

.nz Dispute Resolution Service

DRS Reference: 372

Metrotest.Com Ltd v David Rohani

Key words -

Unregistered mark – similar or identical – unfair registration – likely to confuse, mislead or deceive

1. Parties

Complainant:
Metrotest.Com Ltd
Sheila Goldthorpe
P O Box 95
Blenheim
New Zealand

Respondent:
David Rohani
P O Box 21858
Henderson
Auckland
New Zealand

2. Domain Name/s

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

3. Procedural history

The Complaint was lodged on 11/02/2009 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 16/02/2009. The domain/s were locked on 11/02/2009, preventing any changes to the record until the conclusion of these proceedings.

There was no response filed by the Respondent.

The Complainant paid Domain Name Commission Limited the appropriate fee on 16/03/2009 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

4. Factual background

- 4.1 The Domain Name was first registered on 20 November 1999 when the registrant was Mark Goldthorpe. The Goldthorpe Family Trust, a trading trust, had traded as Metrotest New Zealand (Metrotest NZ) from late 1998.
- 4.2 The business adopted the name Metrotest NZ because its United Kingdom supplier at that time traded under the name of Metrotest Instruments. At the time the website www.metrotest.co.nz was launched on 13 November 2001, Metrotest NZ's business included selling all types of electrical testing instruments, both direct to customers and through electrical wholesalers in New Zealand, running electrical safety/testing training courses, running an electrical safety testing consultancy service, running an electrical safety testing and tagging service and carrying out many other types of electrical work. It operated nationwide.
- 4.3 On 10 December 2002, Metrotest NZ registered the domain name metrotest.com. The registrant was Sheila Goldthorpe and her address was given as Sheila@metrotest.co.nz. In late 2002 webhosting commenced under the name metrotest.com.
- 4.4 In January 2003 the Domain Name was transferred to Freeparking.
- 4.5 On 9 December 2005 the Complainant was incorporated. Mark and Sheila Goldthorpe were and are the shareholders and directors.
- 4.6 The Complainant did not re-register the Domain Name when it expired on 20 October 2008. Its position is that re-registration was overlooked and inadvertent. The Domain Name was cancelled on 24 October 2008.
- 4.7 The Domain Name was registered to the Respondent on 23 January 2009.

5. Parties' contentions

a. Complainant

- 5.1 The Complainant claims to have established itself within New Zealand as a leading company in the areas of electrical testing instruments and all areas of electrical safety testing and training and have built up a substantial reputation and goodwill in both New Zealand and Australia. It has produced evidence of its customer relations with many of New Zealand's top commercial companies, universities and other entities.
- 5.2 The reason given by the Complainant for not re-registering the Domain Name was that the directors were under the mistaken belief that the expiry date was the same for both the Domain Name and the name metrotest.com. Its position is that the non-renewal was not a deliberate act or a desire to no longer use the Domain Name. It was an omission.

- 5.3 The Complainant claims it has Rights in respect of a name or mark which is identical or similar to the Domain Name and relies upon:
- (a) It has for many years traded under the name METROTEST;
 - (b) The prominence of the word METROTEST in its company name;
 - (c) Considerable expenditure on advertising and promotions including magazine advertising, trade shows, guest speaking, brochures, letterheads, website optimisation and many other promotions in which the name Metrotest is the predominant name;
 - (d) The use of the Domain Name from November 2001 to the date of expiry in October 2008, or at least until it was parked.
- 5.4 The Complainant says that the registration of the Domain Name to the Respondent is an Unfair Registration for the following reasons:
- (a) The Respondent has registered the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights (clause 5.1.1(b) of the Policy). The business for which the Respondent is using the Domain Name is an online electrical safety and related industry site. The two businesses are therefore visually identical;
 - (b) The use of the name Metrotest constitutes "passing off" in terms of the Fair Trading Act 1996 and is therefore blocking the use for the Complainant;
 - (c) The Respondent has registered the Domain Name primarily for the purposes of unfairly disrupting the business of the Complainant (clause 5.1.1(c) of the Policy). The Respondent is taking traffic meant for Metrotest and giving many different company listings for difference electrical safety areas including competitors of the Complainant;
 - (d) The Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or business into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (clause 5.1.2 of the Policy);
 - (e) The Respondent is engaged in a pattern of registrations where the Respondent is the registrant of Domain Names 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 (clause 5.1.3 of the Policy). In respect of this allegation, evidence was supplied that the Respondent was the registrant of the following:
 - (i) ripcord.co.nz which is to be compared to ripcord.com of which the Respondent is not the registrant;

- (ii) analogue.co.nz which is to be compared to analogue.com of which the Respondent is not the registrant;
- (iii) lpals.co.nz which is to be compared to lpals.com of which the Respondent is not the registrant; and
- (iv) linkmeup.co.nz which is to be compared to linkmeup.com.

b. Respondent

5.5 The Complaint has been served on the Respondent but the Respondent has not replied or filed any submissions in this matter. It is necessary to consider the Complaint without the benefit of any reply from the Respondent.

6. Discussion and findings

- 6.1 The Complainant is in part the author of its own problem. It overlooked re-registering the Domain Name.
- 6.2 The Complainant is required to prove on the balance of probabilities:
- (a) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - (b) The Domain Name, in the hands of the Respondent, is an Unfair Registration.
- 6.3 Rights include, but is not limited to, rights enforceable under New Zealand law. The Complainant does not have a registered trade mark. It relies on an unregistered trade mark which has achieved reputation in fact. In considering whether it has established a right to such a mark, the level and country code identifiers ".co" and ".nz" respectively are to be disregarded. It is therefore necessary to consider whether the Complainant has Rights in the mark METROTEST.
- 6.4 The Complainant, or its predecessor the Goldthorpes, has used the name METROTEST since 1998. It was purchasing supplies from the United Kingdom supplier, Metrotest Instruments. The evidence establishes on the balance of probabilities that it has built up its business under the name of Metrotest and that name is synonymous with the Complainant's business. It has spent a considerable sum in advertising and promoting its business under the name of Metrotest over a period of a decade. It has a wide-ranging clientele throughout New Zealand. The name Metrotest appears in its company name, as well as in its other domain name metrotest.com. It has for a period of the best part of a decade used the Domain Name. It has to the required satisfaction established that it has achieved a reputation in fact in the unregistered trade mark METROTEST.

- 6.5 The evidence also establishes to the required standard that the provisions of clause 5.1.2 of the Policy apply. The use by the Respondent of the Domain Name in a way in which it is being used 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. That evidence includes:
- (a) The Respondent's website refers to many business activities which are similar to those carried on by the Complainant. There are related links to electrical wiring, electrical safety, electrical installation and other such matters. There are references to electrical courses, electrical compliance, electrical safety and many other matters which are similar to those matters appearing on the Complainant's website metrotest.com. A search using "Domain Tools" on 1 February 2009 gives details of the Domain Name but has the metrotest.com webpage pictured within the body of the search;
 - (b) A search of NZ Search for electricians gives a listing for Metrotest New Zealand but with the web address as www.metrotest.co.nz, the Respondent's website, but the contact details link is to Sheila Goldthorpe;
 - (c) If the Domain Name is put into the Google search engine, the question asked is "Did you mean: metrotest.com";
 - (d) The past use by the Complainant of the Domain Name means that it is already related to the Complainant's business and the use of the same trade name by a competitor is likely to confuse, misled or deceive other businesses;
 - (e) The evidence establishes frequent internet communications between the Complainant and industry members. Industry members are likely to be confused by the use of the Domain Name by a competitor of the Complainant, particularly when the Domain Name had originally been used by the Complainant itself;
 - (f) An inference can clearly be drawn on the facts that many companies and businesses who have previously dealt with the Complainant are likely to be confused, misled and deceived by another company, using the name Metrotest, operating on the Domain Name in a similar line of business.
- 6.6 In the circumstances the Complainant has satisfactorily proved that it has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Unfair Registration.

7. Decision

It is ordered that the Domain Name be transferred to the Complainant.

Place of decision: Auckland
Date 26 March 2009
Expert Name B J Paterson QC

Signature

A handwritten signature in black ink, appearing to read 'B J Paterson', written over the printed name 'B J Paterson QC'.