

## **.nz Dispute Resolution Service**

**DRS Reference: 963**

### **Sienna Group (2008) Limited v Eco Move (NZ) Limited / Eco Move (Aust) Pty Limited**

Key words – registered mark – identical to domain name – discussions but no relationship between parties – dispute unsuitable for decision by Expert

#### **1. Parties**

Complainant:

Sienna Group (2008) Limited

5 William Laurie Place

Albany

Auckland 0632

New Zealand

Represented internally by: Mr Andrew Nichols

Respondent:

Eco Move (NZ) Limited/Eco Move (Aust.) Pty. Limited

Level 8, 57 Fort Street

Auckland 1140

New Zealand

Represented internally by: Mr Stefan Wobking

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

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

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

- 3.1 The Complaint was lodged on 29/04/14 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 02/05/14. The domain/s were locked on 30/04/14, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 The Respondent filed a Response to the Complaint on 22/05/14 and the DNC so informed the Complainant on 22/05/14. The DNC informed the parties on 20/06/14 that informal mediation had failed to achieve a resolution to the dispute.
- 3.3 The Complainants paid DNC the appropriate fee on 11/07/2014 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").
- 3.4 Sir Ian Barker, the undersigned ("the Expert") confirmed to DNC on 02/07/2014 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. The Expert was appointed by DNC to give a decision in this case, on 02/07/2014.

- 3.5 The Expert has changed the intituling of this complaint as filed in the following respects. First, the proper Complainant should be Sienna Group (2008) Limited (“the Complainant”) and not Andrew Nichols who filed the complaint. The reason for the change is that the Complainant is the owner of the trademark to which the disputed domain name is said to be identical or confusingly similar.
- 3.6 The documentation sent to the DNC did not explain what connection, if any, Mr Nichols had with the Complainant. However, the Expert having viewed the websites requested by the Complainant, has ascertained that Mr Nichols is concerned with the management of the Complainant.
- 3.7 However it should be noted that complaints should always be filed in the name of the owner or licensee of the trademark alleged to have been infringed by the disputed Domain Name and not in the name of any individual who is acting for the Complainant. Mr Nichols should have advised one whether he was a director of or a lawyer for the Complainant. In view of the information on the website, the Expert is prepared to allow the complaint to proceed.
- 3.8 The Respondent is cited as “Eco Move”, a registrant with an address recorded on the register at 19 Pascoe Avenue, Bentleigh, Victoria, Australia.
- 3.9 A Domain Name should always be registered always in the name of an individual or of some corporation as the policy requires. It is not enough for registration to be of a trade name which is merely a trading vehicle for an individual or individuals whose true identity is thus not disclosed. Various Experts have said in several previous decisions that registration should be effected only in favour of an individual or individuals or a properly constituted organisation. It is to be hoped that .nz Registrars will take heed and register accordingly.
- 3.10 In this instance, it appears that there is both an Australian company and a New Zealand company each bearing the “Eco Move” name. Both were registered after the disputed Domain Name was registered with a Registrar in Perth, Western Australia in June 2011. The Expert does not know whether the Domain Name is an asset of either the Australian company Eco Move (Aust) Pty Ltd (which presumably procured its registration since the Registrar is in Australia) or the New Zealand company, Eco Move (NZ) Limited.
- 3.11 However, in view of the decision to which the Expert has come, it does not really matter which company it is. For the purposes of this exercise, both companies will be entitled as Respondents on the understanding that one of them must have acquired the rights to the

registration of the disputed Domain Name from its anonymous registrant when one or other of them was incorporated. Despite there being two companies nominated as Respondents, the Expert will refer in this decision to “the Respondent”, singular, since the Expert is uncertain as to which is the correct Respondent. Again, some clarity should have been provided in the documentation filed. To be fair, the Respondent named itself as “Eco Move (New Zealand) Limited” but gave no information as to how this company had come to acquire the disputed Domain Name from the original registrant. No change to registration details has ever been made.

#### **4. Factual background**

- 4.1 The Complainant is the owner of a New Zealand Trademark, Registration No. 977256, for the expression Eco Move. The date of deemed registration is 14 May 2013. The disputed Domain Name was registered on 10 June 2011.
- 4.2 The predecessor of the Respondent commenced trading under the business name “Eco-Move” in Australia in 2010 and registered this as a business name in the State of Victoria on 15 June 2010. On 1 July 2010, according to the Federal Australian Business Register, the name “Eco-Move” was registered as a sole trader. The Respondent registered the Domain Name ecomove.com.au and commenced constructing a website as at 4 July 2010. This website became operative on 14 January 2011.
- 4.3 Eco Move (Aust) Pty Limited was registered under Australian company legislation as a proprietary company on 4 January 2012. This company obtained an Australian trademark, No. 1502631 for the expression “Eco Move” in a stylised box and deemed registration is from 7 July 2012. The Respondent has traded under that mark in Australia in the business of providing relocation goods and services using plastic stackable crates.
- 4.4 The New Zealand company, Eco Move (New Zealand) Limited was incorporated on 30 January 2013. It now operates a website accessed by the disputed Domain Name offering services for the hire of re-locatable boxes to assist persons moving house or office.
- 4.5 The Respondent did not register its Australian trademark in New Zealand nor did the Complainant register its New Zealand trademark in Australia.
- 4.6 The Complainant says that it granted a licence to Rentacrate Limited to provide relocation services to private individuals, households and businesses utilising its registered trademark ECOMOVE. It provides its services to customers in Auckland, Wellington and Christchurch and is

said to expand its operations throughout New Zealand. No copy of the Licence Agreement with Rentacrate was supplied by the Complainant.

- 4.7 The Respondent established a franchise operation in Auckland in early 2013 which was concluded on 19 March 2013 between Eco Move (New Zealand) Limited and TLR Systems Limited which grants the right to the franchisees to use the trademark ECOMOVE and the disputed Domain Name in New Zealand. The Respondent's website accessed through the disputed Domain Name has remained in operation since April 2013. Like the Complainant, the Respondent did not provide a copy of its Franchise or Licence Agreement.

## **5. Parties' contentions**

### **a. Complainant**

- 5.1 The disputed Domain Name is not generically descriptive and is identical or confusingly similar to the Complainant's Trademark. The Respondent registered the Domain Name some two years after the Complainant began using the Eco Move mark in New Zealand. The Complainant has developed a substantial reputation and goodwill in its trademark which is exclusively associated with the Complainant in the minds of New Zealand customers.
- 5.2 The Respondent deliberately registered the disputed Domain Name in a blatant attempt to divert trade to the Respondent and therefore there is an unfair registration as defined in the Policy. The Respondent registered the Domain Name primarily for the purposes of unfairly disrupting the business of the Complainant and is using the Domain Name in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's rights or in a manner which is likely to confuse, mislead or deceive people into believing that the disputed Domain Name is registered to, operated or authorised by or otherwise connected to the Complainant. Customers are being intentionally diverted away from the Complainant by the Respondent.

### **b. Respondent**

- 5.3 The Respondent registered the disputed Domain Name on 10 June 2011 in good faith and for the purposes of marketing its business in New Zealand using the Australian trademark. It seeks to develop an Australasian business. It has been supplying reusable boxes for moving goods for four years, such boxes being branded with the ECOMOVE trademark.
- 5.4 The Respondent commenced trading and using the mark ECOMOVE in Australia during early 2010. It registered the disputed Domain Name prior to becoming incorporated. It also devised a letterhead about this time showing a genuine use of the mark ECOMOVE in association with

its business. It also registered the related .au Domain Name and developed a website accessed by that Domain Name.

- 5.5 The Respondent in good faith considers it is the first user and owner of the mark “Eco Move” and is making fair use of the disputed Domain Name. It has an Australian trademark and had been involved in marketing its services in Australia since 2010. It developed a New Zealand website during 2013 which has been operative since April 2013. It has this legitimate and fair ownership of the disputed Domain Name for which it has established goodwill and a reputation in the marketplace.
- 5.6 The complaint is unfairly brought by the Complainant in that the Respondent believed it was the legitimate owner of the trademark in Australasia and was unaware of the “bad faith activities” of Mr Nichols in appropriating its trademark in New Zealand.
- 5.7 The complaint has established a pattern of misconduct with other competitors by attempting to frustrate and disrupt them as can be seen from a perusal of a decision of the WIPO Panellist in *On-line Digital Solutions Limited (t/a Moovabox) v Rentacrate (NZ) Limited*, (WIPO Decision D2013-0567). The Respondent, Rentacrate (NZ) Limited, which has featured in this narrative earlier, is a company associated with the Complainant which has a Licence Agreement with the Complainant in respect of its trademark. The WIPO Panellist in that case accepted that the main mark of Rentacrate was RENTACRATE which had traded under that name.
- 5.8 The Respondent also alleges the Complainant is currently restraining another competitor, Kiwi Box Hire, by having appropriated and registered that competitor’s proprietary trademark in a similar pattern of conduct to that shown by the Complainant towards the Respondent’s mark.
- 5.9 The Complainant has not provided any evidence of prior use and there is no evidence of actual confusion or that the disputed Domain Name is being used in a way that it confuses, misleads or deceives customers. A copy of the Licence Agreement was not provided. The Complainant’s New Zealand trademark application was made in bad faith and to harass the Respondent. Its registration is invalid and should be either voluntarily withdrawn by the Complainant or an application for removal of the registration will be filed by the Respondent in due course.
- 5.10 The Complainant has not provided any proof of use of the ECOMOVE mark prior to February 2014 and its statements to the contrary are misleading and incorrect. An attachment to the complaint shows one website place page on or about February 2014 referring to ECOMOVE which is the first use by the Complainant of that mark.

- 5.11 The Respondent has researched archived pages of the website of Rentacrate.co.nz through the archive site, Waybackmachine. This shows that changes were made only recently to the "About Us" page which made reference to "Eco Move". The Rentacrate website on 23 May 2010 makes no reference to Eco Move. An archived copy of the Rentacrate website on 16 December 2013 makes no reference to Eco Move. On the About Us part of the website, Mr Nichols states "established in NZ in 2009, Rentacrate was the first company to introduce reusable moving boxes to NZ". Consequently the Complainant is using the trademark RENTACRATE in relation to its business to date and not the ECOMOVE mark. Consequently, no evidence of prior use of the trademark Eco Move has been adduced for the reason that there has been no use since before 2014.
- 5.12 The Respondent's use of its Domain Name represented its trading name. It has always conducted a legitimate activity. It does not take advantage of nor is it detrimental to Rentacrate.
- 5.13 The Complainant has not used the trademark ECOMOVE except for its recent change to its Rentacrate website. Any decision not to transfer the disputed Domain Name to the Complainant as requested would not be unfair or detrimental to the Complainant. Allegations in the complaint about the use of the trademark by the Complainant i.e., that it has used the ECOMOVE trademark from 2009 to 2014 appear to be fabrications. That statement may be correct in respect of the mark RENTACRATE, but not in respect of the mark ECOMOVE. Consequently the Complainant is acting in bad faith.

## **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.
- 6.2 It is necessary to keep in mind the requirements of clause 5.4 of the Policy, which provides that in making a decision, the Expert may not 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.

## **7. Rights**

- 7.1 The Complainant clearly has shown it has a registered trademark for ECO MOVE in New Zealand. Accordingly the Complainant has exclusive rights to use that registered trademark in this country since the Australian mark has not been registered in New Zealand as it could

have been. Unless and until the trademark registration in New Zealand has been cancelled by appropriate process, then the Expert has to find that it is a valid trademark.

- 7.2 Consequently the Expert finds that the disputed Domain Name is identical to the Complainant's registered trademark in which the Complainant has rights and the Complaint has satisfied Paragraph 4.1 of the Policy. .

## 8. Unfair Registration

- 8.1 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.*

- 8.2 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. Two of those factors are:

"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 or otherwise connected with the Complainant.

5.1.1(c) Circumstances indicating that the Respondent has registered in the Domain Name primarily ... for the purposes of unfairly disrupting the business of the Complainant."

- 8.3 Under Part 6 of the Policy the Respondent may demonstrate that the Domain Name is not an unfair registration in a non-exhaustive list of factors as set out in paragraph 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:

- (a) Used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services"

- 8.4 Clause 6.1.2 states:

“The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with the generic or descriptive character.”

- 8.5 This is a case where there may be a claim for breach of trademark rights. It is unsuitable for the summary assessment process under the Policy where there can be no oral evidence, no cross-examination and the Expert has to decide matters solely on the information that the parties choose to provide in written form.
- 8.6 The Complainant has a New Zealand trademark which was registered after the Australian trademark but the Australian trademark was not registered in New Zealand and therefore, the Complainant was entitled to register a New Zealand trademark. However, it appears clear that the Respondent was trading in Australia under the title Eco Move after it registered the disputed Domain Name. There is no evidence that it knew of the operation of the Complainant in 2011. It seems doubtful that the Complainant was then trading under “Eco Move” as distinct from “Rentacrate”. In view of the “way back” information it seems that Mr Nichols was then trading under the name of Rentacrate. The Expert is precluded in considering matters which took place before 29 April 2011.
- 8.7 If the Complainant has a case for infringement of its trademark then it can institute appropriate court proceedings in New Zealand. Likewise the Respondent could institute proceedings to restrain the Complainant from using its Australian trademark which it claims has acquired a reputation in New Zealand through “reputation spill-over”. This contention could be difficult to establish since the Respondent did not register its Australian trademark in New Zealand.
- 8.8 The evidence before the Expert creates substantial doubt over the assertions of the Complainant that it has been trading as “Eco Move” as distinct from “Rentacrate”, since 2011. Such allegations can only be tested and authoritatively ruled upon by a court, after it has seen and heard witnesses. The Respondent appears to have established a genuine business in Australia and having had plans to operate in New Zealand (as witness to its registration of the disputed Domain Name in 2011), now wishes to implement those plans by offering to New Zealand consumers the same services that it offers in Australia. Its only mistake was not to register its Australian trademark in New Zealand.
- 8.9 There is no evidence of a deliberate attempt by the Respondent to divert business from the Complainant.
- 8.10 Under ICANN Uniform Domain Name Resolution Policy, the principle of a Panellist not deciding commercial disputes is well stated by a WIPO Panellist in *Luvion Indis NV v Top Serve Tennis Pty Ltd* DAU2005–0004 September 6, 2005, thus:



“The Policy’s purpose is to combat abusive domain name registrations and not to provide a prescriptive code for resolving more complex trademark disputes ... the issues between the parties are not limited to the law of trademarks. There are other intellectual property issues. There are serious contractual issues. There are questions of governing law and proper forum if the matter were litigated. Were all the issues fully ventilated before a court of competent jurisdiction, and maybe finding a complied contractual terms minimum termination period, breach of contract estoppel or other equitable defences. So far as the facts fit within trademark law there may be arguments of infringement, validity of the registrations ownership of goodwill, local reputation, consent, acquiescence and so on.”

- 8.11 Those words could well apply here. In addition, there would have to be considered the rights of third parties such as the franchisee of the Respondent or the licensee of the Complainant. The Expert would be reluctant to issue a Decision which could affect them when they are not parties to the present process and no information concerning their respective contracts has been provided.
- 8.12 The Expert cannot pay too much attention to what is alleged to have been done by the Complainant or Rentacrate or Mr Nichols in respect of the Complainant’s competitors other than the Respondent. However the WIPO decision cited by the Respondent reinforces the concept that the Complainant has operated this particular business under the name “Rentacrate” rather than “Eco Move” which was not mentioned in the decision of the WIPO Panellist. That factor makes it all the more inappropriate for this Expert to rule on the Complaint. Rather, the parties should litigate in the courts where a full investigation of the facts will be possible.

## 9. Decision

Accordingly the Expert determines that the disputed Domain Name shall remain with the Respondent and the Complaint is dismissed

<b>Place of decision</b>	Auckland
<b>Date</b>	10 July 2014
<b>Expert Name</b>	Hon Sir Ian Barker QC

**Signature** .....