

## **.nz Dispute Resolution Service**

**DRS Reference: 283**

### **Telstra Corporation Limited v E-Promote**

#### **Key words -**

##### *Domain name*

telstaclear.co.nz  
telsraclear.co.nz  
telstarclear.co.nz ("the Domain Names")

##### *Identical or similar trade mark or name*

Registered marks - well-known marks - misspelling – phonetical similarity

##### *Rights*

None asserted.

##### *Unfair registration*

Unfair registration – unfair use – likely to confuse, mislead or deceive - pattern of registration – unfairly disrupting the business of the complainant – respondent having no connection with name or trade mark – typosquatting.

##### *Procedure*

#### **1. Parties**

Complainant:  
Telstra Corporation Limited  
C/- The Office of the Corporate Secretary  
242 Exhibition Street  
Melbourne, Victoria, 3000  
Australia

Represented by Mr Michael Wolnizer,  
Davies Collison Cave  
1 Nicholson Street  
Melbourne, Victoria 3000  
Australia

**Respondent:**

E-Promote  
536 Leavenworth Street  
San Francisco, CA, 94109  
United States of America

**2. Domain Name/s**

telstaclear.co.nz  
telsraclear.co.nz  
telstarclear.co.nz ("the Domain Names")

**3. Procedural history**

The Complaint was lodged on 24/04/2008 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 30/04/2008. The domain/s were locked on 24/04/2008, 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 29/05/2008 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

Hon Sir Ian Barker QC, the undersigned, ("the Expert") confirmed to the DNC on 29/05/2008 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**

The factual background is taken solely from the submissions and exhibits filed by the Complainant. The Respondent did not file a Response. Accordingly, the Panel is prepared to accept the allegations made by the Complainant.

The Complainant, Telstra Corporation Limited, is a leading telecommunications and multi-media entertainment company in Australia. Its fully-owned subsidiary in New Zealand is TelstraClear Limited, which is the second largest telecommunications provider in New Zealand.

The Complainant has provided telecommunications, goods and services in New Zealand since 1996 and under the TelstraClear trademark since December 2001.

The Complainant's total revenue for the financial year of 2007 is approximately A\$24 billion. TelstraClear's revenue in the same period was NZ\$679.4 million.

The Complainant is the registered owner of five trademark registrations in New Zealand for TELSTRACLEAR (stylised), plus 28 trademarks which feature the word TELSTRA and 29 trademarks which feature the word CLEAR.

The Complainant is also the registered owner of trademark registrations or applications featuring the TELSTRA trademark in numerous other countries, including the United States of America. The Complainant has several business locations in that country, including one in San Francisco where the Respondent is domiciled.

The Complainant has successfully issued proceedings under the Uniform Domain Name Dispute Resolution Policy against numerous persons using the word TELSTRA in a domain name.

The Complainant is also the owner of 266 domain names which incorporate the word "Telstra", 11 consist of the word "Telstra" by itself, and 64 the word "Clear". Its principal website for its telecommunications, goods and services, is <TelstraClear.co.nz>.

The Complainant has developed strong sponsorship arrangements under the TELSTRACLEAR trademark for a number of arts, business developments, community, cultural, health and sporting organisations in New Zealand.

The disputed domain names telstaclear.co.nz and telstraclear.co.nz were registered on 3 May 2006 and the disputed domain name telstarclear.co.nz was registered on 23 September 2006.

The registrant administrative and technical contact details are the same for E-Promote (the present Respondent) and Domain Admin – the original registrant of the disputed domain name.

## **5. Parties' contentions**

### **a. Complainant**

The Complainant is the owner of registered trademarks for TELSTRACLEAR stylised and also for other marks which feature the word TELSTRA and yet other marks which feature the word CLEAR.

Between September and October 2006, the Complainant became aware of the registration of the disputed domain names. At this time they were registered in the name of Domain Admin and the domain names resolved to "pay-per-click" websites. The Complainant believes that Domain Admin is the Respondent in another guise. No replies were received to "cease and desist" letters sent by the Complainant to "Domain Admin" on 10 November 2006 and 17 January 2008. They were returned undelivered. On 7 February 2008, E-Promote was shown as the registrant and contact for the disputed domain names. A "cease and desist" letter of 8 February 2008 to E-Promote was unanswered.

The relevant part of the disputed domain name is confusingly similar to the Complainant's marks. The word TELSTRA is an invented word and therefore not one which traders would legitimately use unless they were trying to create a false association.

This is a typical case of typosquatting when the disputed domain names are one letter less than or different from the complainant's registered trademark. Accordingly,

the inevitable conclusion is that the Respondent has registered the disputed domain names in order to create a false association with the Complainant.

The Respondent has been the unsuccessful respondent in at least 10 previous domain name disputes. Nine of these decisions were issued in the last two years before the filing of this Complaint and six have been issued under the NZ Domain Name Dispute process.

The disputed domains in the hands of the Respondent are unfair registrations. The Respondent acquired them in a manner which took unfair advantage of and was unfairly detrimental of the Complainant's rights. The disputed domain names have been, and will continue to be used, in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's rights pursuant to Paragraph 3 of the Policy.

The Respondent is not commonly known by the disputed domain names, nor does it have any connection or association with the Complainant. The Complainant has not licensed or permitted the Respondent to use any of its trademarks or to incorporate them in a domain name. The Complainant's trademarks have been registered for several years before the disputed domain names were registered. The Respondent is "internet-savvy", as is evidenced by its ownership of multiple domain names and its participation in other domain name dispute cases.

The Respondent registered the disputed domain names, which are confusingly similar to the Complainant's marks, with actual knowledge of the Complainant's marks, intentionally to attract users to its website. The circumstances provide clear evidence of an attempt by the Respondent to derive benefit by confusing, misleading or deceiving internet users into believing that the disputed domain names are registered to and operated by or authorised by or otherwise connected with the Complainant in an attempt to derive benefit from the close resemblance to the disputed domain names and the Complainant's trademarks and its goodwill in contravention of Paragraph 5.1.2 of the Policy. Numerous cases in support were cited by the Complainant.

The disputed domain names resolve to websites from which it may be inferred that the Respondent derives profit. The use and registration of disputed domain names which incorporate misspellings of the Complainant's trademarks does not reveal a genuine offering of goods or services or a legitimate non-commercial use but rather an attempt to derive benefit from a close resemblance of the disputed domain names and the Complainant's trademarks and goodwill.

The Respondent (either as E-Promote or Domain Admin) has engaged in a pattern of registrations where the Respondent is the registrant of names which correspond to well-known names or trademarks in which the Respondent has no apparent rights.

The Complainant submits that E-Promote and Domain Admin are the same entity.

#### **b. Respondent**

The Respondent made no submissions

## 6. Discussion and findings

The first matter which the Complainant has to prove is that it has rights in respect of a domain name or trademark which is identical or similar to the disputed domain names. The Complainant is the owner of a trademark for TELSTRACLEAR, as well as for other trademarks involving either the word "Telstra" or the word "Clear". It has owned these marks for a considerable period before the disputed domain names were registered.

The disputed domain names are confusingly similar to the Complainant's marks. They represent classic examples of typo-squatting, that is, a phenomenon whereby a disputed domain name is similar to a well-known domain name or trademark but usually with one additional letter, one letter omitted or one letter incorrect.

Accordingly, the Expert considers that the Complainant has proved that it has rights in respect of the trademark similar to the disputed domain names.

The next question is to whether the Complainant has shown there has been an unfair registration which is relevantly defined in the Policy as:

"a domain name which either:

- (1) was registered or otherwise acquired in a manner which at the time when the registration took place took unfair advantage of or was unfairly detrimental to the Complainant's rights; or
- (2) has been or is likely to be used in a manner which took unfair advantage of or was unduly detrimental to the Complainant's rights."

A non-exhaustive list of facts which may be evidence that a disputed domain name is an unfair registration is set out in paragraphs 5.1.1 to 5.1.5 of the Policy. Of particular relevance is 5.1.2 which reads:

"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 inference is inescapable that the disputed domain names have been registered with slight misspellings of the Complainant's trademarks in the hope that some people might be directed to the Respondent's sites through mistyping. The inference is also quite clear that persons accessing the Respondent's websites through the disputed domain names may be confused into believing that the websites have some connection with the Complainant. The Complainant's submissions on this point are accepted by the Expert.

A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in Paragraphs 6.1.1 to 6.1.4 of the Policy. There is no evidence that any of these apply. The Respondent has chosen not to participate in this process. The onus is on the Respondent to show that it came within one or other of these provisions.

The Respondent is operating "click-through" websites which, presumably, it operates for gain. This is further evidence of bad faith.

The evidence of other abusive registrations by the current Respondent or an entity connected with it, even within the short life of the .nz Dispute Resolution Service, is a further factor in holding that these registrations are unfair.

## **7. Decision**

The decision, therefore, is that the disputed domain names telstaclear.co.nz, telsraclear.co.nz and telstarclear.co.nz should be transferred by the Complainant to the Respondent.

**Place of decision** Auckland

**Date** 6 June 2008

**Expert Name** Hon Sir Ian Barker QC

**Signature** \_\_\_\_\_