

## **.nz Dispute Resolution Service**

**DRS Reference: 480**

### **Massey University v Progressive Solutions**

Key words –

#### *Domain name*

masseyuniversity.ac.nz  
masseyuniversity.co.nz ("the Domain Names")

#### *Identical or similar trade mark or name*

well-known mark

#### *Unfair registration*

Unfair registration –likely to confuse, mislead or deceive - respondent having no connection with name or trade mark

### **1. Parties**

Complainant:

Massey University

Mr Keith Linforth

Assoc. Director (Infrastructure - Network and Tele  
Information Technology Services, PN460

Private Bag 11222

Palmerston North

New Zealand

Respondent:

Progressive Solutions

PO Box 1136

Palmerston North

New Zealand

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

masseyuniversity.ac.nz  
masseyuniversity.co.nz ("the Domain Names")

### **3. Procedural history**

3.1 The Complaint was lodged on 15/03/2010 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on

18/03/2010. The domain/s were locked on 15/03/2010, 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 20/04/2010 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 26/04/2010 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**

4.1 The complainant is a university constituted under s 3 of the Massey University Act 1963. For over 40 years it has enjoyed a reputation as a university. The reputation extends throughout New Zealand and in some measure overseas.

4.2 In 2005 and 2007 someone registered the domain names “masseyuniversity.co.nz” and “masseyuniversity.ac.nz”. The identity of the registrant is unknown because the Registrar permitted registration in the name of “Progressive Solutions”. The expression “Progressive Solutions” is not recognisable as a person or entity in law. A search of the Companies Office reveals that a company “Progressive Solutions Limited” was incorporated in 1995 but there is no evidence linking the domain names to that company. One of the consequences is that it is impossible to tell whether the registrant has exhibited a pattern of unfair registrations masked behind a series of informal trade names.

4.3 Whoever he, she or it may be, the Respondent has since registration used the two domain names in this instance for websites which to all outward appearances are those of the Complainant. The websites have purported to provide information about the Complainant’s courses and other services as well as links to other commercial outlets. Included among the links are those entitled “Domain Name” and “Domain Registration”. They lead to pages advertising domain names for sale.

4.4 It is not disputed that the Respondent’s use of the subject domain names has caused confusion to students. The confusion is compounded by the inaccuracy of some of the information purportedly provided on behalf of the Complainant.

#### **5. Parties’ contentions**

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

5.1 The Complainant relies on its legal right to the name “Massey University” pursuant to the Massey University Act 1963. It argues that these are unfair registrations in that the Respondent’s use of the domain names is confusing people into thinking that when visiting the websites they are dealing with the Complainant.

**b. Respondent**

5.2 The Respondent has not filed any response.

**6. Discussion and findings**

6.1 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;”

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

- (a) Rights in respect of a name or mark (para 4.1.1);
- (b) Identity or similarity between that name or mark and the Domain Name (para 4.1.1); and
- (c) Unfair registration in the hands of the Respondent (para 4.1.2).

**(a) Rights in respect of a name or mark**

6.3 I accept that the Complainant has the right to use the name “Massey University” pursuant to s 3 of the Massey University Act 1963.

**(b) Identity or similarity**

6.4 The domain names “masseyuniversity.co.nz” and “masseyuniversity.ac.nz” are virtually identical to the Complainant’s name “Massey University”.

**(c) Unfair registration in the hands of the Respondent**

6.5 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).

6.6 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. Students are using the sites in the belief that they emanate from the Complainant. In terms of para 5.1.2 of the Policy this is evidence that the disputed Domain Names are unfair registrations.

6.7 This makes it unnecessary to decide whether the primary purpose of the registration was to sell the Domain Names in terms of para 5.1.1(a).

6.8 The Respondent has made no attempt to dispute the Complainant's allegations of confusing use of the Domain 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.

6.9 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.

## **7. Decision**

7.1 The Complaints are upheld. I direct that the two disputed Domain Names be transferred to the Complainant or its nominee.

### **Place of decision**

Auckland, New Zealand

### **Date**

28 April 2010

### **Expert Name**

Hon Robert Fisher QC

### **Signature**