

.nz Dispute Resolution Service

DRS Reference: 149

Fleet & Partners Ltd v Fleet Partners Pty Ltd

Key words – registered mark – similar – descriptive – likely to confuse, mislead or deceive – unfairly disrupting the business of the complainant

1. Parties

Complainant:
Fleet & Partners Ltd
PO Box 5265
L9/HSBC House
290 Queen St
Auckland

Respondent:
Fleet Partners Pty Ltd
1 / 600 Victoria Street
Richmond VIC 3121
AUSTRALIA

2. Domain Name/s

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

3. Procedural history

- 3.1 The Complaint was lodged on 13 November 2006 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 16 November 2006. The domain was locked on 13 November 2006, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 The Respondent filed a Response to the Complaint on 5 December 2006 and InternetNZ so informed the Complainant on 5 December 2006. The Complainant filed a Reply to the Response on 15 December 2006. InternetNZ informed the parties on 26 January 2007 that informal mediation had failed to achieve a resolution to the dispute.
- 3.3 The Complainant paid InternetNZ the appropriate fee on 12 February 2007 for a decision of an Expert, pursuant to Paragraph 9 of the InternetNZ Dispute Resolution Service Policy ("the Policy").

- 3.4 The undersigned, the Hon. Robert Fisher QC, on 12 February 2007 confirmed to InternetNZ that he knew of no matters which needed to be disclosed to the parties which might be of such a nature as to call into question his independence and impartiality. On the same day InternetNZ appointed him as Expert to determine the domain name dispute between the parties in accordance with InternetNZ's Dispute Resolution Service Policy and Procedure.
- 3.5 On 20 February 2007 the Complainant applied to file a non-standard submission "to demonstrate that there continues to be market confusion and misuse of the domain name fleetpartners.co.nz." This was declined on the ground that the Complainant had already put before the tribunal evidence on those subjects and that it could be inferred that there would be a continuation of such difficulties as had already been described.

4. Respondent's name and corporate structure

- 4.1 The name and corporate structure of the Respondent have been left unclear in the submissions. The Domain Name is registered in the name of "Fleet Partners Pty Ltd". The Respondent's own submissions refer to itself as "Fleet Holdings Ltd". Details provided by the Complainant as to the Respondent's company structure refer to only four companies - Fleet Holdings (NZ) Ltd, Leasing Finance Ltd, Pacific Leasing Solutions (NZ) Ltd and FleetPartners NZ Trustee Ltd – none of which has any identified connection to the names used in the submissions for the Respondent.
- 4.2 In the Respondent's promotional material it is said that "on 31 October 2006, the Fleet Partners' vehicle fleet leasing and management business in Australia and New Zealand was acquired by the Nikko Principal Investment group from the ANZ group". The acquisition was presumably associated with the evidence that Fleet Holdings Ltd was incorporated on 30 August 2006 and that the Domain Name was registered on 29 September 2006.
- 4.3 In the end it does not seem necessary to call for further evidence on these matters. It seems safe to assume that the Respondent (however described) registered the Domain Name in order to use it in association with a vehicles business which it acquired in late 2006.

5. The Complainant

- 5.1 The Complainant, Fleet & Partners Ltd, was incorporated in New Zealand on 12 February 1974. It has traded as "Fleet & Partners Ltd" since April 1984. Its business concerns personnel management, consulting and recruitment.
- 5.2 On 24 July 1990 the Complainant registered a logo representation of the words "Fleet & Partners" as a trade mark. The mark was registered

for Class 35 which is confined to “services relating to personnel management consulting; services relating to business management and organisation consulting; services provided by employment agencies; commercial or industrial management assistance; business research services”.

- 5.3 On 18 February 1997 the Complainant registered “fleetpartners.co.nz” as its domain name. It has used the domain name in its recruitment business ever since.

6. The Respondent

- 6.1 From September 1998 to 31 October 2006 a company referred to by the parties as “Esanda” operated a vehicle business in Australia and New Zealand. The business had two arms, one concerned with vehicle fleet management and leasing services and the other with retail used car sales. Promotion of both was built around the name “Esanda”. Its website was www.esandafleet.co.nz. To distinguish between the two arms of Esanda’s business, its own staff and customers commonly referred to the two divisions as “FleetPartners” and “AutoSelect” respectively
- 6.2 In late 2006 both arms of the business were acquired by interests associated with the Respondent. This resulted in the Respondent’s registration of the Domain Name on 29 September 2006 and its launch of a website under that name on 1 November 2006.
- 6.3 The Domain Name is now the main domain of the Respondent in New Zealand. The Respondent uses it to provide customers with information about its services, facilities for making enquiries, credit applications and links to the Respondent’s latest news and publications. Since 1 November 2006 the URL www.esandafleet.co.nz has linked to the Respondent through the Domain Name.

7. Confusion

- 7.1 From 1 November 2006 the Complainant has been receiving up to 40 emails per day intended for the Respondent. In all cases the email authors were intending to correspond with the Respondent but inadvertently omitted the letters “nz” where they first appear in the Domain Name.
- 7.2 The receipt of misdirected emails intended for the Respondent has placed a continuing administrative burden on the Complainant. The burden is compounded by related confusion in other forms, examples being Telecom’s direction of 018 enquiries for the Respondent to the Complainant and the debiting against the Complainant’s ACC accounts of claims relating to the Respondent’s injured staff. These have all been cases in which persons trying to find the Respondent have finished up with the Complainant.

7.3 The Complainant has drawn the confusion to the attention of the Respondent and asked the Respondent to adopt a different domain name. The Respondent has declined to do so.

8. Complainant's Argument

8.1 The Complainant complains of the unnecessary administrative burden on its company, the confusion in the market and detractions from its internet and physical brands. It has paid licence fees on its own domain name and has invested heavily in its brand. It is about to launch an upgraded website. It is an equity holder in an international business operating in Asia, Europe, North America and Australasia which makes extensive use of the Complainant's domain name.

8.2 The Complainant further contends that the Respondent is not commonly known as "Fleet Partners" and nor was its predecessor, Esanda. It points out that the Respondent has been trading in New Zealand only since 1 November 2006, that neither the Respondent nor its predecessor in New Zealand, Esanda, had registered any company in New Zealand with the title "FleetPartners Ltd". It contends that the Companies Office would be unlikely to approve any such registration given the conflict that would result with the Complainant's rights in the name "Fleet & Partners Ltd" registered in 1984.

8.3 The Complainant also relies upon its trade mark. It points to the lack of any evidence that either Esanda or the Respondent have trade marked the name "FleetPartners", this contrasting with the Complainant's own registration of that name/logo in 1990.

8.4 The Complainant asks that the Respondent's domain name be withdrawn from the Respondent and that the Respondent be denied the opportunity to register a domain name that has any likelihood of confusion with that of the Complainant.

9. Respondent's Argument

9.1 The Respondent says that the origin of the expression "FleetPartners" was that it was used to distinguish between the two arms of the business while still owned by Esanda. It also refers to the wider use to which the Respondent is now putting that expression.

9.2 The Respondent argues that domain names in .nz space are registered on a first come, first served basis, with the result that more than one party can have a legitimate claim to a particular domain name. That is said to flow from the fact that under cl 6.1 of the Policy one of the ways in which the Respondent can demonstrate that its domain name is not an unfair registration is to show that it has "been commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name".

- 9.3 The Respondent does not dispute the fact that the Complainant has rights in the name “Fleet & Partners” but says that this does not extend to any rights in the name “FleetPartners”. It says that in practice the only place that the Complainant abbreviates its name to “FleetPartners” is in its domain name.
- 9.4 The Respondent says further that any rights that the Complainant has acquired in the name “Fleet & Partners” are limited to the industry in which the Complainant operates and points out that Class 35 in respect of which the Complainant’s trade mark is registered is confined to personnel management and other matters concerned with the organisation of businesses. In the Complainant’s case it is confined to personnel management, consulting and recruitment. It says that any rights the Complainant has acquired in that industry do not imply that the Complainant has exclusive right to the use of the name “FleetPartners” across all industries and in all media in New Zealand.
- 9.5 The Respondent argues that InternetNZ’s Dispute Resolution Service Policy as to unfair registration is primarily concerned with conduct which deliberately results in unfair advantage or detriment. It denies that there was any such conduct on the Respondent’s part.
- 9.6 Specifically, the Respondent points out that its domain name wholly incorporates the Respondent’s trading name with the addition of a generic “nz” postscript which is appropriate given that the Respondent operates primarily in New Zealand.
- 9.7 The Respondent points out that such confusion as has arisen concerns the Respondent’s customers misreading and/or mistyping the Respondent’s email address; there is no suggestion that customers are confused into thinking that the two companies are in any way associated. It further notes that it is only correspondence from the Respondent’s customers that is being incorrectly addressed. The Respondent has not been receiving any emails intended for the Complainant.
- 9.8 The Respondent argues that any rights that the Complainant has in “Fleet” or “Fleet & Partners” lie within its business area of recruitment as opposed to the Respondent’s field which concerns vehicles.
- 9.9 The Respondent contends that the complaint concerns a “problematic administrative issue” rather than the legal issues with which the DRS is concerned.

10. Discussion and findings

- 10.1 The dispute is governed by the Policy issued by the office of the Domain Name Commissioner on behalf of InternetNZ. Critical portions of the Policy in the present case are these:

“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.

...

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

4.1.1 The Domain Name, in the hands of the Respondent, is an Unfair Registration.

...

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:

5.1.1 Circumstances indicating 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;
- (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 that pattern;

5.1.4 The Complainant can demonstrate that the Respondent has knowingly given false contact details to a Registrar and/or to the DNC; or

5.1.5 The Domain Name was registered arising out of a relationship between the Complainant and the Respondent, and the circumstances indicate that it was intended by both the Complainant and the Respondent that the Complainant would be entered in the Register as the Registrant of the Domain Name;”

10.2 It will be seen that to support a complaint of this kind the Complainant must satisfy three elements:

- (a) Rights in respect of a name or mark (para 4.1.1);
- (b) Identity or similarity between that name or mark and the Domain Name (para 4.1.1);
- (c) Unfair registration in the hands of the Respondent (para 4.1.2).

11. Rights in respect of a name or mark

11.1 It is accepted that the Complainant has rights in respect of a relevant name or mark. The rights appear to be these:

- (a) Rights under the Trade Marks Act 2002 in relation to the “Fleet & Partners” logo (Class 35).
- (b) Rights under the Companies Act 1993 in relation to the company name Fleet & Partners Ltd. Attempts by others to reserve a company name which was identical or almost identical would be foiled by s 22(2)(b) of that Act.
- (c) Common law rights in relation to the names “Fleet & Partners”, “Fleet & Partners Ltd”, and “fleetpartners.co.nz”. It is accepted that in the field of recruitment services and related personnel management and consulting the Complainant has acquired a valuable reputation associated with the name of its mark, company and domain name capable of protection in an action for passing off.

12. Identical or similar

12.1 The second requirement is to show that the Domain Name is “identical or similar” to the name or mark in respect of which the Complainant

has rights. In the present case the Domain Name “fleetpartnersnz.co.nz” is undoubtedly similar to the Complainant’s domain name “fleetpartners.co.nz”. It also has some similarity to the names “Fleet & Partners” and “Fleet & Partners Ltd” in respect of which the Complainant has rights derived from the Trade Marks Act, the Companies Act and passing off. Accordingly this requirement is also satisfied.

13. Unfair registration

13.1 The sole remaining question is whether the Complainant has satisfied the third requirement of unfair registration.

13.2 The Policy includes a non-exhaustive list of factors which may be evidence of unfair registration (paras 5.1.1 to 5.1.5).

13.3 As to para 5.1.1, there is no evidence to suggest that when the Respondent registered its Domain Name it did so primarily for the purposes of selling, renting or otherwise transferring it or as a blocking registration or for the purpose of unfairly disrupting the Complainant’s business. The dominant word in the Domain Name is “fleet”. This is descriptive of an aspect of the Respondent’s business concerned with vehicle fleets. The word “partners” readily describes the relationship which the Respondent seeks with its customers when providing management and leasing services in relation to those fleets. Generic or descriptive use of words in the Domain Name is evidence of fair use (para 6.1.2) but in the present context the appropriate use of generic or descriptive use of words can also rebut suggestions of an ulterior motive. Nor is it possible to discern any motive the Respondent might have had for deliberately causing confusion with the Complainant’s name given the unrelated fields in which the two parties conduct their businesses. It is accepted that in registering the Domain Name the Respondent did not have any of the purposes expressed or implied in para 5.1.1.

13.4 As to para 5.1.2, there is certainly evidence that the Respondent is using the Domain Name in a way which confuses in the limited sense that the adoption and use of that particular Domain Name is obviously the cause of the mis-directed emails. However the consequence of the confusion is not a belief that the Domain Name is registered to, operated or authorised by, or otherwise connected, with the Complainant. On the contrary, all the evidence is that the persons sending those emails did so in the belief that they would be received by the Respondent. There is no suggestion that they believed that the Respondent had any connection with the Complainant. It might also be argued that the Respondent’s use of the Domain Name is contributing to a more general confusion in the market place with more widespread consequences for mis-directed mail and the like. Again, however, there is no suggestion that this confusion has resulted in any misconception that the Domain Name is in some way connected with the Complainant.

- 13.5 Nor is there any suggestion that the Respondent is engaged in a relevant pattern of registrations (para 5.1.3), has given false contact details (para 5.1.4) or procured its registration through a relationship between the two companies (para 5.1.5).
- 13.6 That is not an end to the matter, however, given that the list of factors referred to in para 5.1 is expressly stated to be non-exhaustive. In a more general way subparagraphs (i) and (ii) of the definition of “unfair registration” are respectively concerned with registration, acquisition or use of a Domain Name in circumstances which “took unfair advantage of” or were “unfairly detrimental to” “the Complainant’s Rights”.
- 13.7 It will be convenient to begin with the question whether use of the Domain Name is “detrimental” to the Complainant’s rights in the sense that such use has breached, or is likely to breach, one of the Complainant’s legal rights. No definitive finding on that question is possible or appropriate in this setting but a broad survey is helpful en route to the broader question whether the registration is unfair for present purposes.
- 13.8 The Complainant has statutory rights in the trade mark “Fleet & Partners” expressed in the form of a particular logo and used in relation to the Class 35 activities listed earlier. The effect of s 89(1)(c) of the Trade Marks Act 2002 is to preclude the Respondent from using a sign which is similar to that trade mark if a number of other ingredients are present. Among other things, s 89(1)(c) could be invoked only if the Respondent were using the Domain Name as a trade mark in relation to services that are similar to the services described in Class 35.
- 13.9 It could not be suggested that the goods or services offered by the Respondent are similar to the services in respect of which the Complainant’s trade mark was registered. Vehicle fleet management and leasing services and car sales are not “services relating to personnel management consulting; services relating to business management and organisation consulting; services provided by employment agencies; commercial or industrial management assistance; business research services”. Consequently it seems unlikely that there would be any infringement under s 89(1)(c).
- 13.10 Under s 89(1)(d) the Respondent could be taken to infringe the Complainant’s trade mark for use of the Domain Name in relation to services unrelated to class 35 if a number of other requirements were satisfied. But to succeed under this provision the Complainant would have to show, among other things, that the Complainant’s trade mark was well known in New Zealand and that the Respondent’s use of its Domain Name took unfair advantage of, or was detrimental to, the distinctive character or repute of the Complainant’s mark.
- 13.11 Without trying to finally determine the question, there does not appear to be any evidence before this tribunal indicating that the Respondent’s use of its Domain Name has taken unfair advantage of, or been

detrimental to, the distinctive character or repute of the Complainant's trade mark. The distinctive character or repute of the Complainant's trade mark stems from public perceptions of that trade mark. The confusion complained of in this case seems to have come from an entirely different direction. In attempting to reach the Respondent, through the intended use of the Respondent's own Domain Name, members of the public have inadvertently reached the Complainant instead. The people who have misdirected their emails and other communications have been either entirely ignorant of the Complainant's mark or have at least been uninfluenced by it.

- 13.12 Nor is this a case in which the Respondent's registration or use of the Domain Name breaches the Complainant's common law rights or rights under the Companies Act. The essence of passing off is that the plaintiff's business has suffered due to the defendant's misrepresentation to the public that the defendant's goods or services are in some way associated with the plaintiff. There is no suggestion of that in the present case. And of course there is no suggestion that use of the Domain Name in any way impacts upon the exclusivity of the Complainant's name under the Companies Act.
- 13.13 Accordingly in the evidence put before this tribunal there is presently no indication that the Respondent's use of the Domain Name breaches the Complainant's rights in any legal sense.
- 13.14 That still leaves the broader question whether registration, acquisition or use of the Domain Name took or takes unfair advantage of, or was or is unfairly detrimental to, the Complainant's Rights for the purposes of the Policy.
- 13.15 The circumstances in which unfair registration has occurred, or is likely to occur, will never be exhaustively defined. However in the present case two points are significant. The first is that the focus of the unfairness must be the Complainant's rights. There is no doubt that the Respondent's use of the Domain Name is detrimental to the Complainant in the sense that the receipt of misdirected communications intended for the Respondent imposes an unnecessary administrative burden on the Complainant. However the target of the unwelcome communications is not the Complainant's rights.
- 13.16 The other significant element is the moral or ethical dimension inherent in the word "unfair" where it appears in the phrases "taking unfair advantage of" and being "unfairly detrimental to" in the definition of unfair registration.
- 13.17 It has already been noted that there is no evidence to suggest that the Respondent registered the Domain Name for any purpose which it associated with the Complainant or that the Respondent had the Complainant's existing Domain Name in mind as in some way a useful source of leverage when it registered its own name. On the contrary the origins of the Domain Name were evidently the descriptive

reference to “fleet”, the notion of association inherent in the word “partners” and prior use of the word “FleetPartners” in the Esanda business before the question of registering a Domain Name for the Respondent arose. Nor is there any apparent reason why the Respondent would wish to deliberately create confusion in the marketplace between organisations given that they operated, and still operate, in unrelated commercial fields.

13.18 This case would be very different if there were evidence that the similarity in names caused the diversion of business from the Complainant to the Respondent. However there is presently no evidence of that.

13.19 In those circumstances the conclusion must be that the case does not fall within any of the specific examples in paras 5.1.1 to 5.1.5 nor within the more general language used in defining “unfair registration” in para 3. The Complainant has failed to discharge the onus of showing that this was an unfair registration.

14. Decision

14.1 The Complainant has established that it has rights in respect of names which are similar to the Respondent’s Domain Name but has failed to establish that the Domain Name, in the hands of the Respondent, is an Unfair Registration. Accordingly the Complaint is dismissed.

Place of decision

Auckland

Date

22 February 2007

Expert Name

Hon Robert Fisher QC

Signature