

.nz Dispute Resolution Service

DRS Reference: 399

The Animal Welfare Institute of New Zealand v Animal Welfare in New Zealand

Key words –

Domain name

awinz.org.nz ("the Domain Name")

Registered mark, unfair use, likely to confuse, mislead or deceive, prior relationships between the parties, unfairly disrupting the business of the complainant, evidence, admissibility, weight, non-standard submission.

Parties

Complainant:

The Animal Welfare Institute of New Zealand

Mr Neil Wells

PO Box 60 208

Titirangi

Auckland

New Zealand

Respondent:

Animal Welfare in New Zealand

awinz08@gmail.com

Auckland

New Zealand

Domain Name

awinz.org.nz ("the Domain Name")

Procedural history

1. The Complaint was lodged on 21/05/2009 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 26/05/2009. The domain was locked on 21/05/2009, preventing any changes to the record until the conclusion of these proceedings.
2. The Respondent filed a Response to the Complaint on 17/06/2009 and the DNC so informed the Complainant on 17/06/2009. The DNC

informed the parties on 14/07/2009 that informal mediation had failed to achieve a resolution to the dispute.

3. The Complainant paid Domain Name Commission Limited the appropriate fee on 28/07/2009 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").
4. Mr Clive Elliott, the undersigned, ("the Expert") confirmed to the DNC on 28/07/2009 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.

Factual background

5. The Complainant is The Animal Welfare Institute of New Zealand, or in abbreviated form AWINZ. It was formed as a not-for-profit charitable trust in 1999. The Ministry of Agriculture approved the organization under the Animal Welfare Act 1999 in February 2001. The purpose of the trust is to promote the welfare of animals and in furtherance of this purpose it has a number of objects including the prevention of ill treatment to and suffering of animals and generally to promote a range of animal welfare services.
6. The Respondent is identified as Animal Welfare in New Zealand. In terms of contact details what is provided is a gmail address <awinz08@gmail.com> . This e-mail address is used by Jenny Smith who indicated in e-mail correspondence with the Dispute Support Officer of the Domain Name Commission on 23 June 2009 that she was transient at that time and did not have a fixed address. She did however state that a certain Grace Haden was not the correct respondent.
7. As will become apparent below, while Grace Haden was actively involved in correspondence with the Domain Name Commission and has had a close involvement in the wider dispute that the Respondent in this proceeding is an unincorporated entity known as "Animal Welfare in New Zealand". It also appears that the Respondent is represented in this proceeding by Jenny Smith, even though her role or capacity is not clear. Finally, it is inferred that while Grace Haden has no formal role in this domain name proceeding that she is directly or indirectly associated or connected with the entity Animal Welfare in New Zealand and is likely to have an interest in the Domain Name.
8. That said, the exact identity of the Respondent is unclear. It is apparent from paragraph 24 to 26 of the Judgment of Judge Joyce QC (referred to in paragraph 12 and elsewhere below) that the first defendant (Grace Haden) described herself as a licensed

private investigator, as a director of the second defendant (Verisure) and as trustee of the third defendant. The third defendant was previously known as "Animal Welfare Institute of New Zealand (Inc)" but was at least as at March 2008 identified as the "Animal Owners Support Trust (Inc)".

9. The registered proprietor of the AWINZ trade mark is Animal Welfare Institute of NZ Ltd of Tauranga. Again, this appears to be a different legal entity to the Respondent. However, the Respondent states that "AWINZ is the registered trade mark of the Animal welfare Institute of New Zealand Ltd" (sic) presumably as the basis for a submission that the Respondent rather than the Complainant is properly entitled to the AWINZ trade mark. This suggests that Animal Welfare in New Zealand and the Animal Welfare Institute of NZ Ltd have some connection or association, whether formal or otherwise.
10. It appears that the Domain Name is not currently active. The Expert was invited to view the website at the address <www.awinz.org.nz>. On 11 August 2009 the following message appeared:

Address Not Found

www.awinz.org.nz could not be found. Please check the name and try again.

Parties' contentions

Complainant

11. Complainant asserts that it should have in its control the Domain Name due to the exact match of name and its .org.nz status. In support of its complaint the Complainant states that legal proceedings have been issued in connection with the Domain Name. Further, it is asserted that if anyone else uses the Domain Name it "may be in direct breach of reputation".
12. Principal reliance for this submission was placed upon the Judgment of Judge Joyce QC. The Judgment is *Wells v Haden* [2008] DCR 859, District Court, Auckland. The parties are Neil Edward Wells, Wyn Hoadley and Graeme John Coutts as trustees of the Animal Welfare Institute of New Zealand (First Plaintiffs) and Neil Edward Wells (Second Plaintiff), Grace Haden (First Defendant), Verisure Investigations Limited (Second Defendant) and Animal Welfare Institute of New Zealand (Third Defendant).
13. In particular the Complainant relies on paragraphs [354] to [361] of the Judgment. The complaint stated that a PDF copy of the court judgment could be provided, if required. On 4 August 2009 the Expert was contacted briefly by phone, by a barrister acting for the Complainant to enquire whether the Expert required a copy of the Judgment or any other assistance. The Expert declined the offer.

14. The statement of claim in the District Court Proceedings originally sought remedies for passing off, under the Fair Trading Act 1986 and for defamation. The hearing on 13 March 2008 was by way of formal proof as the defences and counterclaims of the defendants had previously been struck out. Nevertheless, the defendants provided extensive evidence and advanced arguments directed at the issue of mitigation. The Judgment of 30 July 2008 is extensive, 93 pages in length, and canvassed a number of factual and legal issues between the parties.
15. It is not necessary to refer in detail to the Judgment other than perhaps to note the Judge's conclusion that it was necessary to grant relief against the defendants, referring to the dispute as a "sorry saga" (paragraph 143) and in relation to certain pleaded acts of defamation that Mrs. Haden had "made mountains out of a molehill" and that Mrs. Haden and her company Verisure had engaged in conduct that was "remarkable for their plain vindictiveness".
16. Further, the Expert was provided with a copy of a Post-judgment Costs Minute of Judge Joyce QC dated 11 November 2008 where the Judge referred to Mrs. Haden's practice of "repeated filing of papers of great prolixity and obscurity" (paragraph 71) and (at paragraphs 81 and 82) of having "an ulterior motive in embarking upon" an "unrelenting mission to seek and wreak vengeance for the wrong she perceived to have been done to her....".
17. It is apparent from the above that a number of matters of real controversy exist between these parties and that they had been involved in a long and acrimonious dispute over issues, one of which includes the abbreviation or name AWINZ.
18. Directly relevant to the dispute over the Domain Name are the findings of the Court (at paragraphs 353 to 357) which are set out in full below:

PASSING OFF

The relief finally sought against Mrs Haden here was an injunction:

- (a) *restraining Mrs Haden or her servants or agents from using the name "Animal Welfare Institute of New Zealand" or "AWINZ"; and*
- (b) *requiring her to close the website www.awinz.co.nz and deactivate the domain name.*

The point was made here that Mrs Haden's company, Animal Welfare Institute of New Zealand Limited, purported now to own the

domain name and had acquired as a trademark AWINZ.

The submission was that the practical (and desirable, indeed necessary) effect of an injunction as sought would be to require Mrs Haden, in her capacity as sole director and shareholder of that company, to change the company's name, abandon (or at least cease to use) the trademark, close the website and deactivate the domain name.

This Court has no jurisdiction in terms of the enforcement of the Trademarks Act 2002 but I do not see that to inhibit imposition of a prohibition on a trademark's use when, in the hands of its present owner, it is no more than a vehicle to do unlawful damage.

I consider that approach to be both practical and principled, and there will be injunctive relief as sought.

Respondent

19. The Respondent states that "As far as I am aware, legal proceedings have not been issued or terminated in connection with the Domain Name(s)."

20. The Respondent asserts that "the name is being used with their knowledge and permission". It is unclear which name or entity is being referred to. The Respondent goes on to state that "I know that the judgment which had been supplied is under appeal and that Mrs. Haden is filing a complaint of perjury against Mr. Wells with the police." This suggests that the response (which is phrased in the first person) is from someone other than Mrs. Haden. (See comment above in paragraph 7).

21. The Respondent then states that "I am not involved in the court process or appeal". However, it is noted from correspondence on the Domain Name Commission file between Grace Haden and the Dispute Support Officer dated 8 June 2009, that she states that:

"I have appealed the judgment .and am waiting the High court decision (it was heard in February this year), this effectively means that the judgment has no standing ." (sic)

22. The Respondent asserts that the Domain Name was available and was not being used by any other party. The Responded further asserts that the Complainant "animal welfare institute of New Zealand" is not an entity and does not exist as an entity and cannot make a complaint because it only a trading name used by various people at various times. It goes on to say that the unincorporated group of people who claim to use the name "animal welfare institute of New Zealand" have no exclusive right to the name AWINZ.

23. Further, it is contended that the AWINZ trade mark was not contested by the Complainant and that the original owners of the AWINZ trade mark offered the trade mark to Mr. Wells and his associates but they declined to purchase it.

24. Reliance was placed upon trade mark registration number 747889 for AWINZ dated 15 MAY 2006. The registered trade mark is current until 15 May 2016. It is registered in class 41 in relation to education services relating to the care of animals. As noted above in paragraph 9 above the trade mark registration is owned by Animal Welfare Institute of NZ.

Decision

25. 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;"

26. 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).

Procedural Issues

27. Before addressing the substantive grounds it is necessary to first deal with two preliminary procedural points.

28. Paragraph B9.1 of the Policy "Communication Between Parties and the Expert" states that the "*A Party and the Expert must not communicate directly. All communication between a Party and the Expert must be made through the DNC.*" The purpose of this rule is clearly to prevent inappropriate and potentially unfair ex-parte contact with the Expert. The contact referred to in paragraph 13 above was uninvited and unwise. However, given the brief and very limited nature of the discussion it was ignored by the Expert and forms no part of this decision.

29. The second issue relates to the Complainant's reference to and reliance upon the decision in *Wells v Haden* [2008] DCR 859.

Reference is also made to the Post-judgment Costs Minute of Judge Joyce QC of 11 November 2008 which was provided to the Expert by the Domain Name Commission, as part of the file.

30. Paragraph 4.2 of the Policy states that "The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities." Paragraph B15.1 states that "The Expert will decide a Complaint on the basis of the Parties' submissions, the Policy and the Procedure." Paragraph B11.2 states that "The Expert shall determine the admissibility, relevance, materiality and weight of the evidence."
31. Both the Complaint and Response are brief and perfunctory and neither provides adequate particulars of the complaint and response. Both are equally deficient in that regard. However, the Complainant specifically relies on the Judgment in *Wells v Haden* [2008] DCR 859. Having expressly done so the Judgment is arguably incorporated into the Complaint by such reference and accordingly can be relied upon to support the Complainant's case. Under the circumstances the Expert admits the Judgment and Minute of the Court as a means to provide background factual material and context and as part of the Complainant's submissions in support of its case. That is, pursuant to Paragraphs B11.2 and B15.1 of the Policy. Nevertheless, this should not be taken as suggesting that such a reference is necessarily appropriate or will be sufficient. It is certainly not an acceptable substitute for a proper complaint.
32. Even though reference is made by the Expert to the Judgment and Minute of Judge Joyce QC, the decision is based, as it must be, on the establishment by the Complainant of the three elements referred to in paragraph 26 above.

(a) Rights in respect of a name or mark

33. 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 the Expert first has to consider what the name or mark is, what it means and who has rights in it.
34. The expression "Rights" is referred to in the definition of "Unfair Registration" in paragraph 3 of the Policy and is directed to a Domain Name which "took unfair advantage of or was unfairly detrimental to the Complainant's Rights" in some way. The primary question is thus whether some disadvantage or detriment occurs vis-a-vis the Complainant's Rights.
35. The Respondent asserts that the Complainant is not an entity and cannot make a complaint (see paragraph 22 above). A similar argument was advanced in the District Court Proceedings, namely that the Complainant could not be declared an "approved organisation" under section 121 of the Animal Welfare Act 1999. However, that

proposition was rejected by Judge Joyce QC (at paragraph 18) on the basis that any organisation, whether a group of affiliated persons, an Incorporated Society, or as trustees, or as an incorporated company, or as some like and composite entity could apply for and obtain such approval. His Honour further concluded that there was no basis for saying that such an organisation must actually be incorporated.

36. It is relevant in the present case that the Court concluded (at paragraph 355) that Mrs Haden in her capacity as sole director and shareholder of the company, Animal Welfare Institute of New Zealand Limited, which purported to own the domain name in dispute and had acquired the AWINZ trade mark should change its company name, abandon (or at least cease to use) the trade mark, close the website and deactivate the said domain name. Even though the Court took the view (in paragraph 356) that it lacked jurisdiction in terms of enforcement of the Trade Marks Act 2002 that it still found that it had the power to prohibit use of the trade mark as a "vehicle to do unlawful damage". Accordingly, an injunction was granted to prevent such conduct.
37. The Respondent contends that the above Judgment is under appeal to the High Court and submits that it has no standing and should not be relied upon. However, no information is provided as to such an alleged appeal and the Respondent has not put provided any details of the grounds of any appeal or any reasons as to why the Judgment is said to be wrong in fact or law.
38. More to the point, the findings of Judge Joyce QC are clear and unequivocal and they are made against the person/s or entities, who in all likelihood, stand behind or otherwise control the Domain Name but who have, for reasons of their own, remained in the wings. Nevertheless, these findings are relied upon by the Complainant to support its case and having done so, in the Expert's view its calls for a clear and unambiguous explanation or adequate contradiction by the Respondent. The Respondent has had the opportunity but has failed to do so.
39. As is clear from the wording of paragraph 3 of the Policy it is the Complainant that must establish the requisite Rights in order to establish that some form of disadvantage or detriment is likely to occur through the existence or use of the Domain Name by the Respondent. That is the test the Expert must apply here.
40. It appears that while there may be a dispute as to who is entitled to the use of the term that it is common ground between the parties that the abbreviation AWINZ stands for The Animal Welfare Institute of New Zealand, or the like.
41. It is apparent that the Complainant is a not-for-profit, charitable trust and that it was formed as a charitable trust in 1999 and approved for its

particular purposes by the Ministry of Agriculture. The purpose of the trust, whether incorporated or not, is said to be to promote the welfare of animals. It is apparent from paragraph 22 of the Judgment of Judge Joyce QC that it has performed various functions including the provision of animal welfare services to local authorities along with a range of animal welfare monitoring roles with various motion pictures made in New Zealand. None of this is disputed by the Respondent.

42. On this basis the Expert finds that the Complainant has used and has a common-law reputation in the names AWINZ and The Animal Welfare Institute of New Zealand. The Complainant submits that the Complainant should have in its control the Domain Name due to the exact match of name and .org.nz status. There is merit in this submission. It leads to the next consideration dealt with immediately below.

(b) Identity or similarity

43. It is clear that the Domain Name is identical to AWINZ and is an acronym or abbreviation for/of The Animal Welfare Institute of New Zealand. This ground is thus established without difficulty.

(c) Unfair registration

44. As noted in paragraph 25 above, a number of factors may be taken into account as evidence that the Domain Name is an Unfair Registration. This requires the Expert to be satisfied that the Respondent has registered or otherwise acquired the Domain Name primarily for certain purposes. These are dealt with below.

Blocking registration against a name or mark in which the Complainant has rights

45. The Expert has not been provided with reliable evidence that the Respondent is using or intends to use the Domain Name for any, leave alone any legitimate, purposes. As noted in paragraph 10 above it appears that the Domain Name is currently "parked" and is not use.

46. The District Court came to the considered view that the trade mark was being utilised as a "vehicle to do unlawful damage" and granted the injunction sought by the plaintiffs in that action. The Complaint in the present proceeding made it clear that the Complainant was relying on those findings. Indeed, the existence of and findings in the Judgment were central to the Complainant's present argument. The Respondent has not provided an explanation as to why it chose the name Animal Welfare in New Zealand or why the Animal Welfare Institute of New Zealand Limited was formed and acquired the AWINZ trade mark and/or the Domain Name. Indeed, it is unclear whether the Respondent is involved in "animal welfare" in New Zealand at all

and the Response certainly does not assert such an interest or involvement.

47. Accordingly, it is reasonable to infer that in the absence of any real explanation that the Domain Name is being employed primarily as a blocking means.

For the purpose of unfairly disrupting the business of the Complainant

48. For the reasons set out in paragraph 46 above it is again reasonable to infer that the purpose of the Domain Name is to unfairly disrupt the business of the Complainant. Having been involved in a range of animal welfare activities for some years the Expert finds that as part of the campaign against the Complainant that the Domain Name is being used to disrupt its activities.

Using the Domain Name in a way which is likely to confuse, mislead or deceive

49. This requires the Expert to be satisfied 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. Given the close identity between the acronym/abbreviation AWINZ and the full name in which the term "animal welfare" and New Zealand feature prominently it is almost inevitable that members of the public in New Zealand will see some connection or association between the Complainant and Respondent.
50. The existence of the Domain Name registration itself, with or without active use, is sufficient to establish this ground and the necessary connection between the Complainant and the Respondent, contrary to the fact.
51. In the final analysis, the Expert is of the clear view that the primary purpose of the Domain Name is to interfere with and disrupt the Complainant's activities as part of a wider campaign against the Complainant and that the Respondent has taken unfair advantage of and acted in a way that is unfairly detrimental to the Complainant's Rights.
52. The Complainant has thus established each part of paragraph 4.1 of the Policy and is entitled to the relief sought. In the result, the Expert orders that the Domain Name be transferred from the Respondent to the Complainant.

Place of decision

Auckland

Date

11 August 2009

Expert Name

Mr Clive Elliott

Signature