

.nz Dispute Resolution Service

DRS Reference: 343

Pacific Brands Holdings NZ Ltd v Visitec (NZ) Limited

Key words -

Identical or similar trade mark or name

Registered mark - unregistered mark - descriptive

Unfair registration

Unfair registration – likely to confuse, mislead or deceive - pattern of registration

1. Parties

1.1 Complainant: **Pacific Brands Holdings NZ Ltd**
c/o KPMG
18 Viaduct Harbour Ave
Maritime Square
Auckland
New Zealand

1.2 Respondent: **Visitec (NZ) Limited**
34 Apollo Drive
Mairangi Bay
New Zealand

2. Domain Name/s

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

3. Procedural history

3.1 The Complaint was lodged on 28/10/2008 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 31/10/2008. The domain was locked on 28/10/2008, preventing any changes to the record until the conclusion of these proceedings.

3.2 There was no response filed by the Respondent.

3.3 The Complainant paid Domain Name Commission Limited the appropriate fee on 4/12/2008 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

- 3.4 Mr Clive Elliott, the undersigned, (“the Expert”) confirmed to the DNC on 5/12/2008 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

- 4.1 The Complainant (Pacific Brands Holdings NZ Ltd) states that it is part of the Pacific Brands Group of companies and is the owner in New Zealand of the Totally Workwear trade mark, with registrations dating back to 2003.
- 4.2 The Complainant says that they and their licensees have been using the Totally Workwear brand for some time and have promoted that brand in relation to retailing of work wear and safety apparel, including clothing, footwear and headgear.
- 4.3 The Complainant advises that the Totally Workwear network of work wear retailers was established in Australia in 1965 and that the rights to the Totally Workwear brand in Australia and New Zealand were acquired by the Pacific Brands Group in 2001.
- 4.4 The Complainant advises that a related company called Pacific Brands Sport & Leisure Pty Ltd is part of the Pacific Brands Group and is the owner of the Totally Workwear brand in Australia, with registrations dating back to 1996. They also contend that this company is also the holder of the domain names totallyworkwear.com, totallyworkwear.com.au and totallyworkwearonline.com.au, through which it operates an information and retailing internet site for its work wear and safety products. The Complainant contends that New Zealand based businesses and individuals have purchased products from this site over a number of years with enquiries being referred to the totallyworkwear.com.au website.
- 4.5 The Complainant also contends that the Pacific Brands group has contracted with the providers of the Google website to ensure that a Google search for “workwear” on sites anywhere on the world wide web will list the totallyworkwear.com.au website as the first listing, which directs people to their site. It contends that this increases the profile of the Totally Workwear brand. The Complainant asserts that the Respondent’s workwear.com.au website is the third site listed on such a search.
- 4.6 It is submitted by the Complainant that the Pacific Brands Group has licensed retailers in Australia to use the Totally Workwear brand in relation to the retailing of work wear and safety apparel, which they contend is sourced by the Totally Workwear licensees from a range of manufacturers and distributors, including the Pacific Brands Group (under the KingGee brand) and, to a lesser extent, the Respondent (under its Visitec brand).

- 4.7 The Complainant asserts that since 2005 the Pacific Brands Group has conducted negotiations in New Zealand with a number of third parties to become licensees of the Totally Workwear brand, who would be permitted to conduct retailing businesses for work wear and safety apparel under the Totally Workwear brand.
- 4.8 The Complainant submits that as a result of the abovementioned activities, it believes that the Pacific Brands Group has a valuable reputation in the Totally Workwear brand in both Australia and New Zealand.

5. Parties' contentions

5.1 Complainant

- 5.1.1 The Complainant considers the registration of the Domain Name by the Respondent to be an unfair registration. It says that the Respondent is part of the Visitec Group of Companies, which is a wholesale supplier of work wear and safety clothing to the Australasian marketplace. The Complainant advises that the Visitec Group has offices in Sydney, Shanghai and Auckland as well as distribution facilities in Auckland, New Zealand and it invites the Expert to view the Group's websites.
- 5.1.2 The Complainant contends that the Visitec group supplies products to various retailers including a number of the Totally Workwear branded stores operated by the Complainant's licensees in Australia, since prior to the Respondent's registration of the Domain Name.
- 5.1.3 The Complainant says that when it became aware in May 2007 that the Respondent had registered the Domain Name and that it was linked directly to the Visitec group's website located at www.workwear.co.nz, it wrote to the Respondent requesting that it immediately cease use of the Domain Name (and any other domain name containing the name Totally Workwear) and that it transfer its registration of the Domain Name to the Complainant.
- 5.1.4 The Complainant says that it received no response, either in writing or verbally from the Respondent. The Complainant asserts that following its letter of 19 June 2007 the Domain Name ceased to be linked to the Visitec website. The Complainant notes that it has frequently monitored the Domain Name since that date and to the Complainant's knowledge the Respondent has made no other use of it.
- 5.1.5 The Complainant states that it has made repeated attempts by both its business representatives and the Pacific Brands' in-house legal counsel, in writing and by telephone, to enter into discussions or negotiations with the Respondent in an attempt to resolve the issue. The Complainant says that all such attempts to discuss the matter and all requests to sell or transfer the Domain Name to the Complainant have been ignored.

5.2 *Respondent*

5.2.1 There has been no response received from the Respondent.

6. **Decision**

6.1 The dispute is governed by the Policy issued by the office of the Domain Name Commissioner on behalf of DNC. The relevant portions of the Policy for present purposes are as follows:

“3. Definitions ...

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.

4. Dispute Resolution Service

4.1 This Policy and Procedure applies to Respondents when a Complainant asserts to the DNC according to the Procedure 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

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

5. Evidence of Unfair Registration

5.1 A non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration is set out in paragraphs 5.1.1 - 5.1.5:

5.1.1 Circumstances indicating 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;
or
- (c) 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;

5.1.3 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;

5.1.4 The Complainant can demonstrate that the Respondent has knowingly given false contact details to a Registrar and/or to the DNC; or

5.1.5 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;"

6.2 It will be seen that to support a complaint of this kind the Complainant must satisfy three elements:

- (a) Rights in respect of a name or mark (para 4.1.1);
- (b) Identity or similarity between that name or mark and the Domain Name (para 4.1.1); and
- (c) Unfair registration in the hands of the Respondent (para 4.1.2).

7. **(a) Rights in respect of a name or mark**

7.1 In terms of assessing whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name one first has to consider what the name or mark is and what it means.

7.2 As noted above, the expression "Rights" is defined in paragraph 3 of the Policy. The expression includes, but is not limited to, rights enforceable under New Zealand law. The provision further states:

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

7.3 The Complainant relies on trademark registrations in New Zealand and Australia. These trademark registrations include New Zealand trademark number 703768 for the words TOTALLY WORKWEAR in class 35 covering a range of retailing services conducted in relation to clothing and number 705842 for the words TOTALLY WORKWEAR in class 25 covering a range of clothing, footwear and headgear.

7.4 It is clear from the evidence that the term "work wear" is partly descriptive of the goods and services of the Complainant and Respondent and the Complainant acknowledges that both parties are involved in the supply of work wear and safety clothing to the Australasian marketplace. However, paragraph 3 of the Policy is directed to rights in a name or term "*which is wholly descriptive of the Complainant's business*". Paragraph 3 does not appear to apply in the present case because the Complainant's trademark consists of the combination of the

words TOTALLY and WORKWEAR, which in combination may be partly but not wholly descriptive.

- 7.5 In this regard I also note the assertion by the Complainant that it is part of the Pacific Brands Group, which group has a valuable reputation in the TOTALLY WORKWEAR brand in, inter alia, New Zealand. The submissions and information provided by the Complainant appear to support this assertion, which has not been challenged in any way by the Respondent.
- 7.6 The Complainant had gone to the trouble to obtain registration of its trademark in two classes and having done so and in the absence of any contradiction from the Respondent it is entitled to rely on these trademark registrations.
- 7.7 Accordingly, it is found that the Complainant has established the requisite Rights.

8. **(b) Identity or similarity**

- 8.1 The trademark TOTALLY WORKWEAR and the domain name **totallyworkwear.co.nz** are, apart from the gap between TOTALLY and WORKWEAR, for all intents and purposes identical.

9. **(c) Unfair registration**

- 9.1 As noted above, the Complainant asserts that the Respondent is part of the Visitec Group of Companies, which is a wholesale supplier of work wear and safety clothing to the Australasian marketplace. It further asserts that the Respondent supplies products to various retailers including a number of the Totally Workwear branded stores operated by the Complainant's licensees in Australia.
- 9.2 The Complainant states that at least in May 2007 that the Respondent was linked directly to the Visitec Group's website located at www.workwear.co.nz, but that this link has now been removed. Finally, the Complainant indicates that all its efforts to resolve the matter with the Respondent have come to nothing.
- 9.3 The question is whether the Domain Name, in the hands of and dealt with by the Respondent in this way, comprises an Unfair Registration. Paragraph 5 of the Policy provides guidance as to the type of conduct that may amount to or be indicative of an Unfair Registration. Given the Respondent's failure to file any submissions or evidence it is difficult to see which circumstances may or may not apply. However, paragraph 5.1.2 of the Policy reads:

"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;"

- 9.4 Given that the Complainant has registered the trademark TOTALLY WORKWEAR and has used the trademark in the course of trade in New Zealand, that the said trademark and the Domain Name are for all intents and purposes identical and that the parties are either direct or indirect competitors, it is reasonable to infer that some degree of confusion or deception of customers, potential customers and the public at large is likely to occur. Given this, it is found that the Domain Name is an Unfair Registration in the hands of the Respondent.
- 9.5 On this basis, the Complainant has established both parts of paragraph 4.1 of the Policy and the claim for relief is granted. Transfer of the Domain Name from the Respondent to the Complainant is ordered.

Place of decision

Auckland

Date

15 December 2008

Expert Name

Mr Clive Elliott

A handwritten signature in blue ink, appearing to be 'Clive Elliott', written in a cursive style.

Signature