

.nz Dispute Resolution Service

DRS Reference: 255

UMBRO International Ltd v E-promote

Key words

Domain name – umbro.co.nz

Identical or similar trade mark or name – registered marks – well-known marks – identical or similar

Rights – none asserted by Respondent

Unfair registration – blocking registration – unfairly disrupting the business of the Complainant – pattern of registration – Respondent having no connection with trade mark or name

Procedure – resubmission of earlier complaint – remedies – transfer

1. Parties

Complainant:

UMBRO International Ltd
Umbro House
Lakeside Cheadle Royal Business Park
Cheadle (Cheshire)
SK8 3GQ
Cheshire
United Kingdom

Respondent:

E-promote
Suite 95, 536 Leavenworth Street
San Francisco
CA 94109
United States of America

2. Domain Name

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

3. Procedural history

- 3.1 This case is the sequel to DRS 235¹. In that case, the Expert ruled that the parties named in the Complaint had no standing to bring the Complaint, and the Expert dismissed the Complaint without prejudice to the right of UMBRO International Ltd (“the Complainant”) to file a new Complaint under the Policy in respect of the Domain Name. In accordance with the Expert’s decision in that case, the Complainant has lodged the Complaint in this case.
- 3.2 In this case, the Complaint was lodged on 14 January 2008. InternetNZ, through the Office of the Domain Name Commissioner (“the DNC”)², notified the Respondent of the validated Complaint by letter dated 14 January 2008. The domain was locked on 14 January 2008, preventing any changes to the record until the conclusion of this case.
- 3.3 The letter from the DNC to the Respondent dated 14 January 2008 attached a copy of the Complaint and a copy of the InternetNZ Dispute Resolution Policy (“the Policy”)³ and Procedure. The letter advised the Respondent as follows:

In accordance with the Procedure, you have 15 working days, **ie until Thursday, 7 February 2008** to respond to the complaint. In order to be valid, your response must comply with the Procedure, and must be received by InternetNZ in both hard copy and electronic form.

If you respond within the deadline, the Complainant will be given an opportunity to submit a written reply, and the matter will then be referred for mediation. InternetNZ makes no charge for this service. If mediation is not successful, the matter may be referred to an independent expert for a decision.

Please note that no decision has been made at this stage.

Do not ignore this letter. If you do not submit a response by the deadline, this matter may be referred to an independent expert for a decision without further reference to you, which may result in the transfer, suspension or cancellation of the domain name(s).

- 3.4 The Respondent has been a respondent in previous .nz Dispute Resolution Service cases, namely DRS 203 *Thai Airways International Public Company Limited v E-Promote* (thaiairways.co.nz, 9 July 2007); DRS 206 *Telecom IP Limited v E-Promote* (tellecom.co.nz and wwwferrit.co.nz, 16 July 2007); DRS 208 *YPG IP Limited v E-Promote* (yellowpages.co.nz, witepages.co.nz and whitpages.co.nz; 23 July 2007) and the precursor to this case, namely DRS 235. In none of those cases did the Respondent submit a Response to the Complaint.
- 3.5 The Respondent did not submit a Response to the Complaint in this case. By letter dated 8 February 2008, the DNC advised the Respondent that the Complaint would be referred to an independent expert for decision if the Complainant paid the appropriate fees by 22 February 2008. The

¹ *Melbourne IT CBS v E-Promote*, 29 November 2007.

² The DNC is an operational office of InternetNZ (the Internet Society of New Zealand Inc) responsible for the day-to-day oversight of the .nz domain name registration and management system.

³ Words beginning with uppercase letters in this decision include terms defined in Paragraph 3 of the Policy.

Complainant paid the appropriate fees by wire transfer on 20 February 2008.

- 3.6 Mr Terence Stapleton, the undersigned, confirmed to InternetNZ 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. On 27 February 2008, Mr Stapleton was appointed to act as the independent expert in this case (“the Expert”) pursuant to Paragraph 9 of the Policy.

4. Factual background

- 4.1 The Complainant was founded in 1920. The Complainant owns the trade marks “UMBRO” (word and logo) which are registered in various countries worldwide. In New Zealand, the word is registered trade mark number 126159 and the logo is registered trade mark number 103346 (“the trade marks”). The trade marks were registered in New Zealand before the Domain Name which was registered on 4 July 2007.

- 4.2 The only definition for the word “UMBRO” found online is:

Umbro (LSE: UMB) is an internationally recognised football brand based in Cheadle, Greater Manchester, England. Umbro designs, sources and markets football-related apparel, footwear and equipment and its products are sold in over 90 countries worldwide.

5. Parties’ contentions

(a) Complainant

- 5.1 The Complainant contends:

- (a) the Respondent does not have any Rights in the Complainant’s trade marks;
- (b) the Respondent is not using the Domain Name;
- (c) the Respondent’s registration of the Domain Name is stopping the Complainant from marketing its products in New Zealand where it has the trade marks.

(b) Respondent

- 5.2 As noted above, the Respondent has not filed a Response to the Complaint.

6. Discussion and findings

6.1 The dispute is governed by the Policy. Relevant provisions of the Policy in this case are as follows:

3. Definitions

Rights includes, but is not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business;

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;

Part A – Policy

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

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

4.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

...

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;

6.2 For an Expert to uphold a Complaint, the Expert must be satisfied that the Complainant has proved the following elements on the balance of probabilities:

- (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).

7. Rights in respect of a name or mark

7.1 The Expert is satisfied on the balance of probabilities that the Complainant has Rights in respect of a relevant name or mark, namely the trade marks.

7.2 The Rights described in paragraph 7.1 of this decision are legal rights; they are not merely “rights in a name or term which is wholly descriptive of the Complainant’s business”.

8. Identical or similar

8.1 The Expert is satisfied on the balance of probabilities that the trade marks are identical or similar to the Domain Name.

9. Unfair registration

- 9.1 The Expert is satisfied on the balance of probabilities that, in all the circumstances, the Domain Name is an Unfair Registration because:
- (a) the circumstances demonstrate that the Respondent registered the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has Rights (para 5.1.1(b)); and/or
 - (b) the circumstances demonstrate that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant (para 5.1.1(c)); and/or
 - (c) DRS cases 203, 206, 208 and this case 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 (para 5.1.3).

10. Decision

- 10.1 In view of the findings made in this decision, the Expert directs that the Domain Name umbro.co.nz be transferred to the Complainant.

Place of decision Wellington

Date 10 March 2008

Expert Name Mr Terence Stapleton

Signature

A handwritten signature in black ink, appearing to read 'T. Stapleton', with a large, sweeping flourish underneath.