

.nz Dispute Resolution Service

DRS Reference: 291

Auckland Airport v Dave Burghardt

Key words –

Domain name – aucklandairport.co.nz

Identical or similar trade mark or name

Unregistered mark – geographical identifier – mark with generic word

Procedure

Admissibility - materiality

1. Parties

Complainant:

Mr Mal Snaize

Auckland Airport

P O Box 73020

Auckland Airport

Manakau 2150

New Zealand

Respondent:

Mr Dave Burghardt

Dave Burghardt

P O Box 2397

Tauranga

NZ (NEW ZEALAND)

2. Domain Name/s

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

3. Procedural history

The Complaint was lodged on 3/06/2008 and the Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 6/06/2008. The domain was locked on 3/06/2008, preventing any changes to the record until the conclusion of these proceedings.

The Respondent filed a Response to the Complaint on 23/06/2008 and the DNC so informed the Complainant on 23/06/2008. The Complainant filed a Reply to the Response on 2/07/2008. The DNC informed the parties on

16/07/2008 that informal mediation had failed to achieve a resolution to the dispute.

The Complainant paid Domain Name Commission Limited the appropriate fee on 25/07/2008 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

4. Factual background

The Complainant is Auckland Airport Limited. The Respondent, Dave Burghardt, is the registrant of the disputed domain name www.aucklandairport.co.nz.

5. Parties' contentions

a. Complainant

The contentions of the Complainant include the following.

The Complainant does not rely on any registered trade mark. It states that Auckland International Airport, known internationally and commonly as Auckland Airport, is a well established organisation that has been operating as an international airport since 1966.

Further, it states that Auckland Airport is a gateway for New Zealand, attracting visitors locally and from overseas and generating a significant amount of income for New Zealand.

The Complainant also asserts that it is currently going through a rebranding exercise so as to refresh its existing website – www.auckland-airport.co.nz so to promote a "clean green image of both the airport and this country".

Under the heading of the Rights in the Name the Complainant also states:

"People seeking information, usually related to travel and holidays, search on key words and phrases including 'Auckland Airport' and would expect to be presented with links to the Auckland Airport website. Search engines such as Google pick up on the phrase 'Auckland Airport' and direct visitors to www.aucklandairport.co.nz as well as to www.auckland-airport.co.nz.

Hitwise statistics show that there are many hits initially on www.aucklandairport.co.nz which were a result of a search on Auckland Airport and is assumed to be the Auckland Airport website.

Those statistics also show around 49% of those hits then return to search engines indicating that the visit to www.aucklandairport.co.nz did not meet their expectation and Auckland Airport are of the opinion that their intended goal was to reach the Auckland Airport website."

The Complainant submits that the Respondent has unfairly registered the domain name for Auckland Airport as there is little or no connection between the Respondent's business (of being either a taxi or a car rental service) and the domain name for aucklandairport.co.nz. The Complainant also contends

that the registration of aucklandairport.co.nz by the Respondent, was to direct business away from the Complainant's website.

The Complainant also contends that the only function of the Respondent's domain name is to link the website aucklandairport.co.nz to the Respondent's car rental business and its website for this (namely www.carrentalnewzealand.com).

The Complainant further contends (and states that it is the view of specialists in web development and statistics) that the Respondent's domain name unfairly disrupts Auckland Airport's business. It also claims that the disputed domain name to a lesser extent misleads visitors into thinking that there is a connection between the Respondent's website and the Complainant.

The Complainant acknowledges that the Respondent's website includes some criticism of the Complainant's business. The Complainant also acknowledges Rule 6.2 of the DRS Policy (which provides that a Respondent may demonstrate that a domain name is not an unfair registration if it is a site operated solely in tribute or in criticism of a personal business). The Complainant asserts, however, that the links on the Respondent's website to other sites - which relate to other businesses activities carried out by the Respondent - suggest that criticism of the Complainant is not the sole purpose of the site.

The Complainant also refers to there being on the site a link to an objectionable page of "mild pornographic pictures" and that this clearly gives the impression that this content was provided by the Complainant, given the large banner at the head of the page.

The Complainant concludes that the Respondent's registration is unfair on the basis that:

- (a) It "mislead[s] Internet users searching for links to Auckland Airport"; and
- (b) "The nature and use of this link is irrelevant to the name and it is more appropriate that Auckland Airport [the Complainant] be given the opportunity to own the url www.aucklandairport.co.nz".

b. Respondent

The contentions of the Respondent include the following.

The Respondent contends firstly that the words "Auckland Airport" are a generic term and that the Complainant has no rights to the disputed domain name.

The Respondent says that he purchased the domain name on 11 October 2001 and the domain name and website have been very valuable assets to his business which is a car rental business and a car rental reservation service (trading under the names New Zealand Car Hire 2000 Ltd and New

Zealand Car Rental 2000 Limited respectively). Furthermore, to support those businesses, the Respondent owns and operates the websites www.carrentalnewzealand.com and www.carhire-newzealand.co.nz.

The Respondent states that his car hire business has vehicles based at an associate's depot at the Auckland Gateway Hotel – near the Auckland Airport. He says that his primary target market comprises international visitors arriving in New Zealand who want to rent a car. A large percentage of this clientele arrive into New Zealand via the Auckland Airport. Furthermore, the Respondent submits that his business marketing strategy is Internet based, in that he seeks to attract visitors to his website so that the visitor will book a rental car. "Numerous clientele" have made their first contact with the Respondent's business via the disputed domain name. Therefore, the Respondent asserts that the domain name is a valuable asset to his business and he would suffer considerable financial harm if it was transferred to the Complainant.

The Respondent states that he operates his car rental business and reservation services under the names of New Zealand Car Hire 2000 Ltd and New Zealand Car Rental Ltd respectively.

The Respondent linked the disputed domain name to his car rental business on 27 March 2003. From late in 2007, the Respondent contends that, as is his right, he began running a "light hearted commentary" on its website which was critical of the Complainant. This was launched around the time of the proposed sale of shares in the Complainant's business. The Respondent asserts that the purpose behind using the commentary was to increase the disputed domain name's search engine ranking on Google for the search term "Auckland airport" so as to increase traffic to his site.

The Respondent assumes that as the disputed domain name became more popular, the Complainant took notice of it. He notes that the Complainant has taken seven years to lodge an objection.

The Respondent denies that he has ever attempted to "fool/trick/mislead website visitors" into drawing a connection between the Respondent's domain name and the Complainant's website or its business.

The Respondent also refutes the Complainant's assertion that anyone using the search words "auckland airport" is solely looking for the Complainant's website. The Respondent contends that there are a number of other valid reasons for why people using search engine such as Google, Yahoo, MSN us search terms such as "auckland airport". These reasons include the following:

- (a) People looking for flight details;
- (b) People looking for accommodation;
- (c) People looking for rental cars;

- (d) People looking for taxis/buses; and
- (e) People looking for pictures of planes etc.

The Respondent also asserts that there would be no confusion caused to search users by the Respondent's domain name. This is due to the Complainant's site being the first result on Google's search result page. He notes that Google's top 10 sites under the search term "auckland airport" are first the Complainant's official site. Furthermore, Google's description of the Complainant's business on the search results page states that the Complainant's website is the "official site" and the Complainant's Google listing includes the following headings "Flight Information, International Departures, Passenger Information, Facilities etc". There are then (as at the date of this response) an airport bus company, a rental car company, an accommodation business, the disputed domain, a shuttle business, another accommodation business, and then a tourism portal. Finally he notes that there are 255,000 websites that appear under the search term "auckland airport".

The Respondent denies that he is attempting to draw customers away from the Complainant's official site, rather he states that he is legitimately using his domain name to attract customers to his own car rental business.

Finally, the Respondent asserts that the Complainant's submission is "a bit vague" and that the Complainant is not claiming any particular legal right to the words "auckland airport" in a domain name. The Respondent also contends that the Complainant has no rights whatsoever to any domain containing the words "auckland airport" other than the names which the Complainant already owns (which are auckland-airport.co.nz and auckland-airport.com).

c. Complainant's Reply to Respondent

The Complainant's Reply to the Respondent includes the following.

The Complainant notes the Respondent's claim that "Auckland Airport" is a generic term. The Complainant states the following:

"The Complainant denies that the term 'Auckland Airport' is generic, but that it is descriptive of the Complainant and the Complainant's business, that is the Airport in Auckland."

The Complainant contends that it was evident that at the time the Respondent registered the domain name the Respondent would have appreciated that many Internet users looking for the Complainant's website would likely key in the domain name aucklandairport.co.nz. The Complainant thus contends that the Respondent appreciated the likelihood of confusion and that the Respondent intended to attract to its domain name users looking for the Complainant's site.

Furthermore, the Complainant submits that the reason why the Respondent claims that the disputed domain name is valuable to it is because it diverts traffic from the Complainant's official site to the Respondent's site.

The Complainant rejects the Respondent's explanation that he registered the domain name so as to advertise to people searching for hire cars. The Complainant submits that if the Respondent wanted a domain name for its car hire business, there are other more logical domain names to use.

The Complainant also contends that the mere registration of the domain name was misleading as people would consider that the domain name is linked to Auckland Airport. Therefore the registration of the domain by the Respondent must have had the immediate or interim purpose of unfairly disrupting the business of the Complainant by intending to divert users looking for the Complainant's site to the Respondent's website.

The Complainant also contends that, as the Respondent failed to comply with Rule B.3.6 of the DRS Policy (which requires the Respondent to attach four copies of any evidence on which the Respondent relies), that the Respondent's Response must be invalidated.

The Complainant notes that the Respondent has removed offensive pictures from its website. The Complainant draws the assumption that this was in consequence to the filing of the Complaint by the Complainant. The Complainant also relies on the possession of offensive material on the website as being further evidence of the Respondent's bad faith in its registering of the domain name.

6. Discussion and findings

Preliminary

As a preliminary issue, it is necessary to deal with the Complainant's assertion in its Response that, as the Respondent failed to annex four copies of its evidence to its submission – (as required by the DRS procedure at B4.2.6), this "invalidates the Respondent's response".

In the present situation, in terms of supporting evidence, the Respondent annexed four copies of one exhibit referred to. In relation to other supporting material (being the archived history of the disputed website aucklandairport.co.nz) he asked the Expert to view this online through www.archive.org. This request to review the history of the Respondent's website was in support of his submission that in no manner had he ever attempted to mislead website visitors into thinking that his website was connected to the Complainant or its websites.

In relation to the Complainant's preliminary objection, the Expert does not regard the Respondent's actions as in any way invalidating its response. The Respondent properly supplied four copies of the one exhibit relied on. Further, there was nothing inappropriate in the invitation to the Expert to view previous

examples of the website in dispute through archive.org. Indeed, the response form prepared by the DNC and contained on its website has a section to be filled out by the Respondent inviting the Expert to view websites that the Respondent designates.

The Expert therefore rejects this preliminary challenge.

Rights in respect of the mark

For the Complainant to succeed under the DRS Policy, it must satisfy the following two requirements i.e. that:

- “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.”

Furthermore, “Rights” are defined in the Policy as follows:

“Rights includes, but is not limited to, rights enforceable under New Zealand law. 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 Complainant, in its Reply to the Respondent’s submission, makes the following statement:

“The Complainant denies that the term ‘Auckland Airport’ is generic, but that it is descriptive of the Complainant and the Complainant’s business, that is the Airport in Auckland.”

The Complainant has expressly stated that the mark which it relies on – Auckland Airport - is descriptive of its business. As noted above, the DRS Policy clearly sets out that a Complainant is unable to rely on rights in a name or term which is wholly descriptive of the Complainant’s business. Here, the Complainant is seeking to rely on a combination of two descriptive terms. A geographic location – Auckland, and a service - namely an airport.

In respect of descriptive words or names – particularly those of a geographical nature – there are a number of similarities between the DRS Policy and the Uniform Dispute Resolution Policy (UDRP) for top level domain names. Under the UDRP, a number of decisions have considered whether a Complainant has rights in an unregistered trade mark or name which includes or comprises geographic and/or descriptive terms.

These cases make it clear that for a Complainant to have rights in an unregistered mark of this nature, it must function as a trade mark. That is to say, the unregistered mark must perform the function of distinguishing the goods or services of one person in trade from the goods or services of any other person in trade: see *Brisbane City Council v Warren Bolton Consulting Pty Ltd* (Case No. D2001-0047).

In *Brisbane City Council* the Panel cited two earlier WIPO decisions in relation to combined geographic–descriptive domain names. These cases are: *Port of Helsinki v Paragon International Projects Limited* (WIPO Case D2001-0002) and *City of Hamina v Paragon International Projects Limited* (WIPO Case D2001-0001). Relying on those two cases, the Panel in *Brisbane City Council* stated the following:

“In both of the above two cases, the Panel was of the view that the legal authority of a geographic area does not, as a matter of principle, have an exclusive right to name or that area. This Administrative Panel agrees with that view.

... the Panel did [however] recognise that, in certain circumstances, the legal authority of a geographical area might, depending on the actual facts, have a trade mark right in the name of that area.”

In the *Brisbane City Council* case the Panel juxtaposed the two earlier Port decisions to show where an unregistered trade mark may be relied on to establish rights in a mark. In the *Port of Helsinki* case, the Panel denied that the Complainant had rights in the unregistered trade mark *portofhelsinki.com*. The panel held:

“In view of ... the fact that no market research or similar evidence has been submitted by a Complainant to prove establishment on the market in the sense of the trade mark law, the Panel cannot make a finding that trade mark rights exist in the denomination ‘Port of Helsinki’.”

However, a different view was reached in *portofhamina.com*. In that decision, the Panel found that the mark:

“... the name Port of Hamina may, in itself, be a trade mark for services and protected as such, irrespective of trade mark registration, if fulfilling the conditions required under Finnish law for the protection of non registered trade marked (service marks). The test applied to distinguish protected trade marks of this kind from those nonprotectible bears reference to whether the mark, *by its use, has acquired distinctiveness so as to distinguish the goods and services of one undertaking from those of other undertakings*. Under section 2 third paragraph of the Finnish Trade Marks Act the notion “established” is defined to mean that the mark has become generally known in the appropriate business or consumer circles in Finland as a symbol specific to its proprietor’s goods or services” ...

...

“Port of Hamina has acquired distinctiveness and become established in the meaning of the (Finland’s) Trademarks Act as a trademark/service mark relating to services originating from the City of Hamina/Port of Hamina. Consequently, Port of Hamina is a trademark/service mark to which the Complainant has rights.”

In that case, the Complainant had presented to the Panel evidence that the trade mark Port of Hamina was widely used in letterheads, brochures and advertisements. The Complainant had also put in evidence of Port of Hamina’s yearly turnover, the number of visitors, and number of ships which visit the port each year. Accordingly, the Panel found that under the Finnish

Trade Marks Act, that the Complainant had shown that Port of Hamina had acquired distinctiveness so that Port of Hamina served to distinguish the services of one undertaking, namely Port of Hamina, from those of other undertakings.

In *Brisbane City Council*, the Panel held that the evidence relied on by the Complainant was not sufficient to persuade the Panel that the unregistered mark BRISBANE CITY was performing the function of a trade mark. The Panel found that the mark BRISBANE CITY was descriptive of a geographic location, in this case the City of Brisbane.

In the present case the Expert can only make a decision on the evidence that is put forward by the Complainant. As noted already, in its reply the Complainant asserted that Auckland Airport was “descriptive of the Complainant and the Complainant’s business”. This is the very opposite of what a Complainant needs to establish.

The Complaint appears to have been prepared without any legal assistance. The Expert has considered the possibility that the Complainant, in stating that “Auckland Airport ... is descriptive of the Complainant and the Complainant’s business”, may have been intending to assert that the term was *distinctive* of the Complainant.

However no evidence has been advanced by the Complainant to show such distinctiveness. Evidence was submitted by the Complainant that a number of web users searching for Auckland Airport visit the Respondent’s website, and then subsequently leave, therefore indicating that the Respondent’s was not the site they were looking for. This in itself does not establish that the unregistered mark AUCKLAND AIRPORT is distinctive of the Complainant. Unlike the Port of Hamina decision referred to earlier, the Complainant did not present evidence as to the distinctiveness of the unregistered mark Auckland Airport, the length of use of this mark, or other evidence to show that the mark serves to distinguish the Complainant’s mark from those of other undertakings.

Accordingly the Panel is unable to find that the Complainant has rights in the words “Auckland Airport”. The Complaint is therefore dismissed.

Before leaving this point, it is important to record that in its online forms, the DNC goes out of its way to emphasise to Complainants the importance of providing evidence to support a Complaint and in particular the Rights which a Complainant asserts. The opening page of the Complaint form states in red type:

“It is essential that your case is backed by the fullest possible evidence you can provide. An Expert cannot make a decision based on just your word – any assertions you make should be backed up with documentary evidence.”

Specific information to assist the Complainant is given in the **Help** section of the Complaint form. This states:

"Name(s) and mark(s)

If you have a trade mark in this name, you should enter the trade mark number(s) here. If you do not have a trade mark, but are relying on the evidence of use of a name or mark, you should tell us which ones.

Description of Rights

You must provide to the Expert that, on the balance of probabilities, you have Rights in the name."

Finally, if a submission contains fewer than 500 words, a further prompt is given on screen emphasising the need to provide "details of your use and reputation in the name or mark".

7. Decision

For the reasons given, the Complaint is dismissed.

Place of decision	Auckland
Date	13 August 2008
Expert Name	Andrew Brown QC
Signature	

A handwritten signature in black ink that reads "Andrew Brown". The signature is written in a cursive, flowing style.