

.nz Dispute Resolution Service

DRS Reference: 1365

**Goodman Fielder Pte
Limited**

v

Tony Eteveneaux

Key words –

Identical or similar trade mark or name

Registered mark – identical or similar

Unfair registration

Unfair registration – unfair use – likely to confuse, mislead or deceive - unfairly disrupting the business of the complainant – blocking registration

1. Parties

Registrar: Umbrellar Limited t/a Freeparking

Complainant:

Goodman Fielder Pte Limited
8 Shenton Way, #49-02-AXA Tower
Singapore

Represented by: Mr Jason Wach, James & Wells

Respondent:

Tony Eteveneaux
320 Adelaide Road, Newtown
Wellington
New Zealand

2. Domain Name

onenightinmexico.co.nz
(The “Domain Name”)

3. Procedural history

- 3.1.** The Complaint was lodged on 30 May 2019 and Domain Name Commission (DNC), notified Respondent of the validated Complaint on 4 June 2019. The domain was locked on 29 May 2019, preventing any changes to the record until the conclusion of these proceedings.

- 3.2. No response was received.
- 3.3. Complainant paid Domain Name Commission Limited the appropriate fee on 6 July 2019 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4. Clive Elliott Q.C., the undersigned, (“the Expert”) advised the DNC on 10 July 2019 that although he was independent of each of the parties, he wished to disclose a prior connection whereby he had acted in a High Court proceeding involving Complainant and Complainant’s legal counsel. The Expert advised that he did not believe this constituted a conflict of interest for him but chose to declare it in case it called into question his independence in the eyes of one or both of the parties. Outside of that he knew of no reason why he could not properly accept the invitation to act as expert in this case. On 24 July 2019 the Expert was notified by the DNC that no objection had been received to the Expert’s appointment.

4. Factual background

- 4.1. Complainant is a leading manufacturer and supplier of food products across Australia, New Zealand and Asia-Pacific. Its business incorporates 120 brands, servicing over 30,000 outlets in Australasia including all major supermarket chains. Complainant has 40 manufacturing sites across Australasia and the Pacific, employing 5,000 people. In New Zealand Complainant has 13 manufacturing sites employing 1,800 people.
- 4.2. Complainant is the registered owner of New Zealand trade mark ONE NIGHT IN (no. 1053671, with a deemed registration date of 25 October 2016, and actual registration date of 4 January 2018 (“Complainant’s Mark”).
- 4.3. Complainant is also the registered owner of the following domain names which were all registered on 19 March 2018:
 - a. onenightinmexico.nz;
 - b. onenightin.nz; and
 - c. onenightin.co.nz

All three domains redirect to Complainant’s ONE NIGHT IN MEXICO website at <https://goodmanfielder.com/microsites/one-night-in-mexico> (“Complainant’s Website”).

- 4.4. According to the publicly available WhoIs, the Domain Name was registered on 30 January 2018 to Farrah Breads Limited (“Farrah”) with Registrar Umbrellar Limited t/a Freeparking. Then on 11 April 2018 Farrah transferred registration of the Domain Name to Respondent, Tony Eteveneaux.

5. Parties’ contentions

- a. **Complainant**

- 5.1.** Complainant states that it launched its ONE NIGHT IN MEXICO range of products in Australia in September 2017, and in New Zealand in February 2018. Both launches were supported by substantial marketing campaigns in which Complainant used, and continues to use, Complainant's Mark in connection with a range of Mexican foods, including condiments, sauces, seasoning, tortillas, and other food products.
- 5.2.** Complainant further states that since the launch, it has promoted its products using Complainant's Mark directly and indirectly in New Zealand through numerous media, including via:
- a. Complainant's Website;
 - b. New Zealand on-street advertising including bus shelter advertisements nationwide;
 - c. New Zealand television commercials;
 - d. Radio campaigns;
 - e. Sponsorship of Accurate Traffic, a traffic monitoring program that appears on all MediaWorks radio stations;
 - f. Various events including ONE NIGHT IN MEXICO Family Fiesta, 27 and 28 October 2018, Westfield Albany;
 - g. News articles;
 - h. Special promotions and competitions;
 - i. Giveaways: One Night in Mexico meal kit giveaways were advertised in publications around the country; and
 - j. Social media including Facebook, and Google.
- 5.3.** Complainant asserts that as a result of its use of Complainant's Mark, it has acquired substantial reputation and goodwill in New Zealand and is distinctive of, and exclusively associated by consumers with Complainant and its products.
- 5.4.** Complainant is aware that on 30 January 2018, approximately four months after its Australian launch, Farrah registered the Domain Name. Farrah is a direct competitor of Complainant including in the area of Mexican meal kits and the parties' respective goods are sold through identical channels.
- 5.5.** Complainant believes that it is inconceivable that Farrah, as a direct competitor of Complainant, did not have Complainant's distinctive Trade Marks in mind on the date it registered the Domain Name.
- 5.6.** On a date prior to 21 March 2018 Farrah redirected the Domain Name to its own website promoting Farrah's Mexican food products: www.farrahs.co.nz/mexican-range. Complainant argues that, as a result, members of the public familiar with Complainant's Mark, looking for information on Complainant's products, were presented with a competitor's products.
- 5.7.** Complainant contends that on 29 March 2018 it wrote to Farrah requesting the release of the Domain Name before 11 April 2018 and seeking undertakings as well as advising that if Farrah did not release the Domain Name a formal complaint would be filed.
- 5.8.** Complainant adds that on 11 April 2018 Farrah wrote to Complainant requesting evidence of its use of the ONE NIGHT IN MEXICO trade mark in New Zealand. Complainant states that it provided its evidence of use by reply. However, instead of transferring it to Complainant or cancelling the Domain Name, on 11

April 2018 (the same date as the correspondence) Farrah transferred registration of the Domain Name to Respondent, Tony Eteveneaux.

- 5.9. Complainant's research shows that Respondent is the sole director of Besafe N.Z Limited, a construction company, and was formerly a director of Weathertight Roofing N.Z Limited (removed).
- 5.10. Complainant states that on 16 April 2018 Farrah wrote to Complainant stating that as it had no further interest in the Domain Name it considered the matter concluded.
- 5.11. Having then discovered Respondent as the new registrant of the Domain Name, Complainant states that on 1 June 2018 it wrote to Respondent seeking resolution, however no response was received.
- 5.12. Complainant submits that Respondent appears to be engaged in a pattern of registration of domain names corresponding to well-known names or trade marks. Reference is made to the MIAMI WINE COOLER trade mark.
- 5.13. Complainant points out that the Domain Name is identical to Complainant's Mark in which it has rights, and is also similar to the ONE NIGHT IN trade mark in which the Complainant has registered rights.
- 5.14. It appears that the Domain Name, hosted under the domain name <https://tony-travels.squarespace.com/>, is being used as a travel blog for Respondent's travels, although Complainant notes it only contains only one short page of text and five photographs. Complainant contends that Respondent is masking the Domain Name, a method which prevents visitors from seeing a domain or subdomain forwarding by keeping the domain name in the Web browser's address bar.
- 5.15. Complainant thereby contends that registration of the Domain Name by Farrah on 30 January 2018, and the subsequent use of the Domain Name by Farrah from 30 January 2018 to 11 April 2018, amounted to an Unfair Registration.
- 5.16. Complainant further submits that the Domain Name in the hands of Respondent amounts to an Unfair Registration as the circumstances of acquisition, including timing, indicate on the balance of probabilities that the acquisition was intended:
 - a. to transfer the Domain Name away from Farrah to protect against an order for the transfer of the Domain Name from Farrah to Complainant;
 - b. as a blocking registration against Complainant's Mark being registered as a .co.nz domain name, being a name in which Complainant has rights; and
 - c. for the purpose of unfairly disrupting the business of Complainant.
- 5.17. In addition, it is submitted that the use of the Domain Name by Respondent has been, or is likely to, used in a manner which took, and continues to take, unfair advantage of Complainant's rights.

b. Respondent

No formal response was received from Respondent.

6. Discussion and finding

6.1. In terms of paragraph 4.1 of the Policy, where a Complainant asserts that:

The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

The Domain Name, in the hands of the Respondent, is an Unfair Registration

6.2. Pursuant to paragraph 4.2 of the Policy Complainant is required to prove to the Expert that, on the balance of probabilities, both elements are present.

6.3. Paragraph 3 of the Policy (Definitions) defines “Unfair Registration” as:

“... 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.

6.4. As noted above, Respondent filed no formal response. The Expert is reliant upon the information and submissions filed by Complainant. In the absence of any dispute as to the accuracy and correctness of that information, the Expert will decide this proceeding based on Complainant's undisputed representations and draw any necessary inferences from them.

7. Rights

7.1. The Expert is satisfied that Complainant has established it has the necessary rights. Complainant is a well-known manufacturer and supplier of food products in, inter-alia, Australia and New Zealand. It is the registered proprietor of New Zealand trade mark ONE NIGHT IN with a deemed registration date of 25 October 2016, referred to in this decision as Complainant's Mark. Complainant has also registered various domain names as of 19 March 2018 comprising “onenightinmexico” or “onenightin.nz”.

7.2. The term “One Night In” appears to encapsulate the wider concept and the term “One Night In Mexico” the developed concept in relation to a range of Mexican food marketed and sold by Complainant.

7.3. In addition to registering Complainant's Mark in New Zealand, Complainant alleges it launched the ONE NIGHT IN MEXICO range of products in Australia in September 2017. A launch followed in New Zealand in February 2018. Farrah, another producer of food products in New Zealand, registered the Domain Name

on 30 January 2018 and commenced promoting a range of Mexican foods under or by reference to the Domain Name on 21 March 2018.

- 7.4. Complainant, through its attorneys, took issue with Farrah's registration and use of the Domain Name and asserted prior rights in Complainant's Mark. Farrah did not dispute Complainant's allegations of prior rights in Complainant's Mark; but instead of relinquishing the Domain Name to Complainant, transferred it to Respondent.
- 7.5. Respondent did not submit a response. Accordingly, it is unclear on what basis Respondent assumed control of the Domain Name and whether he disputes Complainant's claim to be the proprietor of Complainant's Mark.
- 7.6. On the basis of the evidence and submissions provided, the Expert is satisfied that:
 - a. Complainant has rights in respect of Complainant's Mark and has rights, via common-law rights through use, in respect of the mark ONE NIGHT IN MEXICO;
 - b. The Domain Name contains as a dominant element the term "One Night In" which is confusingly similar to Complainant's Mark and is identical to the common law mark ONE NIGHT IN MEXICO;.
- 7.7. Accordingly, the Expert is satisfied that the first element of the Policy has been met.

8. Unfair Registration

- 8.1. Paragraph 3 of the Policy requires Complainant to establish that at least one of the necessary requirements is established, namely that the domain name in issue was registered or otherwise acquired in a particular way or has been used in a manner which is unfair or unfairly detrimental to Complainant's Rights. These requirements are stated in the alternative, meaning that in order to succeed a complainant needs to establish one or the other.
- 8.2. Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may be regarded as evidence that the domain name is an Unfair Registration. This paragraph includes the following.

Evidence of Unfair Registration

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

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;

as a blocking registration against a name or mark in which the Complainant has rights;

8.3. Paragraph 5.1.2 refers to:

“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”.

Domain Name Confusing or Misleading

- 8.4.** Complainant contends that the Domain Name is identical to Complainant’s Mark in which it has rights, and is also similar to the ONE NIGHT IN trade mark in which the Complainant has registered rights.
- 8.5.** It might have been relevant in relation to Farrah’s registration and use of the the Domain Name, as the ONE NIGHT IN trade mark registration covers a range of food products and ingredients in classes 29 and 30 and services for providing food and drink in class 43. The problem with the argument is that Respondent purports to be using the Domain Name on a travel blog detailing his travel exploits, but apparently limited only to Mexico. The question is whether a travel blog which at this point focuses only on Mexico might be confused in customers minds, with a range of food products having a Mexican flavour.
- 8.6.** A question which arises is whether the travel blog relied upon by Respondent, which contains only one short page of text and five photographs, is bona fide or whether it is a ruse to prevent Complainant from controlling the use of the Domain Name, to Complainant’s detriment. In the absence of any response or explanation from Respondent, the Expert has to make an assessment, on the basis of the evidence and submissions on the record. That is, as to whether Respondents travel blog is legitimate or not. Looking at the circumstances as a whole, the Expert infers, on balance, that Respondent’s travel blog is a device set up to frustrate Complainant’s efforts to recover the Domain Name. Notwithstanding this, the Expert is not convinced that the Domain Name in use by Respondent is necessarily likely to confuse or mislead a substantial number of members of the public.
- 8.7.** However, for the reasons that follow, such a finding is not necessary to provide Complainant with an effective remedy.

Blocking Registration

- 8.8.** The real nub of Complainant’s argument appears to be that the Domain Name, in the hands of Respondent, amounts to an Unfair Registration. That is, in so far as his conduct is intended to protect against an order for the transfer of the Domain Name from Farrah to Complainant and is designed to be a blocking registration and to disrupt Complainant’s business unfairly.
- 8.9.** Complainant’s argument that the circumstances of acquisition, including timing, indicate that the purpose of the transfer of the Domain Name from Farrah to Respondent and the purported use of the Domain Name on Respondent’s alleged travel blog point towards an unfair purpose. That is, to block Complainant’s use of the Domain Name and to unfairly disrupt Complainant’s business. There is merit in this argument, and in the absence of any response, the Expert infers that this is the likely purpose of the exercise.

8.10. Under the circumstances, it is found that the Domain Name amounts to a blocking registration and is likely to disrupt Complainant's business unfairly.

9. Decision

9.1. Complainant has thus established both parts 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 Respondent to Complainant.

A handwritten signature in blue ink, appearing to be 'Clive Elliott', written over a light blue horizontal line.

Signature

Expert Name **Clive Elliott Q.C.**

Place of decision: Auckland, New Zealand

Date: 1 August 2019