

.nz Dispute Resolution Service

DRS Reference: 806

Her Majesty the Queen in right of New Zealand acting through the Department of Inland Revenue v David Henderson

Key words:

Domain name: kiwisaver.org.nz

Identical or similar trade mark or name: registered mark – unregistered mark – well-known mark – identical

Unfair registration: unfair use – likely to confuse, mislead or deceive – pattern of registration – false contact details – unfairly disrupting the business of the complainant – respondent having no connection with name or trade mark

1. Parties

Complainant:

Her Majesty the Queen in right of New Zealand acting through the Department of Inland Revenue
12-22 Hawkestone Street
Wellington
New Zealand
Represented by: Mr Nigel Robb

Respondent:

David Henderson
PO Box 5442
Wellington
New Zealand
Represented by: Mr David Henderson

2. Domain Name/s

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

3. Procedural history

The Complaint was lodged on 16/08/2012 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 21/08/2012. The domain was locked on 16/08/2012, preventing any changes to the record until the conclusion of these proceedings.

There was no response filed by the Respondent.


The Complainant paid Domain Name Commission Limited the appropriate fee on 20/09/2012 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).

Ms Sheana Wheeldon, the undersigned (“the Expert”) confirmed to the DNC on 24/09/2012 that she knew of no reason why she could not properly accept the invitation to act as expert in this case and that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and/or impartiality.

4. Factual background

The Complainant’s rights

- 4.1 The Complainant is Her Majesty the Queen in right of New Zealand acting through the Department of Inland Revenue (“Inland Revenue”). It has filed evidence in the form of statutory declarations by Sharon Mullen, a senior solicitor at Inland Revenue, and Tania Weir, a secretary employed by the Complainant’s representatives. Unless otherwise stated, the facts below are taken from that evidence.
- 4.2 The Complainant acting through Inland Revenue is the administrator of KiwiSaver, a voluntary work based savings initiative to help New Zealanders with their long-term saving for retirement.
- 4.3 KiwiSaver schemes are provided by private sector companies called KiwiSaver Scheme Providers (“Scheme Providers”). Inland Revenue regulates the use of the name KiwiSaver by Scheme Providers to ensure fairness regarding use of the KiwiSaver trade mark between Scheme Providers and to avoid confusion of the public.
- 4.4 There are 30 Scheme providers. In addition, there are 95 other individuals and organisations that Inland Revenue has Licence Agreements with. These Scheme Providers, individuals and organisations all use the KiwiSaver trade mark in the promotion of their KiwiSaver initiative related services and products.
- 4.5 As at 30 April 2012 there were nearly 2 million New Zealanders enrolled in KiwiSaver schemes.
- 4.6 Inland Revenue owns a number of trade mark registrations in respect of the mark KiwiSaver. Details are as follows:

Number	Mark	Class	Registration Date
729804	KiwiSaver	36	17 May 2005
748366		36	23 May 2006
812852	KIWISAVER	9, 16, 41	17 September 2009

- 4.7 These registrations cover financial services, including retirement savings and investment schemes, publications, and education and training.
- 4.8 In addition to these registered trade mark rights, Inland Revenue claims rights in the name KiwiSaver by virtue of:
- a Being administrator of the KiwiSaver Scheme created under the KiwiSaver Act 2006.
 - b Regulating use of the KiwiSaver trade mark by Scheme Providers.
- 4.9 The Complainant also relies on the fact that KiwiSaver is the trade mark by which the KiwiSaver savings initiative is known. The Complainant's evidence includes:
- a a print out from a Google search for KiwiSaver, limited to New Zealand, which shows there were 4,300,000 hits.
 - b KiwiSaver statistics as at 30 April 2012 which indicate that at that time 1,931,557 individuals were members of KiwiSaver.
- 4.10 Inland Revenue operates the official KiwiSaver website from www.kiwisaver.govt.nz. This is where the public can obtain information about the KiwiSaver savings initiative.

The Respondent's activities

- 4.11 Based on information the Expert has accessed at whois.com, the Domain Name was registered on 19 May 2005.
- 4.12 It is not clear whether it was the Respondent who originally registered the Domain Name, but since registration took place more than three years before the filing of the Complaint, that is largely academic. If the Respondent has subsequently acquired the Domain Name, the date of that acquisition is not apparent.
- 4.13 In July 2012 it came to Inland Revenue's attention that the Domain Name was linking to a website which contains "adult" or pornographic content. That website has nothing to do with Inland Revenue or the KiwiSaver savings initiative. It is not clear for how long prior to July 2012 that linkage had been in place.
- 4.14 The DNC contact details for the Respondent list the contact name as David Henderson and the admin contact as James Henderson. The contact address listed for both these names is PO Box 5442, Wellington.
- 4.15 According to the Complainant's evidence, that PO box number is in fact that of a business called Advanz Healthcare. That certainly appears to be the case based on print outs of Advanz Healthcare's website dated 25 July 2012. It is not clear for how long the PO box number has been used by Advanz Healthcare.

- 4.16 The Complainant has suggested that David Henderson and James Henderson are the same person, because their contact details are the same. That does not necessarily follow. More importantly, the Expert is not convinced that real individuals by the name of David Henderson and/or James Henderson are necessarily involved in the ownership and control of the Domain Name.
- 4.17 By sheer coincidence, there are two reasonably well known New Zealand businessmen by the name of David Henderson, both of whom have been involved in well publicised disputes with Inland Revenue. The Complainant has provided copies of various media articles concerning these individuals. According to those, both David Hendersons are property developers, one is based in Christchurch, and the other is based in Auckland.
- 4.18 Notably, according to an article on the New Zealand Herald website dated 13 July 2012 about the Domain Name and the fact it was directing to the “adult” website, ‘Well-known Auckland and Christchurch-based property developers, both named David Henderson, denied any knowledge of or involvement with the domain.’
- 4.19 The domain name registration process requires registrants to give a name and an address, but it does not include any verification as to whether those details are genuine. In the present situation, both well-known individuals by the name of David Henderson, who have been involved in disputes with Inland Revenue and could be perceived as having a grudge against Inland Revenue, have apparently denied all knowledge of the Domain Name.
- 4.20 While there will no doubt be other individuals with the name David Henderson, it would seem an unusual coincidence for one of these to have registered the Domain Name, given the close connection between Inland Revenue and the KiwiSaver savings initiative.
- 4.21 It is possible that some other individual entirely has registered or acquired the Domain Name, and falsely given the name David Henderson (and possibly also the name James Henderson), and the apparently bogus address. The name David Henderson would be a potential choice if an individual wished to interfere with Inland Revenue’s activities while hiding behind the identity of an individual who was known to be in dispute with Inland Revenue.
- 4.22 Given the absence of direct or clear evidence on this point, and the conflicting circumstantial and hearsay evidence, the Expert makes no finding as to whether the real name of the Respondent is indeed David Henderson, and if so, which David Henderson he is. Accordingly references to the Respondent in this decision should be taken as referring to the person who controls the Domain Name, who may or may not have the name David Henderson.
- 4.23 In any event, the Domain Name links to an “adult” website that has no connection with the KiwiSaver savings initiative. The New Zealand

Herald article mentioned earlier refers to a representative of the owner of that website as having said he 'was delighted by the link, which he described as "very smart action in diverting kiwisaver.org to our porn site...someone's done that as a joke, isn't that funny"'.

- 4.24 Though this hearsay statement cannot be given a great deal of weight, it does suggest that the owner of the adult website is not itself involved in the linkage of the Domain Name to that website.
- 4.25 The Complainant has provided evidence of actual confusion and shock caused by people keying in the Domain Name expecting to reach the official KiwiSaver website, but finding themselves at the adult website the Domain Name is directed to.

5. Parties' contentions

Complainant

- 5.1 The Complainant seeks to have the Domain Name transferred to it from the Respondent.
- 5.2 As mentioned above the Complainant asserts rights in the trade mark KiwiSaver by virtue of its trade mark registrations, its statutory responsibilities concerning the KiwiSaver Scheme, and common law rights that arise from the fact KiwiSaver is the trade mark by which the KiwiSaver savings initiative is known.
- 5.3 The Complainant submits that the Domain Name, in the hands of the Respondent, is an unfair registration, on the basis that:
- a The Domain Name takes unfair advantage of or is unfairly detrimental to the Complainant's rights.
 - b The Respondent has knowingly given false contact details to a Registrar or the DNC (paragraph 5.1.4 of the Policy).
 - c The use of the Domain Name:
 - i Is unfairly disrupting the business of the Complainant (paragraph 5.1.1(c) of the Policy).
 - ii Has confused and is likely to confuse, mislead or deceive people or business (paragraph 5.1.2 of the Policy).
 - iii Is part of a pattern of registrations where the Respondent has registered well-known names or trade marks where the Respondent has no apparent right (paragraph 5.1.3 of the Policy).
 - iv Otherwise takes unfair advantage of or is unfairly detrimental to the reputation of the KIWISAVER trade mark in New Zealand.

- 5.4 In relation to disruption (paragraph 5.1.1(c) of the Policy), the Complainant asserts that the use of KiwiSaver as the identifier in the Domain Name will cause people to be diverted from the official kiwisaver.govt.nz website because people will mistakenly assume the Domain Name is the link to official information. It points to two actual examples of diversion or disruption referred to in its evidence and asserts that such disruption and diversion of people's efforts to get in touch with the official administrators and information providers of the KiwiSaver savings initiative is unfair.
- 5.5 With regard to confusion (paragraph 5.1.2 of the Policy), the Complainant asserts that the KiwiSaver trade mark is well known in New Zealand, that use of the trade mark KiwiSaver as part of the Domain Name is likely to infer a connection with the official KiwiSaver savings initiative or an authorised user of the trade mark and because the presence of KiwiSaver in the Domain Name can only be associated with the KiwiSaver savings initiative.
- 5.6 The complainant also refers to DRS 250 *Apollo Marketing v Apollo Marketing and Advertising*, which concerned the Domain Name apollomarketing.co.nz. In that case, the Expert stated:
- ‘First, the Domain Name is identical to the Complainant’s “Apollo Marketing” name or mark, and it is inevitable that some Internet users looking for the Complainant’s website would key in the Domain Name. But the Complainant’s case is stronger than that—the Complainant has produced emails from three separate clients, all saying that they did precisely that....’
- 5.7 The Complainant asserts that the Domain Name is unfair because it has caused confusion and is likely to cause further confusion, to the effect that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- 5.8 Finally, on the topic of confusion, the Complainant asserts that the Respondent is relying on initial confusion caused by use of the Domain Name to cause people or businesses to land at a website that is likely to cause offence to some people, and that such a connection unfairly tarnishes or colours the KiwiSaver savings initiative.
- 5.9 In support of its assertion that the Respondent is engaged in a pattern of registrations where it has registered well-known names or trade marks in which it has no apparent right (paragraph 5.1.3 of the Policy) the Complainant points to the fact that the Registrant for two other domain names is recorded as James Henderson, and the contact details and Registrar are the same as for the Domain Name. The two domain names cited are gogole.co.nz and gooogle.co.nz, both of which are obviously minor typographical variations on google.co.nz, Google of course being the name of a very well-known search engine.

- 5.10 The Complainant asserts based on this that the Respondent, directly or indirectly, is a typo-squatter and is the same person as the Registrant for the two above domain names.

Respondent

- 5.11 The Respondent has not filed any response.

6. Discussion and findings

Relevant Provisions of the Policy

- 6.1 The Complainant is required to prove that it has met the requirements in paragraph 4 of the Policy namely 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.

- 6.2 Paragraph 4.2 requires the Complainant to prove to the Expert that both elements are present on the balance of probabilities.

- 6.3 The Policy provides that “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.

- 6.4 Paragraph 5.1 of the Policy sets out a series of non-exhaustive factors which may be evidence that a Domain Name is an Unfair Registration. They include the following:

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; or
- (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 the 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.

6.5 Paragraph 6.1 of the Policy sets out a series of non-exhaustive factors which may be evidence that the Domain Name is *not* an Unfair Registration.

Application of the Policy in this case

6.6 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. Rights must be enforceable under New Zealand law and may be registered or unregistered.

Complainant's Rights

6.7 The Expert finds that the Complainant clearly has rights in respect of the trade mark KiwiSaver in New Zealand by virtue of its registered trade marks. The Expert notes that the earliest of these registrations, no. 729804, is dated 17 May 2005, which is (just) prior to the date on which the Domain Name was registered.

6.8 The Expert also finds that the Complainant has common law rights in New Zealand in respect of the trade mark KiwiSaver by virtue of its role as administrator of the KiwiSaver savings initiative and the very heavy promotion and awareness of that initiative and of KiwiSaver schemes amongst the New Zealand public, and that the trade mark KiwiSaver is well known in New Zealand.

6.9 While it is not clear from the evidence exactly how long the KiwiSaver trade mark has been in use, based on the deemed registration date of the Complainant's trade mark registration no. 729804, the Expert is satisfied that the Complainant's trade mark rights existed prior to registration of the Domain Name on 19 May 2005.

6.10 The Complainant's trade mark KiwiSaver is effectively identical to the Domain Name.

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

6.11 Under paragraph 4.1.2 of the Policy the Complainant must show, on the balance of probabilities, that the Domain Name is an unfair registration in the hands of the Respondent.

6.12 The Expert notes that under paragraph 5.4 of the Policy:

5.4 In making the decision, the Expert shall not take into account any evidence of acts or omissions amounting to unfair registration or use which occurred more than three (3) years before the date of the Complaint.

6.13 In the present case the date of the Complaint is 16 August 2012, and hence the Expert cannot take into account acts or omissions amounting to unfair registration or use which occurred prior to 16 August 2009.

6.14 The Domain Name was registered on 19 May 2005. Therefore the registration of the Domain Name was outside the relevant three year period. In the event that the Respondent did not himself register the Domain Name but acquired it at a later date, that date cannot be ascertained from the evidence.

6.15 Accordingly the Expert cannot make a finding of unfair registration based on any of the factors in paragraph 5.1.1 of the Policy, all of which refer to circumstances around the Respondent's registration or acquisition of the Domain Name.

6.16 The definition of Unfair Registration includes a Domain Name which:

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.

6.17 The Complainant has also asserted that the Respondent's *use* of the Domain Name is unfair. The linking of the Domain Name to the "adult" website, which has been occurring since at least July 2012, is clearly within the relevant three year period.

6.18 The question therefore is, has the Respondent since 16 August 2009, used the Domain Name in a manner which took unfair advantage of or was unfairly detrimental to the Complainants' Rights?

6.19 The Expert finds that that is the case. Specifically:

a The Expert finds that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. This likelihood of confusion is inherent in the Domain Name itself, kiwisaver.org.nz, which strongly suggests that it denotes an official KiwiSaver website.

- b The Respondent is also using the Domain Name in a way that is unfairly disrupting the business of the Complainant. This is analogous to the factor listed in paragraph 5.1.1(c) of the Policy and, since the listed factors are not exhaustive, this may also be taken as evidence of an Unfair Registration.

6.20 In addition, the Expert finds on the balance of probabilities that the Respondent is engaged in a pattern of registrations that amounts to evidence of an Unfair Registration in terms of paragraph 5.1.3 of the Policy. Specifically, whatever the real identity of the Respondent, the contact details given for the Domain Name are almost identical to those given for the Domain Names gogole.co.nz and google.co.nz, both of which (being obvious typographical variants of google.co.nz) correspond to well known names or trade marks in which the Respondent has no apparent rights.

6.21 The Expert makes no finding with regard to the Complainant's assertion that the Respondent has knowingly given false contact details to a Registrar and/or to the DNC, as the evidence on this is insufficient.

6.22 As mentioned earlier, the Respondent has filed no Response, so it has not disputed the Complainant's assertions.

6.23 There is no evidence of any of the factors listed in paragraph 6.1 of the Policy as potential evidence that the Domain Name is not an Unfair Registration.

6.24 The Expert is satisfied that the Complainant has shown, on the balance of probabilities, that the Respondent's Domain Name is an Unfair Registration.

7. Decision

In view of the findings made above the Expert directs that the Domain Name kiwisaver.org.nz be transferred to the Complainant.

Place of decision

Auckland

Date 10 October 2012

Expert Name Sheana Wheeldon

Signature

