

# **.nz Dispute Resolution Service**

**DRS Reference: 1362**

**The British United  
Provident Association  
Limited  
Matthew Mclroy**

**v**

**Ian Turk Management  
Limited  
Ian Turk Management**

## **Key words –**

*Identical or similar trade mark or name*

Registered mark - unregistered mark

*Unfair registration*

Unfair registration – unfair use –likely to confuse, mislead or deceive – protest site

## **Registrar – Umbrellar Limited t/a Freeparking**

### **1. Parties**

#### **Complainant:**

The British United Provident Association Limited  
Matthew Mclroy  
Level 2, 109 Carlton Gore Road  
Newmarket  
Auckland  
New Zealand

#### **Respondent:**

Ian Turk Management Limited  
Ian Turk Management  
P O Box 29 045  
Ngaio  
Wellington  
New Zealand

### **2. Domain Name/s**

bupa.nz

### **3. Procedural history**

- 3.1.** The Complaint was lodged on 14 May 2019 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 16 May 2019. The domain/s were locked on 15 May 2019, preventing any changes to the record until the conclusion of these proceedings.

- 3.2. The Respondent filed a Response to the Complaint on 06 June 2019 and the DNC so informed the Complainant. The Complainant filed a reply on 4 July 2019. The DNC informed the parties on 21 August 2019 that informal mediation had failed to achieve a resolution to the dispute.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 17 October 2019 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4. Robert Fisher QC, the undersigned, (“the Expert”) confirmed to the DNC on 30 October 2019 that s/he knew of no reason why s/he could not properly accept the invitation to act as expert in this case and that s/he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his/her independence and/or impartiality.

#### **4. Factual background**

- 4.1. The essential facts are not in dispute. The Complainant (“Bupa”) is an international healthcare company incorporated in 1947. In 2018, the Bupa group had a global revenue of £11.9bn, £4.656bn of which was derived from Australia and New Zealand.
- 4.2. On 8 July 2005 Bupa incorporated a wholly-owned subsidiary Bupa Care Services New Zealand Limited. It has over 4,500 employees, operates around 50 aged care homes with beds available for almost 4,000 residents, is a provider of dementia care, has over 30 retirement villages with approximately 1,700 units available, 7 rehabilitation facilities and 25 dental clinics.
- 4.3. Bupa is a well-known name in the New Zealand retirement village and aged care sector. In 2008 it registered the domain name bupa.co.nz which it uses in the course of its business. It also has a series of trade marks containing the name “bupa”.
- 4.4. In 2017 Bupa applied for resource consent to build a new three to five storey Care Home in the Wellington suburb of Crofton Downs. Consent was initially given. Local residents then combined to appeal against the proposal in the form sought by Bupa. Mr Turk was one of the organisers of the residents’ group. The appeal was dismissed but the consent was made subject to many conditions.
- 4.5. Within weeks of the resource consent Mr Turk used his company, Ian Turk Management Limited, to register the disputed domain name bupa.nz. The registration was effected on 31 December 2017. The prominent heading to the homepage of the website is “Watchdog on Bupa Crofton Downs” followed by the slightly less prominent statement “Direct all enquiries related to Bupa New Zealand services to bup.co.nz”. An introductory statement then fairly summarises the purpose of the website as follows:

Wellington City Council has recently given consent for the construction of a three to five story Care Home in Crofton Downs Wellington, at 122 Churchill Drive, the previous site of a Brethren Church.

If construction does go ahead, this site will be a watchdog, inviting community involvement to ensure that Bupa comply with the conditions,

and that the finished project has been fairly represented by the montages on which WCC concluded that this care home is in Character with the suburb.

- 4.6. On the website are a series of criticisms of the construction process and an invitation for members of the public to lodge their own complaints. Contact details for the project manager and the Wellington City Council are provided for that purpose.
- 4.7. The Respondent used the domain as a host for two email addresses, ian@bupa.nz and info@bupa.nz.
- 4.8. On learning of the Respondent's website Bupa offered to buy the domain in return for Mr Turk's costs associated with registering the domain. Mr Turk demanded \$25,000 plus GST which he said would cover the costs of the resource consent appeal and an allowance for distress. Bupa said it would pay no more than those costs directly associated with the domain. Although Mr Turk reduced his figure to \$20,000 plus GST, negotiations broke down when Bupa was not prepared to meet that figure.
- 4.9. In an email of 11 April 2018 Mr Turk advised Bupa that he had put a "return to sender" block on any emails not addressed specifically to his two email addresses. However, by email of 30 April 2018 he advised that he was no longer prepared to continue with that arrangement.

## 5. Parties' contentions

- a. Bupa contends that it has rights in the name Bupa, that the disputed domain name is confusingly similar and that Mr Turk's registration was and is an unfair registration.
- b. The Respondent contends that his registration was not, and is not, an unfair registration.

## 6. Discussion and findings

- 6.1 The dispute is governed by the Policy issued by Domain Name Commission Ltd on behalf of InternetNZ. The foundation for a complaint is found in these extracts from paras 3 and 4 of the Policy:

### 3. Definitions ...

**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;

### 4. Dispute Resolution Service

- 4.1 This Policy and Procedure applies to Respondents when a Complainant asserts to the DNC according to the Procedure, 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.

4.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities. <sup>(L)</sup><sub>(SEP)</sub>

6.2 It will be seen that to support a complaint of the present kind, the Complainant must satisfy three requirements:

- a) It has rights in respect of a name or mark (para 4.1.1);
- b) The name or mark and the Domain Names are identical or similar (para 4.1.1); and
- c) Registration of the Domain Name was or is unfair in the hands of the Respondent (para 4.1.2).

***(a) Rights in respect of a name or mark***

6.3 The Complainant has two independent sources of the right to use the name “Bupa”. One emanates from the reputation it has built up as a retirement and health care provider using that name (technically a common law mark protected by an action for passing off). The other is its registration of a succession of trade marks using that name. Satisfaction of this requirement was not challenged in the present case.

***(b) Identity or similarity between the name or mark and the Domain Name***

6.4 The second requirement is that the Complainant's name or mark be identical or similar to the Domain Name. Satisfaction of this requirement is not challenged either. The word “bupa” is common to both the Complainant's name and the Domain Name.

***(c) Unfair registration in the hands of the Respondent***

6.5 The third requirement is unfair registration. Unfair registration is governed by paras 3 and 5 of the Policy which materially provide:

**3. Definitions**

...

**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;

**5. Evidence of Unfair Registration**

5.1. A non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration is set out in paragraphs 5.1.1 – 5.1.5;

...

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;

...

6.6 For the purpose of this case it is sufficient to consider whether the Respondent has been using the Domain Name in a way which is likely to confuse, mislead or deceive people into believing that the Domain Name is authorised by Bupa. The following factors are relevant when answering that question:

6.6.1 For this purpose the Respondent's intentions are irrelevant - it is solely the effect that matters.

6.6.2 A Google search for "bupa crofton downs" or "bupa nz watchdog" brings up the disputed Domain Name.

6.6.3 A user's inadvertent omission of "co" when attempting to reach the Complainant's Domain also brings up the disputed Domain Name.

6.6.4 In either of those situations, the deception occurs at the outset when the user first clicks on the link to the Respondent's site.<sup>1</sup> The fact that there is ample warning once the user reaches the Respondent's website does not negate the initial deception that is likely to have already occurred.

6.6.5 Protest sites can usually avoid deception by including a warning in the domain name itself e;g by including the words "watchdog", "ihate" or "sucks" in the domain name. But it is too late to inform the user of the true position once he or she has already been diverted to the protest site.

6.6.6 The Respondent agreed to include on its website the warning "Direct all enquiries related to Bupa New Zealand services to bup.co.nz" and to introduce a "return to sender" block on any emails not addressed specifically to the Respondent's two email addresses. Arguably those two measures were a tacit acknowledgement that users might otherwise inadvertently arrive at the Respondent's site rather than the Complainant's.

6.6.7 Any use of the Domain Name by the Respondent to send emails would be likely to mislead or deceive, since the recipients would be receiving messages from someone whose email address appeared to be that of the Complainant.<sup>2</sup>

6.7 Mr Turk advanced a number of arguments said to negate unfair registration. They can be summarised as follows:

6.7.1 The use to which the disputed Domain Name has been put falls outside the classes in which the Bupa trademarks have been registered – but (i) the Respondent's use of the disputed domain is exclusively concerned with the Complainant's health and retirement project which falls within the trade mark classes; and (ii) the broader action of passing off is not confined to registered trade mark classes.

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<sup>1</sup> *Teak Construction Group Ltd v Payback Limited* (DRS) 1045: *Abortion Law Reform Association of New Zealand Inc v Mybook* (DRS 474: [alranz.org.nz](http://alranz.org.nz)); *Rayden Engineering Ltd v Diane Charlton* (Nominet D06284).

<sup>2</sup> *Opinel SAS v Hamish Pirie* (DRS1236).

- 6.7.2 Bupa did not avail itself of the opportunity to oppose the Respondent's registration  
– but this is not legally relevant.
- 6.7.3 The local group of objectors distributed a brochure to local residents removing any doubts over responsibility for the disputed Domain  
– but that was no answer for the rest of the country.
- 6.7.4 Mr Turk had included in the Respondent's website the note "Direct all enquiries related to Bupa New Zealand services to bup.co.nz"  
– but the relevant deception would have already occurred by the time a user reached that warning.
- 6.7.5 As the disputed Domain was used as a blog site, communication was generally by posts and responses through the site, not by email. Mr Turk could not recall any emails that had been sent using the bupa.nz domain other than returns of incorrectly addressed emails  
– but the latter illustrates the very confusion with which para 5.1.2 of the Policy is concerned.
- 6.8 My conclusion is that the Respondent has been using the Domain Name in a way which is likely to confuse, mislead or deceive people into believing that the Domain Name is authorised by Bupa. That makes it unnecessary to consider other potential grounds for categorising the registration as unfair.
- 6.9 The third and final requirement for a successful complaint is therefore satisfied. This was an unfair registration within the meaning of para 5.1.2 of the Policy.
- 6.10 All three elements for a successful complaint are satisfied.

## 7. Decision

7.1 The disputed Domain Name is to be transferred to the Complainant.

**Place of decision** Auckland, NZ

**Date** 31 October 2019

**Expert Name** Robert Fisher

**Signature**

