

.nz Dispute Resolution Service

DRS Reference: 434

YPG IP Limited v E-Promote

Key words -

Domain Name

yellowpaggers.co.nz
yelloepages.co.nz
whitepaggers.co.nz
yellopages.co.nz

Identical or similar trade mark or name

Registered mark - well-known mark - trade name – misspelling

Unfair registration

Unfair registration – likely to confuse, mislead or deceive – pattern of registration – unfairly disrupting the business of the Complainant – presumption of unfair registration

1. Parties

Complainant:
YPG IP Limited

PO Box 17157
Penrose
Auckland 1546
New Zealand

Respondent:
“E-Promote” (Identity of legally recognisable party not stated)

E-Promote
536 Leavenworth Street
San Francisco
California 94109
United States of America

2. Domain Name/s

- 2.1. yellowpaggers.co.nz
yelloepages.co.nz
whitepaggers.co.nz
yellopages.co.nz ("the Domain Names")

3. Procedural history

- 3.1. The Complaint was lodged on 2/09/2009 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 7/09/2009. The domain/s were locked on 2/09/2009, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. There was no response filed by the Respondent.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 9/10/2009 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").
- 3.4. Hon Robert Fisher QC, the undersigned, ("the Expert") confirmed to the DNC on 12/10/2009 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

- 4.1. The undisputed evidence is that since 1909 telephone companies have distributed to telephone subscribers in New Zealand directories known as the "Yellow Pages" and the "White Pages". The business of distributing these directories, with associated advertising revenue, was successively conducted by the Postmaster-General of New Zealand, Telecom Directories Limited and Telecom IP Ltd. Between 1986 and 1998 the Postmaster-General and Telecom companies registered "Yellow Pages" and "White Pages" as trade marks for allied commercial activities.
- 4.2. In October 1996 they also registered the Domain Names "yellow.co.nz", "yellowpages.co.nz" and "whitepages.co.nz".
- 4.3. In May 2007 the then holder of Telecom's intellectual property rights in relation to those names, Telecom IP Ltd, transferred the intellectual property rights to the Complainant, YPG IP Limited.
- 4.4. Between 19 September 2006 and 22 March 2007 an unstated person or company registered the disputed Domain Names "yellowpagers.co.nz", "yellowpages.co.nz", "whitepagers.co.nz" and "yellopages.co.nz". The registrant contact name was recorded as "E-Promote". This is not a legally recognisable person or entity. Registration should not have been accepted in that name.

5. Complainant's contentions

- 5.1. The Complainant complains that the Respondent is unfairly using the disputed Domain Names to divert potential customers of the

Complainant to the Respondent's websites. When web users misspell the names of the Complainant's websites, so as to inadvertently access the Respondent's websites, they access web pages which pictorially show what appear to be copies of the Complainant's directories with the heading "New Zealand White Pages" or "New Zealand Yellow Pages" respectively. These web pages then direct the user to select from a variety of categories including an internet directory. If the user selects the "business listing" option, the user has the option of being directed to various sites of which one is that of the Complainant. However, many of the other sites made available to the user do not relate to business or telephone directory services and are the various business sites of third parties.

- 5.2. The Complainant asserts that it will suffer a loss of revenue through internet users inadvertently accessing and using the Respondent's websites in the belief that they have arrived at the Complainant's websites. This is said to cause loss of revenue which would otherwise have been enjoyed by the Complainant, dilution of the Complainant's trade marks, confusion in the marketplace and damage to the Complainant's goodwill in the provision of inferior services and products by or through the Respondent. The Complainant also asserts that the Respondent is engaged in a pattern of conduct in exploiting well known names in which it has no rights.

6. Respondent's contentions

- 6.1. The Respondent has not filed any response.

7. Discussion and findings

- 7.1. The dispute is governed by the Policy issued by Domain Name Commission Limited on behalf of InternetNZ. Critical portions of the Policy for present purposes are these:

"3. Definitions ...

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.

... 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.

... 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;"

7.2. It will be seen that to support a complaint of this kind the Complainant must satisfy three elements:

7.2.1. Rights in respect of a name or mark (para 4.1.1);

7.2.2. Identity or similarity between that name or mark and the Domain Name (para 4.1.1); and

7.2.3. Unfair registration in the hands of the Respondent (para 4.1.2).

8. (a) Rights in respect of a name or mark

8.1. The Complainant has demonstrated rights in respect of the trade marks "Yellow Pages" and "White Pages" based on the registration of transfers from predecessors in title. That makes it unnecessary to decide whether enough of the Telecom business passed to the Complainant in May 2007 to support additional common law rights in the goodwill associated with those names, on which subject there is presently no evidence.

8.2. I accept that the Complainant has rights in respect of the names "Yellow Pages" and "White Pages" for present purposes. This requirement is satisfied.

9. (b) Identity or similarity between the name or mark and the Domain Name

- 9.1. The second requirement is to show that the Complainant's name or mark is identical or similar to the Domain Names in dispute.
- 9.2. Whether a name or mark is to be regarded as "similar" to a Domain Name must be decided having regard to the context in which each is used or likely to be used.
- 9.3. In the present case the disputed Domain Names are clearly similar to the expressions "Yellow Pages" and "White Pages". This requirement is also satisfied.

10. (c) Unfair registration in the hands of the Respondent

- 10.1. The third requirement is unfair registration. The Policy includes a non-exhaustive list of factors which may be evidence of unfair registration (paras 5.1.1 to 5.1.5).
- 10.2. The evidence supports the conclusion that the Respondent is using the disputed Domain Names in a way which is likely to confuse, mislead or deceive people into believing that the Domain Names are connected with the Complainant. Some users attempting to type one of the Complainant's Domain Names are likely to misspell the required name and finish up at one of the Respondent's websites. Further, upon arriving at one of the Respondent's websites users are likely to believe that they have reached one of the Complainant's websites given the heading "New Zealand White Pages" or "New Zealand Yellow Pages", the photograph of what appears to be one of the Complainant's directories and the lack of any clue that any business other than that of the Complainant is involved. In terms of para 5.1.2 of the Policy this is evidence that the disputed Domain Names are unfair registrations.
- 10.3. In addition, there is undisputed evidence that the Respondent has been repeatedly involved in similar cases and has been the subject of adverse decisions for the transfer of disputed Domain Names including:

wwwferrit.co.nz, tellecom.co.nz, yellowpages.co.nz,
witepages.co.nz, whitpages.co.nz, thairways.co.nz,
telstaclear.co.nz, telstarclear.co.nz and telstarclear.co.nz

The disputed Domain Names conform to that pattern. Although the timings involved have not been provided, the evidence of a pattern demonstrates a qualifying pattern of registrations for the purposes of para 5.1.3 of the Policy.

- 10.4. The Respondent has made no attempt to dispute the Complainant's allegations of confusing, misleading and deceptive use of the Domain Names and a pattern of unfair registrations in respect of other well-known names. Nor has there been any suggestion that unfair

registration can be resisted on any of the grounds specified in paras 6.1 to 6.3 of the Policy.

10.5. I conclude that the Respondent's registrations are unfair ones for the purposes of the Policy and that all three requirements for a complaint of this kind are established.

11. Decision

11.1. The Complaints are upheld. I direct that all four disputed Domain Names be transferred to the Complainant or its nominee.

Place of decision

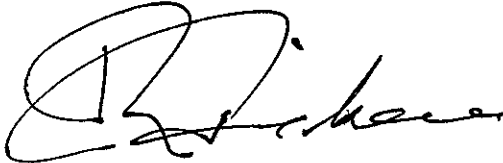
Auckland

Date

20th October 2009

Expert Name

Hon Robert Fisher QC

A handwritten signature in black ink, appearing to read 'R. Fisher', written in a cursive style.

Signature