

.nz Dispute Resolution Service

DRS Reference: 846

Wellington Golf Centre Limited v Ricky Faesen Kloet

Key words

Identical or similar trade mark or name

– unregistered mark – trade name – geographical identifier – misspelling – phonetical similarity – generic – descriptive – name wholly descriptive of Complainant's business – Complaint denied.

1. Parties

Complainant:

Wellington Golf Centre Limited

PO Box 12312

Thorndon

Wellington

New Zealand

Represented by: Mr Antony Ragg

Respondent:

Mr Ricky Faesen Kloet

74 Newton Road

Newton

Auckland

New Zealand

The Respondent is unrepresented

2. Domain Name/s

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

3. Procedural history

3.1 The Complaint was lodged on 05/02/13 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 11/02/13. The domain/s were locked on 08/02/13, 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 25/03/13 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

4. Factual background

- 4.1 The Complainant conducts a business in Wellington specialising in selling goods and services associated with the sport of golf. It was incorporated on 2 December 2010. On 4 December 2010, the Complainant registered the domain name <wellingtongolfcentre.co.nz>. On the website accessed through this domain name can be found extensive promotional information about the Complainant's business.
- 4.2 The Respondent is a director of a New Zealand-wide company called Golf Warehouse Limited. One of its shops is in the Wellington region and is in competition with the Complainant's shop. On 30 April 2011, the Respondent registered the disputed domain name which is identical to the Complainant's domain name except that "centre" is spelt "center".
- 4.3 The Complainant alleged in its complaint that an internet searcher entering the disputed domain name would be directed to the Golf Warehouse Limited website. The Expert did not find this when he undertook this exercise. The first names revealed by such a search were for the Complainant's business.
- 4.4 The Complainant has no registered trademark and has produced no evidence in support of a claim for an unregistered mark.

5. Parties' contentions

A. Complainant

- 5.1 The registration of the disputed domain name is clearly designed with the intention of disrupting the Complainant's business and to elicit business away from the Complainant.
- 5.2 The Respondent is using the disputed domain name in a way likely to confuse, mislead or deceive internet users into thinking that the disputed domain name is registered to, authorised by, or otherwise connected to the Complainant.
- 5.3 The use of the disputed domain name by the Respondent is an attempt to disrupt and damage the Complainant's business.

B. Respondent

- 5.4 The Respondent made no submissions.

6. Discussion and findings

- 6.1 The first matter which the Complainant has to prove is that it has rights in respect of a domain name or trade mark which is identical or similar to the Domain Names. The definition of “rights” in the Policy is “*Rights includes but is not limited to rights enforceable under New Zealand law. However, the Complainant will be unable to rely on rights in an name or term which is wholly descriptive of the Complainant’s business*”.
- 6.2 In many cases, a complainant need point only to a trade mark registered in New Zealand or possibly in a foreign jurisdiction to prove the necessary rights. If there is no registered trade mark, then an unregistered trade mark, if proved, can be dispositive.
- 6.3 In cases under the UDRP decided by WIPO and NAF Panelists, a fairly high threshold for establishing a common law trade mark is required. Far more extensive evidence than that supplied by the Complainant in the present case would be required. Essentially, all the Complainant has shown is that it has been in business as a golfing retailer in Wellington since December 2010.
- 6.4 The Complainant supplied no evidence of the extent of its business or of the reputation that it had acquired. It has acquired rights in its domain name which it has used as a trading tool for some 28 months.
- 6.5 However, decisions under the English Nominet Policy show that the requirement to demonstrate rights is not a particularly high threshold test – See DRS 00248, Seiko-shop.co.uk DRS 00359, parmaham.co.uk. The English definition of “rights” is similar to that in the New Zealand Policy.
- 6.6 The Complainant has traded as “Wellington Golf Centre” since the company was formed only in December 2010. The Complainant has established a ‘Right’ under the Policy in respect of the Domain Name <wellingtongolfcentre.co.nz>, which it uses to promote its retailing business.
- 6.7 The Expert must now consider whether the Complainant’s domain name is “wholly descriptive” of the Complainant’s business. If it is, then the Complainant cannot succeed because of the definition cited in Paragraph 6.1 above.
- 6.8 The Expert acknowledges with gratitude the learned and comprehensive analysis of this requirement of the Policy conducted by the Expert in DRS 108, *B.O.P. Memorials v Jones & Company Funeral Services*.
- 6.9 From that decision the following principles can be extracted:
 - (a) The test for determining whether words are merely descriptive is “*whether the words are equally applicable to any business of the*

like kind". There is a continuum with, at the extremes, purely descriptive names at one end and purely invented names at the other. The closer one moves towards a merely descriptive name, the more a complainant will need to show that the name has acquired a secondary meaning equating it with the products of the complainant and the easier it will be to see a small difference in names as adequate to avoid confusion.

- (b) The more apt a word is to describe the goods or services, the less inherently apt it is to distinguish them as the goods of a particular merchant.
- (c) If the Complainant's product had acquired a secondary meaning, it must go beyond merely describing the name of the Complainant's services or products.

6.10 Is the expression "wellingtongolfcentre" "*equally applicable to any business of the like kind*" – the test adopted by the Expert in the *BOP Memorials* decision? That finding was based on a decision of the Federal Court of Australia in *Equity Access Pty Ltd v Westpac Banking Corporation & Anor* (1989) 161 IPR 431, 448. There must be several retail businesses in the Wellington area specialising in golfing equipment, including the Respondent's business.

6.11 In the Expert's view, the name 'wellingtongolfcentre' is at the descriptive end of the continuum referred to above. The question then is whether the Complainant has provided sufficient evidence to show that the name has been so associated in the minds of a significant number of consumers, that it has acquired a secondary meaning and that is not therefore wholly descriptive of the goods and services provided by the Complainant.

6.12 The information about its business provided by the Complainant is minimal.

6.13 The Expert has viewed the Complainant's website which contains material that one would expect for a website of a retail business of this sort.

6.14 There was no evidence offered of expenditure on promoting the business name nor any evidence from members of the public or users or potential users of the Complainant's services as to how the business name is perceived or understood.

6.15 The evidence of secondary meaning described above is very weak. Although decisions of the appeal panels in the United Kingdom have held that the requirement under the Policy to demonstrate "rights" is not a particularly high threshold test, in the absence of evidence, the Expert cannot say that the Complainant's business has acquired a secondary meaning so as to exempt its domain name from the category of being wholly descriptive of the Complainant's business.

- 6.16 The purpose of the Policy is primarily to provide a quick and relatively cheap means of obtaining redress in circumstances of abusive or otherwise unfair registration of a domain name. The level of proof of the necessary elements under the Policy required cannot reasonably be expected to be at the level which would be necessary to support a court claim for passing-off, or an application to register a trade mark based on distinctiveness acquired through years of use.
- 6.17 That said, the evidence in this case falls short of the fairly low barrier of having to show that the Complainant's name, on the balance of probabilities, has become distinctive of the Complainant's particular services in Wellington and that it is not wholly descriptive of the general nature or characteristics of the service it provides.
- 6.18 In the *BOP Memorials* decision, the Expert was able to show (just) that the name "BOP Memorials" had become distinctive of the complainant's particular services and was not wholly descriptive of the general nature or characteristics of the service it provided. In that case, there had been evidence of ten year's uninterrupted business use of the name: the geographical expression used was "BOP" – an abbreviation of Bay of Plenty, whereas, in this case, the full geographical name of the city is used. This is an important consideration in allaying the concern about granting a monopoly in a region.
- 6.19 Further evidence of advertising in Yellow Pages and business cards and letterheads was presented to the Expert in the *BOP Memorials* case. Taken cumulatively with the other evidence, this evidence tilted the balance towards a finding that, whilst the disputed domain name was descriptive and could have been applicable to any party who wished to provide a memorials service in the Bay of Plenty, the complainant had provided enough evidence to establish that the name had become so associated with its business in the minds of a significant number of consumers. In other words, the disputed domain name had acquired a secondary meaning.
- 6.20 Comparable evidence is just not present in this case. It is doubtful whether much more evidence of the sort required could have been forthcoming from a business in a not unusual retail area which had been operating for only two years or so. Accordingly, the Complaint must be dismissed.
- 6.21 It becomes unnecessary therefore to consider whether this was an unfair registration.

7. Decision

The disputed domain name is to remain with the Respondent. The Complaint is denied.

Place of decision: Auckland

Date 5th April, 2013

Expert Name Sir Ian Barker

Signature
