

.nz Dispute Resolution Service

DRS Reference: 1088

**Western Bay of Plenty
Tourism & Visitors Trust
Jarrad Carroll**

v

Wayland Mark Warner

Key words

Domain name

bayofplentytourism.co.nz
tourismbayofplenty.co.nz

Identical or similar trade mark or name

Registered mark - unregistered mark – identical – generic – descriptive

Rights

Demonstrable preparations to use – legitimate non-commercial or fair use – generic – descriptive

Unfair registration

Unfair registration – unfair use – fair registration – fair use - likely to confuse, mislead or deceive - pattern of registration – blocking registration

1 Parties

Complainant:

Western Bay of Plenty Tourism
& Visitors Trust
Jarrad Carroll
8 Wharf Street
Tauranga, 3110
New Zealand

Respondent:

Wayland Mark Warner
Wayland Warner
P O Box 13442
Tauranga, 3141
New Zealand

2 Domain Name/s

bayofplentytourism.co.nz
tourismbayofplenty.co.nz

(‘the **Domain Names**’)

3 Procedural history

- 3.1 The Complaint was lodged on 01 May 2015 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 05 May 2015. The domains were locked on 05 May 2015, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 The Respondent filed a Response to the Complaint on 22 May 2015 and the DNC so informed the Complainant on 26 May 2015. The Complainant filed a Reply to the Response on 05 June 2015. The DNC informed the parties on 30 June 2015 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 1 July 2015 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4 Sheana Wheeldon, the undersigned, (“the Expert”) confirmed to the DNC on 07 July 2015 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’s rights

- 4.1 The Complainant is Western Bay of Plenty Tourism & Visitors Trust, a not for profit organisation. It is incorporated under the Charitable Trusts Act 1957 on 8 July 2002, but does not have charitable status. The Complainant is a Regional Tourism Organisation (**‘RTO’**). It describes itself as ‘the official RTO that is responsible for promoting the Bay of Plenty to domestic and international visitors’. It also manages the local Tauranga i-SITE, the official visitor information centre for the Tauranga region. Its website is at www.bayofplentynz.com.
- 4.2 The Complainant is the owner of two current New Zealand trade mark registrations, nos. 981838 and 983831, both of which cover printed

matter and publications in class 16 and a variety of tourism and travel related services in class 39. The respective registered trade marks are:



- a No. 981838:
 - b No. 983831: Tourism Bay of Plenty – Plenty for Everyone.
- 4.3 The Complainant provided details of four expired trade mark registrations it had owned, nos. 683073/4/6/7, all in class 16. All the marks include the words BAY OF PLENTY but none includes the word TOURISM.
- 4.4 The Complainant also asserts unregistered rights in the terms TOURISM BAY OF PLENTY and BAY OF PLENTY TOURISM, stating that:
- a 'Tourism Bay of Plenty' has been its operating brand since at least 2002, 'used to market the Bay of Plenty region to domestic audiences and also at an international level with our partners at Tourism New Zealand'.
 - b Alongside use of 'Tourism Bay of Plenty' as its operating name, 'our current trademarks contain both 'Bay of Plenty Tourism' and 'Tourism Bay of Plenty' variants'.
- 4.5 As evidence of these unregistered rights the Complainant has provided examples of a variety of marketing collateral and images of promotional items, including:
- Bay of Plenty 'Official Visitor Guide & Maps'.
 - Bay of Plenty 'What's On' guide produced by Jasons.co.nz.
 - Stationery.
 - Business cards.
 - Images showing the Complainant's premises, various garments and vehicles.
 - Promotional DVD entitled 'BAY OF PLENTY' carrying the notation www.bayofplentynz.com.
- 4.6 None of this material is dated and it is not clear for how long, over what period, and on what scale it has been distributed and/or used.

The Respondent's activities

- 4.7 The Domain Names were registered in May 2012. At the same time the Respondent registered several other domain names and consulted with IPONZ as to registration of his logo and the mark 'BAY OF PLENTY TOURISM'. He went on to register only a logo trade mark. He also registered the companies Bay of Plenty Tourism Limited and Tourism Bay of Plenty Limited. The latter company was the registered owner of two station wagon vehicles as at 15 December 2012.
- 4.8 From around May 2012 onwards the Respondent was working on developing 'a new online directory for tourism, travel and leisure service providers, businesses and organisations located within the greater areas of: Tauranga, Rotorua, Waihi, Whakatane and Taupo'. (This description, and some further information below, is taken from a letter of introduction sent by the Respondent on behalf of his company, Bay of Plenty Tourism Limited, to the Complainant on 26 April 2013.)
- 4.9 Other preparatory activities carried out by the Respondent included:
- a Paying a website developer to carry out what was described as 'Bay of Plenty Tourism Website Development' in an invoice dated 14 June 2013.
 - b Producing marketing material to elicit listings for his website at www.bayofplentytourism.co.nz (giving email addresses at that domain).
 - c Placing advertisements in the Bay of Plenty Times newspaper in June 2013 (as evidenced by an invoice dated 30 June 2013 and a copy of one of the advertisements).
- 4.10 According to the Response the Respondent introduced himself and his business in person or via email/hand-out letter of introduction to 'hundreds of players throughout the Bay of Plenty tourism industry', including Tauranga City Council, Mount Mainstreet, Katch Katikati and Tauranga Mainstreet/Downtown Tauranga, as well as the Complainant.
- 4.11 Currently the Domain Name bayofplentytourism.co.nz resolves to a relatively brief website describing itself as 'BAY OF PLENTY Tourism, Travel & Leisure Regional Services Directory'. It is stated that in September the site 'will provide a comprehensive listing resource for locals, travelling Kiwis and international visitors to the greater Bay of Plenty'. It invites listings from businesses, clubs, groups or organisations who are asked to submit contact details, a website link, short description and photographs.
- 4.12 The Domain Name tourismbayofplenty.co.nz is currently not operational.

Correspondence between the parties

- 4.13 The Respondent included with the Response copies of various correspondence between the parties, which can be summarised as follows.
- 4.14 As mentioned earlier the Respondent on behalf of Bay of Plenty Tourism Limited wrote a letter of introduction to the Complainant on 26 April 2013. He described his proposed new online directory at bayofplentytourism.co.nz as 'a user-friendly platform, with a sense of community focus and visible local representation'. He acknowledged the work and experience of the Complainant, gave a short description of some features of the site, and sought permission to feature on the site a promotional video, a copy of which he had been given in 2010. His suggestion was that the video be featured 'under the banner of the Bay of Plenty RTO' which he said 'would not only benefit us both, but the region and tourism sector as a whole, and in particular further showcase our hometown of Tauranga'.
- 4.15 This letter was apparently hand delivered, and the Respondent followed it up on 18 May 2013 with an email to the Complainant which ended with the sentence 'I would be happy to share with you our plans to contribute to the promotion of the Bay of Plenty region'.
- 4.16 The Complainant did not respond to these communications. Instead, on 28 June 2013 its lawyers wrote to the Respondent asserting a 'long-standing reputation' in the trade marks 'Tourism Bay of Plenty/Tourism BOP' and complaining about various activities of the Respondent involving use of the names 'Bay of Plenty Tourism' and 'Tourism Bay of Plenty'. The activities complained of included the registration of companies under the names 'Bay of Plenty Tourism Limited' and 'Tourism Bay of Plenty Limited', registration of the Domain Names and the starting of a Facebook page called 'Bay of Plenty Tourism'. The letter asserted that the Complainant had been approached with enquiries about the Respondent's businesses, that there was confusion in the market place, and that the activities of the Respondent and his companies breached section 9 of the Fair Trading Act and amounted to passing off.
- 4.17 The Respondent replied on 12 July 2013 referring to his earlier communications, describing the nature of his business and denying the assertions of misrepresentation. He changed the names of the two companies complained about to, respectively, Bay of Plenty Tourism, Travel & Leisure Limited and Visit Bay of Plenty Limited and said he would rename the Facebook pages.
- 4.18 He said the domains tourismbayofplenty.co.nz and tourismbop.co.nz would be parked on a permanent basis, 'or can be made available for purchase by your client at a nominal cost'.

- 4.19 On 14 August 2013 the Complainant's lawyers responded advising that the Complainant wished to purchase those two domain names and asking what would be the 'nominal cost'. The Respondent replied by email on 29 August 2013 advising that the domain tourismbop.co.nz had expired a few days before he received the letter and suggested the Complainant place a backorder for it. He offered to sell tourismbayofplenty.co.nz for \$250. He says he has not heard from the Complainant or its lawyers since.

5 Parties' contentions

Complainant

- 5.1 The Complainant seeks to have the Domain Names transferred to it from the Respondent.
- 5.2 As mentioned above the Complainant asserts registered and unregistered trade mark rights in the terms TOURISM BAY OF PLENTY and BAY OF PLENTY TOURISM.
- 5.3 The main assertions of the Complainant in support of its Complaint are as follows:
- a The Respondent has registered or otherwise acquired the Domain Names as a Blocking Registration (as set out in paragraph 5.1.1(b) of the Policy) against a name or mark in which the Complainant has rights.
 - b The Respondent is using the Domain Names 'in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant' (as set out in paragraph 5.1.2 of the Policy).
 - c The Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names which correspond to well-known names or trade marks in which the Respondent has no apparent rights, and the domain name is part of that pattern (as set out in paragraph 5.1.3 of the Policy).
- 5.4 In support of these assertions the Complainant says:
- a The Respondent's ownership of the Domain Names is misleading as consumers may believe any associated websites are directly related to the Complainant.
 - b It has received enquiries regarding 'which is the real Tourism Bay of Plenty website' from local operators.

- c These operators are seeking support from the Complainant but discover the (currently fledgling) website at bayofplentytourism.co.nz and are subsequently 'sold illicit paid listings'. The Complainant says this will only increase in time, and would also occur if the domain tourismbayofplenty.co.nz was in active use.
- d Because the current website at bayofplentytourism.co.nz is simply two (static) pages, 'the primary purpose of the website is to mislead user search [sic], primarily due to the lack of content or substance of regional informational services'.
- e 'We feel it is a blatant attempt to act as a 'cyber-squatter' and essentially mislead traffic that is actually looking for Tourism Bay of Plenty for information service'.
- f In relation to the assertion of a 'pattern of registrations' (paragraph 5.1.3 of the Policy) they say:
 - i that by using the domain bayofplentytourism.co.nz the Respondent is intending to provide a sense of authority to a wider network of satellite websites he owns, by giving local operators (i.e. potential advertisers) the impression they are dealing with the official RTO for the region; and
 - ii that the Respondent owns a number of domains that relate to the Bay of Plenty and Tourism activities – for example boptourism.com, visitbayofplenty.co.nz, taurangaaccommodationguide.com.

5.5 In both the Complaint and its Reply the Complainant questions the veracity of some statements made on the website at bayofplentytourism.co.nz and other websites of the Respondent, in the Respondent's promotional material and in the Response. Some of these concerns of the Complainant relate to peripheral matters (such as whether the Respondent's vehicles are branded).

Respondent

- 5.6 The Respondent rejects the Complainant's assertions of misrepresentation, confusion, cyber-squatting and blocking.
- 5.7 The Respondent asserts that the Complainant is attempting to reverse hijack the domain bayofplentytourism.co.nz in which he has legitimate rights and interests including:
 - a registered and established business names;
 - b advertising and historic directory listings;
 - c print media listings;

- d associated domains and other established websites;
 - e website marketing/SEO; and
 - f email contacts with three years of customer dealings.
- 5.8 He asserts that the Complainant's registration in late 2013 of the two trade mark registrations mentioned above is 'an attempt to claim full/part naming rights within the widely used descriptive generic term: BAY OF PLENTY TOURISM'. He says he himself was advised by IPONZ that the only way in which he could register a trade mark would be if he included the wording 'BAY OF PLENTY TOURISM' together with other identifying marks pertaining to 'a specific character and/or unique nature'. It was as a result of this that he proceeded to trade mark only his logo.
- 5.9 He also asserts that the Complaint is 'full of untruths and omissions' and that the Complainant is seeking to discredit his business intentions, personal character and integrity.
- 5.10 In response to the assertion of 'illicit paid listings' he says he has not yet issued any invoices in relation to his upcoming website nor received any funds for listings or advertising. Some businesses have reserved places, but would only be making payment once their listing was 'live' online. The Respondent says his intention was to request payment only when all categories within the directory were completed and ready for publishing.
- 5.11 Some of the Respondent's criticisms of the Complainant and the Complaint are not relevant to the matters at issue and will not be repeated here.

Complainant's Reply

- 5.12 In its Reply the Complainant provided some further facts, questions and explanations relating to some relatively minor issues. It also indicated that it would be prepared to purchase the Domain Names (and one other) but only on condition the Respondent gave various undertakings concerning future use not only of 'TOURISM BAY OF PLENTY' and 'BAY OF PLENTY TOURISM', but also of 'TOURISM BOP', 'BOP TOURISM', 'TBOP' or 'BOPT'.

6 Discussion and findings

Relevant Provisions of the Policy

- 6.1 The Complainant is required to prove that it has met the requirements in paragraph 4 of the Policy namely that:

- 6.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - 6.1.2 The Domain Name, in the hands of the Respondent, is an Unfair Registration.
- 6.2 Paragraph 4.2 requires the Complainant to prove to the Expert that both elements are present on the balance of probabilities.
- 6.3 The expression 'Rights' is defined in paragraph 3 of the Policy. That definition goes onto state:

However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business.
- 6.4 The Policy provides that 'Unfair Registration' means a Domain Name which either:
 - a 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
 - b 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.
- 6.5 Paragraph 5.1 of the Policy sets out a series of non-exhaustive factors which may be evidence that a Domain Name is an Unfair Registration. They include the following:
 - 5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - a. 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; or
 - b as a blocking registration against a name or mark in which the Complainant has rights; or
 - 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;

- 5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the Registrant of domain names (under .nz or otherwise) which correspond to well-known names or trade marks in which the Respondent has no apparent rights and the Domain Name is part of the pattern;
- 6.6 Paragraph 6.1 of the Policy sets out a series of non-exhaustive factors which may be evidence that the Domain Name is not an Unfair Registration. They include the following:
- 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;
 - b been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
 - c made legitimate non-commercial or fair use of the Domain Name; or
- 6.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character.

Application of the Policy in this case

- 6.7 The first question is whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name. Rights must be enforceable under New Zealand law and may be registered or unregistered.

Complainant's rights

- 6.8 The Complainant asserts registered and unregistered rights in the terms BAY OF PLENTY TOURISM and TOURISM BAY OF PLENTY which are effectively identical to the Domain Names.
- 6.9 The Complainant's two registered trade marks incorporate the words 'TOURISM BAY OF PLENTY' but in combination with the more distinctive words PLENTY FOR EVERYONE and in the case of no. 981838, a distinctive device.
- 6.10 On their face the terms BAY OF PLENTY TOURISM and TOURISM BAY OF PLENTY appear extremely descriptive in the context of services relating to tourism in the Bay of Plenty area. In the Expert's view neither of these registrations can give exclusive rights to the term

TOURISM BAY OF PLENTY. That is consistent with the advice given by IPONZ to the Respondent.

- 6.11 Further, even if the registrations gave the Complainant rights in the terms TOURISM BAY OF PLENTY, if those words are wholly descriptive of the Complainant's business then the Complainant cannot rely on those rights.
- 6.12 With regard to the unregistered rights the Complainant asserts in BAY OF PLENTY TOURISM and TOURISM BAY OF PLENTY, although these terms are highly descriptive it is at least technically possible that the Complainant could have built up sufficient reputation in them to have unregistered trade mark rights on which to rely. However the Complainant still cannot rely on any such rights if the terms are wholly descriptive of its business.
- 6.13 The Complainant has been using the words TOURISM BAY OF PLENTY as its operating brand since 2002 and asserts that it has also been using trade marks containing both BAY OF PLENTY TOURISM and TOURISM BAY OF PLENTY variants.
- 6.14 The images and examples of promotional material provided demonstrate some use of the words TOURISM BAY OF PLENTY. However this is virtually all in combination with other material, and in



- particular as part of the combination trade mark registered under no. 981838. The only obvious possible use of TOURISM BAY OF PLENTY is if the first four words of this mark were read as such, and not as BAY OF PLENTY TOURISM.
- 6.15 Some of the material (for example the garments and the DVD) appear to display only the words BAY OF PLENTY along with the device of registration no. 981838. As mentioned before, there is no information on how long any of this material has been in circulation, and on what kind of scale
- 6.16 The Complainant's website is at www.bayofplentynz.com and that website is also referred to in much of the Complainant's material.
- 6.17 Given the highly descriptive nature of both BAY OF PLENTY TOURISM and TOURISM BAY OF PLENTY, the fact there is no evidence that the Complainant uses either of these phrases standing alone, and the absence of any information on the scale and duration of its use of its combination trade marks on promotional and other material, the Expert finds that the Complainant has not proved on the balance of probabilities that it has unregistered trade mark rights in either term.

- 6.18 For completeness consideration will also be given to whether these terms are wholly descriptive.
- 6.19 The meaning of 'wholly descriptive' was comprehensively analysed by the Expert in DRS 108, *B.O.P. Memorials v Jones & Company Funeral Services* (coincidentally another 'Bay of Plenty' case). The principles of that decision were succinctly summarised by the Expert in DRS 846, *Wellington Golf Centre Limited v Ricky Faesen Kloet* as follows:
- a *The test for determining whether words are merely descriptive is 'whether the words are equally applicable to any business of the like kind'. There is a continuum with, at the extremes, purely descriptive names at one end and purely invented names at the other. The closer one moves towards a merely descriptive name, the more a complainant will need to show that the name has acquired a secondary meaning equating it with the products of the complainant and the easier it will be to see a small difference in names as adequate to avoid confusion.*
 - b *The more apt a word is to describe the goods or services, the less inherently apt it is to distinguish them as the goods of a particular merchant.*
 - c *If the Complainant's product had acquired a secondary meaning, it must go beyond merely describing the name of the Complainant's services or products.*
- 6.20 In the Expert's view the phrases BAY OF PLENTY TOURISM and TOURISM BAY OF PLENTY are at the 'purely descriptive' extreme end of the continuum. In the *BOP Memorials* case the mark was saved from a finding of being *wholly* descriptive by the fact BOP (which could have other meanings) was used, rather than the full BAY OF PLENTY. Even a phrase such as WELLINGTON GOLF CENTRE could be considered not *wholly* descriptive as there are other ways of describing '*any business of the like kind*' (selling goods and services associated with the sport of golf) though in that case the Complainant did not prove the name had acquired a secondary meaning.
- 6.21 It is difficult to conceive of an alternative descriptive term that another business involved in the field of tourism in the Bay of Plenty could use to describe itself, if it were unable to use the terms TOURISM BAY OF PLENTY or BAY OF PLENTY TOURISM. These terms are entirely apt to describe the Complainant's services and the Complainant has not proved that they have acquired a secondary meaning.
- 6.22 Therefore the Expert finds that the terms BAY OF PLENTY TOURISM and TOURISM BAY OF PLENTY are wholly descriptive. Hence, even if the Complainant did have registered and/or unregistered rights in these terms, the Expert finds that the Complainant could not rely on those rights.

6.23 For completeness the Expert records her finding that she found nothing in the information or annexures filed that supported the Complainant's questioning of the Respondent's veracity.

Are the Domain Names in the hands of the Respondent, Unfair Registrations?

6.24 Given the above findings it is unnecessary to consider whether the Domain Names are Unfair Registrations.

6.25 However for completeness the Expert records her view that:

- a There is no evidence of any of the factors that may be evidence of an Unfair Registration.
- b The Respondent has provided evidence that the Domain Names are not Unfair Registrations, including evidence of the following factors:
 - i Before being aware of the Complainant's cause for complaint, he has:
 - A used and made demonstrable preparations to use the Domain Names in connection with a genuine offering of services; and
 - B made legitimate fair use of one of the Domain Names.
 - ii The Domain Names are generic and descriptive and the Respondent is making fair use of one of them (bayofplentytourism.co.nz) in a way which is consistent with its generic or descriptive character.

7 Decision

7.1 In view of the findings made above the Expert directs that the Domain Names bayofplentytourism.co.nz and tourismbayofplenty.co.nz remain with the Respondent. The Complaint is dismissed.

Place of decision: Auckland

Date: 20 July 2015

Expert Name: Sheana Wheeldon

Signature:

