

nz Dispute Resolution Service

DRS Reference: 531

Green Acres Franchise Group Limited v Ian Macdonald

Key words -

Domain Name

greenacreslawnmowing.co.nz

Identical or similar trade mark or name

Registered mark – unregistered mark – well-known mark – identical – similar
– mark with generic word

Unfair registration

Unfair registration – unfair use – likely to confuse, mislead or deceive

1. Parties

Complainant:

Green Acres Franchise Group Limited
PO Box 41271
St Lukes
Auckland 1346
New Zealand

Respondent:

BJ and AC McCarthy
36 Lynwood Road
Kelston
Auckland
New Zealand

2. Domain Name/s

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

3. Procedural history

3.1 The Complaint was lodged on 23 July 2010 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 28 July 2010. The domain was locked on 27 July 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 27 August 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 27 August 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 owns and operates a franchise system in New Zealand with over 800 businesses using the "Green Acres" business system. The Complainant has been trading using the name "Green Acres" since the early 1990s.

4.2 The Complainant owns registered trade marks in respect of the names "Greenacres" and "Green Acres", plus all associated intellectual property in those names. These trade marks relate to, among other things, lawn mowing services. In relation to those services the names were registered on 31 July 1992.

4.3 On 20 February 2008 the Respondent registered the disputed Domain Name. The Domain Name is used to direct potential customers to the Respondent's website www.greenacreslawnmowing.co.nz. The Respondent uses the website to advertise services for the maintenance of lawns, gardens property and related items.

5. Complainant's contentions

5.1 The Complainant complains that the Respondent is unfairly using the disputed Domain Name to divert potential customers of the Green Acres business group to the Respondent's website.

5.2 The Complainant argues that it has existing rights in respect of the words "Green Acres" and "Greenacres" by virtue of its registered trade marks and its goodwill and reputation in the names "Green Acres" and "Greenacres".

5.3 The Complainant submits that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive.

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:

- (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

7.3 The Complainant has demonstrated rights in respect of the names "Green Acres" and "Greenacres". I accept that by the time the Respondent registered the Domain Name in 2008 the Complainant had registered trade marks in the names "Green Acres" and "Greenacres". I accept also that the Complainant had an established goodwill and reputation in respect of those names.

(b) Identity or similarity

7.4 The first half of the domain name "greenacreslawnmowing.co.nz" is identical to the Complainant's registered trade mark "Greenacres". The second half describes the services associated with that name. I accept that the combination produces a high level of similarity.

(c) Unfair registration in the hands of the Respondent

7.5 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).

7.6 The evidence supports the conclusion that the Respondent is using the disputed Domain Name in a way which is likely to confuse, mislead or deceive people into believing that the Domain Name is connected with the Complainant. Potential customers are likely to use the site in the belief that the lawn mowing services provided by the Respondent emanate from the Complainant or are in some way commercially associated with the Complainant. In terms of para 5.1.2 of the Policy this is evidence that the disputed Domain Name is an unfair registration.

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

7.9 I conclude that the Respondent's registration is unfair for the purposes of the Policy and that all three requirements for a complaint of this kind are established.

8. Decision

8.1 The Complaint is upheld. I direct that the disputed Domain Name be transferred to the Complainant or its nominee.

Place of decision
Auckland, New Zealand

Date

1 September 2010

Expert Name

Hon Robert Fisher QC

A handwritten signature in blue ink, appearing to read 'R Fisher', with a stylized flourish at the end.

Signature