same Name and being in a similar line of business by coincidence is vanishingly small. Evidence in the form of a salary journal (with the amounts obscured) covering the period from 6 April, 2005 to 31 August, 2005, showed that the registrant's administrative contact had been in the employment of the Complainant on 30 June, 2005, being the date when the registration was made. In the circumstances it is impossible to escape the conclusion that the Respondent registered the Domain Name in the constructive knowledge that it embodied the Complainant's Name.

The Respondent has not availed himself of the opportunity to explain why he did this or to justify his holding of the Domain Name in any of the terms of section 6 of the Policy. In particular, there are no circumstances that could suggest that the Respondent used a name similar to the Domain Name in connection with a genuine offering of goods or services, or has been commonly known by the Domain Name, or has made legitimate use of it (paragraph 6.1.1). The Domain Name is not generic or descriptive (paragraph 6.1.2). No evidence suggests that the Respondent holds the Domain Name by agreement with the Complainant (paragraph 6.1.3). There is no evidence that the Respondent contemplated a tribute or criticism site (paragraph 6.2), or could have used the Domain Name in question, in its present unqualified state, without infringing the Complainant's trademark.

Section 5 of the Policy lists a number of specific circumstances that shall be evidence of unfair registration, and the list is non-exhaustive. Those relating directly to the grounds stated in the Complaint are:

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

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

On the date of receipt of the Complaint by the InternetNZ Dispute Resolution Service, the Domain Name was found to be hosted by a service that offers free parking of domain names. This type of service has the incidental effect of confirming that a domain name exists but is not otherwise in productive use.

In overview the Respondent has paid money to register a probably unique and trademarked Name as a Domain Name for which no legitimate use in his hands is foreseeable and which is parked out of use, at least for the time being. It is reasonable to conclude that this was done with some ultimate objective in mind, which need not be monetary.

The use of a free parking facility is sometimes taken to imply that a domain name is available for sale by negotiation. Although in relation to paragraph 5.1.1(a) it “seems” to the Complainant that one possible purpose behind the registration of the Domain Name was to offer it for sale to the Complainant, by implication for a profit, in this case there is not sufficient evidence that this was intended.

The effect of the registration was, however, to block its availability to the Complainant, which the Complainant actually sought, and falls clearly within the scope of paragraph 5.1.1(b) of the Policy.

The Expert is satisfied that unfair registration has been proven under paragraph 5.1.1(b) of the Policy (a blocking registration), and the Respondent has not established under section 6 of the Policy that registration of the Domain Name was not unfair. The Expert finds for the Complainant under paragraph 4.1.2 of the Policy.

7. Decision

The Expert finds on the balance of probabilities that:

- (i) the disputed Domain Name is confusingly similar to a Name in which the Complainant has rights; and
- (ii) the Domain Name, in the hands of the Respondent, is an Unfair Registration.

In accordance with paragraph 13.1 of the Policy, the Expert directs that the disputed Domain Name `geeandhickton.co.nz` be transferred to the Complainant.

Place of decision Dunedin

Date 5 December, 2006

Expert Name Dr Clive Trotman

Signature