

.nz Dispute Resolution Service

DRS Reference: 474

Abortion Law Reform Association of New Zealand Inc v mybook

Key words – personal name – identical – legitimate non-commercial or fair use – criticism and commentary – likely to confuse, mislead or deceive

1. Parties

Complainant:

Abortion Law Reform Association of New Zealand Inc
Dr Margaret Sparrow
62 Raroa Road
Kelburn
Wellington
New Zealand

Respondent:

mybook
P.O. Box 8979
Christchurch
New Zealand

2. Domain Name

alranz.org.nz ("the Domain Name")

3. Procedural history

The Complaint was lodged on 24/02/2010, and Domain Name Commission Limited (DNC) notified the Respondent of the validated Complaint on 1/03/2010. The domain/s were locked on 24/02/2010, preventing any changes to the record until the conclusion of these proceedings.

There was no response filed by the Respondent.

The Complainant paid DNC the appropriate fee on 25/03/2010 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

Although no Response was filed, DNC received an email dated 23 March 2010 which appeared to have been sent by or on behalf of the Respondent. The email showed the sender as "Andy Moore", the same individual who, in an email to the Complainant sent on February 10, 2010, had acknowledged that he was the creator of the website at the Domain Name. The email specifically responded to an email which had been sent by DNC to the Respondent's email address as notified in the Whois particulars for the Domain Name. The author of the 23 March email said only:

"Thanks for your email John – have a great week.
Regards
Andy"

By letter dated March 29, 2010, DNC appointed the undersigned Warwick Smith as independent Expert, to resolve the dispute under the Policy. The Expert is satisfied that he has been properly appointed.

As no Response was filed, the Expert has checked to ensure that the Complaint was properly notified to the Respondent, in accordance with the Policy, paragraph B1.1. The Expert is satisfied that it was, and that having regard to Mr Moore's March 23 2010 email, the Respondent has had actual notice of the Complaint.

4. Factual background

The Complainant

The Complainant is the Abortion Law Reform Association of New Zealand Incorporated, an incorporated society registered in 1971. The Complainant's original primary objectives included seeking changes to New Zealand's abortion law so that a woman would have the right to choose whether to have an abortion, and promoting social reforms and advocating legislation to reduce the numbers of unwanted pregnancies.

The Complainant stated in the Complaint that it has used the acronym "ALRANZ" since 1971. It produced numerous articles, pamphlets, and other printed material bearing out that contention.

The Complainant registered the domain name <alranz.org> in December 2004, and established a website at that domain name ("the Complainant's website"). The Complainant uses the Complainant's website as its principal means of communicating with the public and with its supporters, journalists, politicians, and political activists. Numerous other websites provide links to the Complainant's website.

The Complainant stated in the Complaint that there is no other organisation of which it is aware that has an identical or even similar name or acronym.

The Respondent and the Domain Name

The Domain Name was registered on 5 November 2009. The Complainant produced copies of the website to which the Domain Name resolves ("the Respondent's website"), printed on 10 February 2010 and 21 February 2010.

On each of those dates, the Respondent's website prominently featured what appears to be a picture of a bloodied, presumably dead, late-term foetus. It also featured the following text:

"Welcome to ALRANZ
(Abortion Law Reform Association of New Zealand)"; and

"We are a pro-choice organisation founded in February 1971 to support reforms which allow a woman to choose whether to continue an unplanned pregnancy or to seek an abortion."

On both dates the Respondent's website featured three boxes, each containing a logo device consisting of a green and pink "female" device (i.e. of the cross-beneath-a-circle type), with the words "Keep", "Abortion", and "Safe" respectively appearing in the three circles.

On both dates the Respondent's website provided a click-through link consisting of the words:

"Click here to visit the real ALRANZ website"

The copy of the Respondent's website as it stood on 21 February 2010, contained an additional click-through link:

"We support late-term abortions for disabled babies"

The Complainant stated that this click-through link provided a live link to one of the Complainant's newsletters. The particular newsletter was not produced. However, the Complainant stated that the statement misrepresents its position.

The wording: "Welcome to ALRANZ (Abortion Law Reform Association of New Zealand)", is taken from the Complainant's website, as is the statement: "We are a pro-choice organisation founded in February 1971 to support reforms which allow a woman to choose whether to continue an unplanned pregnancy or to seek an abortion". The "Keep Abortion Safe" logos on the Respondent's website, also appear at the top of the Complainant's website.

The Complainant produced evidence showing that Mr Moore has been an active campaigner against the Complainant and its activities, he being involved in various groups which promote agendas which are "pro-life" and/or opposed to the Complainant's activities and advocacy in the field of family planning.

The Complainant stated that the address listed for the registrant in the Whois particulars for the Domain Name (a Post Office Box in Christchurch), is the address of a Christchurch church of which Mr Moore is a member. In his 10 February 2010 email to the Complainant, Mr Moore acknowledged that he was a member of the church, but

stated: "the Church is in no way affiliated with the [Respondent's] website".

The Complainant's Google Searches

The Complainant produced Google search results on the expression "alranz", run at the website www.google.co.nz on 21 February 2010. The Google search results showed the Complainant's website as the first result, and the Respondent's website in fourth position. When the Google search was limited to "pages from New Zealand", the Respondent's website was shown immediately below two links to the Complainant's website.

Pre-Commencement Communications between the Parties

According to the Complaint, the Complainant first became aware of the registration of the Domain Name on 8 February 2010. The Complainant then sent an email to the email address listed in the Whois Particulars for the Domain Name. The Complainant did not produce a copy of that email, but it did produce a copy of a reply email dated 10 February 2010 from Mr Andy Moore.

Mr Moore said that the Complainant's email had arrived in his inbox (being the inbox at the email address for the Respondent as shown in the Whois particulars for the Domain Name). He went on to note that the Complainant's email had been addressed to "the hosting company" of the Respondent's website, and that he (Mr Moore) was not a representative of the hosting company. He acknowledged, however, that he was the creator of the Respondent's website. Mr Moore went on to express his views on abortion (very much opposed to those of the Complainant), and said that he had no intention of taking the Respondent's website down.

5. Parties' contentions

a. Complainant

The Complainant contends:

1. Considering:
 - (i) the Complainant's 39 year history of using the name "Alranz", and
 - (ii) its 5-year history of using the Complainant's website, and
 - (iii) the fact that the Complainant is based in New Zealand, and

- (iv) that there is no other organisation in New Zealand with a similar name or acronym

the Complainant has Rights in respect of a name which is identical or similar to the Domain Name. (The Complainant referred also to New Zealand DRS Case No. 399, *The Animal Welfare Institute of New Zealand v Animal Welfare in New Zealand*, in which the expert found that the complainant had used and had a common-law reputation in the names "AWINZ", and "The Animal Welfare Institute of New Zealand".)

- 2. The Domain Name, in the hands of the Respondent, is an Unfair Registration, having regard to the following:

- (i) The Respondent's use of the Domain Name is part of a campaign against the Complainant and its ability to conduct its activities. The primary purpose of the Domain Name has been to interfere with and disrupt the Complainant's activities as part of a wider campaign against the Complainant, and the Respondent has taken unfair advantage of and acted in a way that is unfairly detrimental to the Complainant's rights (citing *The Animal Welfare Institute of New Zealand*).
- (ii) With reference to paragraph 5.1.1(c) of the Policy (unfairly disrupting the business of a complainant), the expert in *The Animal Welfare Institute of New Zealand* found that "disrupting the business of" encompassed the disruption of the activities of an animal welfare group by those campaigning against it. So in this case, the Respondent's use of the Domain Name is part of his campaign against the Complainant, and is disruptive of the Complainant's activities.
- (iii) With reference to paragraph 5.1.2 of the Policy (respondent using a disputed domain name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the complainant), the expert in *The Animal Welfare Institute of New Zealand* held that the existence of the disputed domain name registration was in itself, with or without active use, sufficient to establish the paragraph 5.1.2 example of Unfair Registration. In this case, the registration of the Domain Name is likely to confuse Internet users whatever the content of the Respondent's website. Many Internet users will be at the very least side-tracked onto a site that they did not wish to visit.

- (iv) The Respondent is seeking to mislead a particularly vulnerable group – young women facing crisis/unplanned pregnancies.
- (v) The graphic content of the Respondent's website shows the damage the Respondent is seeking to cause to the Complainant.
- (vi) The Respondent cannot rely on the fair use provision at paragraph 6.2 of the Policy, because the Respondent's website, although a criticism website, is not devoted *solely* to criticism of a person or business. The Respondent's website is also intended to interfere with the Complainant's use of the Complainant's website in its advocacy and outreach work, by confusing, misleading and deceiving members of the public, in particular women facing crisis pregnancies. That intention is evidenced by a number of facts. First, it is difficult, if not impossible, to tell from the Google search results which is the "real" site. A user would need to click through to both to find out which is the Complainant's website. If the user did not know what "ALRANZ" was to begin with, the user might still be uncertain after visiting both sites. Secondly, the Respondent's actions in copying text and logos from the Complainant's website, and its misrepresentation of the Complainant's position (on the question of support for late-term abortions for disabled babies), make it clear that the Respondent's intention has been to confuse, mislead, and deceive the members of the public mentioned above.
- (vii) Whatever criticism the Respondent's website may contain (and there is little or none – the content is inflammatory and abusive), that element of criticism is far outweighed by the overriding unfairness arising from the targeting of the Complainant, the disruption of its activities, and the confusion created by the name itself. On balance, taking into account the critical aspects of the Respondent's website, the Respondent's use of the Domain Name is still unfair.
- (viii) The Respondent has given false contact details regarding the registration of the Domain Name. The registrant's name is not "mybook", but Andy Moore. Also, the address listed for the registrant, the Post Office Box for the church in Christchurch, is the address of an organisation which is not in any way affiliated with the Respondent's website.

b. Respondent

Apart from the email dated 23 March 2010 which Mr Moore sent to DNC, the Respondent did not respond to the Complaint.

6. Discussion and findings

A. Relevant Provisions of the Policy

The Policy applies to Respondents when a Complainant asserts that:

- “(i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- (ii) The Domain Name, in the hands of the Respondent, is an Unfair Registration.” (Policy, paragraph 4.1)*

The Complainant is required to prove on the balance of probabilities that both elements are present (Policy, paragraph 4.2).

The expressions “Rights” and “Unfair Registration”, are both defined in paragraph 3 of the Policy.

The expression “Rights” includes, but is not limited to, rights enforceable under New Zealand law. The definition continues:

However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant’s business.”

The expression “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.”*

At paragraph 5.1, the Policy contains a non-exhaustive list of factors which may be evidence that a domain name is an “Unfair Registration”. The list includes the following:

“5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

...

- (ii) *as a blocking registration against a name or mark in which the Complainant has Rights; or*
- (iii) *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."*

Paragraph 6.1 of the Policy sets out a list of factors which may be evidence that the Domain Name is *not* an Unfair Registration. This list, which is again non-exhaustive, contains the following:

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

...

- (iii) *made legitimate non-commercial or fair use of the Domain Name; or*

6.2 *Fair Use may include sites operated solely in tribute to or in criticism of a person or business.*

B. Application of the Policy in this Case – "Rights"

The first question is whether the Complainant has "Rights" in respect of a name or mark which is identical or similar to the Domain Name.

The Expert is satisfied that it does, although identifying the precise nature of those "Rights" has not been a simple task. Most complaints under the Policy tend to be made by traders who own (registered or unregistered) trade marks, and in such cases it is usually not difficult identifying an enforceable "Right". In this case, the Complainant has not clearly relied on any trade mark, registered or unregistered. Indeed, the Expert is not sure after reading the Complaint and visiting the Complainant's website whether the Complainant actually supplies any goods or services which might qualify for trademark protection. As its name suggests, the Complainant's activities appear to be political in nature – generally, promoting changes to the law and practice in the areas of abortion and family planning.

The Complainant has simply asserted that it has a *reputation* in the expression "ALRANZ", and relied on the decision in *The Animal Welfare Institute of New Zealand* as authority for the asserted "Right". But that decision did not contain a detailed explanation of the complainant's "Right", as defined in the Policy: the expert in *The Animal Welfare Institute of New*

Zealand found that the complainant had used (and established a common-law reputation in) the names “AWINZ” and “The Animal Welfare Institute of New Zealand”, and he appears to have regarded those findings as sufficient to support the claimed “Right”. The decision does not make it clear how a common law reputation which a charitable organisation (which the complainant in that case was) may have acquired in a particular name, confers on that charitable organisation *enforceable rights* in that name. The decision on the “enforceability” issue appears to be reliant on an earlier District Court judgment between the parties, in which the complainant had sought remedies for passing off, under the Fair Trading Act 1986, and in the law of defamation. According to the decision in *The Animal Welfare Institute of New Zealand*, the District Court (while acknowledging that it lacked enforcement jurisdiction under the Trade Marks Act 2002) found that it had the power to prohibit use of [the relevant trade mark] as a “vehicle to do unlawful damage”.

Having considered the decision in *The Animal Welfare Institute of New Zealand*, this Expert is left in some doubt as to the basis on which the “Rights” asserted by the complainant in that case were found to be “enforceable”. It is therefore appropriate to consider the issue afresh on the particular facts of this case.

A complainant in a complaint under the Policy does not have to show that it has a *registered* right to bring itself within the definition of “Rights”. As this Expert noted in Case No. DRS 108, *B.O.P. Memorials v Jones & Company Funeral Services*, a right to sue for passing off will qualify as a “right enforceable under New Zealand law” (referring to the United Kingdom Appeal Panel decision in *RuggedCom.Inc v LANstore Inc*; Nominet Case No. DRS 02802).

In this case, the evidence sufficiently shows that, over the years since 1971, the Complainant has been commonly referred to in New Zealand as “ALRANZ”, and has developed a reputation under that name. A significant number of New Zealanders, hearing the expression “ALRANZ”, would undoubtedly associate it with the Complainant.

The difficulty for the Complainant in basing its claim to a “Right” on the tort of passing off, is that passing off, at least in its traditional form, has been primarily concerned with the protection of business goodwill (see, for example, the “*Advocaat*” case in the House of Lords, *Erven Warnink BV v J Townend & Sons (Hull) Limited*, [1979] 2 All ER 927, and, in the context of a political party with no significant trading activities, *Kean v McGivan* [1982] FSR 119, UK Court of Appeal).

In more recent times, the requirement that a plaintiff be acting in trade, or at least that it have some business activities sufficient to generate the goodwill which the tort was designed to protect, appears to have been relaxed to some extent. The tort has now been successfully invoked to protect at least the finance-related activities of various charities and unincorporated associations – see for example *British Diabetic Association v The Diabetic Society* [1996]

FSR 1, the decision of the Court of Appeal of New South Wales in the *Holy Apostolic and Catholic Church of the East (Assyrian) Australia New South Wales Parish Association v Attorney-General Ex Parte Elisha* (1989) 16 IPR 619, and *Burge v Haycock* [2002] RPC 28, E.W.C.A. In the latter case, the UK Court of Appeal was prepared to extend protection under the tort of passing off to a local group which was concerned to prevent a member of the British National Party from representing himself at a local election as an authorised candidate of the plaintiff's "Countryside Alliance" group. The Court of Appeal distinguished its earlier decision in *Kean v McGivan*, in part on the ground that, in that case, Mr Kean had not been able to describe any activities undertaken by his party which could be designated as commercial. The implication of that part of the decision in *Burge*, appears to be that a plaintiff must still show that it has something in the nature of business goodwill, in order to bring a passing off claim.

There might be room for a broader approach on the goodwill question, if one were to focus on any fundraising activities the Complainant might undertake, or its ability to attract subscription revenue. Baroness Hale, in her judgment in *Burge v Haycock*, referred to bodies such as professional associations and charities, and noted that it is not just the loss of trade or of donations which may constitute damage to the relevant goodwill, but particularly the loss of control over the goodwill that has been established. However the Complainant did not put its case on the basis of damage to its capacity to attract donations or subscriptions, and there was little or no evidence on that topic.

It may be that the tort of passing off has now developed to the point where a plaintiff may rely simply on its *reputation* in its name, whether or not it carries on any commercial activities to which valuable goodwill attaches. However, it is not clear that the law has yet reached that point.

The Complainant might conceivably have argued that it has an enforceable "Right" in its name as a registered incorporated society. Section 11 of the Incorporated Societies Act 1908 provides that no society shall be registered under a name which is identical to that of any other society registered under the Act. If the Registrar of Incorporated Societies were to permit someone else to register the Complainant's name, the Complainant could presumably take legal steps to prevent the Registrar from so doing, or to set aside any registration effected in breach of section 11. The issue would then be whether the Domain Name, consisting of the abbreviated version "ALRANZ", could be regarded as "similar" to the Complainant's registered name. Possibly it could, but again, the Complainant did not put its case on that basis.

In the Expert's view, the firmest foundation for the Complainant's assertion that it has "Rights" in a name which is identical to the Domain Name, lies in the provisions of the Fair Trading Act, and in particular section 9, which generally proscribes conduct in trade which is misleading or deceptive, or which is likely to mislead or deceive.

In New Zealand DRS Case No. 156, *National Manager, TeachNZ, Ministry of Education v David Powell*, this Expert stated:

“The Expert considers it more likely than not that, if some trader in New Zealand were to use the Complainant’s ‘TeachNZ’ logo mark in a misleading or deceptive way, the Complainant would be entitled to invoke section 9 of the Fair Trading Act to restrain the misleading or deceptive use. In that sense, the Expert is prepared to find that the Complainant has proved that it has a ‘Right’ in the Complainant’s logo.”

So in this case, if some trader in New Zealand were to use the expression “ALRANZ” in trade in a misleading or deceptive way, such as to cause the Complainant damage, the Expert thinks it likely that the Complainant could rely on its reputation in the name “ALRANZ”, to obtain injunctive or other relief under the Fair Trading Act. On that basis, the Expert finds that the Complainant has “Rights” in the expression “ALRANZ”.

It is true that the Respondent may not have been acting in trade, but that will be a matter for consideration in the next part of this decision, which will address the question of whether the Domain Name, in the hands of the Respondent, is an Unfair Registration.

The name “ALRANZ” is clearly not “wholly descriptive” of the Complainant’s business or activities – the Expert is satisfied on the evidence produced that the expression “ALRANZ” would be taken by a substantial number of New Zealanders as a reference to the Complainant itself, and would not be taken as descriptive of the advocacy and other activities in which the Complainant engages.

The expression “ALRANZ” is identical to the Domain Name – the “.org.nz” suffix is not taken into the comparison. Accordingly, the Complainant has made out its case on this part of the Complaint.

C. *Is the Domain Name, in the hands of the Respondent, an Unfair Registration?*

The Expert is satisfied that the Respondent has been using, and is likely to use, the Domain Name in a manner which is unfairly detrimental to the Complainant’s Rights. In particular, the Expert is satisfied that the circumstances fall within paragraph 5.1.2 of the Policy.

The Respondent has not only registered as a domain name an expression which is the same as that by which many people in New Zealand know the Complainant, he has also copied substantial parts of the text from the Complainant’s website, and reproduced the “female” logos which are featured on the Complainant’s website. The Respondent’s intention appears to have been to attract to the Respondent’s website Internet users looking for the Complainant’s website. Once an Internet user arrived at the Respondent’s website, his or (more probably) her immediate impression (from the Domain Name itself, and from the copying of text and logos from the Complainant’s

website) would be that she had arrived at the Complainant's website. It would only be when she looked more closely at the Respondent's website that the link to the Complainant's website would be noted, and she would be made aware that she had arrived at the wrong website. In the meantime, the Respondent's message, in the form of the picture of the dead foetus, would have been conveyed to the site visitor.

In the Expert's view, the use the Respondent has made of the Domain Name has not been "fair use", of the kind referred to at paragraphs 6.1.1(c) and 6.2 of the Policy. Certainly, those provisions are intended to preserve the domain name registrant's right of freedom of expression, as long as it is exercised fairly, and it is not for the Expert to comment on the rights or wrongs of the respective positions taken by the parties on the abortion question (see to similar effect the decision of the appeal panel in the United Kingdom DRS decision of *Rayden Engineering Limited v Diane Charlton*, Nominet Case No. DRS 06284 – "although an Expert may in many cases form an impression as to whether the views expressed on a protest site are justified or true, we do not consider that in general the legitimacy of the use of a particular domain name should turn on such a judgment. ...").

In the *Rayden Engineering Limited* case, the Respondent had used the disputed domain names (which were trading names of the Complainant) without any indication that they led to a protest site. As the appeal panel put it: "in effect the Respondent is posing as the Complainant in order to attract members of the public to the site".

That appears to be the position in this case. The Respondent has not added any qualifier in the Domain Name which might signal to Internet users that the Respondent's website is operated by a party with views diametrically opposed to those of the Complainant, and the position is compounded when the browser arrives at the Respondent's website and finds text and logos which are identical to those used by the Complainant.

The appeal panel in the *Rayden Engineering Limited* case rejected the respondent's argument of fair use, and the Complainant's position in this case appears to be significantly stronger from that of the complainant in *Rayden Engineering Limited*. The copying of text and logos from the Complainant's website (not a factor in *Rayden Engineering Limited*) take the Respondent in this case well beyond the bounds of any reasonable concept of fair use. The Respondent has not simply expressed views critical of the Complainant; it has effectively masqueraded as the Complainant.

The provision of the hyperlink to the "real" "ALRANZ" website does not affect that finding. It comes too late, after the initial interest confusion created by the use of the Domain Name and the copied text and logos have had their intended effect.

The Respondent's use of the Domain Name must still have been a use which has been, or is likely to be, detrimental to the particular "Rights" on which the Complainant relies. It might perhaps be thought that, because the

Respondent has not been acting "in trade", and the Complainant would appear to have no direct recourse against him under the Fair Trading Act, the Respondent's use of the Domain Name has not been "detrimental" to the relevant "Right". In the Expert's view, that would be too narrow a construction of the Policy. The Complainant's ability to invoke the Fair Trading Act in respect of misleading or deceptive statements about "ALRANZ" made in trade by any third party, is dependent on it showing that *it* is the party with the reputation in that name. If the Respondent were permitted to retain the Domain Name (and continue its use of the Respondent's website) the Complainant's reputation as the only "ALRANZ" in New Zealand would eventually be "diluted", and its ability to invoke the Fair Trading Act in respect of misleading uses of that expression, consequentially impaired. In the Expert's view, that is enough to constitute detriment to the "Right" relied upon by the Complainant.

In conclusion, the Expert notes that the Respondent appears to have recognised that his registration and use of the Domain Name were not defensible under the Policy. Mr Moore's email dated 23 March 2010 made no attempt to dispute the Complainant's allegations; it simply acknowledged receipt of an email from the DNC Case Manager, and wished him a great week.

7. Decision

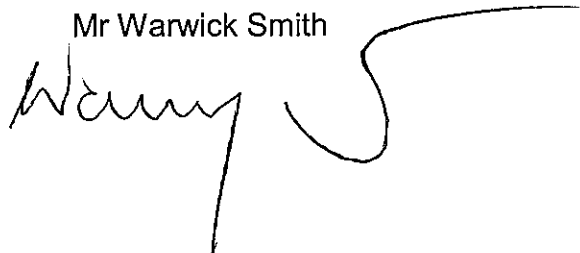
For the foregoing reasons, the Expert orders that the Domain Name <alranz.org.nz> be transferred to the Complainant.

Place of decision Auckland, New Zealand

Date 14 April 2010

Expert Name Mr Warwick Smith

Signature

A handwritten signature in black ink, appearing to read 'Warwick Smith', written over a horizontal line. The signature is stylized and cursive.