

.nz Dispute Resolution Service

DRS Reference: 1297

Neil Protheroe

v

**Odin Advnetures
Brendon Harris**

Key words -

Domain name

Identical or similar trade mark or name
Registered mark – trade name - identical

Rights

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

Procedure
Transfer

1. Parties

Complainant:

Neil Protheroe
Manakau Lodge
198b Parsons Road RD 1 Kaikoura
New Zealand

Respondent:

Odin Advnetures
Brendon Harris
30 Queens Road
Waikanae
New Zealand

2. Domain Name

manakaulodge.nz

3. Procedural history

- 3.1. The complaint was lodged on 19 April 2018 and the Domain Name Commission (DNC), notified the respondent of the validated complaint on 26 April 2018. The domain was locked on 20 April 2018, preventing any changes to the record until the conclusion of this proceeding.
- 3.2. No Response was received to the complaint.

- 3.3. On 7 June 2018, the complainant paid Domain Name Commission Limited the appropriate fee for a decision of an Expert, pursuant to paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4. On 27 June 2018, Maria Dew, Barrister, the undersigned, (“the Expert”) confirmed to the DNC 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

The complainant

- 4.1. The complainant is Mr Neil Protheroe. Since December 2012, Mr Protheroe has operated an accommodation services business known as “Manakau Lodge”. This business operates a boutique luxury lodge called Manakau Lodge in Kaikoura, South Island (“the complainant’s lodge”).¹
- 4.2. In his complaint, the complainant describes Manakau Lodge as “*targeted to the discerning traveller and offer[ing] a high end level of luxury and sophistication, with industry-leading in-room technology and exceptional standards of comfort and guest amenities*”. This description accords with the photographs and descriptions of the complainant’s lodge available on “*Booking.com*”², “*tripadvisor.com*”³ and on its own website,⁴ as well as a number of other websites advertising the lodge. The complainant’s lodge is located in a scenic setting and offers four private rooms with various amenities, including private bathrooms, an iPad in each room and a large music and movie library available to guests.
- 4.3. Since early 2012, the complainant has owned and made continuous use of the domains <manakaulodge.com> and <manakaulodge.co.nz> in promoting and marketing the complainant’s lodge within New Zealand and internationally.
- 4.4. In 2012, the complainant also registered a combined trademark named “Manakau Lodge”. The deemed date of registration of this trademark is 9 March 2012 and the IP Number of the trademark is 955293. The trademark consists of a drawing of a mountain range with the words “MANAKAU LODGE” printed underneath the drawing. The complainant has, since December 2012, used the Manakau Lodge trademark throughout the marketing of the Manakau Lodge business. The complainant produced photographs showing that the trademark appears on various items used at the complainant’s lodge, including postcards, staff uniforms, guest bathrobes, the visitor book, gift bags and menus.

¹ I am satisfied the complainant’s lodge has continuously operated since December 2012. There are numerous guest reviews of the complainant’s lodge available online dated 1 January 2013 until the present date, which indicate the complainant’s lodge has continuously operated for that period.

² Booking.com website <<https://www.booking.com/hotel/nz/manakau-lodge.en-gb.html?label=gen173nr-1DCAorgFCDW1hbmFrYXUtbG9kZ2VIM1gEaK4BiAEBmAEUwgEKd2luZG93cyAxMMgBD9gBA-gBAfgBCJICAXmoAgM;sid=ba2c09a406144884444b19ffccb7e0bc>>.

³ Tripadvisor website <https://www.tripadvisor.co.nz/Hotel_Review-g255374-d3636091-Reviews-Manakau_Lodge-Kaikoura_Canterbury_Region_South_Island.html>.

⁴ Manakau Lodge website <<https://www.manakaulodge.com/>>.

4.5. The complainant referred me to the “*Booking.com*” and “*tripadvisor.com*” pages for his lodge as evidence of the complainant’s lodge’s goodwill and international reputation. Upon reviewing those pages, I have confirmed that the complainant’s lodge enjoys a good reputation. It is highly ranked by guests on the websites “*Booking.com*” and “*tripadvisor.com*”, having a rating of five out of five stars on both websites.⁵ There are a number of positive reviews on both websites, particularly from overseas guests located in the UK, USA and Europe. Recent comments by guests include:

- (a) “*Fabulous place to stay!*” (*Booking.com*, 13 March 2017)
- (b) “*This is better than you can dream!*” (*Booking.com*, 22 February 2018)
- (c) “*All and all, a true gem of an accommodation. You won’t want to leave once you’ve arrived.*” (*Tripadvisor.com*, 16 March 2018)
- (d) “*[N]o expense has been spared on this place, the décor and the fixtures and fittings are to a very high standard.*” (*Tripadvisor.com*, 22 March 2018)
- (e) “*Excellent! Number one choice in Kaikoura. Look no further.*” (*Booking.com*, 2 April 2018)
- (f) “*This super clean and cozy b&b is just awesome! Neil is super, very friendly and incredibly informative...Breakfast is really really good and the room is very clean, spacious with apple tv and iPad for you to enjoy.*” (*Tripadvisor.com*, 3 April 2018)
- (g) “*Set a few Km outside of Kaikoura, in a rural spot with a majestic mountain backdrop, the Lodge is a high-spec modern affair, and all done with professionalism and good taste. The bed was particularly comfortable, and the breakfast was delicious!*” (*Tripadvisor.com*, 16 April 2018)

4.6. The complainant also produced evidence of a Facebook page for the complainant’s lodge, with photos and links to reviews of complainant’s lodge. Again, the Facebook page contains a number of positive reviews of the complainant’s lodge.

4.7. The complainant alleges that the domain name <Manakaulodge.nz> held by the respondent is an Unfair Registration. The complainant seeks an order by the Expert transferring the domain name to the complainant.

The respondent

4.8. The domain name in question, <manakaulodge.nz>, was registered on 18 April 2018. The registrant is the named respondent, a business named Odin Advnetures. Odin Advnetures is the trading name of Mr Brendon Harris of

⁵ Booking.com website <https://www.booking.com/hotel/nz/manakau-lodge.en-gb.html?label=gen173nr-1DCAorgFCDW1hbmFrYXUtbG9kZ2VIM1gEaK4BiAEBmAEuwgEKd2luZG93cyAxMMgBD9gBA-gBAfgBCJICAXmoAgM;sid=ba2c09a406144884444b19ffccb7e0bc>; Tripadvisor website <https://www.tripadvisor.co.nz/Hotel_Review-g255374-d3636091-Reviews-Manakau_Lodge-Kaikoura_Canterbury_Region_South_Island.html>.

Waikanae, who is named in the registrant's details. Odin Advnetures and Mr Harris are together referred to as "the respondent" in this decision.

- 4.9. The respondent, like the complainant, operates an accommodation services business (respondent's lodge). The respondent's lodge is located in the township of Manakau, a settlement in the Horowhenua District, north of Wellington.
- 4.10. The complaint states that, until November 2017, the respondent's lodge was known as Manakau Hotel. According to the complaint, in November 2017, the respondent's lodge was renamed "Manakau Lodge" – the identical name to the complainant's business. The respondent uses the <manakaulodge.nz> domain name to advertise the business and take bookings.
- 4.11. I have not been able to verify when the respondent's lodge was renamed "Manukau Lodge". However, I have visited the website at the domain name currently at issue. The respondent's lodge appears to provide relatively casual accommodation, based on the information on its website. It provides both private room and dorm style rooms with shared bunk beds, aimed at backpackers. The website also suggest the change of name to "Manakau Lodge" occurred recently in the following description of the respondent's hotel:

"Manakau Lodge was the old Manakau Hotel. We have recently converted it to a backpacker/lodge. A lot of the old hotel features are still there to keep the 100 year old history of the building.

Having travelled a lot our self aim [sic] is to give our guests a relaxed fun time while they explore our great region."

- 4.12. I have also been provided with the registration details of the <manakaulodge.nz> domain name, which record the domain name was registered on 27 November 2017.
- 4.13. The respondent's use of the <manakaulodge.nz> domain name was brought to the complainant's attention on 16 December 2017 by a third party who was not known to the complainant. That third party sent the complainant an email about the respondents' hotel, expressing concern about potential confusion caused by the use of the same name.
- 4.14. The complainant states that on or around 18 December 2017, he spoke to Mr Harris by phone and that Mr Harris offered to transfer the <manakaulodge.nz> domain name to the complainant and rebrand the business accordingly. However, the complainant states subsequent phone calls and emails to the respondent were not responded to and no transfer or rebranding has occurred.

5. Parties' contentions

Complainant

- 5.1. The complainant submits the respondent's use of the identical trading name and promotion of it by using the <manakaulodge.nz> domain name causes obvious confusion in the market, unfairly capitalises on the complainant's business' goodwill and reputation and risks harming the reputation of the complainant's lodge. In particular, the complainant contends:

- (a) People who wish to stay at the complainant's lodge, and have little knowledge of New Zealand's geography, may be unable to distinguish between the complainant's lodge and the respondent's lodge when searching online.
- (b) The respondent's use of the <manakaulodge.nz> domain name gives the false impression that the respondent's lodge is related to, registered to, operated by, authorised or endorsed by the complainant's business. The complainant points to the results of a simple Google search for "manakau lodge", which brings up results for both the complainant's and respondent's businesses on the first page of the Google search.
- (c) The respondent's use of the <manakaulodge.nz> domain name undermines the goodwill and reputation which has been established by the complainant's use of the <manakaulodge.com> and <manakaulodge.co.nz> domain names since 2012, and presents a risk of disruption to the complainant's business.
- (d) By using the <manakaulodge.nz> domain name to promote his business, the respondent seeks to capitalise on and profit from the internet traffic generated by the complainant's existing internet presence. The complainant has noted a Google website analytics report dated 15 March 2018 recorded his business was viewed over 22,000 times in the last quarter, with approximately 1,530 searches for the name "manakau lodge" recorded in the last quarter. The complainant contends that the respondent's use of the domain name will allow him to enjoy the benefit of this level of internet traffic in a way which will confuse and deceive the public.
- (e) The complainant also refers to the respondent's lodge as "*clearly targeted to the low ticket, backpacker market and offers a style of accommodation of very basic quality and sparse facilities*", in contrast to the high-end, luxury nature of the complainant's boutique lodge. The complainant considers there is a risk that confusion of the two lodges could result in damage to the reputation of the complainant's lodge. The Complainant refers, in particular, to the importance of online reviews. There is, however, no suggestion that the complainant's lodge has actually received negative reviews as a result of confusion with the respondent's lodge. It appears the complainant's point is that people who search for "Manakau Lodge" online might erroneously attribute poor reviews given to the respondent's business to the complainant's business.

5.2. I consider the complainant's assertions may constitute evidence of an Unfair Registration under paragraphs 5.1.1(c) (unfair disruption of business) and/or 5.1.2 (likely to confuse, mislead or deceive) of the DRS Policy.

Respondent

5.3. The respondent has not provided a response to the complaint. Nevertheless, the Expert has attempted to evaluate whether there is any evidence contrary to the complainant's position.

- 5.4. I have considered the potential application of the factors at 6.1.1 of the DRS Policy (set out above) which may point away from this registration being an unfair registration.
- 5.5. The respondent does operate a business called “Manukau Lodge” and use the domain name to advertise his lodge and take bookings. This is not a case where the respondent does not have a genuine or legitimate business using the name in question. Therefore, for the purposes of paragraph 6.1.1(a) of the DRS Policy, the respondent’s use of the domain name was in connection with a genuine offering of goods or services. In addition, for the purposes of paragraph 6.1.1(b) of the DRS Policy, the respondent’s lodge has the same name as the domain name. In terms of paragraph 6.1.1(c) of the DRS Policy, the respondents have arguably made fair use of the domain name.
- 5.6. The issue, therefore, is whether the respondent was aware of the Complainant’s cause for complaint at the time the respondent registered the domain name. If the respondent was aware, the matters discussed above will not support the argument the registration is not an unfair registration.
- 5.7. I have not been given any information as to whether the respondent was aware of the complainant’s cause for complaint when the domain name was registered. However, given the fact Mr Harris is in the accommodation services industry, I find on a balance of probabilities, and in the absence of any contrary indication by the respondent, that Mr Harris would have been aware the Manakau Lodge name had been used by the Complainant since 2012. A simple Google search of that name would have made Mr Harris aware of this. Accordingly, I do not consider the factors in paragraph 6.1.1 will assist the respondent in this case.

6. Expert discussion and findings

- 6.1. The DRS Policy issued by the DNC governs the present complaint. The complainant is required to prove to the Expert on the balance of probabilities that the following two elements are present (para 4.1):

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. An Unfair Registration is defined in the policy (para 3):

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.*

- 6.3. The DRS Policy sets out a non-exhaustive list of factors which may evidence that the Domain Name is an Unfair Registration including, as relevant to this present case:

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

[...]

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

- 6.4. The DRS Policy also sets out a non-exhaustive list of factors which may evidence that the Domain Name is not an Unfair Registration, including relevantly (para 6):

“ 6.1.1 Before being aware of the Complainant’s cause for complaint (not necessarily the Complaint itself), the Respondent has:

(a) used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;

[...]

(c) made legitimate non-commercial or fair use of the Domain Name;....”

- 6.5. The DRS Policy notes that by themselves trading and holding Domain Names are lawful activities (refer para 6.4).

Does the Complainant have rights in respect of a name or mark?

- 6.6. I accept that, since 2012, the complainant has operated the Manakau Lodge and used domain names incorporating the words “Manakau Lodge” to advertise his lodge and operate bookings. I also accept that since 2012 the complainant has held a registered trademark incorporating the words Manakau Lodge and that he uses this trademark throughout this business. I therefore accept the complainant has rights in respect of the words “Manakau Lodge”.

Is the name or mark in which the complainant has rights identical or similar to the domain name – manakaulodge.nz?

- 6.7. I accept that the domain name and the name “Manakau Lodge”, over which the complainant has rights, are identical.

Is the domain name in the hands of the respondent an Unfair Registration?

- 6.8. As I have indicated, the complaint in this case may establish an unfair registration under paragraphs 5.1.1(c) (unfair disruption of business) and/or 5.1.2 (likely to confuse, mislead or deceive) of the DRS Policy.
- 6.9. I have concluded paragraph 5.1.1(c) is not made out on the facts and evidence I have before me. In order for this to be established, I must find there are circumstances indicating the respondent has registered or otherwise acquired the domain name *primarily* for the purposes of unfairly disrupting the business of the complainant. While I accept the respondent's use of the domain name *could* unfairly disrupt the complainant's business (ie by people intending to book a room at the complainant's lodge mistakenly booking a room at the respondent's lodge), there is no evidence before me indicating the respondent registered the domain name primarily for this purpose. There are other reasons the respondent may have decided to refer to his business as a lodge, for example for the purposes of refreshing the business or wanting the business' name to align better with the style of accommodation provided. For that reason, I do not consider an Unfair Registration under paragraph 5.1.1(c) is established.
- 6.10. I have, however, concluded there are 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, so as to constitute an Unfair Registration under paragraph 5.1.2. In particular:
- (a) There is some force in the complainant's submission that potential guests could confuse the complainant's lodge with the respondent's lodge. When the words "manakau lodge" are searched on Google, results appear for both the complainant's and respondent's lodges. Given most of the complainant's guests appear, from the reviews on *Booking.com* and *Tripadvisor.com*, to be from overseas, those guests are unlikely to have enough knowledge of New Zealand geography to distinguish the two hotels. I note, however, that out of the Google search results for "manakau lodge", the majority of results are for the complainant's business, so this risk of confusion may be lower than the complainant asserts. I am nevertheless satisfied there is enough of a risk of confusion to suggest an unfair registration in terms of paragraph 5.1.2 of the DRS Policy.
 - (b) For the same reasons discussed above, I accept the respondent's use of the domain name is likely to give the false impression the respondent's lodge is related to the complainant's lodge. This again suggests an unfair registration in terms of paragraph 5.1.2 of the DRS Policy.
 - (c) I do not necessarily accept the respondent's use of the domain name undermines the complainant's goodwill and reputation, as there is insufficient evidence of this. I do accept, however, that the respondent's use of the domain name may allow the respondent to unfairly capitalise on the complainant's goodwill and reputation for the benefit of the respondents' hotel, because the two hotels are capable of being mistakenly assumed to be related or the same. I also accept the respondents' use of the domain name will allow the respondents to obtain the benefit of the complainant's internet traffic. I consider this is a factor suggesting an unfair registration.

- (d) The complainant runs a boutique, luxury bed and breakfast lodge business. I accept this is quite different from the business run by the respondent, which is a more inexpensive and casual lodge catering to large groups, backpackers and families. While I do not necessarily accept the complainant's characterisation of the respondent's lodge as "*very basic quality*" (it does provide amenities such as free shuttles, wi-fi, surf, bike and kayak rental and outdoor areas), it is certainly far from the luxury service offered by the complainant. I accept the complainant would not wish for his business to be confused with the respondent's business for that reason, and that such confusion may harm the complainant's business' reputation. I also accept there may be some risk of online reviews of the respondent's lodge being mistakenly attributed to the complainant. I accept those risks indicate the domain name is an unfair registration.

6.11. I accept that the Domain Name is an Unfair Registration in the hands of the respondent under paragraph 5.1.2 of the DRS Policy.

7. Decision

7.1. The respondent's registration of the domain name < manakaulodge.nz >, is an Unfair Registration in breach of the DRS Policy. I determine that the disputed domain name should be transferred to the complainant.

Place of decision Auckland
Date 11 July 2018
Expert Name Maria Dew, Barrister

Signature

