

.nz Dispute Resolution Service

DRS Reference: 909

Genesis Energy Limited v E-Promote

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: E-Promote

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

The Respondent is not represented.

2. Domain Name/s

genisisenergy.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 trademarks for “Genesis”, “Genesis Power” have application dates of 11 December 1998.

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

4.4. A website accessed by the disputed domain name includes links that direct Internet users to competitors of the Complainant and to 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 to use the disputed domain name. It has no prior relationship with the Complainant nor has it ever given any approval to the Respondent to reflect its trade marks in any domain name.
- 5.2. The difference in spelling between the disputed domain name and the Complainant's trademark is deliberate and 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 cause unfair disruption to the Complainant's business and confusion to the persons accessing the Internet for information about the Complainant. Such persons may have typed in the incorrect spelling of the Complainant's name and ended up on the Respondent's website.

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 has to show that it has rights in respect of a name or mark which is identical or similar to the disputed domain name and under paragraph 4.1.2 the

Complainant must show that the disputed domain name in the hands of the Respondent is an unfair registration.

Rights

- 6.2. The Complainant has clearly shown it has a registered trade mark for “Genesis Energy”. Accordingly the Complainant has exclusive rights in New Zealand to use those registered trademarks 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 although there is a difference of one letter. This is a classic case of what is called “typosquatting” which takes advantage of a person accessing the Internet inadvertently typing in a wrong letter.

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 take unfair advantage and is likely to be detrimental to the Complainant's rights. It is not without significance that the disputed domain name was registered on the same day as the application date for one of the Complainant's trademarks.
- 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. Additional comment

- 7.1. Before parting with this decision the Expert notes that the Respondent is merely shown as "E-promote" with an address in Las Vegas in the United States.
- 7.2. Various experts under the New Zealand domain name dispute jurisprudence have been at pains to point out that registrants of domain names should be either an identifiable individual person or else a recognised corporation incorporated under some relevant law. It is not good enough to register as the owner of a domain name an expression like "E-promote". Despite various statements to this effect made over the years since the .nz dispute resolution system has been in operation some Registrars do not heed the comments of all the Experts who have addressed this point.
- 7.3. It could be potentially unfair for a trademark owner to have nobody against whom it can take legal action other than by a complaint under the Domain Name Dispute Resolution Service. That may not always be an adequate remedy for the harm suffered by a Complainant at the hands of a cybersquatter.

8. Decision

For the foregoing reasons, the Expert determines that the name <genisisenergy.co.nz> be transferred to the Complainant.

Place of decision	Auckland
Date	5 December 2013
Expert Name	Hon Sir Ian Barker QC
Signature