

## **.nz Dispute Resolution Service**

**DRS Reference: 235**

### **Melbourne IT CBS v E-Promote**

Key words – Rights, Complainant not owner of mark or name, Procedure: agent of owner filing complaint; dismissal without prejudice to owner's right to file fresh complaint.

#### **1. Parties**

Complainant:

Miss Sara Freixa

Melbourne IT CBS

2-5 Benjamin Street

1st Floor

London

United Kingdom

Respondent:

E-promote E-promote

E-promote

536 Leavenworth St. Suite 95

Ca

94109

San Francisco

United States

#### **2. Domain Name**

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

#### **3. Procedural history**

The Complaint was lodged on 3/10/2007 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 8/10/2007. The domain/s were locked on 3/10/2007, 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 15/11/2007 for a decision of an Expert, pursuant to Paragraph 9 of the InternetNZ Dispute Resolution Service Policy ("the Policy").

Mr Warwick Smith, the undersigned, ("the Expert") confirmed to InternetNZ on 16/11/2007 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. The Expert was appointed by InternetNZ as independent expert to resolve this complaint under the Policy, on 19/11/2007.

#### **4. Factual background**

The Complaint is sparse. It consists of few short paragraphs, followed by an invitation to the Expert to view the website at [www.umbro.com](http://www.umbro.com) (which is said to be the "official" website of UMBRO International Limited).

There are 4 annexures, two of which appear to show that the latter company is the proprietor of a number of trade marks consisting of or prominently including the word "Umbro", in New Zealand and in the European Union.

The Complainant is named in the Complaint as Miss Sara Freixa, of Melbourne IT CBS, London, United Kingdom. It is not clear from the Complaint what office Miss Freixa holds in Melbourne IT CBS.

The Complaint commences:

"Our client UMBRO International Limited is the owner of the trade mark "UMBRO" registered in different countries all over the world including New Zealand ...."

The Complaint includes the statements required by paragraphs B2.3.8 and B2.3.9 of the Policy, over an indecipherable signature which the Expert presumes to be that of Miss Sara Freixa.

The Complaint asserts that the Respondent is using the Domain Name for the purpose of deriving pay-per-click advertising revenue, by pointing the Domain Name to a website which contains links to other sites, including sites which offer for sale products of the same kind as those sold by UMBRO International Limited (including football apparel and footwear). A screenshot from a website to which the Domain Name has resolved was annexed to the Complaint. It is undated. It contains click-on links grouped under a number of categories, which include "Football Jerseys" and "Footwear".

#### **5. Parties' contentions**

##### **a. Complainant**

The Complainant contends that "My clients has the registered trademark", and that the Respondent has no trademark registered.

The Complainant further contends that the Respondent is using the Domain Name to mislead internet users into visiting the website to which

the Domain Name resolves, for the purpose of deriving click-through revenue when some of those site visitors click on the links to other sites (including sites marketing the same kinds of products as those marketed by UMBRO International Limited). The Complainant contends that that constitutes bad faith use of the Domain Name.

**b. Respondent**

The Respondent did not submit any Response.

**6. Discussion and findings**

The complaint cannot succeed unless *the Complainant* shows that she (or it, if the Complainant is Melbourne IT CBS) has Rights in respect of a name or mark which is identical or similar to the Domain Name (Policy, Paragraph 4.1.1). In this case, neither Ms Sara Freixa nor Melbourne IT CBS even *claims* to have Rights in any relevant name or mark – the complaint simply asserts “that our client UMBRO International Ltd is the owner of the trade mark “UMBRO”.....” UMBRO International Ltd is not named as a Complainant.

In the circumstances described above, the parties named in the Complaint have no standing to bring the Complaint, and it must be dismissed.

Quite clearly, UMBRO International Ltd should have been named as the Complainant. If that had been done, the above-described flaw, which is fatal to the Complaint, would have been avoided. It would also have been clear that the various statements required by paragraphs B2.3.8 and B2.3.9 of the Policy were being made on behalf of the real party in interest (UMBRO International Ltd), and not simply on behalf of Miss Freixa, or Melbourne IT CBS.

The Panel has considered whether the defect might be cured by permitting an amendment to the Complaint, to add UMBRO International Ltd as an additional complainant. But no such amendment has been sought, whether by UMBRO International Ltd or by the present named Complainant or Complainants, and it is by no means clear that such an amendment would be permissible under the Policy. Furthermore, any amended complaint would have to be re-notified to the Respondent, and the Respondent would have to be given a further period of 15 days to file a Response (in case the Respondent elected to ignore the original Complaint in the belief that it could not possibly succeed because the named Complainant(s) was/were not asserting any relevant Rights).

Having regard to the last point in particular, the Expert can see little practical benefit in looking further at the question of possible amendment of the Complaint. The simplest and best solution is to dismiss the Complaint,

without prejudice to the Right of UMBRO International Ltd to file a fresh complaint in respect of the Domain Name, if it wishes to do so.

Any such fresh complaint will have to comply with all provisions of the Policy, including the requirement that the statements included pursuant to paragraph B2.3.9 of the Policy must be followed by the signature of "the Complainant or its authorised representative". If the signature on any such fresh complaint is to be that of the Complainant's authorised representative, the signature should be followed by the name of the signatory, together with words showing the basis of the signatory's authority to sign (e.g. "solicitor and authorised representative of the Complainant", or "[office or job description] of/for the Complainant with authority to sign this Complaint on the Complainant's behalf").

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## 7. Decision

The Complaint is dismissed, without prejudice to the right of UMBRO International Limited to file a new complaint under the Policy in respect of the Domain Name.

**Place of decision**                      **Auckland, New Zealand**

**Date**                                        **29 November 2007**

**Expert Name**                            **Mr Warwick Smith**

**Signature**

A handwritten signature in black ink, appearing to read 'Warwick Smith', with a stylized flourish at the end.