

.nz Dispute Resolution Service

DRS Reference: 208

YPG IP Limited v E-Promote

Key words -

Identical or similar trade mark

registered marks – well-known marks – misspelling – phonetic similarity

Rights

None asserted

Unfair Registration

unfair registration – unfair use – likely to confuse, mislead or deceive – pattern of registration – unfairly disrupting business of complainant – respondent having no connection with marks. - typosquatting

1. Parties

Complainant:

YPG IP Limited
c/- Buddle Findlay
Level 18
PriceWaterhouseCoopers Tower
188 Quay Street
Auckland
New Zealand

Respondent:

E-Promote
536 Leavenworth St
San Francisco, CA, 94109
USA

2. Domain Name/s

yellowpages.co.nz
witepages.co.nz
whitpages.co.nz ("the Domain Names")

3. Procedural history

The Complaint was lodged on 15/06/2007 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated

Complaint on 20/06/2007. The domain/s were locked on 15/06/2007, 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 12/07/2007 for a decision of an Expert, pursuant to Paragraph 9 of the InternetNZ Dispute Resolution Service Policy ("the Policy").

Hon Sir Ian Barker QC, the undersigned, ("the Expert") confirmed to InternetNZ on 16/07/2007 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 factual background is taken solely from the submissions and evidence filed by the Complainant. The Respondent did not file a Response. Accordingly, the Panel is prepared to accept the allegations made by the Complainant, which are supported by a statutory declaration from a Mr Swan, corporate counsel with a knowledge of the various factual matters.

The Complainant, YPG IP Limited, acquired the intellectual property rights of Yellow Pages Group Limited ("YPG"). Until 30 April 2007, YPG was a subsidiary of Telecom Corporation of New Zealand Limited ("Telecom"). Another subsidiary of Telecom, Telecom IP Limited, licensed or authorised YPG to use various New Zealand registered trade marks, including the registered marks YELLOW PAGES and WHITE PAGES. Various trade marks for the two expressions 'YELLOW PAGES' and 'WHITE PAGES' had been registered over the years. Copies of the relevant registrations were exhibited to Mr Swan's declaration. These confirm that the Complainant is now the registered proprietor of the trade marks.

The Complainant also owns the domain names <yellowpages.co.nz>, <yellowpages.net.nz> and <whitepages.co.nz>. The Complainant, or its predecessors in interest, have been producing Yellow Pages and White Pages directories for many years. The White Pages contain lists of telephone subscribers and their telephone numbers covering all the various regions of New Zealand. Some 4.3 million copies of the White Pages are printed and circulated in New Zealand as the official telephone directory. The information in the White Pages telephone directories is also freely available on the internet. In 2006, there were about 1.7m searches per month and some 130,000 every week.

The Yellow Pages directories for various regions contain an anthology of business classifications used to describe goods and services which are

grouped and which are available for search by business description. By searching for a particular category, a user can obtain details of businesses listed under that classification. There are some 4.3 million printed editions of the Yellow Pages. There are some 330,000 searches per day and 10 million searches per year of the online Yellow Pages website.

The Complainant and its predecessors enjoy a significant reputation in both the YELLOW PAGES and WHITE PAGES marks, due to extensive advertising over the years by its predecessors.

Both the YELLOW PAGES and WHITE PAGES marks have been extensively marketed over the years by the Complainant and its predecessors in interest.

In the Respondent's websites, accessed through the disputed domain names, there are a number of business categories which direct a user to the Respondent's sponsored websites. Under the disputed domain names witepages.co.nz and whitpages.co.nz, one link is to "findpeople". On clicking this link, the user is directed to a number of sites that enable the user to find a person or a relationship. It is not a directory service to search for telephone numbers.

The Respondent, E-Promote, is closely related to Domain Admin which has been found to have made unfair registrations in Decision 113, *barfoot.co.nz* and Decision 137, *seek.co.nz*. Domain Administration Limited features in a table of abusive registrations prepared by Nominet in the United Kingdom.

5. Parties' contentions

a. Complainant

The Complainant is the owner of registered trade marks for YELLOW PAGES and WHITE PAGES. These trade marks have been in existence for many years during which they have been utilised and marketed by the Complainant's predecessors in interest. All goodwill and reputation which had accrued in these trade marks belongs now to the Complainant which has purchased the intellectual property rights from YPG.

Adding yet another "L" to the word 'Yellow' in YELLOW PAGES and misspelling the word "WHITE" as "whit" and "wite" in WHITE PAGES make the disputed domain names confusingly similar to the Complainant's trade marks and domain names.

The registration of the domain names was made unfairly to disrupt the Complainant's business. The Respondent uses the domain names in a way likely to confuse, mislead and deceive internet users into believing that the disputed domain names are connected to the Complainant.

The Respondent is engaged in a pattern of conduct of registering well-known names in which it has no apparent rights.

These are all clear cases of “typo-squatting”. If a person wishes to access one of the Complainant’s sites, either whitepages.co.nz or yellowpages.co.nz, and makes a certain kind of mistake, he or she will be directed to the Respondent’s site.

In addition, internet users seeking a Yellow Pages site who access the Respondent’s site are likely to be confused as to whether they have arrived at the correct website. The Respondent’s website provides a number of business categories that direct a user to particular sponsored websites. The user may consider mistakenly that he or she has arrived at a Yellow Pages website.

The continued use by the Respondent of the disputed domain names will dilute the Complainant’s trade mark. The Respondent’s Yellow Pages website is not a complete business directory. The services available on that site are not to the same standard as these available on the Complainant’s website.

An internet user accessing the Respondent’s websites under the disputed domain names whitpages.co.nz or witepages.co.nz will be confused as to whether he or she has arrived at the correct website. These websites have a “find people” link which indicates to the user that he/she can find contact details of a person on the website when, in fact, he/she cannot.

The Complainant will suffer a loss of revenue through internet users using the Respondent’s websites and not the Complainant’s website. The quality of services on the Respondent’s website is not the same. The use of an inferior website will dilute the Complainant’s trade mark.

b. Respondent

The Respondent made no submissions.

6. Discussion and findings

The first matter which a Complainant has to prove is that it has rights in respect of a domain name or a trade mark which is identical or similar to the Respondent’s domain names. Here, the Complainant is the legitimate successor to the original registrants of the trade marks for WHITE PAGES and YELLOW PAGES. Consequently, the Expert finds that the Complainant has rights under the Policy in respect of the registered trade marks and also the domain names whitepages.co.nz and yellowpages.co.nz.

The disputed domain names are confusingly similar to the Complainants' trade marks. They represent classic examples of typo-squatting; that is, a phenomenon whereby a disputed domain name is similar to a well-known domain name or trade mark but with usually one additional letter, one letter omitted or one letter incorrect.

Accordingly, the Expert considers that the Complainant has proved that it has rights in respect of a trade mark or domain name similar to the disputed domain names.

The next question is whether there has been an "unfair registration" which is relevantly defined in the Policy as:

"a domain name which either:

- (i) was registered or otherwise acquired in a manner which at the time when the registration 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 and was unduly detrimental to the Complainant's rights."

A non-exhaustive list of facts which may be evidence that a disputed domain name is an unfair registration is set out at paragraphs 5.1.1 to 5.1.5 of the Policy. Of particular relevance is 5.1.2 which reads:

"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 a domain name is registered to, operated or authorised by or otherwise connected with the complainant."

In the present case, the inference is inescapable that the disputed domain names have been registered with slight misspellings of the Complainant's trade marks and domain names in the hope that some people might be directed to the Respondent's sites through mis-typing. The inference is also quite clear that persons accessing the Respondent's websites through the disputed domain names, will be confused into believing that the websites have some connection with the official White Pages and Yellow Pages of the New Zealand telephone directory system.

A non-exhaustive list of factors which may be evidence that the domain name is not an unfair registration is set out at paragraphs 6.1.1 to 6.1.4 of the Policy. There is no evidence that any of these apply. The Respondent has chosen not to participate in this process. The onus would be on the Respondent to show that it came within one of these provisions.

The Respondent is operating "click-through" websites which, presumably, it operates for gain. It cannot possibly provide the comprehensive services both by way of an anthology of goods and service providers or a list of telephone

subscribers, which an enquirer seeking to utilise 'Yellow Pages' or 'White Pages', would expect.

The evidence of other abusive registrations, by the Respondent or entities connected with it even within the short life of the .nz Dispute Resolution Service, is a further factor in holding that these registrations are unfair registrations.

7. Decision

The decision, therefore, is that the domain names yellowpages.co.nz, whitpages.co.nz and witepages.co.nz should be transferred to the Complainant by the Respondent.

Place of decision Auckland

Date 23 July 2007

Expert Name Hon Sir Ian Barker QC

Signature