

.nz Dispute Resolution Service

DRS Reference: 290

Fiji Water Company LLC v James Robinson and Melissa Robinson

Key words

Domain name – fijiwater.co.nz

Identical or similar trade mark or name – registered marks – registered names – identical or similar

Rights – no use by Respondents to date – assertions by Respondents of intended future use

Unfair registration – unfair advantage of or unfairly detrimental to the Complainant's Rights – blocking registration – unfairly disrupting the business of the Complainant

Procedure – remedies – transfer

1. Parties

Complainant:
Fiji Water Company LLC
11444 West Olympic Boulevard
10th Floor
Los Angeles
United States of America

Respondent:
James Robinson and Melissa Robinson
PO Box 54304
Bucklands Beach
Auckland
New Zealand

2. Domain Name

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

3. Procedural history

3.1 The Complaint was lodged on 26 May 2008. The Domain Name Commission ("DNC")¹ notified the Respondent of the validated Complaint by

¹ Domain Name Commission Limited is a company wholly-owned by InternetNZ (the Internet Society of New Zealand Inc) responsible for the day-to-day oversight of the .nz domain name registration and management system.

letter dated 28 May 2008. The domain was locked on 28 May 2008, preventing any changes to the record until the conclusion of this case.

- 3.2 The Respondents filed a Response to the Complaint on 10 June 2008. The Complainant filed a Reply to the Response on 23 June 2008. The DNC referred the dispute to informal mediation on 24 June 2008. The DNC notified the parties on 9 July 2008 that it had not been possible to achieve a resolution to the dispute by informal mediation.
- 3.3 By letters dated 9 July 2008, the DNC notified the parties that the Complaint would be referred to an independent expert for decision if the Complainant paid the appropriate fees by 23 July 2008. The Complainant paid the appropriate fees by wire transfer on 11 July 2008.
- 3.4 Mr Terence Stapleton, the undersigned, confirmed to the DNC 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.
- 3.5 On 14 July 2008, Mr Stapleton was appointed to act as the independent expert in this case (“the Expert”) pursuant to paragraph 9 of the InternetNZ Dispute Resolution Service Policy (“the Policy”)².

4. Factual background

- 4.1 Fiji Water is a brand of bottled water which is bottled in the Fiji Islands. The water comes from an artesian aquifer in the Yaqara Valley of Viti Levu. The first bottles were shipped to the United States in late 1997. Fiji Water later became available at retail locations throughout North America, the United Kingdom, France, Germany, Mexico, much of the Caribbean, and Australia.
- 4.2 The Complainant is incorporated in the State of Delaware in the United States of America. The company was formed on 7 September 2004 under the name South Pacific Acquisition Company LLC. The Complainant changed its name from South Pacific Acquisition Company LLC to Fiji Water Company LLC on 24 November 2004. The Complainant’s application for registration under Part XVIII of the Companies Act 1993 to carry on business in New Zealand was registered on the overseas register on 9 May 2008.
- 4.3 On 5 April 2006, the Respondents formed and incorporated Fiji Water Limited (“FWL”) under the Companies Act 1993. As at the date of this decision, the Respondents are the sole directors and shareholders of FWL. They each hold 500 of FWL’s 1,000 shares. The Expert notes that Melissa Robinson is commonly known as Mel Robinson (she signed the Response in that name) and was formerly known as Mel Daly.
- 4.4 The search details of the Domain Name on the New Zealand Domain Name Registry Limited website record that the Domain Name was registered on 5

² Words beginning with uppercase letters in this decision include terms defined in paragraph 3 of the Policy.

April 2006 (the same date as the incorporation of FWL). The search details record the registrant contact name as the Respondents and the registrant contact email as mel@rfimports.co.nz. The search details record the admin contact name as Mel Daly and the admin contact email as mel@rfimports.co.nz.

- 4.5 R F Imports Limited (“RFI”) was formed and incorporated under the Companies Act 1993 on 6 July 2006, about three months after the formation and incorporation of FWL and the registration of the Domain Name on 5 April 2006. As at the date of this decision, the Respondents are two of four directors of RFI (the others being Deborah Susan Robinson and Iain Nicholas Robinson), and each director holds 250 of RFI’s 1,000 shares. The Expert notes that the registrant and admin contact emails for the Domain Name are not at FWL (fijiwater.co.nz), but at RFI (mel@rfimports.co.nz).
- 4.6 In the Complaint, in asserting that the Complainant’s trade mark/service mark is identical to the Domain Name, the Complainant set out details of the Complainant’s business, history, trade marks and domain names and referred to press coverage and internet exposure of its Fiji Water and Fiji Water-based goods and services. As the Respondents did not take issue with any of these matters in any way in the Response, I accept them as facts and now reproduce them as part of the factual background to this case:

Complainant is a well-known bottling and beverage manufacturer and delivery service with a large network of beverage distributors throughout the world including, without limitation, New Zealand. Complainant has used the FIJI WATER name and mark in connection with its beverage manufacturing, bottling, and delivery business and various related products and accessories since at least as early as 1996. Complainant has spent an enormous amount of time and money promoting its FIJI WATER and FIJI WATER-based goods and services.

Complainant is the owner of a number of New Zealand and foreign trademark registrations for FIJI WATER and FIJI WATER-based marks, including FIJI WATER, New Zealand Registration No. 636134; FIJI WATER, New Zealand Registration No. 636133; FIJI WATER, Fiji Registration No. 24/99; FIJI WATER, Fiji Registration No. 23/1999; and FIJI WATER, Fiji Registration No. 27/99. A copy of selected FIJI WATER and FIJI WATER-based marks (hereinafter collectively referred to as the “FIJI WATER Family of Marks”) as well as relevant assignment documentation is attached as Exhibit A.

Complainant is also the owner of numerous domain names including, without limitation, fijiwater.com, fijiwater.net, fijiwater.org, fijiwater.biz, fijiwater.info, and numerous others (hereinafter collectively referred to as the “FIJI WATER Domain Names”). A true and correct copy of the WHOIS information for other FIJI WATER Domain Names as printed from Network Solution’s WHOIS database is attached as Exhibit B.

Complainant has received widespread press coverage of its FIJI WATER and FIJI WATER-based goods and services. A search of the Westlaw ALLNEWS Database revealed over 445 individual references to the Complainant’s FIJI WATER Family of Marks and FIJI WATER Domain Names in the last fifteen months alone. A true and correct copy of the first page of this Westlaw

ALLNEWS Database search is attached as Exhibit C. Complainant has also received tremendous exposure on the Internet. A search of the Internet for "Fiji Water" using the Google New Zealand search engine revealed approximately 487,000 hits for the term, virtually all of which refer to Complainant's FIJI WATER and FIJI WATER-based goods and services. A true and correct copy of the first page of this Internet search result, conducted on May 15, 2008, is attached as Exhibit D.

By virtue of the above, including Complainant's extensive use, advertising and promotion, Complainant's FIJI WATER Family of Marks and FIJI WATER Domain Names have become uniquely associated with Complainant in the minds of consumers and in the trade throughout the world, including, without limitation, in New Zealand.

4.7 Details of the FIJI WATER Family of Marks are as follows:

- (a) the Fijian registrations (FIJI WATER: T.M. Nos. 23/99, 24/99 and 27/99) were all registered in 1999, remain in force for a period of 14 years from their dates of registration, and may be renewed at the expiration of that period;
- (b) the New Zealand registrations (FIJI WATER: Certificate of Trade Mark Registration Numbers 636133 and 636134) were registered on 18 October 2001 with effect from 17 April 2001.

4.8 Details of the FIJI WATER Domain Names are as follows:

- (a) fijiwater.com registered on 4 December 1996 and expires on 3 December 2011;
- (b) fijiwater.net registered on 29 January 2002 and expires on 29 January 2012;
- (c) fijiwater.org registered on 29 January 2002 and expires on 29 January 2012;
- (d) fijiwater.info registered on 29 March 2002 and expires on 29 March 2012;
- (e) fijiwater.biz registered on 30 March 2002 and expires on 29 March 2012.

4.9 In the Response, the Respondents state that they incorporated FWL and registered the Domain Name with the intention of importing and distributing Fiji Water within New Zealand. They make the point that they incorporated FWL and registered the Domain Name in April 2006 well before the Complainant was registered to carry on business in New Zealand in May 2008. They attach copies of emails with the General Manager of Fiji Water Australia as evidence that they took steps to further their stated intentions. While they have yet to realise their stated intentions, they state that they *"have every intention of doing so in the very near future"*. They state that at no time have they ever advertised or solicited offers for the Domain Name as

they “*have every intention of making full use of the domain in the very near future*”. Details from www.domainz.net.nz/parked.asp? (exhibit E to the Complaint) record that the Domain Name is registered for a future website.

4.10 While the Respondents state they incorporated FWL and registered the Domain Name on 5 April 2006 with the intention of importing and distributing Fiji Water within New Zealand, the fact is that they did not import and distribute Fiji Water within New Zealand before the Complainant’s registration on 9 May 2008 to carry on business in New Zealand. In addition:

- (a) there is no evidence that the Respondents engaged in any activity between April 2006 and June 2007 which was likely to result in their stated intention becoming reality;
- (b) during June and July 2007, there were email communications between RFI and Michael White (Fiji Water’s General Manager for Australia and New Zealand) about the importation and distribution of Fiji Water within New Zealand. At that time, Fiji Water had a local distributor that managed Auckland only. RFI was only interested in nationwide distribution rights. The email communications took place when Mel Daly was out of New Zealand on business for six weeks. On 23 July 2007, Ms Daly sent Mr White an email in the following terms:

I am still currently overseas on business. We have your proposal from your previous email which we are actively considering. I will contact you on my return.

- (c) there is no evidence that Ms Daly contacted Mr White on her return to New Zealand and, likewise, no evidence of any further communications between RFI and Mr White from July 2007 to May 2008;
- (d) there is no evidence of any activity on the part of RFI or the Respondents between July 2007 and May 2008 which was likely to result in the Respondents’ stated intention becoming reality;
- (e) there is no evidence that the Respondents used the Domain Name after registration on 5 April 2006. As noted, the email communications were from RFI and the relevant search details record that the Domain Name was registered as a name for a future website.

4.11 As noted, the Complainant was registered to carry on business in New Zealand on 9 May 2008. The Complaint is dated 20 May 2008 and, as noted, was lodged on 26 May 2008.

5. The Complainant’s contentions

5.1 The Complainant contends:

- (a) the Complainant has enforceable Rights in its FIJI WATER Family of Marks and its FIJI WATER Domain Names;

- (b) the Domain Name is identical to the Complainant's FIJI WATER Family of Marks and FIJI WATER Domain Names;
- (c) the Respondents had actual knowledge of the Complainant's Rights in the FIJI WATER Family of Marks at the time of registration of the Domain Name because the marks are recognised nationally and internationally and the Domain Name fully incorporates the FIJI WATER mark;
- (d) the Complainant's registration of the Domain Name is an Unfair Registration in terms of paragraphs 3 and 5.1.1(a), (b) and (c) and 5.1.5 of the Policy;
- (e) the Respondents cannot demonstrate that the Domain Name is not an Unfair Registration in terms of paragraphs 6.1.1(a), (b) and (c) of the Policy.

5.2 The Complainant relies on DRS cases 108, 145, 203, 229, 244, 250 and 252.

6. The Respondents' contentions

6.1 As noted in paragraph 4.9 of this decision, the Respondents contend:

- (a) the Respondents' registration of the Domain Name is not an Unfair Registration because they incorporated FWL and registered the Domain Name on 5 April 2006 with the intention of importing and distributing Fiji Water within New Zealand well before the Complainant was registered on 9 May 2008 to carry on business in New Zealand;
- (b) they furthered their stated intentions by the email communications with Mr White in June and July 2007 and they have every intention of pursuing their stated intentions and making full use of the Domain Name "*in the very near future*".

6.2 In the Response, the Respondents do not deny or challenge in any other way the Complainant's contention that the Respondents had actual knowledge of the Complainant's Rights in the FIJI WATER Family of Marks at the time of registration of the Domain Name.

7. Relevant provisions of Policy and elements of Complaint

7.1 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

...

5.1.5 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. How the Respondent may demonstrate in its Response that the Domain Name is not an Unfair Registration

6.1 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in paragraphs 6.1.1 – 6.1.4:

6.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the Complaint itself), the Respondent has:

- (a) used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;
- (b) been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- (c) made legitimate non-commercial or fair use of the Domain Name;

7.2 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).

8. Rights in respect of a name or mark

8.1 The Expert is satisfied on the balance of probabilities that the Complainant has Rights in respect of a relevant name or mark, namely:

- (a) the FIJI WATER Family of Marks set out in paragraphs 4.6 and 4.7 of this decision;
- (b) the FIJI WATER Domain Names set out in paragraphs 4.6 and 4.8 of this decision;
- (c) common law rights in relation to the Fiji Water name capable of protection by an action for passing off.

8.2 The Expert is satisfied on the balance of probabilities that the Complainant's Rights in the trade marks in the FIJI WATER Family of Marks, the domain names in the FIJI WATER Domain Names and the Fiji Water name were established and existed before the incorporation of FWL and the registration of the Domain Name on 5 April 2006.

9. Identity or similarity between the relevant name or mark and the domain name

9.1 The Expert is satisfied on the balance of probabilities that the trade marks in the FIJI WATER Family of Marks, the domain names in the FIJI WATER Domain Names and the Fiji Water name are identical to the Domain Name.

9.2 In that respect, the Expert adopts the observations of the Expert in *COMPAGNIE GERVAIS DANONE v Triple Eight Holdings Limited*³:

The Respondent's Domain Name is identical to the Complainant's trade mark registration. The level and country code identifiers (".co" and ".nz") are not taken into account when comparing similarity as they are an inevitable part of a domain name (*Mountain Buggy Trade Marks Limited v Campbell Gower* DRS 186). Furthermore, the registration of the word "DANONE" in capitals on the trade mark register in New Zealand does not mean that the trade mark rights in the name are restricted only to a capitalised version of the word. It is well-established law that a word mark covers all conceivable forms and typifies in which the word might be used including lower case.

10. Unfair Registration

10.1 The Expert is satisfied on the balance of probabilities that, in all the circumstances, the Domain Name is an Unfair Registration because the factual background set out in part 4 of this decision demonstrates that:

- (a) when the Domain Name was registered by the Respondents on 5 April 2006, the registration took unfair advantage of or was unfairly detrimental to the Complainant's Rights in the trade marks in the FIJI WATER Family of Marks, the domain names in the FIJI WATER Domain Names and the Fiji Water name which had existed for some years at the date of registration of the Domain Name (para 3(i)⁴); and/or
- (b) if the Domain Name is used by the Respondents in future, then it is likely to be used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's Rights (para 3(ii)); and/or
- (c) the Respondents registered the Domain Name as a blocking registration against a name or mark in which the Complainant had Rights, namely the trade marks in the FIJI WATER Family of Marks, the domain names in the FIJI WATER Domain Names and the Fiji Water name which had existed for some years at the date of registration of the Domain Name (para 5.1.1(b)); and/or
- (d) the Respondents registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant in New Zealand (para 5.1.1(c)); and/or
- (e) the Respondents have not demonstrated in any of the manners specified in paragraphs 6.1.1(a), (b) and (c) of the Policy that the Domain Name is not an Unfair Registration.

10.2 The Expert's finding that, in all the circumstances, the Domain Name is an Unfair Registration is also supported by the matters noted in paragraphs 5.1(c) and 6.2 of this decision.

³ DRS257, Auckland, 15 April 2008, Andrew Brown QC.

⁴ The para references in these subparagraphs of the decision are to paragraphs in the Policy.

10.3 The Expert does not uphold the Complainant's contention that the Domain Name is an Unfair Registration because of the provisions of paragraph 5.1.1(a) of the Policy. In this case, the evidence is that at an unspecified time before February 2007 the Complainant engaged Markmonitor to endeavour to obtain the Domain Name from the Respondents for the Complainant. By email on 13 February 2007, Cynthia Hegge of Markmonitor advised Rina Yano of the Complainant as follows:

fijiwater.co.nz – The owner is asking too much for name. We've countered with two offers \$500 and \$2,000. The owner maintains they have received offers in excess of \$15K. Our recommendation is we stay patient and leave our offer on the table and see if he will come back to us. I doubt they have received an offer that high.

10.4 In view of the Respondents' statements that at no time have they ever advertised or solicited offers for the Domain Name and that the issue of selling the Domain Name was raised not by them but by the party (Markmonitor) who contacted them on behalf of the Complainant, the evidence in this case does not satisfy the requirements of paragraph 5.1.1(a) of the Policy.

10.5 The Expert does not uphold the Complainant's contention that the Domain Name is an Unfair Registration because of the provisions of paragraph 5.1.5 of the Policy. The evidence in this case does not satisfy the requirements of that paragraph.

11. Decision

11.1 In view of the findings made in this decision, and as requested by the Complainant in the Complaint, the Expert directs that the domain name fijiwater.co.nz be transferred to the Complainant.

Place of decision Wellington

Date 25 July 2008

Expert Name Mr Terence Stapleton

Signature

A handwritten signature in black ink, appearing to read 'T. Stapleton', written over a horizontal line.