

.nz Dispute Resolution Service

DRS Reference: 943

Coöperatieve Centrale Raiffeisen-Boerenleenbank B.A v S Hunter

Key words

Domain name

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

Identical or similar trade mark or name

Registered mark – unregistered mark – identical - similar

Unfair registration

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

1. Parties

Complainant:

Coöperatieve Centrale Raiffeisen-Boerenleenbank B.A
PO Box 38396
Wellington Mail Centre
Lower Hutt 5045
Wellington
New Zealand
Represented by: Mr John McLean

Respondent:

S Hunter
P.O Box 1282
Gisborne 4040
New Zealand

2. Domain Name/s

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

3. Procedural history

- 3.1 The Complaint was lodged on 04/02/14 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 10/02/14. The domain was locked on 04/02/14, 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 18/03/14 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 21/03/14 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 Coöperatieve Centrale Raiffeisen-Boerenleenbank B.A. It is a company incorporated in The Netherlands and commonly known as Rabobank. According to the Complaint the term ‘RABO’ is derived from combining the first two letters of the last two words of the Complainant’s name i.e. Raiffeisen-Boerenleenbank.
- 4.2 The Complainant is the owner of New Zealand trade mark registration no. 761524 for the mark RABO. The registration is in classes 9, 16, 35, 36 and 38 and covers goods and services associated with a banking or finance business including computers and software, printed material, accounting and business services, banking and financial services, and telecommunication services in the fields of business and finance.
- 4.3 The Complainant also asserts unregistered trade mark rights, having provided some facts concerning use of the trade mark RABO which could support such a claim.
- 4.4 Specifically the Complaint states that there are two New Zealand incorporated companies that are wholly owned subsidiaries of the Complainant and whose names include the word ‘RABO’. These are:

- a. Rabobank New Zealand Limited, whose business includes the provision of equipment finance through a division known as 'Rabo Equipment Finance'.
 - b. Rabo Capital Securities Limited, which is an issuer of securities listed on the NZX.
- 4.5 According to the Complaint, these company names demonstrate that RABO is an expression that is significant for, and extensively used by, the Complainant. The Complaint also states that 'RABO' is associated worldwide with the Complainant and its provision of financial services.
- 4.6 No evidence or further details of the Complainant's activities or reputation in New Zealand have been provided.

The Respondent's activities

- 4.7 The Domain Name was registered on 9 January 2007. The only information available as to the Respondent's identity is the name listed as registrant which is 'S Hunter' whose stated address is a PO box number in Gisborne.
- 4.8 The timing of the Domain Name registration was five days after the filing date of the Complainant's trade mark registration no. 761524 RABO. The Complainant believes that the Respondent, having seen that trade mark filing, then 'camped on' the Domain Name and made it available to other businesses, who have endeavoured to attract customers through the Domain Name.
- 4.9 The Complaint states that the Domain Name currently re-directs to <http://www.btcrobot.com/bitcoin.php?cbid=bonusurl> ('BITCOINROBOT website'). It further says that the BITCOINROBOT website appears to provide an automated way of trading in BITCOINs, which are a 'cyber-currency'. The Complainant has no connection with BITCOIN or the BITCOINROBOT website.
- 4.10 According to the Complaint, BITCOIN is controversial and has received adverse publicity. The Complaint states that it has been variously regarded as a potential vehicle for money laundering, a risky investment, a currency whose only use as a medium of exchange is to purchase illegal goods or services and a means of crowd-funding, assassinations and other nefarious activities.
- 4.11 The Expert was invited to view the BITCOINROBOT website, and did so. The website does indeed concern the cyber-currency BITCOIN and appears to be directly associated with the BITCOIN enterprise.

- 4.12 It appears that the re-direction position has now changed. When the Expert, at the Complainant's invitation, attempted to view the website at rabo.co.nz, she was re-directed to the website of 3 News at 3news.co.nz.
- 4.13 As no response was filed to the Complaint, there is nothing to suggest the Complainant's account of the re-direction to the BITCOINROBOT website was incorrect. It appears the situation changed in the intervening period.
- 4.14 The Complaint notes that the expression 'RABO' has no connection with the content of the existing rabo.co.nz website. This is true in respect of both the earlier re-direction to the BITCOINROBOT website, and the current re-direction to the 3 News website. Based on this absence of connection, the Complainant asserts that the Respondent appears to be attempting, by using 'RABO', to trade on the Complainant's good name and perhaps suggest some association (which does not exist) with the Complainant, and that the Respondent is likely to be receiving income from such redirection.
- 4.15 The Complainant also asserts that the Respondent is the holder of the domains adultfriends.co.nz and webhostingreview.co.nz, which contain links to other websites, and says it is unclear what rights the Respondent may have to either of these domain names. Based on this the Complainant asserts that the Domain Name is part of a pattern of registrations where the Respondent is the Registrant of domain names which correspond to (arguably) well-known names or trade marks in which the Respondent has no apparent rights.

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 registered and unregistered trade mark rights in the mark RABO in New Zealand.
- 5.3 The main assertions of the Complainant in support of its Complaint are as follows:
- a. The Domain Name was 'registered in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights', under the first arm of the definition of 'Unfair Registration' in the Dispute Resolution Service Policy ('Policy').

- b. The Respondent's use of the Domain Name took unfair advantage of and was unfairly detrimental to the Complainant's Rights, under the second arm of the definition of 'Unfair Registration' in the Policy. In support of this assertion the Complainant says that:
 - i Visits to the Domain Name website do not give access to details about the Complainant, and hence the Complainant is losing internet traffic and potential business.
 - ii The fact the Domain Name redirects to the BITCOINROBOT website suggests a connection with the Complainant, and that this is unfairly detrimental to the Complainant's Rights.
 - iii The use of the Domain Name has also been detrimental to the Complainant's Rights because, the businesses that have used the Domain Name 'have been of dubious credibility'. No basis is given for this assertion.
- c. The Domain Name is a Blocking Registration (as set out in paragraph 5.1.1(b) of the Policy) in that it prevents the Complainant from using the Domain Name to express its rights in the trade mark RABO.
- d. The Respondent is using the Domain Name 'in a way which is likely to confuse, mislead or deceive' (as set out in paragraph 5.1.2 of the Policy). This assertion is based on the fact that the Complainant is a bank and the Domain Name (when the Complaint was prepared) was re-directing to the website of BITCOIN which is a financial service provider.
- e. The Domain Name is 'part of a pattern of registrations where the Respondent is the Registrant of domain names which correspond to (arguably) well-known names of trade marks in which the Respondent has no apparent rights' (as set out in paragraph 5.1.3 of the Policy). This assertion is based on the statement that the Respondent is the holder of the Domain's adultsfriends.co.nz and webhostingreview.co.nz. The Complaint states that neither of these websites provides any substantive content

Respondent

5.4 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:

4.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

4.1.2 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:

5.1.1 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

- 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 the 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.
- 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 has rights in respect of the trade mark RABO in New Zealand by virtue of its registered trade mark which dates from just before the date on which the Domain Name was registered.
- 6.9 The Complainant filed no evidence and did not provide any details to support its claim of unregistered trade mark rights in respect of the mark RABO in New Zealand. Therefore the Expert does not find that the Complainant has unregistered trade mark rights.
- 6.10 The Domain Name is rabo.co.nz while the Complainant's trade mark is RABO.
- 6.11 The Complainant's trade mark RABO is therefore identical to the Domain Name.

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 The Expert notes that under paragraph 5.4 of the Policy:
- 5.4 In making the decision, the Expert shall not take into account any evidence of acts or omissions amounting to unfair registration or use which occurred more than three (3) years before the date of the Complaint.
- 6.15 In the present case the date of the Complaint is 4 February 2014, and hence the Expert cannot take into account acts or omissions amounting to unfair registration or use which occurred prior to 4 February 2011.
- 6.16 The Domain Name was registered on 9 January 2007. To the extent that the Complainant asserts that the Respondent's *registration* of the Domain Name amounts to unfair registration, the Complainant cannot succeed. Even if, as the Complainant suggests, the Respondent registered the Domain Name after seeing the Complainant's newly filed trade mark application in respect of RABO, the circumstances of its registration of the Domain Name could not be taken into account as they occurred before 4 February 2011.
- 6.17 Turning now to the second arm of the definition of an Unfair Registration, the Complainant has also asserted that the Respondent's use of the Domain Name is unfair. It points to the fact the Domain Name re-directed to the BITCOINROBOT website, which relates to the provision of financial services. The Complainant is a bank and its trade mark RABO is registered for financial services, amongst other things.
- 6.18 It is clear that these activities took place after 4 February 2011.

- 6.19 This use of the Domain Name, which comprises the Complainant's registered trade mark RABO, is likely to damage the Complainant's interests through possible confusion on the part of the Complainant's customers or potential customers and dilution of the Complainant's rights in the trade mark RABO.
- 6.20 At the time of writing the Domain Name is re-directing to the website of 3 News. Neither the BITCOINROBOT website nor the website of 3 News has any connection with the trade mark RABO. Any members of the public who were aware of the Complainant and its RABO trade mark would expect the Domain Name to be controlled by and/or associated with the Complainant.
- 6.21 The Domain Name is rabo.co.nz. To members of the New Zealand public looking for the website of the Complainant in New Zealand, this is likely to be an obvious choice of Domain. However, anyone who attempts to reach the Complainant at rabo.co.nz will be redirected to an unrelated website, possibly financial in nature.
- 6.22 The existence of an active domain at rabo.co.nz in itself is likely to confuse, mislead or deceive people or businesses into believing the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant as set out in paragraph 5.1.2 of the Policy. Where the Domain Name is being redirected to a website that is financial in nature, such as the BITCOINROBOT website, people may be confused, misled or deceived into believing that the Complainant is associated with the BITCOIN Enterprise. If the Domain Name is redirecting to an obviously unrelated website, the initial confusion or deception may be short lived but nevertheless it will have taken place.
- 6.23 Therefore based on both the damage to the Complainant's interests caused by confusion or deception of customers or potential customers and trade mark dilution, the Expert finds that the Respondent has used and is using the Domain Name in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's rights.
- 6.24 For completeness the Expert notes that:
- a. in relation to the Complainant's assertion that the Domain Name is a blocking registration, the Expert cannot take into account circumstances at the time of registration, and further there is no evidence that the Domain Name is being used primarily as a blocking registration, which may have given a foundation for a finding that the Domain Name is an Unfair Registration on a basis analogous to that set out in paragraph 6.1.1(b) of the Policy;

b. there is an insufficient factual foundation in the Complaint, and no evidence, on which to make a finding on the Complainant's assertion that the Respondent is engaged in a pattern of registrations of domain names which correspond to well-known names or marks, as set out in paragraph 5.1.3 of the Policy.

6.25 As mentioned earlier, the Respondent has filed no Response, so has not disputed the Complainant's assertions.

6.26 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.

6.27 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 rabo.co.nz be transferred to the Complainant.

Place of decision: Auckland

Date: 7 April 2014

Expert Name: Sheana Wheeldon

Signature:

