

## **.nz Dispute Resolution Service**

**DRS Reference: 477**

### **TigerDirect, Inc. v Thomas Ku**

Key words – Identical or Similar trademark - Registered mark – identical;  
No rights – unfair registration – unfair use – unfairly disrupting  
business of complainant and respondent having no connection  
with name or trademark – No resubmission of earlier complaint  
which did not produce decision

#### **1. Parties**

##### **Complainant:**

TigerDirect, Inc.  
7795 West Flagler St. Suite 35  
Miami, Florida  
USA

(represented by Mr Lonny Paul)

##### **Respondent:**

Thomas Ku  
PO Box 51706  
Pakuranga  
Auckland  
New Zealand

(Self-represented – no physical address given)

#### **2. Domain Name/s**

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

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

The Complaint was lodged on 8/03/2010 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 11/03/2010. The domain was locked on 8/03/2010, preventing any changes to the record until the conclusion of these proceedings.

The Respondent filed a Response to the Complaint on 7/04/2010 and the DNC so informed the Complainant on 7/04/2010. The DNC informed the parties on 5/05/2010 that informal mediation had failed to achieve a resolution to the dispute.

The Complainant paid Domain Name Commission Limited the appropriate fee on 21/05/2010 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

The Complainant had filed a complaint against the Respondent on 25 November 2009 which was sent to mediation which did not end in a result. The Complainant did not pay the fee to refer the complaint to Expert decision and the complaint was considered withdrawn. The present case does not come within the Rules under the Policy relating to resubmission of complaints because there had been no prior decision from an Expert.

#### **4. Factual background**

The Complainant is a global online retailer of computers, computer supplies and electronics. It is a subsidiary of Systemax, Inc, a large public corporation listed on the New York Stock Exchange.

The Complainant sells and ships products to customers all over the world, including New Zealand and has been globally recognised in the online electronics industry since 1987. Its website <tigerdirect.com> is accessed by millions of people every day from all parts of the world.

The Complainant owns registered trademarks in the United States, Canada, Mexico and Australia. Included in the United States trademark registrations in 2003 is one for the word mark TIGERDIRECT. It also owns trademarks for TIGERDIRECT.COM and TIGERDIRECT.COM DISCOUNT COMPUTERS.

The trade name TIGERDIRECT has been used by the Complainant globally since 1987. The Complainant has spent millions of dollars protecting its brand and name over the internet in the United States and abroad. It spends \$40m annually on marketing its brand.

The disputed domain name has no ties to the Respondent. The Respondent had no authorisation from the Complainant to reflect its trademarks in a domain name.

Although the Complainant has no physical operations inside New Zealand, it does much business with New Zealand citizens over the internet and has many regular customers in this country.

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

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

The disputed domain name is identical to at least one of the registered trademarks owned by the Complainant and is also identical to the name under which the Complainant trades online in New Zealand and elsewhere around the world.

The disputed domain name is an unfair registration in that the use of the name is likely to confuse, mislead and deceive people and businesses into believing that the disputed domain name is registered to, operated or authorised by or otherwise connected with the Complainant. It is none of those things.

The Respondent's website has received numerous enquiries from persons in New Zealand as to whether the Complainant has started operating in New Zealand because of the confusion created by the Respondent's website and domain name.

## **b. Respondent**

The Respondent said merely the following in his Response:

"I would like to confirm that the domain name of <Tigerdirect.co.nz> has been registered by myself and is at my disposal. I might agree a paid transfer of the domain name <Tigerdirect.co.nz> to the person who is interested in. I would like to state that I have never been an employee of Mrs Chen."

He did not offer any documents for consideration by the Expert.

## **6. Discussion and findings**

Because the Respondent chose not to make any factual submissions, the Expert has accepted the statements of fact made by the Complainant.

The first matter which the Complainant has to prove is that it has rights in respect of a trademark which is identical or similar to the Respondent's domain name. The disputed domain name is identical to the registered trademark TIGERDIRECT. Because the Complainant has traded under that name online in New Zealand and throughout the world, it is clear that the disputed domain name is identical to that trading name as well. The disputed domain name is also confusingly similar to the Complainant's other registered trademarks which incorporate the words Tiger Direct.

Accordingly, the Complainant has proved that it has rights in respect of a trademark which is identical to the disputed domain name.

The next matter that a complainant must prove is whether there has been an "unfair registration" which is relevantly defined in the Policy as:

"a domain name which either:

- (1) was registered or otherwise acquired in a manner which at the time when the registration took place took unfair advantage of or was unfairly detrimental to the Complainant's rights; or

- (2) has been or is likely to be used in a manner which took unfair advantage of or was unduly detrimental to the Complainant's rights."

A non-exhaustive list of facts which may be evidence that a disputed domain name is an unfair registration is set out in paragraphs 5.1.1 to 5.1.5 of the Policy. The one relevant here is para. 5.1.2, viz:

- 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..."

In the present case, the inference is inescapable that the Respondent is using the disputed domain name in a way that is likely to confuse or mislead internet users into believing that the disputed domain name is registered to, operated or authorised by or otherwise connected with the Complainant.

The Respondent is clearly engaging in cybersquatting. He had no right to register this name. The fame of the Complainant as an online retailer of considerable substance is well-known.

The Panel has no hesitation in finding that the Complaint is proved.

## **7. Decision**

The decision is that the disputed domain name <Tigerdirect.co.nz> should be transferred to the Complainant by the Respondent.

**Place of decision** Auckland

**Date** 1 June 2010

**Expert Name** Hon Sir Ian Barker QC

**Signature**

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