

## **.nz Dispute Resolution Service**

**DRS Reference: 926**

### **Wesfarmers Limited v Marco Dente**

#### **Key words**

##### *Domain name*

Wesfarmerscorp.co.nz ('the Domain Name')

##### *Identical or similar trade mark or name*

Registered mark – unregistered mark – well-known mark – identical - similar

##### *Unfair registration*

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

#### **1. Parties**

Complainant:

Wesfarmers Limited  
Wesfarmers House  
40 The Esplanade  
Perth  
Western Australia 6000  
Australia  
Represented by: Mr Richard Watts

Respondent:

Mr Marco Dente  
Via Roma, 19  
Vigonza  
Italy 35010

#### **2. Domain Name/s**

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

#### **3. Procedural history**

- 3.1 The Complaint was lodged on 15/11/13 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 20/11/13. The domain was locked on 15/11/13,

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 17/12/13 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4 Ms Sheana Wheeldon, the undersigned (“the Expert”) confirmed to the DNC on 23/12/13 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 Wesfarmers Limited. According to the Complaint it is one of Australasia’s largest listed companies with more than 200,000 employees. In New Zealand it owns numerous businesses including Bunnings Warehouse, Kmart, Lumley New Zealand, Crombie Lockwood and Wesfarmers Industrial and Safety NZ.
- 4.2 According to the Complaint the Complainant has been trading under the name Wesfarmers in Australia since 1914, and in New Zealand since 2001.
- 4.3 The Complainant is the owner of a number of New Zealand trade mark registrations covering the mark WESFARMERS in numerous classes, under registration nos. 642738 to 642749 and nos. 642751 to 642762. The goods and services covered by these registrations are wide ranging and include chemicals, fuels, animal medicines, printed matter, food and drink, retail and wholesale services, insurance and financial services, communications services and transportation and storage services.
- 4.4 In addition to its registered trade mark rights in WESFARMERS the Complainant asserts that through its use of the WESFARMERS brand in Australia and New Zealand, it has substantial goodwill and reputation in the name WESFARMERS in the New Zealand market place and hence has common law rights in that name and rights enforceable under sections 9, 11, 13 and 16 of the Fair Trading Act 1986.
- 4.5 The Complainant has provided no evidence of the common law rights it asserts in the name WESFARMERS in New Zealand (or

elsewhere). No details or examples have been provided of use of the WESFARMERS brand either in Australia or in New Zealand, to support the assertion of substantial goodwill and reputation in this name in New Zealand. The fact the Complainant is a substantial company which owns numerous businesses does not in itself support the assertion that WESFARMERS is a well-known brand in New Zealand.

### ***The Respondent's activities***

- 4.6 The Domain Name was registered on 19 November 2012. The Respondent appears to be an individual residing in Italy and the Complainant has advised that it has no other information about the Respondent.
- 4.7 From the evidence filed by the Complainant it is clear that the Domain Name is being used by one or more individuals in what appears to be a scam, directed at duping Italian businesses into sending money to a certain bank account, purportedly in payment for airfares to Qatar to attend an apparently fictitious suppliers meeting.
- 4.8 The nature of the scam, as described by the Complainant and evidenced by copies of email exchanges with numerous Italian businesses filed by the Complainant in support of the Complaint, is as follows:
- a. Emails are sent to the Italian businesses by individuals whose names are said to be 'Mark Anderson Franceschi' and 'Frank Sullivan' and who present themselves as being employed by or associated with 'Wesfarmers'. The emails request the businesses to provide quotations for goods, assigning a reference number for each business, such as WES/S/ITA/4404/2013.
  - b. The businesses are offered a place at the 'Annual Wesfarmers Suppliers Meeting' in Qatar. No such meeting exists.
  - c. The businesses are then offered special fares on flights to Qatar, organised through a Mattheus Kerry, of 'Amtrack Incentive'. They are requested to wire the money for the fares to Amtrack Incentive's New York bank account.
  - d. The person calling himself Mark Anderson Franceschi is using the email addresses [m.andersonfranceschi@gmail.com](mailto:m.andersonfranceschi@gmail.com) and [purchase@wesfarmerscorp.co.nz](mailto:purchase@wesfarmerscorp.co.nz). He also claims to have a New Zealand address.
  - e. The individual calling himself Frank Sullivan claims to be a Wesfarmers Purchase Manager and is using the email address

[sullivan.f@wesfarmerscorp.co.nz](mailto:sullivan.f@wesfarmerscorp.co.nz) along with an Auckland address and phone number.

- f. Neither individual is employed by the Complainant, and the Complainant states that both appear to be fictional.
- g. A further email address, for a 'Lysa Borrows' ([lysa.b@wesfarmerscorp.co.nz](mailto:lysa.b@wesfarmerscorp.co.nz)) has also been linked to the operation.
- h. A typical email exchange between Mark Anderson Franceschi and an Italian business runs as follows:
  - i. Mr Anderson Franceschi writes in Italian to the business, claiming to be in search of a new supplier for the largest retail group in Australia and New Zealand, which he describes as 'Wesfarmers Corp'. He asks for a catalogue, price list and other documents. He says that he speaks Italian because he is Italian on his mother's side.
  - ii. The business replies asking for more details of Wesfarmers' interest in its products.
  - iii. Mr Anderson Franceschi then sends, in (dubious) English, a further email describing specific products in which he claims Wesfarmers is interested, asking for prices for the purposes of a valuation and comparison with competitors, and also stating 'Wesfarmers will arrange a meeting to define the purchasing Agreement and trial order'.
  - iv. In subsequent correspondence Mr Anderson Franceschi invites the business to attend the aforementioned 'Annual Wesfarmers Suppliers Meeting' to be held in Doha, Qatar. Wesfarmers is to be responsible for the cost of hotel accommodation but the business is to fund flights which it is said will be provided at special rates by Mr Mattheus Kerry, purportedly of 'Amtrack Incentive', a New York travel agent.
  - v. According to at least one recipient of this correspondence, 'Mr Kerry' is 'very pushy' in his request for money. At least one Italian business which became involved in this correspondence did transfer funds to 'Mr Kerry' but then received an email from Mr Anderson Franceschi telling him the meeting had been cancelled. At the time that business sent its account of events to Wesfarmers (in October 2013), after its suspicions had been aroused, it had sought a refund of the money sent for the tickets but this had not been received.

- 4.9 The Complainant, with justification, asserts that this is clearly a scam intended to defraud businesses out of money, by using emails from the Domain Name to deliberately mislead people into believing they are dealing with Wesfarmers. The Complainant has referred the matter to the Italian Police for further investigation.
- 4.10 As no Response was filed to the Complaint, there is nothing to suggest the Complainant's account of the facts and assertions are incorrect.

## **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 both registered trade mark rights and common law rights in the mark WESFARMERS in New Zealand.
- 5.3 The Complainant submits that the Domain Name, in the hands of the Respondent, amounts to an unfair registration because:
- a. the Respondent has registered the Domain Name for the purpose of committing fraud, by trading off the Complainant's global reputation;
  - b. the use of the Domain Name by the Respondent has been shown to be in a way that has, or is likely to, confuse, deceive or mislead people into thinking there is a connection with the Complainant; and
  - c. there is no conceivable legitimate use of the Domain Name by the Respondent.

### ***Domain Name registered for the purpose of committing fraud***

- 5.4 As mentioned, the Complainant has filed evidence in the form of copy emails and enquiries sent to it by Italian businesses. This evidence demonstrates that several Italian businesses have engaged with the individuals purporting to be Mark Anderson Franceschi and Frank Sullivan, before at some point becoming suspicious or realising they were becoming involved in a scam, and contacting Wesfarmers either to enquire as to the credentials of Messrs Anderson Franceschi and Sullivan, or to report the scam. The Complainant has said that the 11 examples filed with the Complaint are only some of those received by Wesfarmers.

- 5.5 The Complainant says that it is hugely detrimental to its business and reputation that the Domain Name continues to be registered by the Respondent as this allows Messrs Anderson Franceschi and Sullivan to continue to use email addresses containing wesfarmerscorp.co.nz. It also says its business is damaged by the continued inactive status of the Domain Name which may lead potential customers to assume the Complainant does not trade in New Zealand.
- 5.6 Further, the Complainant, via its subsidiaries, sources goods from all over the world, including from Europe. It says that its and its subsidiaries' reputation as reliable and honest businesses has been damaged by the Respondent and/or his associates passing themselves off as being associated with the Complainant, as seen from the emails provided.

*Any use has, or is likely to, confuse, mislead or deceive*

- 5.7 The Complainant states that the Respondent and/or his associates are using the Domain Name to justify their claim that they are employees of or associated with the Complainant, for commercial gain. It notes that by using a domain name that appears legitimate, the Respondent is creating confusing with the Complainant's trade marks as to the source or endorsement of the Respondent's communications with businesses.
- 5.8 The Complainant says this amounts to a misrepresentation that the Respondent is somehow associated with the WESFARMERS brand, which misrepresentation is likely to cause damage to the Complainant's business, and to the WESFARMERS brands.

*No conceivable legitimate use*

- 5.9 The Complainant says that any future activation and use of the Domain Name would be for the sole purpose of trying to take advantage of the Complainant's trade marks and goodwill. It adds that any use will infringe the Complainant's registered trade marks, amount to passing-off and breach the Fair Trading Act.
- 5.10 With regard to trade mark infringement, the Complainant says that the continued registration by the Respondent and its use of email addresses with a wesfarmerscorp.co.nz suffix infringes the Complainant's rights in relation to its registered trade marks, as use of the Domain Name would be use of a similar sign in relation to services identical to those for which the mark is registered, and confusion will be inevitable.
- 5.11 The Complainant also asserts that use of the Domain Name would breach the Fair Trading Act and amount to passing-off, because:

- a. Consumers expecting to find the Complainant's website at the Domain Name will be misled or deceived;
- b. registration of the Domain Name that includes the well-known trade mark of the Complainant is liable to mislead or deceive the public; and
- c. damage to the Complainant would inevitably follow.

***Respondent***

5.12 The Respondent has filed no response.

**6. Discussion and findings**

6.1 Given the absence of a Response, the Expert is able to consider only the information and submissions provided by the Complainant, which are undisputed, and to make appropriate inferences from the available facts.

***Relevant Provisions of the Policy***

6.2 The Complainant is required to prove that it has met the requirements in paragraph 4 of the Policy namely that:

- 6.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- 6.1.2 The Domain Name, in the hands of the Respondent, is an Unfair Registration.

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

6.4 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.

6.5 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:

- 6.1.1 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

6.1.2 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;

6.1.3 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;

6.1.4 The Complainant can demonstrate that the Respondent has knowingly given false contact details to a Registrar and/or to the DNC.

6.6 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***

6.7 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***

6.8 The Expert finds that the Complainant clearly has rights in respect of the trade mark WESFARMERS in New Zealand by virtue of its registered trade marks. The Expert notes that these date from 2002, i.e. long before the date on which the Domain Name was registered.

6.9 As mentioned earlier, no evidence has been filed to support the assertion that the Complainant has common law rights in New Zealand in respect of the trade mark WESFARMERS. Therefore the Expert does not find that the Complainant has unregistered trade mark rights.

6.10 The Domain Name is wesfarmerscorp.co.nz while the Complainant's trade mark is WESFARMERS. The Complainant submits that the Domain Name is similar to the registered WESFARMERS trade marks because consumers are likely to focus on the 'Wesfarmers' portion of the Domain Name and place little weight on the word 'corp' because this simply means 'corporation'.



6.11 The Expert accepts that submission and finds that the Domain Name is similar to the Complainant's registered trade mark WESFARMERS.

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

6.12 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.

6.13 The definition of Unfair Registration includes 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.

6.14 With reference to the first arm of the definition, the Complainant has asserted that the Respondent has registered the Domain Name for the purpose of committing fraud, by trading off the Complainant's global reputation.

6.15 The evidence shows that the scam involving email addresses connected to the Domain Name has been operating since at least July 2013. The Domain Name was registered on 19 November 2012. There is nothing to suggest the Domain Name has been used for any purpose other than this scam.

6.16 The entire basis for the scam is the fact recipients of correspondence from the Respondent and/or his associates are intended to believe they are dealing with the Complainant. It therefore seems clear that the Domain Name was registered for the purpose of facilitating the scam described above.

6.17 It follows that at the time of registration of the Domain Name the registration was directed at taking unfair advantage of the Complainant's rights in its mark WESFARMERS, and that the intended use of the Domain Name would be unfairly highly detrimental to the Complainant's rights.

6.18 The Expert therefore finds that the Domain Name was registered in a manner which took unfair advantage of and was unfairly detrimental to the Complainant's rights.

6.19 With reference to the second arm of the definition, the Complainant has also asserted that the use of the Domain Name has, or is likely to, confuse, mislead or deceive.

- 6.20 The Expert notes that:
- a. With reference to paragraph 5.1.1(c) of the Policy, there is strong evidence that the scam in which the Domain Name is being used has unfairly disrupted, and presumably is continuing to unfairly disrupt, the business of the Complainant. Whether or not this was the Respondent's purpose in registering and using the Domain Name, that has been the result.
  - b. With reference to paragraph 5.1.2 of the Policy, there is strong evidence that the Respondent and/or his associates are 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. This likelihood is inherent in the Domain Name itself, wesfarmerscorp.co.nz, which strongly suggests that it denotes an official Wesfarmers website, and is exacerbated by the way in which the Domain Name is being used. Indeed, the emails sent from addresses associated with the Domain Name contain false statements which actively create these beliefs.
- 6.21 The whole purpose of the scam is to deceive business people into believing they are dealing with the Complainant, so as to create a sufficient level of confidence to dupe them into transferring funds to pay for travel to a fictitious suppliers' conference. These individuals and businesses are being confused, misled or deceived into believing the Domain Name is operated by the Complainant.
- 6.22 Whether or not the recipients of these emails are already aware of the Complainant, or research the Complainant's credentials after being approached, it is the Complainant's rights in its trade mark WESFARMERS that are being taken advantage of and damaged.
- 6.23 Accordingly, the Expert has no difficulty in finding that the Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights, and hence that it is an Unfair Registration.
- 6.24 As mentioned earlier, the Respondent has filed no Response, so has not disputed the Complainant's assertions.
- 6.25 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.
- 6.26 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**

- 7.1 In view of the findings made above the Expert directs that the Domain Name wesfarmerscorp.co.nz be transferred to the Complainant.

**Place of decision**

**Date** 20 January 2014

**Expert Name: Sheana Wheeldon**

**Signature:**

A handwritten signature in blue ink, appearing to read 'Sheana Wheeldon', with a long horizontal flourish extending to the right.