

## **.nz Dispute Resolution Service**

**DRS Reference: 256**

### **Harvey Norman Retailing Pty Limited v Woosh Domains Limited**

Key words -

*Domain name* - harveynormans.co.nz

*Identical or similar trade mark or name* - registered mark – similar

*Rights* – commonly known by

*Unfair registration* - offer to sell, rent or otherwise transfer – likely to confuse, mislead or deceive - pattern of registration

*Procedure* – transfer

#### **1. Parties**

Complainant:

Jason Nesbit  
Harvey Norman Retailing Pty Limited  
A1 Richmond Road  
Homebush West  
New South Wales 2140  
Australia

The Complainant is represented by Kensington Swan, Auckland

Respondent:

Woosh Domains Limited  
23a Ladbrooke Gardens  
Notting Hill  
London  
GB (UNITED KINGDOM)

The Respondent is represented by Brian Pritchard, Woosh Domains Limited

#### **2. Domain Name**

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

### **3. Procedural history**

The Complaint was lodged on 9/01/2008 and InternetNZ, through the Office of the Domain Name Commissioner, notified the Respondent of the validated Complaint on 14/01/2008. The domain was locked on 10/01/2008, preventing any changes to the record until the conclusion of these proceedings.

The Respondent filed a Response to the Complaint on 7/02/2008 and InternetNZ so informed the Complainant on 7/02/2008. The Complainant filed a Reply to the Response on 19/02/2008. InternetNZ informed the parties on 27/02/2008 that informal mediation had failed to achieve a resolution to the dispute.

The Complainant paid InternetNZ the appropriate fee on 4/03/2008 for a decision of an Expert, pursuant to Paragraph 9 of the InternetNZ Dispute Resolution Service Policy ("the Policy").

Dr Clive Trotman, the undersigned, ("the Expert") confirmed to InternetNZ on 12/03/2008 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**

The Complainant of record is Harvey Norman Retailing Pty Limited. The Complainant describes itself as the Lead Complainant and describes Harvey Norman Stores (N.Z.) Pty Limited as the Joint Complainant. The Complainant and Harvey Norman Stores (N.Z.) Pty Limited are subsidiaries of Harvey Norman Holdings Limited, an Australian company. Evidence of their relevant trade mark registrations is annexed to the Complaint.

The HARVEY NORMAN chain of retail outlets has operated in New Zealand since 1997.

Harvey Norman Retailing Pty Limited owns registrations in New Zealand for the following trade marks:

HARVEY NORMAN  
HARVEY NORMAN DISCOUNTS (Device)  
HARVEY NORMAN EXTENDED WARRANTY ASK FOR DETAILS (Device).

Harvey Norman Stores (N.Z.) Pty Limited owns registrations in New Zealand for the following trade marks:

HARVEY NORMAN BIG CAMERA  
HARVEY NORMAN HOMESTARTERS.

The Respondent provides an address in London, UK, and is the registrant of the disputed domain name harveynormans.co.nz.

## **5. Parties' contentions**

### **a. Complainant**

The contentions of the Complainant include the following and are supported with documentary evidence.

The Complainants have since 1997 been operating the well known HARVEY NORMAN chain of retail outlets in New Zealand. The reputation of HARVEY NORMAN is described in an affidavit of Jason Nesbit, Company Director.

It is contended that a New Zealand company (Budget Domains Limited) is behind the Respondent. The Whois result for the domain name states that the registrant "contact province" is www.wooshdomains.com. This domain name redirects to a website at www.domainsupermarket.co.nz. The "About Us and Frequently Asked Questions" section of that website states that "Domain Supermarket is a trading name of Budget Domains Limited" and "Domain Supermarket has offices in New Zealand and the UK". Budget Domains Limited is a New Zealand company.

The Complainant's representative sent a letter to the Respondent on 15 November 2007, at the email addresses it provided, setting out the Complainant's position. The letter said that the Complainant had rights in its trademarks, that the Respondent's holding of the registration was unfair, and asked for transfer of the domain name.

The Complainant contends that the Respondent's registration of the disputed domain name is an unfair registration because:

1. Circumstances demonstrate 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, operated or authorised by, or otherwise connected with the Complainants.

This is because the domain name is virtually identical to the name of the New Zealand HARVEY NORMAN website, harveynorman.co.nz.

2. Circumstances indicate that the Respondent:

- a. Has registered the domain name for the purposes of unfairly disrupting the business of the Complainant.

This is because the website at the disputed domain name provides links to a range of commercial websites, unrelated to the Complainant, which offer goods and services to New Zealand consumers. These websites supply goods and services in direct competition to those of the Complainant,

encouraging consumers to believe mistakenly that they have reached a website associated with the Complainant, thereby diverting business away from the Complainant.

b. Has registered the domain name possibly for the purposes of selling or otherwise transferring the domain name to the Complainant or a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring the domain name.

The possibility of the Respondent attempting to sell the domain name is suspected because Domain Supermarket describes itself as: "the source for premium yet affordable domain name registrations for "already owned" domain names. As New Zealand's leader in the secondary domain name registration market, our goal is to combine premium names with excellent customer service into one quick, easy and affordable process for both the buyer and seller".

Accordingly, the Complainant requests transfer to it of the disputed domain name.

#### **b. Respondent**

The Contentions of the Respondent include the following.

The domain name [www.harveynormans.co.nz](http://www.harveynormans.co.nz) was registered on behalf of the Respondent's client Mr Harvey Normans. Mr Normans is a UK resident planning to move to New Zealand. The registration of the URL was so that Mr Normans could have his own website about his family and friends. The Respondent acquired the URL from a New Zealand auction site called [www.expireddomains.co.nz](http://www.expireddomains.co.nz). The Complainant has never owned the URL in question despite it being freely available to purchase, and hence the reason why it could be acquired.

The Respondent says that the URL was not transferred to Mr Normans as contact with him was lost. The Respondent kept the domain name and uses it to generate click-through revenue in connection with [www.namedrive.com](http://www.namedrive.com) and Google AdSense. It is also for sale via [www.domainsupermarket.co.nz](http://www.domainsupermarket.co.nz).

At the relevant times the Respondent was never aware of Harvey Norman Retailing Pty Limited. Respondent searched the IPONZ database and found no match under Harvey Normans. Harvey Normans is a common personal name and Respondent believed it was not protected by a trade mark as that would remove the human rights of a person to own a domain name consistent with their personal name. With future technology a URL consistent with a person's personal name will make practical sense.

The Respondent refutes the Complainant's allegations specifically as below.

The Complainant says “Circumstances demonstrate 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, operated or authorised by, or otherwise connected with the Complainants”.

The Respondent says “The content of the URL [www.Harveynormans.co.nz](http://www.Harveynormans.co.nz) landing page is clearly a parked domain holding page and in no way purports to be associated with the Complainant’s business. There is no mention of the Complainant either directly or via logos etc. There are links to third party sites on this page but no links to the Complainant so no money is made by us for visitors trying to reach the Complainants own website”.

The Respondent also says it would be willing to provide a disclaimer stating that the website is not linked to the Complainant.

The Complainant says the respondent has registered the domain name for the purpose of unfairly disrupting the business of the Complainant.

The Respondent says that because its website provides links to, for example, [Woolworths.co.nz](http://Woolworths.co.nz), which the Complainant would not have wanted to provide, it is obvious that these are not authorised by the Complainant.

The Complainant says that circumstances indicate the Respondent has registered the domain name possibly for the purposes of selling or otherwise transferring the domain name to the Complainant or a competitor.

The Respondent says a price of NZ\$5,000 is reasonable given the income the website generates through AdSense, and confirms that the Respondent trades in domain names. If the Respondent wins this case, the price of the disputed domain name will be increased.

The Expert has taken note of all other observations and comments made by the Respondent.

### **c. Complainant’s Reply to Respondent**

The Complainant’s Reply to the Response includes the following, with appropriate documentation.

The Respondent’s assertion that it registered the domain name for a Mr Harvey Normans is not credible. The Respondent has not provided any evidence to show that Mr Harvey Normans exists. The same argument was attempted by the relevant defendant in *Oggi Advertising Ltd v McKenzie* [[1999] 1 NZLR 631; (1998) 8 TCLR 363].

“Normans” is not a common surname. There is no such listing in the Auckland telephone directory and only one has been found in the United Kingdom.

The domain name is for sale on [domainsupermarket.co.nz](http://domainsupermarket.co.nz) website where it is listed under “Business”, not “People-Culture”.

The Respondent is the registrant for several other domain names listed for sale on the domainsupermarket.co.nz website, that are identical or very similar to famous names including LJ Hooker, Dick Hubbard, Impreza, Porsche 911, Ssangyong and Mini Cooper. As with the disputed domain name, some of these websites contain links to businesses competitors.

The Respondent's account of its registration of the domain name is untenable. On the evidence, the Respondent has engaged in a pattern of unfair registrations (clause 5.1.3 of the Policy).

The Respondent claims that it searched the IPONZ database for HARVEY NORMANS and "the search provided no match". The Complainant understands that the IPONZ database automatically returns wildcard results. Accordingly, if HARVEY NORMANS is entered in the basic search field, the Complainant's trademarks are returned.

The Respondent asserts that the website of the disputed domain name "in no way purports to be associated with the Complainant's business" and that "there is no mention of the Complainant either directly or via logos etc". The Complainant says that in the light of there being no identifiable "Harvey Normans", and given the previous pattern of unfair registrations, these claims are disingenuous. The Respondent's relevant website prominently displays the heading "Harveynormans.co.nz" in bright orange at the top of the page. Links on the website are to businesses in the same retail sectors as the Complainant, and are clearly intended to divert business away from the Complainant.

The Complainant refutes the Respondent's claim that it makes no money from visitors seeking the Complainant's website. Internet users may type harveynormans.co.nz accidentally or colloquially. Once at the Respondent's website, the consumer may generate click-through revenue for the Respondent.

The Respondent claims it would be willing to display a statement to the effect that the URL is not linked to the Complainant. The Complainant does not accept this. It has been held in previous decisions that "a disclaimer is not usually sufficient to dispel the inference of unfair registration", and that "the sort of confusion that Clause 5.1.2 has in mind is implicit in the Domain Name itself" (*NZ Aerial Mapping Limited v Terralink International Limited*, NZDNC Case No. 172, citing *Thomas Cook UK Limited v Whitley Bay Uncovered*, UK DRS Case No. 00583, and *Estée Lauder Inc. v. estelauder.com, estelauder.net and Jeff Hanna*, WIPO Case No. D2000-0869).

The Complainant says that although the Respondent claims no one would think its links could be authorised by the Complainant, the issue is that business is unfairly diverted from Harvey Norman.

The Complainant says the Respondent offered to sell the Domain Name for NZ\$5,000 on December 27, 2007. The Respondent did not refer to a Mr

Harvey Normans in this message, but described the domain name as “an investment name”. The Complainant declined the offer and filed this Complaint. On January 18, 2008 the Respondent increased the price to NZ\$15,000 and mentioned Mr Harvey Nomans for the first time. The Respondent has not provided any evidence to show that either price is reasonable.

The Complainant cites *Skype Technologies, S.A. v Bellamy Price Mansfield, Ltd.*, NZDNC Case No. 150 (a demand for US\$50,000 was “evidence that when the Respondent registered the skypehop.co.nz domain name it did so primarily for the purposes of selling, renting or otherwise transferring it or as a blocking registration or for the purpose of unfairly disrupting the First Complainant's business”).

## **6. Discussion and findings**

### *The Policy*

The InternetNZ Dispute Resolution Service Policy and Procedure apply to Respondents when a Complainant asserts in accordance with section 4 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.

Paragraph 4.2 of the Policy requires the Expert to be satisfied that both of the above elements are present on the balance of probabilities.

The Policy defines Unfair Registration as meaning 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.

The Policy at section 5 provides guidance in the form of criteria that may be evidence of unfair registration. Pertinent parts of section 5 read:

## 5. Evidence of Unfair Registration

5.1. 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:

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;
- (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 that pattern;

[5.1.4 - 5.4]

The Policy provides in section 6 a non-exhaustive list of criteria by which a Respondent may seek to show that a domain name registration is not unfair, as follows:

6.1. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in paragraphs 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;
- (b) been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- (c) made legitimate non-commercial or fair use of the Domain Name;

[6.1.2 - 6.3]

### **Preliminary**

The Complainant identifies itself as Harvey Norman Retailing Pty Limited, as set out in section 1. In the body of the Complaint the Complainant seeks to distinguish between a "Lead Complainant" (Harvey Norman Retailing Pty Limited) and a "Joint Complainant" (Harvey Norman Stores (N.Z.) Pty Limited). It will be sufficient to proceed in the name of the Complainant as it is stated in section 1 and with reference to those particular trademarks registered in the name of that Complainant.

### **Rights in respect of a name or mark**

The name in which the Complainant asserts rights is HARVEY NORMAN, both plainly and in the variants set out in section 5 above. Adequate documentary evidence is provided, in the form of copies of trademark registrations at the Intellectual Property Office of New Zealand (IPONZ), that Harvey Norman Retailing Pty Ltd has rights in the name HARVEY NORMAN.

### **Identical or similar**

The disputed domain name is harveynormans.co.nz. The level and country code identifiers ".co" and ".nz" are normally of no consequence for the determination of confusing similarity. The residual "harveynormans" differs from the Complainant's trademark HARVEY NORMAN by the addition of a letter "s".

The Complainant operates a chain of retail outlets. An affidavit sworn by a director of the Complainant says that some customers refer to Harvey Norman stores as "Harvey Normans". The Expert recognises that in New Zealand the name of a supplier, in the context, is sometimes referred to colloquially in the possessive, i.e., Harvey Norman's, with or without the apostrophe, having the sense "Harvey Norman's shop" (the Respondent itself

makes reference to Woolworths.co.nz, the name being colloquial for F.W.Woolworth).

The technology of the Internet domain name address system does not provide for apostrophes or spaces and does not distinguish case. Thus the closest domain name to Harvey Norman's (or Harvey Normans) is harveynormans, which registration the Respondent has acquired. On the facts, the disputed domain name is found to be confusingly similar to the trademark in which the Complainant has rights, within the meaning of paragraph 4.1.1 of the Policy.

### **Unfair registration or acquisition**

The Complainant must prove that the Respondent holds an unfair registration.

Definition (i) of unfair registration in the Policy refers to the manner of registration or acquisition of a domain name. The date on which the Respondent acquired the domain name is not clear but it appears to have been registered on June 26, 2006, and acquisition within the three-year period of limitation (paragraph 5.4 of the Policy) has not been questioned. The Complainant has produced evidence that the surname Normans is rare, there being in the United Kingdom telephone directory, for example, one listing in Kent and none in Lincolnshire, East Midlands, Birmingham, Manchester, Essex or London; and none in the Auckland (NZ) telephone directory.

The Complainant has produced evidence to show that a search for Harvey Normans in the IPONZ database locates five entries in which the proprietor is named as Harvey Norman Retailing Pty Ltd and four more in which it is named as Harvey Norman Stores (NZ) Pty Limited.

Paragraph 5.1.3 of the Policy refers to a pattern of the registration of domain names incorporating well-known marks in which a Respondent has no apparent rights. The Complainant produces evidence that the Respondent has engaged in such a pattern, in the form of screen prints from Domain Supermarket, which the evidence shows to be a New Zealand company. The following domain names derived from recognised names are for sale and the Respondent is listed as their registrant:

ljhookers.co.nz  
dickhubbard.co.nz  
impreza.co.nz  
porsche911.co.nz  
ssanyong.co.nz  
minicooper.co.nz  
skycitycasino.co.nz.

The Respondent says the disputed domain name was acquired on behalf of a customer by the name of Mr Harvey Normans, who intended to migrate to New Zealand, but with whom it has since lost contact. The Respondent says it did not find the name of the Complainant in prior searches including a search of IPONZ and denies that it was aware of the Complainant.

The purposes for which the disputed domain name was originally registered, before being acquired by the Respondent, can only be surmised. The facts are that the domain name, confusingly similar to that of a New Zealand retail chain and identical to a colloquial form of that name, changed hands in the New Zealand market place and was acquired by the Respondent.

Whilst it is for the Complainant to prove its case, the Respondent is found not to have succeeded in demonstrating generally or in the non-exclusive terms of section 6 of the Policy that it does not hold an unfair registration. In particular it is not able to do so under paragraph 6.1.1(b) because the Respondent is not a Mr Harvey Normans.

On the facts and the balance of probabilities, the Respondent is found to have acquired the disputed domain name without having any plausible rights in the name, as part of a pattern of registrations of well known names in which the Respondent has no apparent rights. The Expert finds that there has been unfair acquisition of the disputed domain name in the terms of paragraph 5.1.3 of the Policy.

### **Unfair Use**

Definition (ii) of unfair registration refers to unfair use of a domain name.

A screen print produced by the Complainant in evidence shows that the disputed domain name is in use as a website. The website offers links to a variety of what appear to be retailers of household and general merchandise. In the Respondent's own words, "The landing page offers links to a wide range of global sites ...". The confusing similarity between the domain name and the Complainant's name is likely to lead some users into finding their way to the Respondent's website, for instance by guessing the Complainant's domain name wrongly, by typing it wrongly, or by following links from a search engine or elsewhere. Once at the Respondent's website, some users may think it is operated by the Complainant and that links from it are endorsed by the Complainant.

It may reasonably be presumed that these links have been provided by or on behalf of the Respondent in order to generate revenue by the well known click-through device. The Respondent confirms as much by saying, "We have indicated to the Complainant that we were willing to sell them the domain name for NZ\$5,000. This amount is considered reasonable given the AdSense income that is generated by the URL". At least part of the revenue may be generated by the Respondent trading unfairly on the name and reputation of the Complainant. The Complainant may suffer detriment through the diversion of some of its potential business elsewhere and may suffer the odium of being associated with links of which it does not approve. The Expert finds unfair registration proven in the terms of paragraph 5.1.2 of the Policy.

The Complainant also says, with evidence in the form of prints of emails between the Parties, that the Respondent offered to sell the domain name to it for NZ\$5,000. An email from the Respondent to the Complainant said, "We have no long term interest in holding the domain name but are not prepared to transfer the name to your client without being paid commercial value for the name. We believe that NZ\$5,000 is very reasonable". After this case was initiated, the Respondent said to the Complainant in an email, "In the event that we win the DNC case (which we believe we will) we will increase the asking price to NZ\$15,000 due to the confrontational stance that you are taking". There is no documentation of Respondent's out-of-pocket costs. A screen print produced by the Complainant shows the domain name for sale on Domain Supermarket for \$15,000 on February 13, 2008.

The Expert finds that the Respondent has used and is likely to use the domain name for the purpose of offering it for sale at a price in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using it, constituting unfair use in the terms of paragraph 5.1.1(a) of the Policy.

In summary the disputed domain name is found to be confusingly similar to a name in which the Complainant has rights (paragraph 4.1.1 of the Policy). Unfair registration of the domain name under paragraph 4.1.2 of the Policy is found particularly in the terms of paragraphs 5.1.1(a), 5.1.2 and 5.1.3 of the Policy.

## **7. Decision**

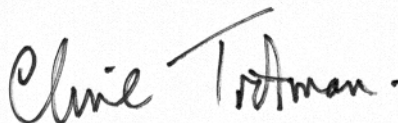
The decision is that the domain name harveynormans.co.nz shall be transferred to the Complainant.

**Place of decision** Dunedin

**Date** March 26, 2008

**Expert Name** Dr Clive Trotman

**Signature**

A handwritten signature in black ink that reads "Clive Trotman." The signature is written in a cursive style with a period at the end.