

.nz Dispute Resolution Service

DRS Reference: 721

Shotgun Supplements Ltd v Xtreme Nutrition and Training Ltd

Key words -

1. Parties

Complainant:

Shotgun Supplements Ltd

PO Box 7135

Fitzroy, 4341

New Plymouth

New Zealand

Represented by: Mr Andrew Hill

Respondent:

Xtreme Nutrition and Training Ltd

201 Victoria Street West

Auckland Central, 1010

Auckland

New Zealand

Represented by: Mr Moe Moses

2. Domain Name/s

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

3. Procedural history

The Complaint was lodged on 3/11/2011 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 8/11/2011. The domain/s were locked on 8/11/2011, 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 15/12/2011 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

4. Factual background

The Complainant is a retailer of sports and health supplements. It sells online.

It has its own website, www.shotgunsupplements.co.nz. Its website discloses that it has more than 80 brands of supplements and dozens of individual products. It offers free nationwide courier delivery and has a full time customer service team. It claims to be New Zealand's biggest online supplier of sports supplements, weight loss products, muscle builders, protein powders and vitamins. It says it sends thousands of orders to customers all over New Zealand every year and has up to a million dollars worth of product in its warehouse at all times. There are photos of 8 of its employees on its website.

The Complainant is the owner of registered Trade Mark No. 820121 in Class 35 for retailing and importing and distribution of sports and health supplements. The trade mark, which is depicted below, clearly includes the words SHOTGUN SUPPLEMENTS. The trade mark was registered on 25 February 2010.



2.1.1 26.1.1 26.1.4 21.3.21

Although it did not produce substantiating details, the Complainant says it uses the name "Shotgun Supplements" in the marketing of its business around New Zealand in many different types of media, and because it trades online it encourages respective customers who are searching to do so to use the name Shotgun Supplements. The heading on its home page on the website is "shotgun supplements.co.nz". Its registered trade mark appears on its home page.

The Respondent, which is under the control of Moe Moses, also sells sport and nutritional products online. Its website is www.xtremenutrition.co.nz. It obtained the Domain Name on 29 April 2011.

5. Parties' contentions

a. Complainant

The Complainant claims Rights in the names "Shotgun Supplements" and "shotgunsupplements.co.nz". It says it has spent a great deal of time and energy building the profile and good name of the Complainant and its brand in New Zealand, and alleges that the sole reason for the Respondent acquiring the Domain Name was to enable it to redirect inquiries to the website xtremenutrition.co.nz.

It says that online purchasers will assume that there is some association between the Complainant and Xtreme Nutrition. In redirecting shotgunsupplement.co.nz to the Xtreme Nutrition website, it is directly and

intentionally misleading members of the public who are actually looking for the Complainant's site.

b. Respondent

The Respondent has not responded to the Complaint. The factual allegations of the Complainant, in respect of its business, and the use of the term "shotgun supplements", the trade mark and its own web domain name in its advertising are therefore unchallenged.

6. Discussion and findings

The dispute is governed by the Policy issued by the Domain Name Commission on behalf of Internet NZ.

Under the Policy, the Complainant, to succeed, is required to satisfy the Expert that:

- (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.

Unfair Registration means a domain name which either:

- (a) 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
- (b) 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.

Rights is defined in the Policy as including, but not limited to rights enforceable under New Zealand law. In this case, the right relied upon is Trade Mark Registered No. 820121. In addition, by implication the Complainant relies upon a common law mark. It is in effect complaining that the Respondent is "passing off".

I am satisfied that the Complainant has rights in the words "Shotgun Supplements". These Rights are established both by the patent which it holds and by usage which has created a common law right to the words. The words are the Complainant's trade name.

The words "Shotgun Supplements" appear prominently in the registered trade mark. Not only is the trade name registered, but also that trade mark appears in the Complainant's on-line advertising.

A common law right arises from the facts that the Complainant's name is Shotgun Supplements Limited, the pages of its website are headed "shotgun supplements.co.nz" and there are numerous references on its website where it refers to itself as "Shotgun Supplements". There is a link to its facebook page where the names "Shotgun Supplements" and "shotgun supplements.co.nz" appear frequently and prominently. The Complainant has built up a business reputation in the names.

The names "Shotgun Supplements" and "shotgunsupplements.co.nz" need to be "identical or similar" to the Domain Name, if the Complainant is to succeed. They are not identical but in my view they are similar to the extent that they are confusing. The substantive words of the Complainant's rights are "Shotgun Supplements". There are two differences from the Domain Name. First, there is one word in the Domain Name, rather than two words in some, but not all forms of the trade name in which the Complainant has Rights. Secondly, the word "supplement" in the Domain Name is in the singular rather than the plural form.

It follows that the Complainant has established Rights in a name or mark similar to the Domain Name. It is also necessary to establish that there was an Unfair Registration. Paragraph 5.1.2 of the Policy contains a non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration. That list includes:

- 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;

The definition of Unfair Registration includes a domain name which 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.

An inference can be drawn from the facts that the redirection by the Respondent to its own website www.xtremenutrition.co.nz was and 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. The fact that a competitor has the ability to direct "Shotgun Supplement" inquiries to its own website means that the Domain Name is likely to be used in a manner which is unfair or detrimental to the Complainant's Rights. This is the allegation made in the Complaint and by not replying to the Complaint, the Respondent has not challenged this position.

It is also obvious from the Complainant's own website by the constant references to either "shotgun supplements" or "shotgunsupplements.co.nz" that a person seeking to purchase online from the Complainant is likely to be misled by the Domain Name into believing that the Respondent, which also sells supplements on-line, is associated with the Complainant.

For the above reasons I am satisfied that the further requirement has been met and that the Domain Name in the hands of the Respondent is an Unfair Registration.

7. Decision

The Complaint is upheld. I direct that the Domain Name be transferred to the Complainant.

Place of decision: Auckland, New Zealand

Date 22 December 2011

Expert Name Barry Paterson QC

Signature

A handwritten signature in blue ink, appearing to read 'B. Paterson', is written over the printed name 'Barry Paterson QC'.