

.nz Dispute Resolution Service

DRS Reference: 549

BHP Billiton Innovation Pty Ltd v Greg Mate

Key words – registered mark – identical – unfair registration – likely to confuse, mislead or deceive – unfairly disrupting the business of the Complainant – blocking registration – Respondent having no connection with name or trade mark – evidence – transfer.

1. Parties

Complainant:

BHP Billiton Innovation Pty Ltd
180 Lonsdale Street
Melbourne, 3000
Australia

Respondent:

Greg Mate
11/2 Raglan St
Mosman 2088
Sydney
Australia

2. Domain Name/s

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

3. Procedural history

- 3.1 The Complaint was lodged by the Complainant's representative (Griffith Hack, Melbourne) on 9/24/2010 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 9/29/2010. The domain was locked on 9/28/2010, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 The Respondent filed a Response to the Complaint on 10/28/2010 and the DNC so informed the Complainant on 10/28/2010. The DNC informed the parties on 11/26/2010 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 12/8/2010 for a decision of an Expert, pursuant to Paragraph 9 of the .NZ Dispute Resolution Service Policy (“the Policy”).
- 3.4 Ms Sheana Wheeldon, the undersigned, (“the Expert”) confirmed to the DNC on 12/9/2010 that she knew of no reason why she could not properly accept the invitation to act as expert in this case and that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality.

4. Factual background

- 4.1 The factual background is taken from information submitted by the Complainant.
- 4.2 The Complainant is incorporated in Australia and is a wholly owned subsidiary of BHP Billiton Limited, one of two companies comprising the BHP Billiton Group (‘BHP Billiton’).
- 4.3 BHP Billiton is the world’s largest diversified Group, employing approximately 37,000 people in more than 100 operations in 25 countries. It operates a website at www.bhpbilliton.com. It is also the registrant of numerous domain names comprising ‘bhpbilliton’ or a variant thereof (such as ‘bhp-billiton’) together with a top level domain.
- 4.4 BHP Billiton’s average annual turnover between 2001 and 2005 exceeded US\$22 billion, and its annual turnover in the years 2007, 2008 and 2009 was between US\$47 billion and US\$59 billion.
- 4.5 BHP Billiton owns numerous trade marks worldwide for marks consisting of and containing the words BHP BILLITON. These include registrations in New Zealand owned by BHP Billiton Limited of BHP BILLITON in 15 different classes under registration nos. 634243–634261, all dating from 19 March 2001.
- 4.6 The disputed domain name bhpbilliton.co.nz resolves to a website that indicates that the domain name is parked.
- 4.7 The disputed domain name appears to have been registered in the name of Greg Mate, the Respondent, on 20 March 2009. The Respondent’s formal participation in this matter has been limited to the filing of a brief Response which indicated that he was prepared to transfer the disputed domain name to the Complainant.

5. Parties’ contentions

a. Complainant

The Complainant contends that the disputed domain name, in the hands of the Respondent, is an Unfair Registration for the following reasons:

- 5.1 Because the Respondent has parked the disputed domain name, it appears it was registered primarily as a blocking registration against BHP BILLITON, in which the Complainant has rights (Policy, paragraph 5.1.1b).
- 5.2 The Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of BHP Billiton (Policy, paragraph 5.1.1(c), noting that the disputed domain name is identical to the trade mark BHP BILLITON). The Complainant goes on to submit that the Respondent registered the domain name with the primary aim of diverting Internet traffic intended for BHP Billiton, and that it follows that the disputed domain name was obtained with the intention of disrupting the Complainant's business.
- 5.3 Reference is made by the Complainant to the World Intellectual Property Organisation ('WIPO') gTLD decisions of *Zwack Unicum Rt v Erica J. Duna* (WIPO Case No. D2000-0037) and *The Nasdaq Stock Market v Act One Internet Solutions* (WIPO Case No. D2001-1492) in which it was held that bad faith registration may be inferred from the registration of a well known mark. The Complainant submits that the finding of bad faith in these circumstances (albeit under a different policy) is illustrative in indicating Unfair Registration in the present matter.
- 5.4 The Complainant submits it is highly unlikely that the Respondent was not aware of the Complainant's BHP BILLITON trade mark in view of the fact that BHP Billiton is the world's largest resources group. It submits that BHP Billiton has acquired a reputation in the BHP Billiton trade mark, referring to BHP Billiton's annual turnover figures as set out above. It submits that the choice of the Respondent's domain name, being identical to the BHP BILLITON trade mark, is in itself evidence of the Respondent's knowledge of BHP Billiton's trade mark rights and its business.
- 5.5 Registration and use of a domain name consisting of such a well known trade mark as BHP BILLITON is likely to confuse, mislead or deceive people or businesses into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant (Policy, paragraph 5.1.2).
- 5.6 Finally, the Complainant expressly requests that, in the event that the Respondent consents to the transfer of the disputed domain name following the filing of its Complaint, the Expert nevertheless issue a decision on the merits. This is said to be because it is highly unlikely the Respondent was not aware of BHP Billiton when he registered the disputed domain name, and having the matter decided without a finding on the merits in a scenario of this kind, may remove any disincentive the

Policy may present to parties that register domain names in bad faith. In other words, a party that registers domain names in bad faith and profits from such registrations, may do so more readily in the knowledge that it may avoid a decision on the merits simply by consenting to the transfer of the domain name after a complaint is filed.

b. Respondent

5.7 The Respondent in his Response said:

'I am pleased to transfer this domain to the complainant immediately. This initially was indicated in my email to NZ DNC 28/09/2010. I am not contesting the complainant's request.'

5.8 He did not offer any documents or information for consideration by the Expert.

6. Discussion and findings

6.1 The Complainant is required to prove that it has met the requirements in paragraph 4 of the Policy namely 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.

6.2 Paragraph 4.2 requires the Complainant to prove to the Expert that both elements are present on the balance of probabilities.

a. Complainant's Rights

6.3 The Complainant is a wholly owned subsidiary of BHP Billiton Limited, so is presumably controlled by BHP Billiton Limited.

6.4 BHP Billiton Limited owns numerous New Zealand trade mark registrations in respect of the mark BHP BILLITON, which is identical to the disputed domain name. Though the Complainant itself does not own these registered trade mark rights, the Expert is prepared to accept, based on its relationship with the owner, that the Complainant has the required Rights in the trade mark BHP BILLITON.

6.5 The Expert is also prepared to infer from the information in the Complaint that the Complainant, as a member of the BHP Billiton Group, has common law rights in the trade mark BHP BILLITON on which it could found an action for passing off in New Zealand, which also qualify as a 'Right' under the Policy.

6.6 The disputed domain name is 'bhpbilliton.co.nz', of which the component '.co.nz' may be disregarded for the purpose of determining similarity.

What remains is 'bhpbilliton', which is effectively identical to the Complainant's trade mark. The Expert finds for the Complainant in terms of paragraph 4.1.1 of the Policy.

b. Unfair Registration

6.7 The Policy provides that '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.

6.8 The Policy sets out a series of non-exhaustive factors which may be evidence that a Domain Name is an Unfair Registration. They include the following:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

- (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 businesses or people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

6.9 There is nothing to suggest that at the time he registered the disputed domain name in March 2009, the Respondent had any rights to or connection with the trade mark BHP BILLITON. At that time, the Complainant had been using the trade mark BHP BILLITON for many years and BHP Billiton Limited's New Zealand trade mark registrations had been in place for eight years.

6.10 Any use of the disputed domain name in March 2009 by the Respondent would have taken unfair advantage of or been unfairly detrimental to the Complainant's Rights in its trade mark BHP BILLITON. This meets the first limb of the definition of Unfair Registration.

6.11 With reference to the Complainant's submission that, based on the WIPO decisions cited above in paragraph 5.3, an Unfair Registration may be inferred from the registration by the Respondent of a well known mark, the Expert accepts that this factor entitles her to draw appropriate adverse inferences.

6.12 The Complainant having proved circumstances falling within the definition of Unfair Registration, and there being no evidence (under paragraph 6 of the Policy or otherwise) suggesting that the disputed domain name is not an Unfair Registration, the Expert finds in terms of paragraph 4.1.1 of the Policy that the disputed domain name, in the hands of the Respondent, is an Unfair Registration.

6.13 The Expert wishes to record her appreciation for the clear and succinct manner in which the Complaint was presented.

7. Decision

7.1 In view of the findings made above the Expert directs that the domain name bhpbilliton.co.nz be transferred to the Complainant.

Place of decision Auckland

Date 22 December 2010

Expert Name Ms Sheana Wheeldon

Signature