

.nz Dispute Resolution Service

DRS Reference: 908

Genesis Energy Limited v Chris Marshall

Key words – domain name confusingly similar to registered marks - unfair registration - taking unfair advantage of or unfairly detrimental to complainant's rights – likely to mislead or deceive – unfairly disrupting complainant's business.

1. Parties

Complainant: Genesis Energy Limited

The Genesis Energy Building
660 Great South Road
Greenlane
Auckland 1051
NEW ZEALAND

Represented by: Miss Grace Chan

Respondent: Chris Marshall

220 E Flamingo Road
Suite 321
Las Vegas, NV 89169
UNITED STATES

The Respondent is not represented.

2. Domain Name/s

www.genesisenergy.co.nz ("the Domain Name")

3. Procedural history

The Complaint was lodged on 14/10/13 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 17/10/13. The domain/s were locked on 14/10/13, 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 22/11/13 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).

Hon Sir Ian Barker QC, the undersigned, (“the Expert”) confirmed to the DNC on 25/11/13 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. The Complainant is Genesis Energy Limited previously known as Genesis Power Limited. It is a New Zealand-owned energy company in the business of electricity generation. It is a wholesaler and retailer of electricity, natural gas and LPG. It claims to be the biggest energy retailer by customer numbers in New Zealand.

4.2. The Complainant owns various registered trademarks in New Zealand for the words “Genesis Energy”, “Genesis Power” and “Genesis” as follows:

The registered trademarks for Genesis Energy have application dates of 2 June 2000 and 26 July 2006. The registered trademark for “Genesis”, “Genesis Power” have application dates of 11 December 1998.

4.3. The Complainant also has various domain name registrations including, in particular, genesisenergy.co.nz by which is its principal website for information about its products and pricing is accessed.

4.4. A website accessed by the disputed domain name includes website links that direct Internet users to competitors of the Complainant and other unrelated companies. This website suggests that these are links to Genesis Energy by using descriptions commonly used by the Complainant such as “Brownie Points” which is a residential customer loyalty programme.

- 4.5. The disputed domain name was registered on 11 December 1998, the same date as the Application date for one of the Complainant's trademarks.

5. Parties' contentions

Complainant

- 5.1. The Respondent has no rights from the Complainant to use the disputed domain name. He has no prior relationship with the Complainant nor has the Complainant ever given him any approval to reflect its trade marks in any domain name.
- 5.2. The disputed domain name incorporates the Complainant's trademark preceded by "www", the standard abbreviation for "world wide web". This is an attempt to pass off and to mislead potential customers. The top of the Respondent's web browser reads "The Leading Genesis Energy site on the net".
- 5.3. The links to the Complainant's competitors and to other persons causes unfair disruption to the Complainant's business and confusion to persons accessing the Internet for information about the Complainant.

Respondent

- 5.4. The Respondent made no submissions and is not represented.

6. Discussion and findings

- 6.1. The Complainant is required to satisfy the Expert on the balance of probabilities that it has met the requirements of paragraph 4 of the Policy. Under paragraph 4.1.1 the Complainant must show that it has rights in respect of a name or mark which is identical or similar to the domain name and under paragraph 4.1.2 it must show that the domain name in the hands of the Respondent is an unfair registration.

Rights

- 6.2. The Complainant has a registered trade mark for Genesis Energy, Genesis and Genesis Power. The Complainant has exclusive rights in New Zealand to use those registered trade-marks and to authorise others to use them.
- 6.3. The Expert finds that the disputed domain name is confusingly similar to the Complainant's registered trade mark in which it has rights. The addition of "www" makes no difference to those conclusions. Those letters are sometimes found when a reference to a domain name is given. In fact the addition of www only exacerbates the Respondent's cybersquatting.

Unfair Registration

- 6.4. Unfair Registration is defined in paragraph 3 of the Policy as follows:

"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."

- 6.5. 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 of the Policy. One of those factors in paragraph 5.1.2 states:

"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."

- 6.6. The Expert considers this is a very clear case of unfair registration. Despite the fact that the disputed domain name was first registered

in 1998, its continued use takes unfair advantage of, and is likely to be detrimental to the Complainant's rights.

6.7. If it is not transferred, the disputed domain name is likely to continue to be used in a manner which takes up unfair advantage of and is unfairly detrimental to the Complainant's rights.

7. Decision

7.1. For the foregoing reasons, the Expert determines that the name www.genesisenergy.co.nz is to be transferred to the Complainant.

Place of decision: Auckland

Date 5 December 2013

Expert Name Hon Sir Ian Barker QC

Signature