

.nz Dispute Resolution Service

DRS Reference: 241

L. Archer v Daddio's Developments Limited (Struck Off)

Key words – Identical or Similar trademark or name

registered mark – identical

Rights

None shown

Unfair Registration

unfair use – unfairly disrupting business of Complainant

1. Parties

Complainant:

Mr Lincoln Archer

c/- Draig Goch Limited

238 B Victoria Street

Hamilton

New Zealand

Respondent:

Daddio's Developments Limited (Struck Off)

PO box 101

Matamata

New Zealand

2. Domain Name/s

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

3. Procedural history

The Complaint was lodged on 26/10/2007 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 31/10/2007. The domain was locked on 26/10/2007, 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 4/12/2007 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 6/12/2007 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 filed by the Complainant. The Respondent did not file a Response. The information provided in the Complaint was minimal. The Complaint had not been prepared with the benefit of legal advice. There was barely enough information provided to enable a proper assessment to be made of the Complainant's case.

The Complainant, Lincoln Archer, and one, B Janis Rothwell, are jointly registered as proprietors of New Zealand trademark 684163 for the words DADDIOS PIZZA & MEXICAN and of New Zealand Trademark 7212228 for the word DADDIOS. The registrations for these marks were effected on 10 December 2003 and 17 June 2004 respectively. The marks are being used in connection with takeaway food and restaurant services.

The disputed domain name <daddios.co.nz> was registered on 8 August 2000. According to the Complainant, it was registered by a Mr Stephen Jones who started a pizza business in New Zealand called Daddios in 1994. which he franchised out to various people, including the Complainant. Mr Jones was said by the Complainant to have traded in New Zealand under an alias and to have been arrested in the United States, where he is said to have broken his conditions of bail. He is then alleged to have been rearrested and imprisoned.

The registrant of the disputed domain name is a company called Daddio's Developments Limited, with a post office box address in Matamata. According to a certificate from the Registrar of Companies, this company was incorporated on 31 May 1996 and was removed from the Register on 7 August 2007.

The website operated under the disputed domain name advertises an operation called "Daddio's" promoting the sale of pizzas through outlets called "Daddio's". The website lists pizza outlets trading under that name in various parts of New Zealand. It invites persons interested in becoming franchisees to consider a franchise agreement for a Daddio's outlet. It specifically refers to "**Daddio's – Pizza & Mexican**". The 'Contact Us' link refers to Daddio's Developments Limited with an address in Mosgiel, not Matamata.

The Complainant alleges that the site has not been updated since 2004 but is being used to drive traffic to the United States. He claims there are Daddios operators in New Zealand trying to operate legitimately and having to compete with a website that promotes the wrong pricing and gives inaccurate information on store locations and service expectations. He has received distressing and abusive calls relating to wrong information on this website.

He claims that the website of the disputed domain name is paid for from the United States, driving traffic to that country at the expense and inconvenience of New Zealand pizza businesses operating under the name of Daddio's.

5. Parties' contentions

a. Complainant

The Complainant is part-owner of registered trademarks for the words DADDIOS and DADDIOS PIZZA & MEXICAN. The website of the disputed domain name gives inaccurate information and has unfairly disrupted the Complainant's business.

b. Respondent

The Respondent made no submissions.

6. Discussion and findings

The first matter which a complainant has to prove is that he has rights in respect of a domain name or trademark which is identical or similar to the respondent's domain name.

Here, the Complainant is one of the owners of trademarks for DADDIOS and for DADDIOS MEXICAN AND PIZZA. Consequently, the Expert finds that the Complainant has rights in respect of registered trademarks which are identical or similar to the disputed domain name. The disputed domain name is identical to one of the Complainant's marks and similar to the other.

The next matter that a complainant must prove is whether there has been an "unfair registration" which is relevantly defined in the Policy as:

"a domain name which either:

- (1) 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
- (2) has been or is likely to be used in a manner which took unfair advantage of or 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 in paragraphs 5.1.1 to 5.1.5 of the Policy. The one relevant here is para. 5.1.2, **viz:**

- 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...”

In the present case, the inference is inescapable that the Respondent is using the disputed domain name in a way that is likely to confuse or mislead internet users into believing that the disputed domain name is registered to, operated or authorised by or otherwise connected with the Complainant.

Moreover, by giving inaccurate information about products and prices, the website harms businesses such as the Complainant’s, which use the name Daddio’s for selling pizzas.

A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in Paras 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 have been on the Respondent to show that it came within one of these provisions, had it chosen to respond to the Complainant.

The fact that the Respondent is now a struck-off company does not present a difficulty. The situation with regard to struck-off companies as respondents was dealt with at length by the Expert in *Intercity Group NZ Ltd v. Traction Group Ltd* (DRS ref. 101). The Expert confirms his view in that case that disputes under the DRS are proceedings *in rem*. Therefore it is not relevant to the Expert’s decision that the Respondent company no longer exists legally.

7. Decision

The decision is that the disputed domain name <daddios.co.nz> should be transferred to the Complainant by the Respondent.

Place of decision	Auckland
Date	17 th December 2007
Expert Name	Hon Sir Ian Barker QC

Signature
