

.nz Dispute Resolution Service

DRS Reference: 897

Child Cancer Foundation Inc. v Garth Piesse

Key words –

Identical or similar trade mark or name

Well-known mark - trade name – generic - descriptive

Unfair registration

Fair use - likely to confuse, mislead or deceive

1. Parties

Complainant:

Child Cancer Foundation Inc.
PO Box 152
Auckland
New Zealand

Represented by: Mrs Sue Ironside of Baldwins Intellectual Property; Auckland

Respondent:

Garth Piesse
Domain-For-Sale.co.nz
PO Box 181
Palmerston North
New Zealand

Represented by: Mr Adam Taylor of Adlex Solicitors; London

2. Domain Name

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

3. Procedural history

- 3.1. The Complaint was lodged on 22/08/13. The Domain Name Commission (DNC) notified Respondent of the validated Complaint on 27/08/13. The Domain Name was locked on 23/08/13, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. Respondent filed a Response to the Complaint on 16/09/13 and the DNC so informed Complainant on 16/09/13. Complainant filed a Reply to the Response on 26/09/13. The DNC informed the parties on 14/10/13 that informal mediation had failed to achieve a resolution to the dispute.

Respondent sought leave on 14/10/13 to file a non-standard reply in accordance with paragraph B12.2 of the DRS Procedure on the basis that there was an exceptional need for such non-standard submission.

- 3.3. Complainant paid Domain Name Commission Limited the appropriate fee on 24/10/13 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4. Mr Clive Elliott QC, the undersigned, (“the Expert”) confirmed to the DNC on 24/10/13 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. Respondent registered the Domain Name on 1 October 2009.

5. Parties’ contentions

5.1. Complainant

- 5.1.1. Complainant states that it is a duly incorporated society and registered charity under the laws of New Zealand, having its registered office at 76 Grafton Road, Grafton, Auckland, New Zealand, and carrying on business primarily as providing support and care for children with cancer and their families. It has been using the name Child Cancer Foundation Inc. in relation to its services since 29 May 1978, and asserts that it has rights in the name CHILD CANCER.
- 5.1.2. Complainant claims that the words “CHILD CANCER” are not generic in New Zealand and that over the past 35 years it has developed an extensive and exclusive reputation in the name CHILD CANCER. Complainant contends that its extensive reputation, combined with the proper use and development of its intellectual property, has distinguished the words CHILD CANCER as synonymous with the CHILD CANCER FOUNDATION.
- 5.1.3. Complainant also claims that the connection between the names CHILD CANCER and Child Cancer Foundation is publicly recognised and submits that such claim is supported by a Google Trends search showing the frequency, over time, the words CHILD CANCER were searched in New Zealand. The search shows that people who searched CHILD CANCER in New Zealand most often searched for the term CHILD CANCER FOUNDATION as well.

- 5.1.4. Complainant states that it is the owner of five registered trade marks that contain the words CHILD CANCER and that in 1998 it registered the CHILD CANCER FOUNDATION logo. In this logo the words CHILD CANCER are emphasised in bold whereas FOUNDATION is in standard text.
- 5.1.5. Complainant further states that in 2005 it registered the CHILD CANCER FOUNDATION word mark and the new CHILD CANCER FOUNDATION Logo. In this new logo the words CHILD CANCER have been further emphasised through stylisation and size. The word FOUNDATION is barely noticeable due to the small size of the text. Complainant believes that the words CHILD CANCER contribute extensively to the distinctiveness of this logo and the name of the foundation that differentiates it from others.
- 5.1.6. Complainant states that it originally registered the Domain Name in 2004 and that it is the current registrant of the domain name <childcancer.org.nz>.
- 5.1.7. Complainant submits that the use of the words CHILD CANCER as the past and present domain name for the Foundation, in conjunction with use and development of the logos emphasising the words CHILD CANCER, has contributed to the vast goodwill it has established in the words CHILD CANCER.
- 5.1.8. Complainant asserts that the registration of the Domain Name by Respondent is detrimental to, and takes unfair advantage of, the rights Complainant has in the words CHILD CANCER and further that Respondent's use of the words CHILD CANCER in the Domain Name constitutes a breach of Complainant's registered trade marks and therefore takes unfair advantage of the goodwill the marks possess and the rights Complainant holds over use of the marks. Complainant submits that Respondent is using the Domain Name in a way that is likely to confuse, mislead or deceive people into believing that the Domain Name is registered to, operated or authorised by Complainant.
- 5.1.9. Complainant asserts that Respondent does not have rights or a legitimate interest in the Domain Name and is improperly benefitting from the goodwill of Complainant's marks, whether by revenue gained by click-through advertising or by cybersquatting for the purposes of sale.
- 5.1.10. Complainant contends that confusion arises when Internet users attempting to contact or gain information on Complainant, with an imperfect recollection of its trade mark, but with the emphasis of the words CHILD CANCER in Complainant's marks, it is likely that people will use these words. This is demonstrated by the information shown on Google Trends; an Internet user entering the words CHILD

CANCER followed by the commonly used “.co.nz”, will be led to Respondent's page when they are looking for Complainant. It is contended that another possibility is that a web search will locate Respondent's page. Respondent has labelled his page "The Leading Child Cancer Site on the Net". This claim, in conjunction with a “.nz” domain registration wrongly suggests Respondent's website is registered to, or by a subsidiary of, Complainant.

- 5.1.11. Complainant asserts that the Domain Name is registered to a New Zealand address and Respondent is the director and sole shareholder of Coherent Limited, a company registered in New Zealand. Complainant contends that Respondent is known for purchasing domain names for resale and owns a significant portfolio of domain names featuring the option to purchase, and as such the Domain Name may have been purchased with the aim of selling it back to Complainant for a profit, which Complainant submits contributes to an unfair registration.
- 5.1.12. Complainant believes Respondent must have known it existed when Respondent purchased the Domain Name and suggests that Respondent is well aware of the extent of financial value instilled in the Domain Name by Complainant which is reflected in the correspondence between the two parties prior to the lodging of this complaint.
- 5.1.13. Complainant notes that Respondent, through his solicitor, declined a formal offer of \$3500 from Complainant for the transfer of the Domain Name, although it points out that in 2010 Respondent offered the domain <www.a1furniture.co.uk> to a business for 450 pounds (NZ\$866.87). Complainant argues that the fact Respondent refused an offer of over twice this amount from a charitable foundation exemplifies how important Respondent considers the Domain Name is to Complainant.
- 5.1.14. Complainant submits that Respondent's registration of the Domain Name is unfair because Respondent is a registrant of other domain names which correspond to well-known names or trade marks and the Domain Name is a part of that pattern. In support of this allegation Complainant provides two examples of domain names that are registered to Respondent. <www.studylink.co.nz> which is a well-known service provided by the Ministry of Social Development, offering information about student-related issues and providing financial support to students. The Ministry of Social Development own the domain registration <www.studylink.govt.nz> and the registered trade marks STUDYLINK and the STUDYLINK Logo. The domain name, <www.studylink.co.nz> registered by Respondent features the same click through advertising and option to purchase as his other domains.

- 5.1.15. The second example is <www.ariki.co.nz> Arika New Zealand Ltd is the largest paua jewellery manufacturer in New Zealand and was established in 1932. Arika New Zealand Ltd has owned the ARIKI trade mark since 1959 and the domain name, <www.ariki.co.nz> registered by Respondent features the same click through advertising and option to purchase as Respondent's other domains.
- 5.1.16. Complainant submits that Respondent is not using the Domain Name for legitimate use but is using the Domain Name unfairly as it is not offering services relating to cancer in children, nor is it involved in any industry concerning child cancer or offering information on cancer in children in the advertising featured on <www.childcancer.co.nz> Complainant further submits that Respondent has not made any demonstrable preparations to use the Domain Name in connection with any genuine offerings of goods and services and is not commonly known by the name or connected in any way with any identical or similar mark.

5.2. Respondent

- 5.2.1. Respondent notes that Complainant has produced no evidence in support of its claimed use of "Child Cancer Foundation" since 1978. It denies that "child cancer" is not generic or that Complainant has developed an extensive and exclusive reputation in the common descriptive term, distinguishing it from others.
- 5.2.2. It submits there is no reason to think that, when searching for "child cancer", the public are looking for Complainant as distinct from information about "child cancer" generally. Indeed, Complainant's Google Trends evidence shows that users do indeed search specifically for "child cancer foundation".
- 5.2.3. Respondent argues that the Google Trends evidence provided by Complainant does not help it and that, leaving aside the lack of a detailed explanation of how "related terms" are generated, the fact that a party interested in "child cancer" also searches for an organisation involved in that field does not mean that the searcher considered that "child cancer" referred to the organisation itself. By way of example, Respondent points out that related search terms for "breast cancer" include "breast cancer foundation" and "breast cancer society" and suggests that this does not demonstrate that either organisation is itself known by the generic / descriptive term "breast cancer".
- 5.2.4. Respondent contends it is difficult to see the relevance of Complainant's use of <childcancer.org.nz> or its past ownership / use of <childcancer.co.nz> (the Domain Name) (as to which Respondent says it was unaware) when there is no evidence at all of the extent of such use, let alone any evidence that users have

come to associate the term "child cancer" with Complainant independent of Complainant's name "Child Cancer Foundation", with which its website at those domains is and has been branded.

- 5.2.5. Respondent denies that Complainant's registered trade marks generate rights in the term "child cancer". Three of the marks comprise or include Complainant's name. Notwithstanding the text stylisation / size, these marks are dominated not by the common descriptive / generic term "child cancer" but by the only distinctive term: "foundation". The other two marks consist, respectively, of slogans which both include purely descriptive references to "child cancer".
- 5.2.6. Respondent points out that he registered the Domain Name on 1 October 2009, which is more than three years before the filing of the Complaint. He therefore submits Complainant's submissions relating to the circumstances of registration of the Domain Name are excluded under the Policy. Respondent nonetheless says he is keen to demonstrate that he registered the Domain Name in good faith.
- 5.2.7. Respondent states that since 2007, he has been in the business of buying, selling and monetising generic domain names, and that he became aware that the Domain Name was on a list of domains which were about to "drop" and he assumed that the previous owner no longer wanted it. Respondent further states that he acquired the Domain Name because it reflected a common generic term. He owns a number of similar generic cancer-related domain names registered from 2009 to 2012 including <breastcancer.co.nz> registered previously in February 2009 as well as a number of other child-related generic domains.
- 5.2.8. Respondent contends that given the passage of time since registration he cannot recall whether he was aware of Complainant or not, but that he had in mind ultimately to sell the Domain Name to anyone with an interest in the generic term "child cancer" and, in the meantime, to profit from advertising links relating to the generic meaning of the words comprised in the Domain Name.
- 5.2.9. Respondent denies that there is deception with the slogan "Leading Site on the Net" and explains that it is in meta-text, and not on the parking page itself, and is a standard wording automatically generated by the parking page provider, which is common marketing "puff" and not New Zealand specific.
- 5.2.10. Respondent asserts that he is using the Domain Name fairly and consistently with its generic or descriptive character by placing a generic domain name with an automated parking service generating a range of cancer-related links based on the term "cancer" in the Domain Name.

- 5.2.11. Respondent also points out that in the two examples provided by Complainant with regard to unfair registration, there is no evidence that either trade mark is well known. Respondent states he was unaware of Study Link when he registered the domain name <studylink.co.nz> and that it is one of many other similar domains containing generic descriptive terms that he owns. Respondent also states that he registered <ariki.co.nz> because "ariki" is a dictionary Maori word meaning "chieftain" and the parking page links are to "Aboriginal People" and other indigenous peoples, not to jewellery-related links.

5.3. Complainant's Reply

- 5.3.1. Complainant responded to the above.
- 5.3.2. Complainant suggests that because Respondent's solicitor, who has presented the argument on behalf of Respondent, does not reside in New Zealand he is therefore unaware of the extensive and exclusive reputation Complainant has in the mark Child Cancer.
- 5.3.3. Complainant, in support of its claim that it is well known, exhibits excerpts from a book entitled "No Journey Made Alone - 35 years of the Child Cancer Foundation" where at page 3 it is stated the incorporation date of the Child Cancer Foundation is 29 May 1978, and at pages 4 to 6 there is a short extract on the founder, Sir David Mauer, which shows the influence the Child Cancer Foundation has had on paediatric oncology in New Zealand.
- 5.3.4. Complainant submits that the exhibits produced by Respondent do not support his arguments regarding the reputation enjoyed by Complainant in New Zealand in the name Child Cancer.
- 5.3.5. Complainant suggests that Respondent has wrongly equated Child Cancer with the term breast cancer because it believes that the term breast cancer does not have the goodwill and reputation the term Child Cancer has acquired in New Zealand.
- 5.3.6. Complainant notes that Respondent has attempted to downplay the significance of the previously registered domain name and believes it is significant because it was registered to Complainant for a number of years up until 2008. Complainant contends that the public will have associated the address with Complainant and it is therefore likely they would either have bookmarked the address or would type it into a web browser manually. The previously registered and currently registered domain names also add further identity and distinction to the words Child Cancer.
- 5.3.7. Complainant denies the allegation that the Complaint is time barred.

- 5.3.8. Complainant suggests there are discrepancies in the Response regarding Respondent's activities as Respondent states that he began business in domain sales in 2007, yet it confirms that the press cutting referring to Respondent being in the business of domain sales is dated 10 August 2004, three years prior to the date Respondent claims he began buying and selling domains. Complainant argues that this is an attempt to limit the relevant period of awareness of Complainant's reputation and also the level of experience in "monetising" domain names that provided the foresight to register a mark with prior reputation in an effort to gain a significant profit.
- 5.3.9. Complainant claims that Respondent must have been aware of Complainant when the Domain Name was registered, as he had at least five years of experience in domain monetising prior to registering the Domain Name, and as this was a list of domains that were about to become available, it is more than likely Respondent would have visited the domain before it had dropped, thereby becoming aware of Complainant and its reputation prior to registration.
- 5.3.10. Complainant goes on to contend that regardless of the date <studylink.co.nz> was registered Studylink's reputation in New Zealand as a financial provider for students is undeniable. Given the press Studylink receives, in combination with a number of Respondent's LinkedIn contacts who have attended courses/programmes approved for student-loan/allowance, knowledge may be inferred from both the strong public reputation and association.
- 5.3.11. Complainant asserts that any use of the mark Child Cancer in New Zealand has been shown to be strongly associated with Complainant and that Respondent's use is not "capitalising on generic meaning", but is an exploitation of the reputation of Complainant. Complainant also states that a number of groups and associations use the Child Cancer mark when working with Complainant in pursuit of a common goal and that Respondent's registration represents no common goal, but that Respondent is an individual capitalising on the goodwill and reputation of a charity for personal financial gain.

5.4. Respondent's Reply

- 5.4.1. Respondent in turn responded to Complainant's reply submissions by way of a non-standard reply. Respondent submitted that in accordance with paragraph B12.2 of the DRS Procedure, there was an exceptional need for non-standard submission as Complainant's Reply went well beyond an answer to the Response and was an attempt to remedy the deficiencies in the Complaint by providing substantial new evidence relating to points already covered in the

Complaint. There is some basis for this complaint and the reply is admitted.

- 5.4.2. Respondent points out that none of the 14 or so pages from "the Book" refer to Complainant as "child cancer". On the contrary, Complainant is invariably referred to as "Child Cancer Foundation" – or indeed simply "the Foundation", undermining Complainant's surprising denial that the word "Foundation" is the distinguishing term in Complainant's name.
- 5.4.3. Respondent goes on to contend that Complainant's extraordinary reference to the location of Respondent's solicitor shows that Complainant does not realise that it must prove rights rather than relying on a vague, unsupported assertion of "reputation".
- 5.4.4. Respondent argues it did not "equate" child cancer with breast cancer. Respondent only used breast cancer to illustrate the point that, just because terms were "related terms" in Google Trends, that did not mean that they were interchangeable with the original search term.
- 5.4.5. Respondent argues that Complainant confuses the concept of being "associated" with the term "child cancer" with the entirely different concept of being known by that term and that like other organisations in the field, Complainant is associated with the term "child cancer" because it deals extensively with child cancer.
- 5.4.6. Respondent submits that without prejudice to his contention that the circumstances of registration are excluded under 5.4 of the Policy, Respondent did not visit the website at the Domain Name before registration. He asserts that the lists of pending release domains are published only a few days before release, not leaving much time to research. Further, he submits that even if Respondent had been able to visit such a site, he would simply have assumed that Complainant had for whatever reason decided to abandon a generic domain name.
- 5.4.7. Respondent goes on to indicate he strongly resents Complainant's pejorative and unsupported references to him as a "serial domain squatter". Respondent then seeks to contradict Complainant's continued reliance on a1furniture.co.uk; studylink.co.nz and ariki.co.nz and concludes with the submission that in view of Complainant's persistence in presenting deliberately misleading evidence, Respondent requests a finding under B15.4 of the Policy that Complainant has brought the Complaint in bad faith.

6. Discussion and findings

- 6.1. The dispute is governed by the Policy issued by the office of the Domain Name Commissioner on behalf of DNC. The relevant portions of the Policy for present purposes are as follows:

“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
- 4.1.1 The Domain Name, in the hands of 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. In order to support a complaint of this kind Complainant must satisfy three elements:

6.2.1. Rights in respect of a name or mark (para 4.1.1);

6.2.2. Identity or similarity between that name or mark and the Domain Name (para 4.1.1); and

6.2.3. Unfair registration in the hands of Respondent (para 4.1.2).

7. Decision

7.1. Rights in respect of a name or mark (Para 4.1.1 of Policy)

- 7.1.1. In terms of assessing whether Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name the Expert first has to consider the wording of the Policy.
- 7.1.2. The expression "Rights" is referred to in the definition of "Unfair Registration" in paragraph 3 of the Policy and is directed to a Domain Name which "took unfair advantage of or was unfairly detrimental to Complainant's Rights" in some way. The primary question is whether some disadvantage or detriment occurs vis-a-vis Complainant's Rights.
- 7.1.3. Pursuant to paragraph 3 of the Policy Complainant must establish the requisite Rights in order to establish that some form of disadvantage or detriment is likely to occur through the existence or use of the Domain Names by Respondent.
- 7.1.4. Complainant asserts that it is a registered charity and has provided support and care for children with cancer and their families since 1978 under the name Child Cancer Foundation Inc. It goes on to say that since that time it has used as a name and trade mark and become known as CHILD CANCER. It asserts that the words "CHILD CANCER" (in the discussion below the terms CHILD CANCER and Child Cancer are used interchangeably, unless otherwise indicated) are not generic in New Zealand and that over the past 35 years it has developed an extensive and exclusive reputation in the name CHILD CANCER and that as a result of such use the words CHILD CANCER have become synonymous with the Child Cancer Foundation.
- 7.1.5. Complainant is the owner of five registered trade marks that contain the words CHILD CANCER including various CHILD CANCER FOUNDATION logos in which, as Complainant points out, the words CHILD CANCER are emphasised.
- 7.1.6. Complainant relies on its use of the words CHILD CANCER as the past and present domain name for the Foundation, in conjunction with use of the above logos to establish goodwill and/or a reputation in the words CHILD CANCER.
- 7.1.7. Respondent disputes this and argues that Complainant has produced no evidence in support of its claimed use of "Child Cancer Foundation" since 1978. Respondent argues that there is no evidence at all of the extent of such use, let alone any evidence that users have come to associate the term "child cancer" with Complainant, independent of Complainant's name "Child Cancer Foundation".

- 7.1.8. Further, Respondent contends that Complainant's registered trade marks do not generate rights in the term "child cancer" per se particularly as with a number of the marks they are dominated not by the common descriptive / generic term "child cancer" but by the only distinctive term: "foundation" or comprise slogans which include purely descriptive references to "child cancer".
- 7.1.9. In its reply Complainant relied on excerpts from the book "No Journey Made Alone - 35 years of the Child Cancer Foundation" which provides a history of the foundation and illustrates the influence of the Child Cancer Foundation on paediatric oncology in New Zealand. This includes a discussion of the Child Cancer Foundation's relationship with the Cancer Society (pages 6 and 8) and the establishment of the Child Cancer Foundation. While the reference in the book is to the Foundation there is also reference to organisations such as the National Child Cancer Network, established in 2000 by the Ministry of Health and where reference is made to "a national framework for child cancer services" (page 13). This amounts to descriptive use of "child cancer" but on the same page is reference to "childhood and adolescent cancer care" comprising an accurate description of the particular services but without use of the term "child cancer" as such.
- 7.1.10. This indicates that the term "child cancer" is apt for use to describe a "child with cancer" but that other terminology is also available. The Child Cancer Foundation is clearly well established and well known in New Zealand, as the organisation responsible for catering for the interests of children who have cancer and require care. In this regard the term Child Cancer is descriptive, even highly descriptive. The important question however is whether, by virtue of the Child Cancer Foundation's activities for over 35 years that CHILD CANCER has become sufficiently associated and identified with the Foundation. The next question is whether the Foundation has some protectable rights by virtue of its trade mark registrations which incorporate the words CHILD CANCER.
- 7.1.11. The question which then arises is whether the name, mark or term CHILD CANCER is wholly descriptive of Complainant's business. As noted above in paragraph 6.1 the definition of "Rights" makes it clear that a Complainant cannot rely on rights in a name or term which is *wholly descriptive* of Complainant's business (emphasis added).
- 7.1.12. The words child and cancer are descriptive. The question however is whether together they create a term which is capable of alluding to wider qualities and which, through extensive use, might attract a secondary meaning. Put another way; is CHILD CANCER as at 2009 and now wholly descriptive of Complainant's business?
- 7.1.13. While the matter is not without difficulty, on balance the Panel is of the view that Complainant has done enough to show that the term

CHILD CANCER is not wholly descriptive. That is, based principally on the following factors:

- 7.1.13.1. Complainant's extensive and ongoing use of the term CHILD CANCER in New Zealand;
 - 7.1.13.2. the existence of Complainant's registered trade marks which contain the words CHILD CANCER, with an emphasis on the words CHILD CANCER;
 - 7.1.13.3. that no other organisation appears to represent the interests of children with cancer in New Zealand and style itself along these lines;
 - 7.1.13.4. that even if not synonymous with each other there is clearly a close and ongoing association between the Child Cancer Foundation and the term Child Cancer; and
 - 7.1.13.5. the lack of merit in Respondent's argument that Complainant's marks are dominated not by the common descriptive / generic term "child cancer" but by the only distinctive term: "foundation".
- 7.1.14. While Respondent asserts that CHILD CANCER is both descriptive and generic in New Zealand he does not provide evidence that entities, other than Complainant, have used the name or trade mark in a significant way in the health sector. Nor does Respondent elaborate on why an entity might not be able to acquire protectable rights in a term over time, notwithstanding its descriptive meaning.
- 7.1.15. On this basis the Expert is satisfied that the Domain Name is not "wholly descriptive" of the goods or services of Complainant and accepts that Complainant has established sufficient Rights in respect of a name or mark which is identical or similar to the Domain Name.

8. Identity or similarity (Para 4.1.1 of Policy)

- 8.1. Complainant's name and trade mark, in so far as it/they contain as an essential part the words CHILD CANCER are substantially similar to the Domain Name. The Domain Name contains the same words. On the face of it, this suggests that some form of association or connection exists between Complainant and Respondent. This ground is thus established.

9. Unfair registration (Para 4.1.2 of Policy)

- 9.1. As noted in paragraph 6.1 above, a number of factors may be taken into account as evidence that the Domain Name is an Unfair Registration. This requires the Expert to be satisfied that Respondent has registered or otherwise acquired the Domain Name primarily for certain purposes. These are dealt with below.
- 9.2. The Domain Name was registered in October 2009. That is more than three years ago. Pursuant to Rule 5.4 of the Policy the Expert is not entitled to take into account any evidence of acts or omissions amounting to unfair

registration or use which occurred more than three years before the date of the Complaint. On this basis the Expert assumes that the registration of the Domain Name was made in good faith.

- 9.3. However, the essential question under Rule 4.1.2 of the Policy is whether the Domain Name, in the hands of Respondent (i.e. as judged in the present setting) is an Unfair Registration. Complainant has put Respondent on notice and outlined the basis upon which it believes Respondent's current actions are unfair and detrimental.

Using the Domain Name in a way which is likely to confuse, mislead or deceive

- 9.4. Complainant's primary complaint is that Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses in some way. Complainant submits that Respondent is using the Domain Name in a way that is likely to lead people into believing that the Domain Name is registered to, operated or authorised by Complainant.
- 9.5. Complainant firstly asserts that Respondent is improperly benefitting from the goodwill of Complainant's marks by revenue gained by click-through advertising. That is, on the basis that confusion arises when Internet users attempting to contact or gain information on Complainant, with an imperfect recollection of its trade mark, but with the emphasis of the words CHILD CANCER in Complainant's marks.
- 9.6. The Expert is satisfied that, on balance, given the goodwill and/or reputation Complainant has in the CHILD CANCER name and mark and the way in which Respondent has labelled his page "The Leading Child Cancer Site on the Net" which is displayed in conjunction with a ".nz" domain registration (previously owned by Complainant) wrongly suggests Respondent's website is somehow approved by, or associated or connected with Complainant.
- 9.7. It is also apparent that by including on that page a number of hypertext links to other forms of cancer or like treatment, for example, "Alternative Cancer Treatments"; "Brain Cancer" and "Breast Cancer Information" that Respondent has set up the site which contains a page or conduit with information on various forms of cancer.
- 9.8. The fact that Respondent has used the Domain Name to attract and redirect enquiries suggests that there is some benefit or value in doing so. The parties of course differ markedly as to the motivation for wishing to do so. Complainant argues it is because Child Cancer has a particular kudos and reputation. Respondent argues it is because it is a generic term. However, having found that Complainant has rights in the name and mark CHILD CANCER it is likely that in such a scenario consumers are likely to assume, wrongly, that there is some connection between the parties or otherwise that some authorisation or licence has been given to use the CHILD CANCER name and/or mark. Given its long-standing efforts to address childhood

cancer care and overall standing in the community the Expert infers that that would be an affiliation worth having.

9.9. As noted in paragraph 5.2.7 above Respondent acknowledges that he has been in the business of buying, selling and monetising generic domain names, and that he acquired the Domain Name because it reflected a common generic term. Respondent indicates, at paragraph 5.2.8 above, that given the passage of time since registration he cannot recall whether he was aware of Complainant or not; but he goes on to contend that that in any event he is using the Domain Name fairly and consistently with its generic or descriptive character

9.10. The Expert is required, pursuant to paragraph 6 of the Policy, to take into account a range of factors which may indicate that the Domain Name is not in fact an Unfair Registration. The relevant parts of the provision (with parts underlined by the Expert) reads as follows:

6. How the Respondent may demonstrate in its Response that the Domain Name is not an Unfair Registration

6.1. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in paragraphs 6.1.1 - 6.1.4:

6.1.1. Before being aware of the Complainant's cause for complaint (not necessarily the Complaint itself), the Respondent has:

(c) made legitimate non-commercial or fair use of the Domain Name; or

6.1.2. The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character; (emphasis added)

9.11. Taking this part of Policy into account and addressing Respondent's contentions as summarised in paragraph 10.6 above, it seems that paragraph 6.1.1.(c) of the Policy is of no material assistance to Respondent. Firstly, he has made overtly commercial use of the Domain Name. Secondly, for the reasons set out below the Expert is of the view that the use is not fair.

9.12. In terms of paragraph 6.1.2 of the Policy, the question is whether the Domain Name is generic or descriptive *and* Respondent is making fair use of it in a way which is *consistent with its generic or descriptive character*. For the reasons set out above in paragraph 7.1.13 the Expert considers that CHILD CANCER is not wholly descriptive and given the overtly commercial manner in which Respondent is using the Domain Name to achieve click through revenue Expert is not satisfied that Respondent is making fair use of the term CHILD CANCER in a manner "consistent with its generic or descriptive character".

9.13. Instead, it seems to be used, at least in part, in a manner designed to benefit from the reputation and/or goodwill of a term used extensively by Complainant over the years. In this regard, it is noted that Respondent does not use the terms Adolescent Cancer, Teenage Cancer or for that matter

Adult Cancer on its so-called "parking" page, even though it is just as likely, if not more likely, that adults would require information on "breast cancer" or "colon cancer". For these reasons the Expert infers that the real reason, or at least a reason, for registration and use of the Domain Name is because of the reputation and/or goodwill Complainant has established in the term CHILD CANCER/Child Cancer.

9.14. In addition to this, it is one thing for Respondent to say that he is in the business of monetising generic domain names and acquired the Domain Name "because it reflected a common generic term", while at the same time saying that "he cannot recall whether he was aware of Complainant or not". Given that the Domain Name was previously owned by Complainant and that it has been using the term CHILD CANCER/Child Cancer for many years it is reasonable to infer that Respondent knew or ought to have known of Complainant and its claimed rights in CHILD CANCER/Child Cancer. Further, absent evidence as to reasonable, or indeed any, enquiries at the time it is difficult to see how Respondent could safely say he acquired the Domain Name "because it reflected a common generic term".

10. Other Grounds

10.1. Finally, Complainant asserts that Respondent is improperly benefitting from the goodwill of Complainant's marks by cybersquatting for the purposes of sale. It also asserts that Respondent has illustrated a pattern of bad faith registration of other domain names.

10.2. While there might possibly be some merit in these allegations Respondent counters them and explains his position. Further, the Expert considers that the central issue in this dispute is whether Complainant has protectable Rights in the term Child Cancer or whether it is a wholly descriptive, or generic term; and the consequences that flow from this. Having found in Complainant's favour it is unnecessary to address these additional considerations.

10.3. As noted above, Respondent requests a finding under paragraph B15.4 of the Policy that Complainant has brought the Complaint in bad faith. Having succeeded in its complaint that request is declined.

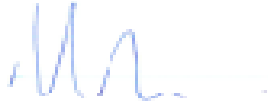
11. Decision

11.1. Complainant has thus established each part of paragraph 4.1 of the Policy and is entitled to the relief sought. In the result, the Expert orders that the Domain Name be transferred from Respondent to Complainant.

Place of decision Auckland, New Zealand

Date November 19, 2013

Expert Name Mr Clive Elliott QC

A handwritten signature in blue ink, appearing to be 'Clive Elliott', with a horizontal line extending to the right.

Signature