

.nz Dispute Resolution Service

DRS Reference: 168

Financial Services v Insurance Agent

Key words -

trade name, identical, commonly known by, prior relationships between the parties

1. Parties

Complainant:

Ms Joy Cooper

Financial Services

34 Roto-o-rangi Road

Cambridge

Respondent:

Mr Greg Noice

Insurance Agent

PO Box 475

Cambridge

2. Domain Name/s

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

3. Procedural history

The Complaint was lodged on 12/12/2006 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 15/12/2006. The Domain Name/s were locked on 12/12/2006, preventing any changes to the record until the conclusion of these proceedings.

The Respondent filed a Response to the Complaint on 16/01/2007 and InternetNZ so informed the Complainant on 16/01/2007. The Complainant filed a Reply to the Response on 23/01/2007. InternetNZ informed the parties on 16/02/2007 that informal mediation had failed to achieve a resolution to the dispute.

The Complainant paid InternetNZ the appropriate fee on 7/03/2007 for a decision of an Expert, pursuant to Paragraph 9 of the InternetNZ Dispute Resolution Service Policy ("the Policy").

4. Factual background

The Complainant is a self employed financial advisor who trades under the name Atlas Financial Services.

The Respondent is a self employed financial adviser and insurance agent. In 1997 he set up an agency arrangement and also traded under the name Atlas Financial Services.

For a period of time the Complainant and the Respondent shared office space in Cambridge but their relationship ended in 2002. In March 2005 the Complainant received an email from the Domain Name registrar Wave Internet advising that the Respondent had contacted them and requested the Domain Name be transferred to him.

A dispute arose as to who the Domain Name name belonged to. This proceeding is part of that dispute.

5. Parties' contentions

a. Complainant

The Complainant asserts that while the parties had been in a previous commercial relationship that when a dispute developed in 2005 as to who the Domain Name belonged to that it was resolved that she was the rightful administrator of the Domain Name and that the parties would both trade under Atlas Financial Services and that neither could claim sole ownership of the name

It is asserted that the Respondent contacted Ihug (who at that point had taken over from Wave Internet) advising that the Domain Name was his as that he is Atlas Financial Services and that consequent upon that the Domain Name was improperly transferred to the Respondent.

In response to the Respondent's submission, the Complainant contends that it is misleading. She disputes that the Respondent arranged a managing agency with Prudential Assurance as alleged and that all advisors had individual contracts with many insurance providers.

The Complainant accepts that the Respondent had full control over his business but asserts that likewise she had full control over her business.

She further asserts that at the time she registered the Domain Name the Respondent did not even own a computer and that he became an additional user to her site some four months later. Further, she states that at the time she registered the Domain Name her postal address was also P.O Box 475 Cambridge

She then asserts that Atlas Financial Services was named after a racehorse she owned and trained and was subsequently sold to Hong Kong interests and that the horse was called Atlas by Lowell out of Dame Eulogy.

Finally, the Complainant notes that the Respondent has only paid registry fees for the Domain Name since December 2006, and not before.

b. Respondent

The Respondent asserts that in 1997 he formed a Managing Agency with Prudential Insurance and that this was called Atlas Financial Services. He asserts that he is a sole trader in control of his business. He states that he had a number of agents working under the umbrella of Atlas Financial Services, one of whom was the Complainant Joy Cooper, until she resigned from the managing agency on 21 July 2002.

The Respondent provides evidence that he has in fact traded under the name Atlas Financial Services, at P O Box 475, Cambridge.

Finally, he states that since Atlas Financial Services purchased the Domain Name his credit card has been debited with charges monthly.

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.

7. Decision

Background

Before addressing the specific grounds it is necessary to traverse certain factual issues. It is apparent that according to invoices and payment details attached to the Complaint that the Complainant has in fact been paying both a registry fee and a domain name hosting service fee to Wave Internet and been doing so for some time. Further, there is no evidence that the Respondent has paid the monthly Domain Name charge until December 2006, which was when the Domain Name was transferred to the Respondent.

It is noted that the Domain Name was first registered on 6 April 1998. This indicates that it has been in the hands of the Complainant for a considerable period of time. It is also noted that the registrant contact name is Atlas Financial Services of PO Box 475, Cambridge and that the administrative contact name was until recently Joy Cooper whose contact email is <atlasins@wave.co.nz>.

Various documents are annexed to the Complaint. These purport to show that the Complainant is usually known by the name Atlas Financial Services. The documentation clearly indicates this to be the case. Of relevance is a copy of details of a cheque account from the ASB Bank and relating to the period in or about October 2005. That document is addressed to Cadet Holdings T/A Atlas Financial Services, c/o Joy Cooper. This suggests that Cadet Holdings was trading as Atlas Financial Services at that time.

Included in the material supplied to the Panel is a printout from the Companies Office providing details of a company Cadet Holdings Limited. This Company was incorporated on 25 November 1997 and struck off on 25 January 2006. The Panel notes that both Joy Cooper (the Complainant herein) and Gregory Noice (the Respondent herein) were named as directors (appointed on 25 November 1997) and as shareholders. This appears to support the Complainant's contention that both Complainant and Respondent trade under Atlas Financial Services. It also provides some foundation for the claim that neither can claim sole ownership of the name.

In support of her contention that the Registrar has improperly transferred the Domain Name to the Respondent, the Complainant attaches a copy of an email from Wave Internet dated 10 March 2005, asking whether the Domain Name indeed belongs to her and whether they had permission to transfer it. There is no evidence that such consent was given and it is unclear to the Panel how, in the face of an expressly declared dispute between the parties, that Ihug transferred the Domain Name to the Respondent on the basis that Complainant had overlooked amending the address on the Domain Name site.

While the Panel cannot and does not seek to resolve this issue, the question arises whether the Domain Name is legitimately in the hands of the Respondent and whether the DRS procedure is adapted to deal with situations of this type or whether the Respondent, by procuring the Domain Name in the way outlined above, is able to defeat or avoid the Complaint.

It seems to the Panel that in a way the parties to this dispute could, and arguably should, have been in reverse order, that is, with the current Respondent seeking to recover the Domain Name from the current Complainant. However, the fact that the parties are effectively in reverse order should not, in the Panel's view, prevent the Panel from trying to address the controversy between the parties, provided the necessary jurisdiction exists.

The underlying philosophy of the DRS is to provide parties in dispute over a .nz domain name with an efficient, effective and affordable dispute resolution service. In the Panel's view this must include dealing with the real controversy between the parties, if permitted by the Policy.

Rights

It is clear from the information provided by the Complainant that the trade name/mark Atlas Financial Services and Atlasins has been used in New Zealand in relation to, inter alia, financial services.

It appears that Complainant has rights in the name Atlas Financial Services by virtue of her use of that trading name for a period of time, as evidenced by the various correspondence. The distinctive part of that name is "Atlas". She has also provided a reasonable explanation for the derivation for the name, namely from a racehorse previously owned by her. It is also clear that the Complainant has used the address <atlasins@wave.co.nz> and has been the registrant of the Domain Name since 1998.

It is found that the Complainant has protectable Rights under the Policy in relation to Atlas that being the distinctive part of her trade name and also in the moniker "Atlasins" used as part of her e-mail address, this being a modification of the word Atlas but still identifiable with it.

On this basis it is found that:

- (a) The Complainant has rights in respect of the trade name/mark Atlas and Atlasins.
- (b) The Domain Name is similar to the Atlas and Atlasins trade name/mark.

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

Unfair Registration

The types of conduct and situations covered by the concept of unfair registration are not closed and ultimately depend on the circumstances. It appears from the submissions and evidence that the Complainant registered the Domain Name quite legitimately and that both the Complainant and the Respondent had an interest in and used the trade name Atlas Financial Services and the Domain Name itself. It also appears that they had a

previous commercial relationship and shared an interest in the trade name, mark and Domain Name.

However, it is common ground that the Domain Name was registered by the Complainant, not the Respondent and that she paid for the ongoing renewal of the Domain Name name, along with the hosting charges, for a number of years without objection from the Respondent. If there was a dispute as to whether the Complainant was legitimately entered as the Domain Name registrant, then arguably the Respondent could and should have dealt with such dispute under the DRS, this being the very purpose for the procedure.

Instead, it appears that the Respondent has procured the Domain Name registration by other means, which are not entirely clear and which the Complainant asserts involved convincing the Registrar that the Respondent, rather than Complainant, was the rightful owner of the Domain Name. How this occurred is not an issue before the Panel. However, the Panel is entitled to draw appropriate inferences from the situation. To the limited extent it needs to do so, the Panel finds that such transfer took place without Complainant's authority or consent.

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.

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 may well be that upon acquiring the Domain Name in December 2006 that people or businesses may be confused, misled or deceived into believing that the Domain Name is authorised by or connected with the Complainant. That is, given her previous status as registrant and her use of and/or association with the Domain Name and the trade name/mark Atlas over a period of time

However, paragraph 5.1.5 of the Policy is arguably more relevant. It states that evidence of Unfair Registration may exist if:

“The Domain Name was registered arising out of a relationship between the Complainant and the Respondent, and the circumstances indicate that it was intended by both the Complainant and the

Respondent that the Complainant would be entered in the Register as the Registrant of the Domain Name;”

The Panel take reference to registration as applying to either the original registration or the subsequent acquisition of the Domain Name.

In turn, paragraph 6 of the Policy sets out a number of factors that may be taken to account to demonstrate that the Domain Name is not in fact an Unfair Registration. Once again, the situation in hand (or a situation akin to it) is dealt with. Paragraph 6.1.3 of the Policy states:

”In relation to paragraph 5.1.5; that the Registrant’s holding of the Domain Name is consistent with an express term of a written agreement entered into by the Parties;”

The Panel finds that there is evidence of a relationship between the Complainant and the Respondent and the agreement or tacit consent to the registration of the Domain Name by the Complainant. That is, sufficient to establish that it was intended by the parties that the Domain Name would be registered by the Complainant. However, the Panel does not find, on the evidence, that the Registrant’s holding of the Domain Name is consistent with an express term of a written agreement entered into by the parties.

In other words, the Panel is of the view that the situation is more consistent with the contention that the current registration, in the hands of the Respondent, is unfair and contrary to the provisions of the Policy. The Panel concludes that, on balance, the Complainant is properly entitled to the Domain Name. That is, as the party who originally registered the Domain Name with the knowledge of the Respondent and in a situation where the Respondent allowed the Domain Name to remain in her hands for a number of years.

On this basis, it is found that the Respondent’s conduct is unfair and detrimental to the Complainant’s Rights and that the second element of the Policy has been met.

The Complainant has thus established both parts of paragraph 4.1 of the Policy and is entitled to the relief sought. In the result, the Panel orders that the Domain Name be transferred from the Respondent to the Complainant.

Place of decision

Auckland

Date

25 March 2007

Expert Name

Clive Elliott

Signature