

## **.nz Dispute Resolution Service**

**DRS Reference: 409**

### **Frucor Beverages Ltd. v Clark R F Mills**

Key words -

*Domain name* – v.co.nz

*Identical or similar trade mark or name* – registered mark – identical

*Rights* – none

*Unfair registration* – prior relationships between the parties

*Procedure* – remedies – transfer

#### **1. Parties**

Complainant:

Frucor Beverages Ltd.

Alan Scouller

PO Box 76 202

Manukau City

Auckland

2241

New Zealand

Respondent:

Clark R F Mills

PO Box 76 202

Manukau City

Auckland

2241

New Zealand

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

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

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

The Complaint was lodged on 15/06/2009 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 18/06/2009. The domain was locked on 15/06/2009, preventing any changes to the record until the conclusion of these proceedings.

There was no response filed by the Respondent.

The Complainant paid Domain Name Commission Limited the appropriate fee on 22/07/2009 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

Dr Clive Trotman, the undersigned, ("the Expert") confirmed to the DNC on 23/07/2009 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 from information contained in the Complaint.

The Complainant, Frucor Beverages Ltd., (Frucor) is a company previously part of a group owned by Danone, and since February 1, 2009, owned by Suntory. At the time of transfer of the company to Suntory it came to light that the disputed domain name was registered in the name of Clark R F Mills, and not the Complainant. Clark R F Mills was a patent attorney who had worked for Frucor and who registered the disputed domain name in 1997.

Efforts by the Complainant to trace Clark R F Mills have failed.

The Complainant has been paying for the ongoing registration of the disputed domain name since it was created and currently uses it for a website that displays information on the "V" brand of drinks and other products.

The Complainant also owns a number of other websites reflecting its product "V", including vblack.co.nz, vblack.com, venergydrink.co.nz, venergydrink.biz, venergydrink.com.au, venergydrink.com, v-energydrink.co.nz, v-energydrink.biz, v-energydrink.com.au, v-energydrink.com, vitalise.com, itallstartswithv.com.au, itallstartswithv.net, vpocketrocket.com, vpocketrocket.co.nz and vpocketrocket.com.au.

The disputed domain name was registered on 5 February, 1997.

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

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

The Complainant has provided documentary evidence in support of its contention that it is a registered limited liability company. Documentary evidence has been submitted showing Frucor Beverages Limited to be the registrant of New Zealand registered trademarks for "V" as a word (with limitations) or device for certain drinks, dietary supplements and other products. These trademarks include No. 271443, registered with effect from

10 January, 1997; No. 301564, registered 26 May, 1999; No. 302313, registered 9 October, 2001; and No. 782448, registered 17 July, 2008.

The thrust of the Complainant's contentions is that its various domain names were registered for the Complainant by Clark R F Mills in his capacity as a patent attorney working for Frucor. Thus, domain names including vblack.co.nz, vblack.com, venergydrink.co.nz, venergydrink.biz, venergydrink.com.au, venergydrink.com, v-energydrink.co.nz, v-energydrink.biz, v-energydrink.com.au, v-energydrink.com, vitalise.com, itallstartswithv.com.au, itallstartswithv.net, vpocketrocket.com, vpocketrocket.co.nz and vpocketrocket.com.au were all correctly registered in the Complainant's name. When checks were made in connection with the sale of Frucor, however, the disputed domain name v.co.nz was found to have been registered in 1997 in the name of Clark R F Mills. It has not been possible to contact Clark R F Mills.

The Complainant asks for the transfer to it of the disputed domain name.

**b. Respondent**

The Respondent has not been traced by the Complainant and has not replied.

**6. Discussion and findings**

*The Policy*

Paragraph B1.1 of the Policy prescribes how the Domain Name Commission shall communicate with the Respondent in respect of the Complaint. In the context of the present Complaint, the relevant communication procedure was to send the Complaint to the address of the registrant of the disputed domain name. The Expert observes that the Respondent's address and contact details other than his name are in fact those of the Complainant, by whom the Respondent was at one time employed. The evidence of attempts to locate the Respondent comprises the statement of the Complainant's representative, to the best of his knowledge true and complete, that "We have tried to get in contact with Clark R F Mills but have been unable to do so as we do not have any current details for him".

The Dispute Resolution Service takes seriously the need for the Parties to be identified correctly and for reasonable efforts to be made to contact the Respondent. On the other hand, a registrant is under an obligation to keep the registrar informed of their correct contact details. Having regard to the totality of this particular case, as will unfold below, the Expert is satisfied that the Dispute Resolution Service acted in accordance with the Policy in attempting to contact the registrant at the address of record, and accepts the Complainant's assurance that it has been unable to locate a forwarding address for the Respondent.

The Policy applies to a Respondent when a Complainant asserts in accordance with section 4 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.

Paragraph 4.2 of the Policy requires the Expert to be satisfied that both of the above elements are present on the balance of probabilities.

First it is necessary to establish that the Complainant has rights in a name or mark. The Expert has seen copies of the registration documents for the trademarks Nos. 271443, 301564, 302313 and 782448 for the word “V”, and is satisfied of the Complainant’s rights in those trademarks. The first of these predates the registration of the disputed domain name.

The Complainant must establish that the disputed domain name is identical or similar to a name in which the Complainant has rights. The operative part “v” of the disputed domain name v.co.nz is clearly identical to the Complainant’s trademark “V”. The directory levels “.co” and “.nz” are inevitable components of the disputed domain name and are usually of no consequence in the determination of identity or similarity. The Expert finds for the Complainant under paragraph 4.1.1 of the Policy.

The Complainant must then prove that the disputed domain name, in the hands of the Respondent, is an unfair registration. The Policy defines unfair registration as meaning a domain name that 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.

Section 5 of the Policy specifies evidence of unfair registration; the list of examples provided is non-exhaustive. The example of unfair registration provided in paragraph 5.1.5 is relevant to the present case:

- 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.

The Complainant states that Clark R F Mills was a patent attorney hired to register domain names for Frucor. It would appear that he did this correctly for each of the other domain names listed above other than v.co.nz, registering them in the name of the Complainant. No explanation is available as to why the domain name v.co.nz alone was registered in the name of Clark R F Mills and not the Complainant. The Complainant's implication is that it may have been a mistake.

Nothing indicates to the Expert that Clark R F Mills did anything to attempt to keep control or ownership of the disputed domain name for himself. The document showing registration of the disputed domain name on 5 February 1997 lists Clark R F Mills as the registrant contact name, but then goes on to list the address, telephone and fax numbers of the Complainant for all other contact details. Significantly the contact email of the registrant is given as alan.scouller@danone.com, Alan Scouller being the signatory of this Complaint. The registration document of the disputed domain name also listed the administrative contact name as Alan Scouller, with the accompanying contact details and email address being those of the Complainant and Alan Scouller.

The Complainant says in evidence that it has had effective control over the disputed domain name since it was registered, paying for its maintenance and renewal and having the necessary access to use it as a website. The evidence includes a copy of an invoice for renewal dated 29 January 2008 addressed for the attention of Alan Scouller at the address of the Complainant.

In the terms of paragraph 5.1.5 of the Policy, and on the available evidence, the Expert is satisfied on the balance of probabilities that the disputed domain name was registered arising out of a relationship between the Complainant and the Respondent, in circumstances indicating 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.

There is no evidence that the Respondent's registration of the disputed domain name in his own rather than the Complainant's name was other than a mistake, or that he has deliberately avoided service of the Complaint. The inference of mistake is supported by the absence of any action by the Respondent to interfere with, change or take advantage of the registration of the disputed domain name in the 12 years since leaving the Complainant's service. Nevertheless the effect of the mistake was, within definition (i) of unfair registration under the Policy, at the time when the registration took place, "unfairly detrimental to the Complainant's Rights".

Accordingly the Expert finds the registration of the disputed domain name to have been unfair in the terms of paragraph 4.1.2 of the Policy.

## 7. Decision

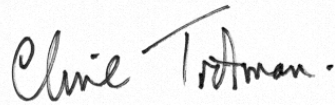
The decision of the Expert is that the domain name v.co.nz shall be transferred to the Complainant.

**Place of decision** Dunedin

**Date** August 3, 2009

**Expert Name** Dr Clive Trotman

**Signature**

A handwritten signature in black ink that reads "Clive Trotman." The signature is written in a cursive style and is positioned to the right of the "Signature" label.