

.nz Dispute Resolution Service

DRS Reference: 426

Toshiba (Australia) Pty Ltd v Leigh Brotherston

Key words –

Domain Name
mytoshiba.co.nz

Identical or similar trade mark or name

Registered mark – unregistered mark

Unfair registration

Unfair use – pattern of registration – presumption of unfair registration –
Respondent having no connection with name or trade mark

Procedure

Remedies - transfer

1. Parties

Complainant:
Toshiba (Australia) Pty Ltd

Building C
12-24 Talavera Road
North Ryde NSW 2113
Australia

Respondent:
Mr Leigh Brotherston
PO Box 9241
Newmarket
Auckland 1031
New Zealand

2. Domain Name/s

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

3. Procedural history

3.1. The Complaint was lodged on 21/08/2009 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint

on 26/08/2009. The domain/s were locked on 25/08/2009, 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 24/09/2009 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 25/09/2009 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. Factual background

- 4.1. The Complainant forms part of a global group of companies known as Toshiba. The group is headed by a Japanese company trading from Tokyo as Toshiba Corporation. Toshiba Corporation holds registered trade marks in various countries. These include 56 Toshiba trade marks registered in New Zealand.
- 4.2. The Toshiba group is internationally known for the manufacture and supply of electric and electronic goods. The goods include information processing and telecommunication systems, industrial machinery, electronic components and materials, plant engineering, home appliances and entertainment software.
- 4.3. The Complainant was incorporated in Australia on 14 October 1975. It is the proprietor there of the Domain Name www.mytoshiba.com.au (date of original registration not shown).
- 4.4. The Complainant was registered in New Zealand as an overseas company on 9 June 1986. It is an authorised user of the Toshiba trade mark in New Zealand. Since 4 April 1997 it has been the proprietor and user of the Domain Name www.toshiba.co.nz.
- 4.5. From 1986 the Complainant has sold Toshiba goods in New Zealand using Toshiba trade marks. Various forms of Toshiba trade mark are not only registered in New Zealand but are also well-known in this country.
- 4.6. The Respondent is the CEO of MyToys Ltd, a company registered in, and trading from, New Zealand. MyToys Ltd conducts an online business selling a variety of branded goods including Toshiba branded goods.
- 4.7. On 20 October 2005 the Respondent registered the disputed Domain Name. The Domain Name is used to direct potential customers to the Respondent's website www.mytoys.co.nz.

5. Complainant's contentions

- 5.1. The Complainant complains that the Respondent is unfairly using the disputed Domain Name to divert potential customers of the Toshiba Group to the Respondent's online store.
- 5.2. The Complainant argues that it has existing rights in respect of the name "Toshiba" by virtue of its registered trade marks, reputation in the name "Toshiba" and copyright in the Toshiba stylised mark used by the Respondent in connection with the disputed Domain Name.
- 5.3. The Complainant submits that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive. It also submits that the Respondent is engaged in a pattern of registering other well-known names or trade marks including myibm.co.nz, myphilips.co.nz and mylenovo.co.nz.

6. Respondent's contentions

- 6.1. The Respondent has not filed any response.

7. Discussion and findings

- 7.1. The dispute is governed by the Policy issued by Domain Name Commission Limited on behalf of InternetNZ. 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
 - 4.1.2 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;"

7.2. 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).

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

- 8.1. The Complainant has demonstrated rights in respect of the name "Toshiba" based on the use of that word in its business activities in New Zealand and also its own registration in New Zealand of the Domain Name toshiba.co.nz. The Complainant is also entitled to rely upon its Australasian goodwill associated with its registration of the Domain Name mytoshiba.com.au and its associated commercial goodwill.
- 8.2. That makes it unnecessary for me to consider whether, for present purposes, the Complainant is entitled to rely upon the registered trade marks which are owned not by the Complainant but by Toshiba Corporation. There may be some legal basis upon which the Complainant can rely upon the registration of trade marks in the name of another company but, if so, the Complainant has not embarked upon that argument.

8.3. I accept that the Complainant has rights in respect of the name "Toshiba" and in respect of the name "mytoshiba" for present purposes. This requirement is satisfied.

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

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

9.2. 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.

9.3. In the present case the disputed Domain Name is clearly similar to "Toshiba" and identical to "mytoshiba". This requirement is satisfied.

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

10.1. 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).

10.2. The evidence supports the conclusion the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people into believing that the Domain Name is connected with the Complainant. A consideration of the products sold by the two companies, and an examination of the Respondent's website, makes that consequence inevitable. In terms of para 5.1.2 of the Policy, this is evidence that the Domain Name is an unfair registration.

10.3. In addition the Complainant has demonstrated that 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. The Domain Names registered by the Respondent with reference to IBM, Philips and Lenovo illustrate the pattern. The Domain Name currently in dispute conforms to that pattern. Because of the timings involved there is no automatic presumption of unfair registration under para 5.3 of the Policy but the evidence of a pattern independently demonstrates a qualifying pattern of registrations for the purposes of para 5.1.3.

10.4. The Respondent has made no attempt to dispute the Complainant's allegations of confusing, misleading and deceptive use of the Domain Name and a pattern of unfair registrations in respect of other well-known names. Nor has there been any suggestion that unfair registration can be resisted on any of the grounds specified in paras 6.1 to 6.3 of the Policy.

10.5. I conclude that the Respondent's registration is an unfair one for the purposes of the Policy and that all three requirements for a complaint of this kind are established.

11. Decision

11.1. The complaint is upheld. I direct that the disputed Domain Name "mytoshiba.co.nz" be transferred to the Complainant or its nominee.

Place of decision

Auckland

Date

2 October 2009

Expert Name

Hon Robert Fisher QC

A handwritten signature in black ink, appearing to read 'R Fisher', written over the printed name 'Hon Robert Fisher QC'.

Signature