

.nz Dispute Resolution Service

DRS Reference: 353

Wicked Campers v Escape Rentals

Key words -

Domain Name

wickedcampers.co.nz (the Domain Name)

Identical or similar trade mark or name

Registered mark – trade name – similar

Rights

Commonly known by

Unfair registration

Blocking registration — respondent having no connection with name or trade mark

Procedure

Remedies - transfer

1. Parties

Complainant:

The Wicked Cult Ltd
Represented by Mr Andrew Murphy
16 Atherton Street
Woolloongabba
Australia

Respondent:

Escape Rentals Ltd
Represented by Mr Andrew McGregor
Escape Rentals
7 Gore Street
Central City
Auckland
NZ (NEW ZEALAND)

2. Domain Name/s

2.1 wickedcampers.co.nz ("the Domain Name")

3. Procedural history

- 3.1 The Complaint was lodged on 17/11/2008 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 8/12/2008. The domain/s were locked on 17/11/2008, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 The Respondent filed a Response to the Complaint on 23/12/2008 and the DNC so informed the Complainant on 23/12/2008. The DNC informed the parties on 3/02/2009 that informal mediation had failed to achieve a resolution to the dispute.
- 3.3 The Complainant paid Domain Name Commission Limited the appropriate fee on 5/02/2009 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4 Hon Robert Fisher QC, the undersigned, (“the Expert”) confirmed to the DNC on 5/02/2009 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. The Parties

- 4.1 On a strict view this matter came before me as a phantom dispute between non-existent parties. The complaint described the Complainant as “Wicked Campers”. The Domain Name and response describe the registrant and Respondent as “Escape Rentals”. Neither is a recognisable legal entity. The documents go on to reveal much confusion over who is involved.
- 4.2 Rights attaching to the use of a Domain Name must be ultimately traceable to a legal person. Legal persons include natural persons (a specifically identifiable man, woman or child) and other legal entities having the power to sue or be sued such as limited liability companies and incorporated societies.
- 4.3 Business names, trading names, brand names and organisational names do not of themselves denote a legal person. At best they are a mask behind which the inquirer may be able to find the actual legal person or persons involved. That is why public registers of property are invariably confined to legal persons. Land, personal property and trade marks are good examples. If Domain Names are to have the status of legally recognisable intellectual property the same principles must apply.
- 4.4 In the present case the complaint was received from Mr Andrew Murphy of Woolloongabba, Australia, who submits to the jurisdiction in the first person singular. There are statements made in the first person plural such as “we operate in New Zealand as Wicked Campers” but

the identity of “we” is not stated. In support of the complaint a certificate of trade mark registration has been produced recording the registration of a relevant trademark in New Zealand in the name of a New Zealand company described as “The Wicked Cult Ltd”. The complaint asks that the remedy be a transfer of the Domain Name but the identity of the proposed transferee is unstated. A search of the Companies Register shows that a company “Wicked Campers Ltd” was incorporated on 12/02/04, the shareholder of which is “Getaway NZ Ltd” of Auckland.

- 4.5 If this complaint had been actively defended a more strict approach would have been required. The fact that it is effectively undefended justifies a pragmatic approach. I have decided to treat the complaint as one made by The Wicked Cult Ltd since that is the legal entity which holds the right on which those bringing the complaint appear to primarily rely. I have decided to treat Mr Andrew Murphy as a representative of that company for present purposes. I will also assume that the proposed transferee of the Domain Name is The Wicked Cult Ltd.
- 4.6 If I am wrong in those assumptions, and a different legal person wishes to bring a complaint in relation to the disputed Domain Name, it should be able to either come to an appropriate agreement with The Wicked Cult Ltd over the transfer of the Domain Name or bring a further complaint in its own name.
- 4.7 Identifying the respondent is more difficult. The problems began when the registrar of the disputed Domain Name, Free Parking Ltd, allowed registration in the name of “Escape Rentals”. There is no such entity as “Escape Rentals”. The registrar should have insisted on the name of an identified person or company.
- 4.8 When the Domain Name was registered “P O Box 1573, Shortland Street, Auckland” was recorded as the postal address and “(*email obfuscated*)” as the registrant contact email. Consequently upon receipt of the current complaint, the Domain Name Commission posted it to the Domain Name via the internet and also sent it by mail to “Mr Michael Boddy, Escape Rentals, P O Box 1573, Shortland Street, Auckland”.
- 4.9 In his reply Mr Boddy stated that he was the owner of the Domain Name, that he was a former shareholder in a company called “Escape Rentals Ltd”, that he has since sold his shares in that company, that he had retained ownership of the Domain Name, and that he hoped to use it for another business to be launched in 2009. He enclosed a letter from the Chief Executive Officer of a company described as Escape Rentals Ltd confirming that the disputed Domain Name was owned by Mr Boddy and going on to state that “the registration under Escape Rentals Ltd is incorrect and the Domain is to be transferred as soon as possible”.

4.10 In addition to Mr Boddy's reply, a response form has been received from Mr Andrew McGregor showing "Escape Rentals" as the Respondent, P O Box 1573, Shortland Street, Auckland as the postal address, Mr McGregor's mobile telephone number and (*email obfuscated*) as the email address. The document states:

- The www.wickedcampers.co.nz domain is incorrectly registered to Escape Rentals Ltd. The attached letter from the CEO confirms this.
- The Freeparking account registering the domain to Escape Rentals Ltd is incorrect and will be changed when possible.
- Escape Rentals Ltd has its own account where it holds its Domain Names.
- The owner of the URL is Michael Boddy a former shareholder in Escape Rentals Limited.
- Escape Rentals Ltd was sold last year to private investors.
- Michael Boddy has no financial interest in Escape Rentals Ltd and no involvement with Escape Rentals Limited.

Therefore the basis for this action as per the correspondence is invalid as Escape Rentals Ltd should not be the registered holder of the domain.

You should contact Michael Boddy to sort out this matter.

4.11 Making the best of this unsatisfactory situation, I have decided to treat the current registrant of the disputed Domain Name as Escape Rentals Ltd. The most likely scenario is that at the time of the registration in 2003 there was such a company; that at that time Mr Boddy was one of its shareholders; that he was acting as its agent in registering the Domain Name, and that registration in the name "Escape Rentals" was no more than an inept way of referring to that company. There is no record of the transfer of the Domain Name to any other person.

4.12 I therefore proceed on the assumption that this is a dispute between The Wicked Cult Ltd as Complainant and Escape Rentals Ltd as the registrant of the disputed Domain Name. I have recorded those names as the parties in the entitlement to this decision and have shown Mr Andrew Murray and Mr Andrew McGregor as the relevant representatives.

5. Factual background

5.1 The name "wickedcampers.co.nz" was registered by Free Parking Ltd as registrar on 14/11/03. It appears that at that time Escape Rentals Ltd was in the business of providing camper vehicles for hire but there is no evidence that it has ever used the Domain Name in the course of its business.

5.2 There is no direct evidence as to the business operations of The Wicked Cult Ltd but it has produced a certificate of trade mark registration of 8/09/04 registering the name "Wicked" in relation to

Class 39 which refers to “transport services, rental/hire of vehicles including camper vans; transport reservation; camper van hire/rental information and advisory services”.

- 5.3 Mr Murphy states on behalf of the Complainant “we operate in New Zealand as Wicked Campers”. He has also drawn attention to the websites www.wickedcampers.com, www.wickedcampers.com.au, www.wickedcampers.co.uk and www.wicked-campers.co.nz.
- 5.4 I think it reasonable to infer that the Complainant is a New Zealand subsidiary or licensee of a multi-national business which offers camper vans for hire and that for some unknown period the multi-national business has been in operation in New Zealand.

6. The Complaint

- 6.1 The Complainant says:

Escape Rentals have registered www.wickedcampers.co.nz to prevent us registering the same name. They do not use it (it is parked) and it is not aligned with their business name. We are a direct competitor with Escape Rentals. Currently we need to use a more complex Domain Name to promote our business in New Zealand – www.wicked-campers.co.nz”.

7. The Response

- 7.1 I have quoted the response above. In essence the Respondent admits that it has no right to the Domain Name, while asserting that it belongs to a third person who has never appeared on the register.

8. Discussion

- 8.1 For reasons referred to earlier, it is necessary to assume that Escape Rentals Ltd is the current registrant of the disputed Domain Name notwithstanding the denial of that position by both that company and Michael Boddy. It would always have been possible for Escape Rentals Ltd to arrange to have the Domain Name transferred to Michael Boddy by agreement had that been the intention. That has never occurred and the Complaint must proceed according to the status quo.
- 8.2 If Michael Boddy has rights in relation to the Domain Name it will be for him to assert those rights in properly constituted proceedings against Escape Rentals Ltd or a complaint against whoever is the current registrant of the disputed Domain Name at the relevant time. I make no comment on whether any such proceedings or complaint would succeed. I regret that Mr Boddy has no standing in the current dispute. The current dispute is confined to rights as between The Wicked Cult Ltd and Escape Rentals Ltd.

- 8.3 There being no agreement between the Complainant and the Respondent, the Complainant must establish its case on the merits, albeit without challenge to its evidence.

9. Discussion and findings

- 9.1 The dispute is governed by the Policy issued by the office of the Domain Name Commissioner on behalf of DNC. Critical portions of the Policy for present purposes are these:

“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;”

9.2 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).

10. (a) Rights in respect of a name or mark

10.1 There is no doubt that the Complainant has rights in respect of the trade mark “wicked”. That in itself satisfies the first requirement.

10.2 Another source of rights appears to be goodwill in the name “wicked” in connection with the hire of camper-vans. Little information has been provided as to the factual background but the complaint is proceeding on an undefended basis. It seems reasonable to infer that the Complainant had and has an established goodwill in New Zealand in the name “wicked” used in connection with the hiring of camper vans.

11. (b) Identity or similarity between the name or mark and the Domain Name

11.1 The second requirement is to show that the Complainant’s name or mark is identical or similar to the Domain Name.

11.2 Whether a name or mark is to be regarded as “similar” to a Domain Name must be decided having regard to the context in which each is used or likely to be used.

11.3 In the present case “wicked” forms only part of the disputed portion of the Domain Name “wickedcampers”. However the word “wicked” is a memorable one in a commercial context. At least in its primary meaning, it is pejorative. Descriptive words used in a commercial context are usually laudatory, or at the very least neutral. Among a select few - largely teenagers - the word has also acquired a recent and secondary meaning of approval. Either way the word attracts attention.

11.4 The Complainant uses its name and mark in the context of hiring camper-vans. The Domain Name includes a reference to campers. Given that context I conclude that the Complainant’s name and mark are similar to the Domain Name for present purposes.

12. (c) Unfair registration in the hands of the Respondent

- 12.1 The third requirement is unfair registration. The Policy includes a non-exhaustive list of factors which may be evidence of unfair registration (paras 5.1.1 to 5.1.5).
- 12.2 There is no evidence of unfair registration of the kinds listed in paras 5.1.2 to 5.1.5. In particular, there is no suggestion that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive (para 5.1.2). On the contrary, the evidence is that the Respondent is not currently using the Domain Name and has no intention of doing so. Nor is there any evidence that the Respondent registered the Domain Name for the purposes of selling, renting or transferring it (cl 5.1.1(a)).
- 12.3 However the Complainant alleges that the Respondent registered the Domain Name "to prevent us registering the same name". That allegation has not been denied. "Wicked" is an unusual word to use in any commercial context, let alone in connection with camper-vans. It must be more than coincidence that the Respondent, which is a competitor of the Complainant, chose to register a Domain Name containing the same word.
- 12.4 I conclude that the Complainant is right in its allegation this was a blocking registration. It was a blocking registration against a name or mark in which the Complainant has rights. This is evidence of an unfair registration in terms of cl 5.1.1(b) of the Policy.
- 12.5 I conclude that the Respondent's registration was an unfair one for the purposes of the Policy. All three requirements for a complaint of this kind have been satisfied.

13. Decision

- 13.1 The Complaint is upheld. I direct that the disputed Domain Name "wickedcampers.co.nz" be transferred to the Complainant or its nominee.

Place of decision:

Auckland

Date:

17 February 2009

Expert Name

Hon Robert Fisher QC

Signature: