

.nz Dispute Resolution Service

DRS Reference: 1064

Slickdeals, LLC

v

Marc's Pc

Key words -

1. Parties

Complainant:

Slickdeals, LLC
Patrick Justman
12670 High Bluff Drive
San Diego
USA

Represented by: Mrs Jenni Rutter

Respondent:

Marc's Pc
Leslie Avenue
Auckland
New Zealand

2. Domain Name/s

slickdeals.co.nz

3. Procedural history

- 3.1 The Complaint was lodged on 11 February 2015. The Domain Name Commission ("DNC"), notified the Respondent of the validated Complaint on 12 February 2015. The domain/s were locked on 12 February 2015, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 No Response was received from the Respondent.
- 3.3 The Complainant paid Domain Name Commission Limited the appropriate fee on 18 March 2015 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").
- 3.4 Maria Dew, the undersigned, ("the Expert") confirmed to the DNC on 24 March 2015 that s/he knew of no reason why s/he could not properly accept the invitation to act as expert in this case and that s/he knew of no matters which

ought to be drawn to the attention of the parties, which might appear to call into question his/her independence and/or impartiality.

4. Factual background

- 4.1 The complainant, Slickdeals, LLC, has alleged that the domain name 'slickdeals.co.nz, held by the respondent, Marcs Pc, is an Unfair Registration. Under the Policy, the DNC has the power to transfer, suspend or cancel or otherwise amend a domain name registration which is found by an independent Expert to be an Unfair Registration.
- 4.2 Since 1999, Slickdeals has operated a deal comparison website at slickdeals.net (and also uses slickdeals.com and other domains to forward to that site) and is the owner of the trade mark SLICKDEALS in the United States, Australia and other countries. Slickdeals' website is a social commerce website featuring deals and coupons from numerous retailers including Amazon, eBay, Walmart and Macy's.
- 4.3 In 2008, Slickdeals registered its word trade mark SLICKDEALS and other related trade marks ('Slickdeals Trade Marks'), in the USA. The trade mark SLICKDEALS (word) is the subject of US registration no.3416831 and the Slickdeals Logo mark is the subject of US registration no.4432278 ('Slickdeals Logo'). The trade mark registration in Australia did not come until more recently in July 2014. Applications for Slickdeals Trade Marks have also been made in New Zealand but have not yet been granted.
- 4.4 Slickdeals has its headquarters in Los Angeles, but its website offers deals with online retailers that are accessible to Internet users around the world. Rather than using automated feeds from networks and retailers, Slickdeals relies primarily on user-generated content. The best deals and coupons are voted on by its active community, and Slickdeals' Deal Editor team curates the best of the best for the website's front page.
- 4.5 Slickdeals' website includes forums, mobile aps, coupons, and a seasonal Black Friday section. In addition, each deal thread contains comments from users discussing the deal's validity and value.
- 4.6 Slickdeals states it has over 2.5 million registered users and it attracts more than 8 million unique visitors monthly to the slickdeals.net website. In the New Zealand context, Slickdeals' business and website are known and used by New Zealand customers. The complainant states, there were 76,392 visits from New Zealand to slickdeals.net in 2012; 66,385 visits in 2013; and 66,879 visits in 2014.
- 4.7 Since 2012, Slickdeals' app for the iPhone and iPad has also been available to New Zealand-based purchasers on the New Zealand section of the Apple iTunes website. See <https://tunes.apple.com/nz/app/slickdeals-1-deals-coupons/id584632814?mt=8>.
- 4.8 The Complainant produced evidence that New Zealand users were aware of and making use of the slickdeals.net website in 2012 on the website geekzone.co.nz where its online forum shows a discussion in November 2012 about the slickdeals.net website.

- 4.9 Slickdeals undoubtedly owns some reputation in New Zealand in Slickdeals Trade Marks in relation to website service and the facilitation of online purchasing and advertising. As a result, the Complainant considers it has unregistered trade mark rights in respect of its trade mark SLICKDEALS. Specifically, it claims rights in New Zealand to prevent a third party from passing off services (including a website) as those of Slickdeals when they are not, and rights under the Fair Trading Act 1986, to prevent misleading and deceptive conduct in trade.
- 4.10 The Respondent registered its domain name slickdeals.co.nz on 23 November 2013. Its website at slickdeals.co.nz provides the same deal comparison and coupons services as the Complainant's website and prominently displays the logo slickdeals on its website in a similar font and colour to the Complainants.
- 4.11 The Respondent has given the New Zealand Domain Name Registry, registrant contact name of Marcs Pc. The address details given are Leslie Ave, Auckland, Postcode 1025, New Zealand. The postcode given relates to Leslie Ave, Sandringham, Auckland. A mobile phone number is listed as the contact phone number. The Respondents website notes at the foot of the front page that it is "powered by Marcs pc solutions".

5. Parties' contentions

Complainant

- 5.1 The Complainant contends that the Respondent registered the domain name slickdeals.co.nz ("the domain name") and the domain name is effectively identical to the word mark "SLICKDEALS" and to the Complainant's own domain names slickdeals.net and slickdeals.com.
- 5.2 The Complainant states that the domain name is used and is likely to continue to be used in a manner which takes unfair advantage of and is unfairly detrimental to the rights of the Complainant. The Complainant points to the following factors which it considers on their own, or together, amount to an Unfair Registration:
- (a) *Circumstances showing that the Respondent is using the domain name in a way which is likely to confuse, mislead or deceive people into believing that the domain name is registered to or otherwise connected to the Complainant.*

It is alleged that the Respondent has been operating a deals website using the domain name including lists of deals available on the Internet which is very similar to that operated by the Complainant. The Complaint states that Respondent's website operates in direct competition with its own SLICKDEALS website and given the similarity in the names and the service, the Respondent is likely to mislead New Zealand consumers to mistakenly believe that have reached the website of SLICKDEALS and divert business away from the Complainant.

It is also alleged that the Respondent's website looks confusingly similar to the Complainant's website, given the heading "Frontpage

Deals and Coupons” for the Complainant and “Frontpage Deals” for the Respondent.

It is also alleged that the logo used by the Respondent shown at the top of its website is a substantial reproduction of the SLICKDEALS logo, using the same font and red blue colours in the logo. It is submitted that this increases the likelihood that the domain name will mislead viewers into believing that the website of the Respondent is the same as, or in some way authorised or connected to, the Complainant’s business.

The Complainant also alleges that there is already public confusion as evidenced by an email sent to the Complainant’s website on 15 December 2014. This unsolicited email asked if the New Zealand website slickdeals.co.nz, was affiliated with the Respondent.

- (b) *Circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily for the purpose of unfairly disrupting the business of the Complainant.*

This allegation is made on the basis that New Zealand consumers looking for the Complainant’s website, but selecting the Respondent’s domain name, will be misled and misdirected and that this unfairly disrupts the Complainant’s business.

- (c) *Circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily as a blocking registration against a name or mark in which the Complainant has rights.*

The Complainant contends that the Respondent’s registration of the domain name is also blocking the Complainant from registering this domain name in New Zealand. This is blocking registration which is closest to the Complainant’s trade mark in SLICKDEALS and it is therefore preventing the Complainant exercising its rights as owner of its trademark in New Zealand.

- (d) *The Complainant can demonstrate that the Respondent has knowingly given false contact details to a Registrar and/or the DNC.*

A “WHOIS” search showing the Respondent’s details shows the Registrant’s contact details as Marcs Pc, Leslie Avenue, Auckland, 1025, New Zealand, with a mobile contact number and email address as “sambahbau122@gmail.com”. The Complainant says these are incomplete and inaccurate and avoid being able to identify who owns the domain name.

- 5.3 The Complainant seeks transfer of the Respondent’s domain name registration to it, Slickdeals, LLC.

Respondent

- 5.4 The Respondent did not respond to the Complaint. It appears the only communication from the Respondent has been a brief email sent by the Respondent on 29 November 2014 to the solicitors for the Complainant.

Kensington Swan wrote to the Respondent on 27 November 2014, the Respondent replied on 29 November stating *"Hi, We really apologise about the logo, we will change it as soon as we can. About the domain I get it legally before, so I will keep the domain. Thank you."*

6. Discussion and findings

6.1 The Dispute Resolution Service Policy ("the DRS Policy), paragraph 4, sets out the test that applies in respect of any complaint of Unfair Registration. The Complainant is required to prove to the Expert on the balance of probabilities that the following two elements are present:

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

6.2 An Unfair Registration is defined, in paragraph 3 of the DRS Policy, as:

"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."*

6.3 The DRS Policy, paragraph 5, also sets out a non-exhaustive list of factors which may evidence that the Domain Name is an Unfair Registration including, as relevant to this present case:

- (a) circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - (i) 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
 - (ii) as a blocking registration against a name or mark in which the Complainant has Rights; or
 - (iii) for the purpose of unfairly disrupting the business of the Complainant (DRS 5.1.1); or
- (b) 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 (DRS 5.1.2).

(c) The Complainant can demonstrate that the Respondent has knowingly given false contact details to a Registrar and/or the DNC (DRS 5.1.4)

6.4 The Policy at, paragraph 5.4, also provides that the Expert shall not take into account any evidence of acts or omissions amounting to unfair registration or use which occurred more than 3 years before the date of the complaint. The complaint was made on 11 February 2015, therefore this Expert determination can take account of any acts or omissions back to 11 February 2012.

Does the Complainant have relevant rights?

6.5 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. The Rights must be enforceable under New Zealand law and may be registered or unregistered rights.

6.6 The Complainant has provided evidence that since 2008, it has held a registered word mark in the United States for SLICKDEALS. This is specifically for advertising and commercial information services via the internet; including advice and information about customer services and product management and prices on internet sites in connection with purchases over the internet.

6.7 The Complainant has had similar rights in the logo being a registered word mark \$d SLICKDEALS as from April 2013, registered in the United States. This includes a description of the mark being colours orange, blue and white being claimed as a feature of the mark and the dollar symbol and the letter "d" appearing in white on a blue square with the word "slickdeals" appearing next to it with "SLICK" in orange and "DEALS" in blue.

6.8 The Complainant has also produced evidence that since July 2014, it has had word mark rights in the word SLICKDEALS in Australia.

6.9 In November 2014, the Complainant lodged an application for trademark registration in New Zealand, but this has not as yet been granted. Therefore, the Complainant does not currently have enforceable trademark rights in New Zealand under the Trade Marks Act 2002 in respect of the trademark SLICKDEALS.

6.10 Nevertheless, having reviewed the evidence produced by the Complainant the Expert is satisfied that the Complainant does have other enforceable rights under New Zealand law in respect of the name slickdeals. These rights would be enforceable.

6.11 This is the result of the extensive use and recognition of the Complainant's business trading as slickdeals both overseas and in New Zealand. It is clear on the evidence that the Complainant's website dominates the internet in terms of its use of the word SLICKDEALS as associated with its business. It has provided evidence that its website has been in operation in the United States since 1999 and it has over 2.5 million registered users. It attracts more than 8 million unique visitors monthly to its website. In New Zealand, over the past three years, it has had over 60,000 plus visits from New Zealand customers to its website in each year. The Respondent has not produced any evidence to rebut this.

6.12 As a result, it is accepted that on the balance of probabilities the Complainant has unregistered rights in New Zealand in respect of its trademark SLICKDEALS. It therefore has rights in New Zealand to prevent a third party passing off the same services under the same name in New Zealand. These are rights enforceable under the Fair Trading Act 1986 to prevent misleading and deceptive conduct in trade.

6.13 The Expert is satisfied that the Complainant's Rights existed well prior to the Respondent's registration of the domain name in November 2013.

Is the domain name in the hands of the respondent an unfair registration?

6.14 The Complainant must also satisfy the Expert on the balance of probabilities that the Domain Name is an unfair registration. The definition of Unfair Registration under the Policy provides two limbs either of which permit a finding of unfair registration, if the domain name:

(i) was registered or otherwise acquired in a manner which at the time of registration took unfair advantage of or was unfairly detrimental to the Complainant's Rights? Or,

(ii) has been, or is it likely to be, used in a manner which takes unfair advantage or is unfairly detrimental to the Complainant's Rights?

6.15 The Complainant asserts that it is an Unfair Registration under the second limb.

6.16 The Expert is satisfied that it is an Unfair Registration under this second limb based on the following grounds, (being factors evidencing an unfair registration under paragraph 5.1 of the DRS Policy):

(a) The Respondent's use of the domain name and its website is likely to mislead or confuse the public that it is a part of the Complainant's business. This is because the Respondent's website is substantially similar in presentation and content to the Complainant's website.

(i) The Respondent's website uses the same banner heading on its front page "slickdeals" with a very similar font and the same use of red colour for the word "slick" and blue colour for the word "deals" and this second word is bolded as it is in the Complainant's website.

(ii) The look of the front page is similar with "frontpage deals" and the use of blue banners through both front pages.

(iii) The logo used by the Respondent on its website is sufficiently similar that it adds to the overall misleading impression that it is authorised or otherwise associated with the Complainant's websites. The Complainant's logo has the "\$d" in white bold font set into a blue square background. The Respondent's logo has an "SD" also using a white bold font set in a blue boxed background.

- (iv) The Respondent's Facebook front page also uses the same logo as on its website.
- (v) It is also notable that the Respondent in its email dated 29 November 2014, appears to acknowledge the similarity in the logo, as the Respondent apologises for its use and states "*we will change it as soon as we can*".
- (b) The fact that the Respondent's website offers substantially similar services to the Complainant's website means that there is no opportunity to differentiate the websites and makes it likely that it will unfairly take advantage of, and be detrimental to, the Complainant's Rights in the name slickdeals.
- (c) The Complainant was also able to produce an email dated 15 December 2014, from a member of the public. The email was sent to the Complainant's "contact us" area on its website stating "*I was just wondering if the New Zealand site, SLICKdeals.co.nz was affiliated with Slickdeals?*". This evidences the actual confusion in the mind of at least one member of the public and together with applying a common sense approach to reviewing both websites, makes it reasonable to conclude that on the balance of probabilities, the Respondent's website is likely to be confused with that of the Complainant's.

6.17 Taking these factors together, the Expert is satisfied that the Respondent's registration of the domain name in November 2013 has been and is likely to continue to be used in a manner which takes unfair advantage and is likely to be unfairly detrimental to the Complainant's Rights.

6.18 The Expert is not satisfied that the Respondent has registered the Domain Name primarily for the purpose of unfairly disrupting the business of the complainant or to otherwise block registration by the Complainant. There is not sufficient evidence presented that the Respondent has had these intentions, though it is acknowledged that these impacts may have resulted.

6.19 Equally, the Expert has not been satisfied that the Complainant has demonstrated that the Respondent has knowingly given false contact details to the Registrar. The contact details appear incomplete and somewhat inadequate but there is no evidence that they are knowingly false. The Respondent, or its representative, replied to an email from the Complainant's solicitors in November 2014, which shows the email contact given was correct.

6.20 While the Respondent has not made any response to this complaint, the Expert has given some consideration to the factors which may evidence that the Domain Name is not an Unfair Registration as listed in paragraph 6 of the Policy. The Expert is satisfied that there is not available evidence that any of these factors will apply.

7. Decision

7.1 The Expert has determined that the registration is an Unfair Registration and directs that the Domain Name be transferred to the Complainant.

Place of decision **Auckland**
Date **2 April 2014**
Expert Name **Maria Dew, Barrister**

Signature 