

.nz Dispute Resolution Service

DRS Reference: 458

Capital Conservator Group v Giordan Samuels

Key words -
Domain name

capitalconservator.co.nz

Identical or similar trade mark or name

Registered mark – identical

Rights

None

Unfair registration

Unfair registration – unfair use – offer to sell, rent or otherwise transfer – likely to confuse, mislead or deceive – false contact details – respondent having no connection with name or trade mark

Procedure

Transfer

1. Parties

Complainant:

Capital Conservator Group, including its New Zealand arms, Capital Conservator Savings & Loan Ltd; Capital Conservator Trustees Ltd.

Mr David Finzer

Calle Canelanes 867/704

CP 11100

Montevideo

Uruguay

Respondent:

Giordan Samuels

60 Cook Street 324

Auckland

New Zealand

2. Domain Name

capitalconservator.co.nz ("the disputed domain name")

3. Procedural history

The Complaint was lodged on 30/11/2009 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 3/12/2009. The domain was locked on 30/11/2009, 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 15/01/2010 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 18/01/2010 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 submitted by the Complainant.

The Capital Conservator Group, based in Uruguay, is in the business of finance. In New Zealand the Group is represented by Capital Conservator Trustees Limited and Capital Conservator Savings & Loan Limited. Much of the Group's business is done on the Internet and a physical presence in New Zealand is being established.

The Capital Conservator Group uses the name Capital Conservator in New Zealand and internationally, holds a registered trademark for the phrase in New Zealand, and owns the domain name and corresponding website capitalconservator.com.

The disputed domain name capitalconservator.co.nz was registered by the Respondent on September 23, 2008.

Nothing is known about the Respondent except for the information provided in the registration document for the disputed domain name.

5. Parties' contentions

a. Complainant

The Complainant states that it is the owner of a registered trademark for the words CAPITAL CONSERVATOR. Documentary evidence submitted in support comprises a database extract downloaded from the Intellectual Property Office of New Zealand, showing trademark number 803553, the proprietor being Capital Conservator Savings & Loan Limited, Dunedin. The trademark was applied for on March 12, 2009, and registered on September 17, 2009.

The Complainant contends that its name is known internationally since it has spent several hundred thousand US dollars on advertising to create its brand. Submitted in evidence are brief advertisements in *The Economist* of September 27, 2008, for offshore banking, and in the issue of September 19, 2009, for corporate formation, each advertisement providing as sole contact information the website address www.capitalconservator.com. The Complainant says that the success of its advertising is such that offshore professionals now approach the Capital Conservator Group, rather than the reverse. The Capital Conservator Group has a very high Google search ranking, particularly when the phrases "capital conservator" or "off-shore banking" are searched; documentary evidence was submitted.

The Complainant contends that there are only two companies registered in New Zealand with the words "Capital Conservator" in their title, namely its own companies.

The Complainant further contends that the disputed domain name, in the hands of the Respondent, is an unfair registration. The website of the disputed domain name purports to be an Italian website offering online shopping for Sony products. It purports to be a division of Sony, but no evidence can be found for this. The website is in Italian, but the button to provide an English translation does not work, and some links are broken. An attempt to purchase a product was unsuccessful (although the Complainant says this may have been owing to the difficulty of attempting to do so in Italian).

The Complainant says that the Respondent's website has nothing to do with the Complainant and is likely to confuse, mislead or deceive users into believing that the website is endorsed by the Complainant and backed by its good name.

The disputed domain name was registered to the Respondent on September 23, 2008, six days after Capital Conservator Trustees Limited was registered with the New Zealand Companies Office. The Complainant says the timing of this registration points to the domain name being acquired as a blocking registration since a ".co.nz" domain name is the most obvious for the Complainant to use in New Zealand. It is also suspected that the Respondent

intends to sell, rent or otherwise transfer the domain name to the Complainant for profit.

Attempts by the Complainant to contact the Respondent have met with no reply. The Respondent has not attempted to establish any rights to the disputed domain name or to refute the Complaint.

The Complainant considers that there is evidence that the Respondent knowingly gave false contact details to the registrar or DNC. A telephone number provided for the Respondent was rejected as invalid when called and the postal address provided could not be found in the NZ Post address finder. The post code relates to a different part of the city.

The Complainant requests the transfer to it of the disputed domain name.

b. Respondent

The Respondent has not submitted any Response to the Complaint.

6. Discussion and findings

The Policy

The Dispute Resolution Service Policy and Procedure apply 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.

Similarity to a Name

It is clear from the evidence submitted that Capital Conservator Savings & Loan Limited has rights in the registered trademark CAPITAL CONSERVATOR. For the purposes of this dispute the Complainant as named is found to have rights in the name CAPITAL CONSERVATOR, which is identical to the distinctive component of the disputed domain name capitalconservator.co.nz within the meaning of the Policy. The Expert finds for the Complainant in the terms of paragraph 4.1.1 of the Policy.

Unfair Registration

The Complainant must proceed to prove 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.

The Policy at section 5 provides guidance in the form of criteria that may be evidence of unfair registration. Pertinent parts of section 5 read as follows:

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 that 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.]

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 - 5.4].

The disputed domain name comprises essentially the words “capital” and “conservator”, which are descriptive dictionary words each having wide potential application and little distinctiveness. Placed together, however, the two words are found to form an uncommon combination that reflects the core element, Capital Conservator, of the Complainant’s company names. The Respondent has not claimed that the words “capital” or “conservator” reflect any aspect of his own name or business, nor are the words found to have any relationship to the Respondent’s website according to the available evidence.

In the absence of a Response it is necessary to infer the Respondent’s intentions.

The Complainant’s proposed interpretation of the facts is that the Respondent’s intentions are to block the Complainant from registering the essence of the Complainant’s name in a domain name; to offer to sell the disputed domain name to the Complainant at a profitable price; or to trade through a website owned by the Respondent on the basis of the Complainant’s good name.

The evidence of there being non-functional links on the website, together with the non-functional English translation, the apparently non-functional purchase facility, and the irrelevance of the disputed domain name to the nature of the website, all support a conclusion on the balance of probabilities that the website has been equipped with token content in order to portray a veneer of actual use. This device is in keeping with the habit of many traders in domain names, since it provides an Internet presence for potential buyers to find and may also provide income from the website whilst the domain name is for sale. Trading in domain names and earning revenue from them may be entirely legitimate activities, but not if the domain name is unfairly registered or used.

Having regard to the fact that the disputed domain name was registered only six days after the company name Capital Conservator Trustees Limited was registered at the New Zealand Companies Office, and to the totality of the evidence, the Expert finds on the balance of probabilities that the disputed domain name was registered in the expectation or hope that the Complainant would be motivated to buy it back. The Policy definition of unfair registration encompasses the manner in which a disputed domain name “is likely to be” used. Unfair registration is found in the terms of paragraph 5.1.1 (a) of the Policy.

The content of the Respondent’s website is further indicative of unfair use. An Internet user looking for the Complainant, or a shopper looking for certain goods or services on the Internet, could be led to the Respondent’s website and be confused by its domain name into thinking it had the endorsement of the Complainant. Unfair use is found in the terms of paragraph 5.1.2 of the Policy.

The Complainant has submitted reasonable evidence to the effect that the telephone and physical contact details provided by the Respondent to the registrar are, on balance, false or misleading. Paragraph 5.1.4 of the Policy

provides for a finding of unfair registration where the Complainant can demonstrate that the Respondent has knowingly given false contact details to a registrar or to the DNC, and in this instance the Expert so finds.

7. Decision

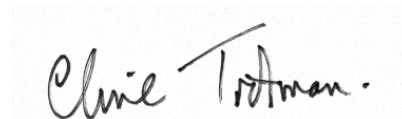
The decision of the Expert is that the domain name capitalconservator.co.nz shall be transferred to the Complainant.

Place of decision Dunedin

Date 25 January 2010

Expert Name Dr Clive Trotman

Signature

A handwritten signature in black ink that reads "Clive Trotman." The signature is written in a cursive style with a horizontal line underlining the name.