

.nz Dispute Resolution Service

DRS Reference: 1327

**Victoria University of
Wellington**

v

**Fortune Sources Group
Limited**

Key words -

1. Parties

Complainant:

Victoria University of Wellington
Kelburn Parade
Wellington
New Zealand

Represented by: Kate Duckworth Intellectual Property Limited

Respondent:

Fortune Sources Group Limited
82 Burswood Drive
Pakuranga
Auckland

2. Domain Name/s

wellington.ac.nz

3. Procedural history

The Complaint was lodged on 02 October 2018 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 05 October 2018. The domain/s were locked on 02 October 2018, preventing any changes to the record until the conclusion of these proceedings.

No Response was received.

The Complainant paid Domain Name Commission Limited the appropriate fee on 20 November for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

Andrew Brown QC, the undersigned, ("the Expert") confirmed to the DNC on 23 November 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 is Victoria University of Wellington. It was founded in 1897 but used the name Victoria College until 1962 when it changed its name to Victoria University of Wellington.
- 4.2 The Complainant has three main campuses in Wellington and a campus in Auckland. It was formerly the only university in New Zealand with a presence in Wellington. The Complainant notes that “it is only relatively recently that other universities have established presences in Wellington” but does not provide any details as to when these other universities established their Wellington presence.
- 4.3 The Complainant states that in 2018 it “began a process to consider a name change to ‘University of Wellington’”. In May 2018 the University applied for registration of the trade mark UNIVERSITY OF WELLINGTON in classes 9, 16, 35, 36, 39, 41, 42 and 43 under trade mark application 1092265. The Complainant states that “assuming the change of name to UNIVERSITY OF WELLINGTON goes ahead, further trade mark applications including the words UNIVERSITY OF WELLINGTON will be made”.
- 4.4 The .ac.nz second level domain name space is an unmoderated domain space. The Complainant states that .ac is intended for use by tertiary organisations.
- 4.5 The Complainant states that it sought to acquire the Disputed Domain Name. It initially contacted the Respondent via text but the owner indicated that it was not for sale. When asked whether the Respondent had a figure the Disputed Domain Name would be for sale at, the Respondent replied by text message “No. Sorry.”
- 4.6 Emails in both English and Mandarin were then sent to the Respondent as well as further text messages. No response was received to any of these approaches. The Complainant “believes that the owner [of the Disputed Domain Name] is based in China”. However the address for the Respondent is a New Zealand address.
- 4.7 The Complainant does not provide any details as to when the Disputed Domain Name was registered. A check of the WHOIS NZ Service offered by the Domain Name Commission shows that this was registered on 19 August 2012.

5. Parties’ contentions

a. Complainant

- 5.1 As to Rights, the Complainant asserts that, “as the only university in New Zealand with Wellington as part of its name and having used the name WELLINGTON as part of its name for over 100 years”¹ and “as the applicant” for the trade mark UNIVERSITY OF WELLINGTON, it “has rights to a name that is identical or similar to [the Disputed Domain Name]”.

¹ In fact, since 1962.

- 5.2 The Complainant states that although unmoderated, the ac.nz second level domain is intended for use by tertiary education institutions and “understood by the New Zealand public as denoting an academic website”.
- 5.3 It asserts that “assuming the name change goes ahead”, the University has rights to a name that is identical or similar to the Disputed Domain Name.
- 5.4 The Complainant also submits that the Disputed Domain Name is an unfair registration on the basis that, so far as the Complainant is aware, the Respondent has no connection with academia or New Zealand and has no reason to need to use an ac.nz domain name. It goes on to state that, *as far as it is aware*, there has never been a website or any page hosted at the Disputed Domain Name and it appears that the Respondent is not using the Disputed Domain Name.
- 5.5 The Complainant states that the current registration is blocking it from acquiring and using the current registration. It wishes to use the registration. It states that “it seems unlikely that the current Respondent would ever want to do so given ac.nz is for academic institutions based in New Zealand”.

b. Respondent

- 5.6 As noted earlier the Respondent did not submit a response.

6. Discussion and findings

- 6.1 The Complainant is required to satisfy the Expert on the balance of probabilities that it has met the requirements of 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.”

a. Rights

- 6.2 The term “Rights” is defined in paragraph 3 of the Policy as follows:

“**Rights** includes, but is not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant’s business.”

- 6.3 As noted earlier in section 5, the Complainant relies for Rights on its use of VICTORIA UNIVERSITY OF WELLINGTON and also its position as applicant for the trade mark UNIVERSITY OF WELLINGTON.
- 6.4 The Expert is satisfied that the Complainant has rights in its unregistered trade mark VICTORIA UNIVERSITY OF WELLINGTON as a result of its continuous use of that mark since 1962. These rights would be enforceable in passing off or under s. 9 of the Fair Trading Act 1986. A dominant part of the mark is Victoria University. But the long user of the mark as a whole will also have

given the Complainant rights in the mark as a whole including UNIVERSITY OF WELLINGTON.

- 6.5 As to the Complainant's reliance on the pending trade mark application for UNIVERSITY OF WELLINGTON at the date of this Decision, that application is still under examination with IPONZ. The definition of Rights includes but is not limited to those that are "enforceable under New Zealand law". A trade mark application is not enforceable under New Zealand law until it is registered and on its own (absent use) gives no rights.
- 6.6 The Complainant does not make it clear whether it is claiming any rights to UNIVERSITY OF WELLINGTON on its own as a result of the announced wish to move to that name (as at the date of Complaint). If this particular aspect is claimed, then the Complainant has not provided any evidence of publicity or use which would create a separate goodwill. Rather, it seems that the reliance is as a result of the long use of the unregistered trade mark VICTORIA UNIVERSITY OF WELLINGTON.
- 6.7 In summary, the Expert is satisfied that the Complainant has rights in its unregistered trade mark VICTORIA UNIVERSITY OF WELLINGTON as a whole and as component parts. However, the Expert is not satisfied that this would give any rights to Wellington on its own given the fact that Wellington is a geographical place and the capital of New Zealand, and that even in the trade mark VICTORIA UNIVERSITY OF WELLINGTON, Wellington is being used as a geographical description (i.e. "of Wellington").
- 6.8 The issue then arises under paragraph 4.1.1 of the Policy as to whether VICTORIA UNIVERSITY OF WELLINGTON is *similar* to the Disputed Domain Name.
- 6.9 The Guide to .nz Disputed Resolution Service (DRS) Expert Decisions notes that "similarity" essentially requires the domain name and the name or mark to be considered in respect of their look and sound, the goods or services to which they are related and whether consumers are likely to be confused or deceived by the degree of similarity between the two names.²
- 6.10 *The WIPO Overview of WIPO Panel Views on Selected UDRP Questions*, 3rd Edition, notes "while each case is judged on its merits, in cases where a domain name incorporates the entirety of a trade mark, or where at least a dominant feature of the relevant mark as recognisable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".³
- 6.11 Similarity is therefore a relatively low threshold test. The Expert is prepared to find that the Disputed Domain Name is similar to VICTORIA UNIVERSITY OF WELLINGTON. However, the similarity is weak given the fact that Wellington is a geographical place name, and the capital of New Zealand.

b. Unfair registration

- 6.12 Unfair Registration is defined in paragraph 3 of the Policy as follows:

² September 2016.
³ Section 1.7.

“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.”

6.13 Paragraph 5.1 of the Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration. Relevantly, paragraphs 5.1.1, 5.1.3 and 5.1.4 provide as circumstances indicating Unfair Registration as follows:

“5.1.1. Circumstances indicating that 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 Similarly, 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.”

6.14 Under this heading, the key issue for determination is whether the Complainant is able to meet either of the limbs of Unfair Registration as defined in paragraph 3 of the Policy.

6.15 The Disputed Domain Name was registered on 19 August 2012, over six years ago.

6.16 From a careful reading of the Complaint and its allegation that “the current registration is unfair”, it is clear that the grounds of complaint are:

- That the Respondent has no connection with academia or New Zealand and has no reason to need to use an .ac.nz domain name.
- That there has never been a website or any page hosted at the current registration. The Complainant has submitted that “It appears the current registrant is not using the domain name and ... has no need to use the current registration or any .ac website.” The second level domain .ac.nz is for academic institutions based in New Zealand.
- The current registration is blocking the University from acquiring and using the current registration.
- The public will expect the current registration to direct them to a website owned, run and featuring the University.

6.17 The Complainant does not in fact make any direct complaint directed to the *registration* of the domain name. Its complaints are related to the non-use of the Disputed Domain Name and the fact that the Respondent has no need to use this or indeed the .ac.nz space. The Complaint that the Disputed Domain Name is blocking the University from acquiring and using it appears to have been caused by the very recent 2018 decision by the Complainant to make a shift to the name and trade mark UNIVERSITY OF WELLINGTON. Up until then it has used the domain name www.victoria.ac.nz and has always used the full name VICTORIA UNIVERSITY OF WELLINGTON on all its marketing and publicity (as the Complaint notes).

6.18 It appears that it is only the anticipated name change to University of Wellington which has prompted it to consider *Wellington* on its own.

6.19 Given that no complaint is made as to registration, the remaining issue is whether under the second limb of “unfair registration” the Disputed Domain Name:

“Has been or is likely to be used in a manner which took unfair advantage of or is detrimental to the Complainant’s rights”.

6.20 In this regard, after carefully considering the Complaint and all the circumstances, the Expert is not satisfied on the balance of probabilities that the Disputed Domain Name is an unfair registration under the second limb.

(i) No evidence of use to date: paragraph 5.2 of the Policy

6.21 First there is no evidence that the Disputed Domain Name *has been used* in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

6.22 In this case, the Complainant itself states that so far as it is aware there has never been a website or any pages posted at the current registration. This means that there is a period of some six years during which the Disputed Domain Name has not been used.

6.23 In any event, paragraph 5.2 of the Policy also places the following requirement on the Expert:

“Failure on the Respondent’s part to use the Domain Name for the purposes of email or a website is not in itself evidence that the Domain Name is an Unfair Registration”.

6.24 So the fact that there has been no use of the Disputed Domain Name is not on its own a factor leading to a conclusion that this is an Unfair Registration.

(ii) Likely use

6.25 Secondly, for the reasons set out below, the Expert is not satisfied that the Disputed Domain Name *is likely to be used* in a manner which will either take unfair advantage of or be unfairly detrimental to the Complainant’s Rights.

6.26 There is no evidence of any pending or intended use.

- 6.27 It is necessary, however, to go on and address the ground of complaint that “as far as the Complainant is aware” the Respondent has no connection with academia and has no reason to need to use an ac.nz domain name. The Complainant’s argument is that the public would expect the Disputed Domain Name “to direct them to a website owned, run and featuring the University”, so that *any use* of the Disputed Domain Name will be a breach of Limb (ii).
- 6.28 In determining this, it is necessary to have regard to the nature of the .ac.nz second level domain space (2LD). As the Complaint notes correctly, this is an unmoderated domain space. As such, at the date when the Disputed Domain Name was registered, it fell within the DNC Policy on Second Level Domains.⁴ Policy Version 2.2 issued by the DNC encourages prospective registrants to select the second level domain that most appropriately matches a community of interest and that doing otherwise may cause confusion.⁵
- 6.29 Schedule 1 to the Policy describes a community of interest that each 2LD represents but the Policy itself makes a distinction between *moderated* 2LD’s and *unmoderated* 2LD’s.
- 6.30 For use of a *moderated* 2LD such as .cri, .govt, .health, .iwi, .mil and .parliament⁶ “permission must be sought from the moderator” in order for a domain to be registered. For example, to be eligible for the .cri 2LD the applicant must be a bona fide Crown Research Institute.⁷
- 6.31 The .ac.nz 2LD is *unmoderated* which means that there is no restriction on any party registering. Although the community of interest noted for .ac.nz⁸ is “tertiary educational institutions and related organisations”, there is no ability to prevent registrants from registering in this 2LD. Nor is there any process by which registrants can be rejected or removed. Importantly, paragraph 4.3 of the 2LD Policy states:
- “For the unmoderated 2LD’s the final choice of the appropriate 2LD to use, and the name chosen, rests with the applicant”.
- 6.32 The mere fact that a respondent registrant does not breach the Policy on 2LD’s when registering a domain name in an unmoderated 2LD does not automatically mean that there has been no breach of the Dispute Resolution Policy. So the question remains whether any *future use* of the Disputed Domain Name will take unfair advantage of or be unfairly detrimental to the Complainant’s Rights.

⁴ Version 2.2 dated 1 April 2008. The Policy has now been updated to Version 2.3 (dated 19 June 2018) but as no further second level domains are to be permitted (para 6.2). Para 6.3 states: “For further explanation of second level domains, the Second Level Domains Policy, which is no longer in force, is available in the Policy archives on the DNCL website”.

⁵ Para 4.1

⁶ Second Level Domains Policy Schedule 1

⁷ Policy, para 4.2. See also para 6.6.

Moderation entails the following activities:

- 6.6.1 Registering and seeking to register a domain name within the 2LD being moderated will be evaluated to ensure that they meet the requirements of the Moderation Policy for the 2LD. This is to ensure that only those registrants who are eligible to register domain names into the Moderation Policy are permitted to obtain a name in the 2LD as sought.

⁸ Policy Schedule 1

6.33 The Expert is not satisfied that the Complainant has met the onus of proving this on the balance of probabilities for the following reasons taken together:

- As noted earlier in the section on Rights, the Complainant's rights do not extend to Wellington on its own.
- The fact that .ac.nz is an unmoderated 2LD means that the community of interest listed for .ac.nz does not operate so as to automatically designate and require tertiary education institutions and related organisations to be the only registrants. If there were such a requirement, the 2LD would have been "moderated". Further, and importantly, there is no evidence that the general public have this understanding or expectation of that 2LD.
- Even if the community of interest were to be taken as being the designation and understanding of .ac.nz, "tertiary education institutions and related organisations" can clearly include industry training organisations, private training establishments and related organisations. The community of interest does not automatically connote a university and therefore the Complainant and only the Complainant.

6.34 The Expert is therefore not satisfied that this is an unfair registration.

7. Decision

7.1 The Complaint is therefore dismissed.

Place of decision Auckland

Date 14 December 2018

Expert Name Andrew Brown QC

A handwritten signature in blue ink, appearing to read 'Andrew Brown', with a long horizontal flourish extending to the right.

Signature