

.nz Dispute Resolution Service

DRS Reference: 600

Massey University v Progressive Solutions

Key words – Identical or similar trademark or name – well-known mark – Unfair registration – likely to confuse, mislead or deceive – respondent having no connection with name or mark

1 Parties

Complainant:

Massey University
Private Bag 11222
Palmerston North
New Zealand

(represented by Mr Keith Linforth (Associate Director of Information Technology Services)

Respondent:

“Progressive Solutions”

PO Box 1136
Palmerston North
New Zealand

(no representation)

2 Domain Name/s

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

3 Procedural history

- 3.1 The Complaint was lodged on 11/8/2010 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 11/11/2010.
- 3.2 No response filed by the Respondent.
- 3.3 The Complainant paid Domain Name Commission Limited the appropriate fee on 12/8/2010 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).

- 3.4 Hon. Sir Ian Barker QC, the undersigned, (“the Expert”) confirmed to the DNC on 09/12/10 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 On 04/28/10 a decision was given by another Expert in DRS 480 on a complaint by the present Complainant against the present Respondent over the domain names <masseyuniversity.co.nz> and <masseyuniversity.ac.nz>. The respondent did not file a response and the Expert found in favour of the complainant.

- 4.2 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 throughout New Zealand and in some measure overseas.

- 4.3 In DRS 480, the Expert said:

“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 1965 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.”

- 4.4 The present Expert agrees with the above statement and goes further to say that Registrars should not accept registrations from applicants who are neither named individuals nor incorporated bodies.

- 4.5 In 2007, the Respondent (whoever he or she may be) registered the disputed domain name and uses a website accessed by the disputed domain name which provides sponsored links to (inter alia) tertiary-education-related sites. The links divert users to institutions competing with the Complainant for students.

- 4.6 It is not disputed that the Respondent’s use of the subject domain name will cause confusion to internet users.

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 this is an unfair registration in that the Respondent's use of the domain name is diverting people searching for information about Massey University to the sites of competing academic institutions.

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 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 unduly 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 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 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).

Rights in respect of a name or mark

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

Identity or similarity

6.4 The disputed domain name “massey.co.nz” whilst not containing the word “university” is confusingly similar to the Complainant’s name.

6.5 Because the word “university” does not appear in the disputed domain name, it might have been open to the Respondent to aver that he/she bore the surname “Massey” and had built up a reputation based on this name. But in the absence of such information, the Expert takes judicial notice of the fact that Massey University is commonly referred to in New Zealand as, simply, “Massey”.

Unfair registration in the hands of the Respondent

6.6 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).

6.7 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. Searchers enter the site in the belief that it emanates from the Complainant. In terms of para 5.1.2 of the Policy this is evidence that the disputed Domain Names is an unfair registration.

6.8 The primary purpose of the registration was to disrupt the business of the Complainant by diverting internet users to competing academic institutions.

6.9 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.

6.10 The decision DRS 480 demonstrates that this Respondent has engaged in a pattern of registrations of domain names which correspond to the Complainant’s well-known name and mark. Rule 5.1.3 applies to this Respondent to reinforce the view that there is an unfair registration.

6.11 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.

7 Decision

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

Place of decision

Date 13 December 2010

Expert Name

Hon. Sir Ian Barker

Signature