

.nz Dispute Resolution Service

DRS Reference: 1060

H-D U.S.A., LLC

v

**After Hours Home Physio
Dave Furneaux**

Key words – Domain Names confusingly similar to registered marks – Unfair Registration – taking unfair advantage of or unfairly detrimental to Complainant's rights – likely to mislead or deceive – unfairly disrupting Complainant's business

1. Parties

Complainant:

H-D U.S.A., LLC
3700 West Juneau Avenue
Milwaukee, 53208
Wisconsin
United States of America

Represented by: Mr Thomas Huthwaite

Respondent:

After Hours Home Physio
Dave Furneaux
13 Export Drive
Molendinar
QLD 4214
Australia

2. Domain Name/s

harleydavids.com.nz
harleysforsale.com.nz

3. Procedural history

- 3.1. The Complaint was lodged on 19 December 2014 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 05 January 2015. The domains were locked on 19 December 2014, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. There was no response filed by the Respondent.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 16 February 2015 for a decision of an Expert, pursuant to Paragraph 9 of

the .nz Dispute Resolution Service Policy ("the Policy").

- 3.4. Hon Barry Paterson QC, the undersigned, ("the Expert") confirmed to the DNC on 17 February 2015 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 an incorporated company under the laws of the United States of America with its registered head office in Wisconsin.
- 4.2. For more than 100 years it has manufactured, advertised and sold motor cycles under the trade mark HARLEY-DAVIDSON. It also offers motor cycle parts, accessories, merchandise and various other products and services relating to motor cycles, including rentals, financing, repair, maintenance, dealership, and tour services. It says it is well-known for these goods and services throughout the world and in New Zealand.
- 4.3. The Complainant relies on registered trademark rights which in New Zealand date back to 1985. The various registered trade marks will be referred to later but they include the words HARLEY-DAVIDSON, HARLEY, and HARLEY OWNERS GROUP in a number of classes.
- 4.4. The Complainant also has many registered trade mark rights in Australia and these date back to 1968. The Complainant has supplied details of its Australian trade marks as the Respondent is based and trades in Queensland, Australia.
- 4.5. The Complainant owns and operates several domain names and websites at harley-davidson.com which has different versions for different countries. In New Zealand it holds the domain names harleydavidson.co.nz and harley.co.nz. These link to its primary website.
- 4.6. The Respondent registered the Domain Names on 27 May 2012 although the Complainant did not become aware of the registrations until November 2014. It has registered similar domain names in Australia.
- 4.7. The Domain Name harleydavidsons.co.nz (the first Domain Name) automatically redirects to harleydavidsonaustralia.net.au. The other Domain Name harleysforsale.co.nz (the second Domain Name) does not redirect to any website.
- 4.8. The Australian website harleydavidsonaustralia.net.au contains the following statement:

Based on the Gold Coast of Queensland but servicing Australia wide, Quality Harleys, is the Internet Brand of Queensland Performance P/L. Queensland Performance P/L are Licensed Motor Vehicle Dealers who specialise in the sale of near new quality used, immaculate, late model, low mileage Harley-Davidson motorcycles. Our clients are based throughout Australia, transporting the bike to any main centre is not a problem and our transport provider delivers to most towns in Australia.

- 4.9. The Australian website is the website of Queensland Performance P/L (QP) whose registered address is 13 Export Drive, Molendinar, Queensland. The Respondent's agent, David Furneaux, has the same address. Helen Furneaux is the sole shareholder and director of QP. The Australian domain name was registered by Shadex Industries P/L, which was formerly known as "The Trustee of the Furneaux Family Trust", which is registered in Australia as a discretionary trading trust. The Australian website has frequent references to "Dave".

5. Parties' contentions

(a) Complainant

- 5.1. The Complainant relies on Rights under various trade marks registered in New Zealand. It also claims to have a reputation and goodwill in various alternatives of HARLEY including in particular HARLEY-DAVIDSON. It relies on the reputation and goodwill as a Right which entitles it to bring passing off and breach of the Fair Trading Act 1986 actions against those who use HARLEY-DAVIDSON in competing businesses. This, in effect, is a claim that the Complainant has Rights in these two particular names which exist regardless of the trade marks.
- 5.2. The Complainant has a wide range of trade marks registered in New Zealand. For the purposes of this decision it is only necessary to refer to the following:
- (a) The trade mark HARLEY-DAVIDSON is registered in Class 12 in respect of cycles including motor cycles and parts and fittings therefor. While many of its other trade marks are not relevant to this Complaint, many are and the classes in the relevant trade marks include motor cycle helmets, motor cycle electrical parts and gauges of various descriptions, parts and motor cycle helmets and goggles and novelty items for motor cycle enthusiasts.
 - (b) The trade mark HARLEY is registered in respect of services rendered by retail dealers, wholesale dealers and distributors in the fields of motor cycles, and motor cycle parts and accessories. Another trade mark in the name of HARLEY is in respect of motor cycles, motor cycle engines and parts and accessories therefor.
 - (c) The trade mark HARLEY OWNERS GROUP is registered in respect of several classes and included in those classes are magazines relating to motor cycling, newsletters relating to motor cycling, parts and service manuals for motor cycles, parts catalogues for motor cycles, accessory catalogues and lists and organising clubs for motor cycle enthusiasts.
 - (d) There are other trademarks held by the Complainant which include the words HARLEY-DAVIDSON sometimes in stylized form. Some of these relate to dealing in motor cycles and parts and accessories.
- 5.3. It is noted that in respect of the trade mark HARLEY-DAVIDSON, the mark does not give right to the exclusive use of the word DAVIDSON.

- 5.4. Apart from relying upon registered trade marks the Complainant relies upon the reputation and goodwill and the words HARLEY-DAVIDSON and HARLEY which it says are famous throughout the world including New Zealand in relation to various motor cycle goods and services. It has traded in New Zealand under the name Harley-Davidson since 1983 and has manufactured, advertised and sold motor cycles under the trade mark HARLEY-DAVIDSON. In New Zealand it says that it has offered motor cycle parts and accessories, clothing and various other products and services under the two trade marks since at least the early 1980s.
- 5.5. The Complainant utilises a network of authorised dealers to market its motor cycles, parts, accessories and services and sales of its products and services are made at the sites of individual authorised dealers and through the dealers' websites. It has more than 1,500 authorised dealers throughout the world and six of these are in New Zealand while a further 40 are in Australia. The New Zealand dealers are in Wellington, Palmerston North, Christchurch, Hamilton, Auckland and Dunedin.
- 5.6. The Complainant's worldwide revenue exceeds USD5 billion and the number of new Harley Davidson motor cycles registered each year in New Zealand range from 442 in 2005 to 941 in 2011 and totalled 5,130 during that period of seven years.
- 5.7. The Complainant has promoted its products and services on the Internet since at least 1996 with its primary website at www.harley-davidson.com. There are different versions in different countries. Between 1 June 2009 and April 2011, the New Zealand portion of the website received 39,999 hits.
- 5.8. Interbrand, a world leading branding firm, has ranked HARLEY-DAVIDSON in its "top 100" for many years including in 2014.
- 5.9. The Complainant says that the registration of the Domain Names are Unfair Registrations for the following reasons:
 - (a) The names are confusingly similar to the Complainant's famous and registered names and trade mark HARLEY-DAVIDSON and HARLEY and its wider family of HARLEY marks.
 - (b) The Respondent is not and has never been authorised by the Complainant to use the HARLEY-DAVIDSON or HARLEY trade marks or to register the Domain Names. It does not have any rights or legitimate pre-existing interests in the Domain Names.
 - (c) The registration of harleydavidsons.co.nz is being used as a redirection to the domain name harleydavidsonaustralia.net.au.
 - (d) The registration and use of the Domain Names is unfairly disrupting the business of the Complainant, including by drawing unauthorised and false representations between the Respondent and the Complainant and by deleting the Complainant's trade marks. The use of the Domain Names by the Respondent is also likely to mislead, deceive and/or confuse members of the public.

- (e) The Respondent has no legitimate intention for the use of the Domain Names neither of which are the same as the Respondent's name or associated entities.
 - (f) The Domain Names were registered, acquired and/or have been, or are likely to be used in a manner that takes advantage of or is unfairly detrimental to the Complainant's Rights. The Respondent does not have any legitimate right to the Domain Names or any intention to legitimately use the trade names.
- 5.10. The Complainant requested the Respondent to cease using the Domain Names and transfer them to the Complainant. The Respondent refused.

(b) Respondent

- 5.11. The Respondent has not responded to this Complaint.

6. Discussion and findings

- 6.1. The Complainant under paragraph 4.1 of the Policy is required to establish that:
- (a) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - (b) The Domain Name, in the hands of the Respondent, is an Unfair Registration.
- 6.2. Rights as defined in the Policy include, but are not limited to, Rights enforceable under New Zealand law. It is unable to rely on Rights in a name or term which is wholly descriptive of the Complainant's business. This qualification has no application in this Complaint.
- 6.3. The Complainant has Rights by virtue of the trade mark HARLEY-DAVIDSON. It has been accepted that the test to determine whether a name or mark is identical or similar to the Domain Name is a relatively low level test. There can be no doubt that the Domain Name HARLEY-DAVIDSON is identical or similar to harleydavidsons in the first Domain Name. The addition of .co.nz is to be ignored and the plural rather than the singular and the lack of the hyphen are not sufficient differentiating factors. The trade mark HARLEY-DAVIDSON is identical or similar to the first Domain Name.
- 6.4. The second Domain Name, namely harleysforsale.co.nz contains the Complainant's registered trade mark HARLEY. The addition of "for sale" is descriptive and these words do not differentiate the second Domain Name from the trade mark HARLEY which is a worldwide trade mark. In other words, the descriptive words do not break the connection between the second Domain Name and the Complainant's trade mark.
- 6.5. The Complainant's trade marks are Rights which are identical or similar to the Domain Names. It is not necessary for the Complainant to rely upon the Right which it says gives it a Right against the Respondent either for passing off or under the Fair Trading Act 1986. It is suffice to say that this Right also supports the Complainant's position.

- 6.6. Under the Policy, an 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.
- 6.7. In light of the Respondent's failure to reply to the Complaint, it is necessary to draw inferences. The Respondent on the evidence of its own website operates in Queensland but services Australia wide. It specialises in the sale of near new quality used, immaculate, late model, low mileage Harley-Davidson motor cycles. It is prepared to transport its motor cycles throughout Australia and has been selling these motor cycles since 1983.
- 6.8. The Respondent has no business connections with the Complainant which has not given the Respondent the right to use its trade mark or infringe its trade name or goodwill. The Respondent has no known business affiliates in New Zealand. It registered the Domain Names on 27 May 2012. The first Domain Name redirects to the Respondent's Australian website. That website clearly promotes and advertises the Respondent's services which are in competition with those of the Complainant and its authorised distributors and resellers.
- 6.9. If the Respondent were to use the first Domain Name in New Zealand in respect of motor cycle sales and related activities, it would be infringing the Complainant's trade marks. On the face of it, the first Domain Name cannot be used in connection with a legitimate harley-davidson business in New Zealand unless authorised by the Complainant. There is substance in the Complainant's submission that the Respondent has no legitimate intention for the use of the Domain Names in New Zealand.
- 6.10. Paragraph 5.1.2 of the Policy provides that 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, is evidence of Unfair Registration. The fact that the first Domain Name redirects to the Respondent's Australian website supports the Complaint that the Respondent is using the Domain Names in a way which is likely to confuse, mislead or deceive people of business into believing that the Respondent's business is authorised or otherwise connected with that of the Complainant's. Under paragraph 5.1.2 the registrations were Unfair Registrations.
- 6.11. The circumstances also allow an inference to be made that the purpose of the registration was as a blocking registration as it will prevent the Complainant from registering a domain name in which it has Rights (5.1.1(b) of the Policy). Further, an inference can be drawn that the Domain Names are registered for the purposes of unfairly disrupting the business of the Complainant (5.1.1(c) of the Policy).
- 6.12. In summary:

- (a) The Complainant has Rights under its trade marks and its common law mark and goodwill in respect of a mark which is identical or similar to the Domain Names; and
- (b) The Domain Names in the hands of the Respondent, are Unfair Registrations. They are being used in a way which is likely to confuse, mislead or deceive people and businesses. Further they are Unfair Registrations under clauses 5.1.1(b) and (c) of the Policy. They are being used and are likely to be used in a manner unfairly detrimental to the Complainant's Rights.

7. Decision

- 7.1. It is directed that the Domain Names are to be transferred to the Complainant.

Place of decision Auckland
Date 27 February 2015
Expert Name Hon Barry Paterson QC

Signature

