

.nz Dispute Resolution Service

DRS Reference: 137

Seek Limited v Domain Admin

Key words -

Domain Name – wwwseek.co.nz

Rights – well-known registered trade marks and common law trade marks

Prefix “www” added to Complainant’s Domain Name

Unfair Registration – likely to confuse, mislead or deceive

Pattern of registration – typosquatting

1. Parties

Complainant:

Seek Limited
Level 2
3 Wellington St
St Kilda, Victoria 3182
Australia

Respondent:

Domain Admin
536 Leavenworth St
San Francisco
USA

2. Domain Name/s

wwwseek.co.nz ("the Domain Name")

3. Procedural history

The Complaint was lodged on 3/10/2006 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 6/10/2006. The domain/s were locked on 3/10/2006, preventing any changes to the record until the conclusion of these proceedings.

There was no response filed by the Respondent.

The Complainant paid InternetNZ the appropriate fee on 3/11/2006 for a decision of an Expert, pursuant to Paragraph 9 of the InternetNZ Dispute Resolution Service Policy (“the Policy”).

Hon Barry Paterson QC, the undersigned, (“the Expert”) confirmed to InternetNZ on 3/11/2006 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 Complainant is listed on the Australian Exchange and has a market capitalisation in excess of AUD \$1 billion. It carries on business in New Zealand, Australia and the United Kingdom and provides online employment and job-related classified advertisements (the Complainant’s business). It has conducted such business in New Zealand since at least January 2000.

The Complainant has a New Zealand website seek.co.nz and claims that there are typically more than 16,000 advertisements on that website at any given time. A copy of the front page of the website provided with the Complaint stated: “16,811 jobs online” while a perusal of the website on 7 November 2006 showed “16,259 jobs online”.

The Complainant is the registered proprietor of several trade marks in New Zealand which include a SEEK component. Registered trade mark number 316524 is SEEK and is for “advertising services including classified advertising services; internet advertising including Internet classified advertising services”. Trade Mark No 725362 is a series registration which includes “SEEK seek.co.nz and device” for services including “classified advertising services; advertising services including classified advertising services on a global computer network ... employment advice and information including career development advice and information”.

The Domain Name was registered on 27 June 2006. Details of the Respondent are unknown as is the exact nature of its activities. It has neither filed a response to the Complaint nor did it respond to letters from the Complainant’s attorney. It is the same respondent as the respondent in DRS Reference 113.

5. Parties’ contentions

a. Complainant

The Complainant asserts that since commencing business in New Zealand in January 2000, it has conducted extensive media advertising on television, radio, and in magazines and outdoor billboards. It advertises on many major

online websites such as Xtra MSN, Yellow Pages and NZ Search. It provided copies of online advertisements from these websites. The Complainant asserts it has spent an average of \$1,500,000 per annum over the last 3 years on advertising and marketing in New Zealand.

The Complainant asserts that by virtue of use it is the owner at common law of the trade marks SEEK and "seek.co.nz". In support of this assertion it states that its website is the number 1 employment website in New Zealand as measured by Nielsen/Net Ratings. According to Nielsen unique browsers logging on to the Complainant's New Zealand website have increased from 198,000 in August 2005 to 285,000 in August 2006. An independent survey in July 2006 showed that unaided brand awareness of the SEEK trade mark was 60% in the 18-34 age group and 42% in the 35-49 age group.

The Complainant claims Rights under both the common law trade marks and the registered trade marks.

The Complainant asserts that the Respondent has registered and is using the Domain Name in relation to an online employment and job-related classified advertising service, and is thus using the Domain Name in a business identical to the Complainant's business. Particular reference was made to the prominence of and manner in which the combination Wwwseek.co.nz is displayed on the Respondent's website. The Respondent first used the Domain Name after the Complainant's first use and registration of its trade marks and without the authority of the Complainant.

It is contended that the Domain Name so closely resembles the Complainant's trade marks that consumers and traders in the field of the Complainant's business will, as a natural consequence of the registration and use of the Domain Name erroneously conclude that the Respondent's business has a connection with the Complainant's business or at least be caused to wonder whether that might not be the case.

The Complainant asserts that this is a clear case of "typosquatting" of a well-known name and trade name and an abusive and unfair search engine optimisation technique. It asserts that the Respondent has engaged in a pattern of such registrations including the domain name wwwbnz.co.nz, wwwbarfoots.co.nz and wwwharcourts.co.nz.

The Complainant endeavoured by several means to contact the Respondent asking it to cease using the Domain Name but received no response.

The Complainant claims that:

- (i) the use of the Domain Name is an infringement of registered trade marks under the Trade Marks Act 2002;
- (ii) the use of the Domain Name amounts to passing off as well as conduct in trade that is likely to mislead and cause deception contrary to provisions of the Fair Trading Act 1986.

Accordingly the Complainant submits that for some of the reasons given in paragraph 5.1 of the Policy the registration of the Domain Name was an Unfair Registration.

It is further contended that none of the provisions of paragraphs 6.1 or 6.2 of the Policy, which lists factors which may be evidence that the Domain Name is not an Unfair Registration do not apply.

b. Respondent

The Respondent has not filed a Response.

6. Discussion and findings

The Complainant is required to prove on the balance of probabilities that:

- (i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (ii) the Domain Name, in the hands of the Respondent, is an Unfair Registration.

The Rights

The Expert is satisfied on the balance of probabilities that the Complainant had rights in a mark which is similar to the Domain Name and that such rights arise from both the common law trade marks and the registered trade marks owned by the Complainant. The home page of www.seek.co.nz has the word "SEEK" prominently displayed in more than one position. The evidence is that these marks have been in existence for several years and well before the registration of the Domain Name. The evidence discloses that the Complainant has spent a considerable sum of money developing the Complainant's business and that it is one of the leading employment websites in New Zealand. (Its claim is that it is the number 1 such employment website.) The Expert is satisfied on the evidence that the rights are established in respect of seek.co.nz and SEEK.

It is noted that on the Respondent's website there are several references to the Complainant's domain name on the Sponsored Links. The following two examples illustrate this point:

NZ Jobs- #1 Site SEEK has over 15,000 new jobs Get jobs emailed daily
<http://www.seek.co.nz>
 Interest:

Job-SEEK Thousands of jobs, millions of opportunities. Begin here!
<http://www.seek.co.nz>
 Interest:

Unfair Registration

These sponsored links are evidence not only of the Respondent's knowledge of the use by the Complainant of its domain name but also of the volume of advertisements which appear on the Complainant's website.

The Expert is also of the view that the Complainant has established to the necessary standard that the registration of the Domain Name was an Unfair Registration in accordance with paragraph 5.1 of the Policy. It is not necessary to consider the Complainant's allegations under the provision of subparagraphs 5.1.1(c) and 5.1.4. In the Expert's view the registration was clearly an Unfair Registration under both paragraphs 5.1.2 and 5.1.3 of the Policy which read:

- “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 that pattern;”

This is not the first case in which the Respondent has been involved in which there has been a suggestion of “typosquatting” (see DRS Reference 113 *Barfoot & Thompson v Domain Admin*). The Respondent has set up its website in such a way which is likely to lead to a conclusion that the Respondent is connected with the Complainant's business. Not only is there the use of “seek.co.nz” in the Domain Name, but also there is a direct link to the Complainant's domain name in the sponsored links referred to above. The manner in which the website has been set up leads logically to the view that there is likely to be confusion, misleading or deception of people and also that there is likely to be a belief that the Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant (para 5.1.2 of the Policy).

The use of the prefix “www” is also likely to lead to confusion. It would be very easy for a consumer to overlook the absence of a full stop and to assume that the prefix stands for World Wide Web (www).

Further, the “typosquatting” allegation has substance. Domain names of well-known organisations as noted above clearly suggest a pattern of registration where the respondent is registering domain names which correspond to well-known names or trade marks in which the respondent has no apparent rights. The Domain Name is part of that pattern (para 5.1.3).

In coming to these views it has not been necessary to draw inferences from the Respondent's failure to respond to correspondence or to file a Reply. The evidence is sufficient without drawing the inferences which paragraph B14.3 of the Policy enable the Expert to draw. However, it is noted that the failure of the Respondent to answer complaints in now more than one complaint against it would have enabled the Expert to have drawn an adverse inference if that had been necessary.

The Expert has considered whether any of the provisions of paragraph 6 of the Policy demonstrate that the Domain Name is not an Unfair Registration. There is no evidence upon which the provisions of paragraph 6.1.1 can be applied. Nor is there reason to suggest that 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. In evaluating the Domain Name as a whole and taking particular note of the prefix "www", there is no reason to conclude that the registration was not an Unfair Registration. Further as noted, the Respondent has taken no steps to establish that it is not an Unfair Registration.

7. Decision

The Complainant has satisfied the Expert to the required standard of the balance of probabilities that:

- (i) The Complainant has rights in respect of a name or mark which is similar to the Domain Name; and
- (ii) The Domain Name, in the hands of the Respondent, is an Unfair Registration.

In the circumstances the appropriate remedy is to transfer the Domain Name from the Respondent to the Complainant and there is an order accordingly.

Place of decision	Auckland
Date	10 November 2006
Expert Name	Hon Barry Paterson QC

Signature