

**.nz Dispute Resolution Service**

**DRS Reference: 766**

**Delta Force Paintball v Delta Force**

Key words –

*Identical or similar trade mark or name*

Registered mark - unregistered mark - well-known mark - trade name – identical

*Rights*

Commonly known by

*Unfair registration*

Unfair registration – unfair use - Likely to confuse, mislead or deceive – unfairly disrupting the business of the complainant

**1. Parties**

Complainant:

Delta Force Paintball  
4/4 Grivelle St  
Kumeu  
New Zealand  
Represented by: Mr Duncan Gass

Respondent:

Delta Force  
199 Sparks Rd  
Christchurch  
New Zealand  
Represented by:

**2. Domain Name/s**

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

**3. Procedural history**

- 3.1. The complaint was lodged on 16/02/2012 and the Domain Name Commission ("DNC") notified the Respondent of the validated complaint on 21/02/2012. The domain was locked on 27/01/2012, 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 21/03/2012 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").
- 3.4. The Hon Robert Fisher QC, the undersigned, ("The Expert") confirmed to the DNC on 22/03/2012 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 that ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

#### **4. The Parties**

##### *Identity of the complainant*

- 4.1. The complaint has been lodged in the name of "Delta Force Paintball". There is no such person or entity capable of recognition under New Zealand law.
- 4.2. As pointed out in *Wicked Campers v Escape Rentals* (DRS Reference 353), legal rights can be ascribed to only legally recognisable persons or entities. They cannot attach to a nebulous brand, business or trading name. If Domain Names are to have the status of legally recognisable intellectual property, the registration and complaints processes must be confined to legal persons.
- 4.3. In the present case the complaint was received from a Mr Duncan Gass of Kumeu, Auckland. Mr Gass frames the complaint in the Third Person with descriptions such as "Delta Force Paintball negotiated a lease" but concludes in the First Person plural with "We request that the domain name be returned to us at the earliest opportunity". The identity of "we" is left unstated. A search of the Companies Register reveals three apparently connected New Zealand companies, each with the same registered office and address for service and each with a name including the words "Delta Force". The companies have common directors. Mr Gass is a director and major shareholder of one.
- 4.4. If this complaint had been defended a stricter approach would have been required. The fact that it is undefended justifies a pragmatic approach. I have decided to treat the complaint as one made by Mr Gass, since Mr Gass holds the trade mark on which the complaint is partly based and he was also the one who instigated the current proceedings with the Domain Name Commission.
- 4.5. If a different legal person wishes to bring a complaint in relation to the disputed Domain Name, that person should be able to come to an appropriate agreement with Mr Gass or bring a further complaint in its own name.

##### *Identity of the respondent*

- 4.6. The same problem arises with the Respondent. The Registrar of the disputed Domain Name, 1st Domains, should not have allowed registration in the name of "Delta Force". There is no such person or entity. The Registrar should have insisted on the name of either an identified person or a company.
- 4.7. The complaint states that the Respondent is based in Christchurch. A search of the Companies Register shows that Deltaforce Paintball NZ Limited (incorporated on 22/08/11) is the only Christchurch company with a name which includes words "Delta Force".
- 4.8. The sole director and shareholder of Deltaforce Paintball NZ Limited is Mr Varunthon Khurasee of 1060 Mcleans Island Road, Harewood, Christchurch. The registered office of the company is the same address.
- 4.9. The disputed Domain Name currently redirects visitors to [www.deltaforcepowderball.co.nz](http://www.deltaforcepowderball.co.nz), a website registered on 13 December 2011.

This website is also registered to “Delta Force” but WHOIS lists the administrative contact of the registrant as The Ultimate Game (NZ) Limited, 1060 Mcleans Island Road, Mcleans Island.

- 4.10. A further search of the Companies Register reveals two New Zealand companies, the names of which contain the words “The Ultimate Game”. Both The Ultimate Game Limited (incorporated on 14/03/12) and Paintball The Ultimate Game Limited (incorporated on 16/06/10) have their registered address at 1060 Mcleans Island Road, Mcleans Island. Mr Khurasee is sole shareholder of both companies, sole director of The Ultimate Game Limited and one of two directors of Paintball The Ultimate Game Limited. I will treat the current registrant of the disputed Domain Name as Mr Khurasee.
- 4.11. Making the best of an unsatisfactory situation I will proceed on the basis that this is a dispute between Mr Duncan Gass as Complainant and Mr Varunthon Khurasee as the registrant of the disputed Domain Name.

## **5. Factual background**

- 5.1. Whether directly or through his companies, Mr Gass appears to conduct a paintball sports business in Auckland under the name “Delta Force Paintball”. He has drawn attention to the following websites:

- [www.paintballing.com.au](http://www.paintballing.com.au),
- [www.paintballing.co.nz](http://www.paintballing.co.nz); and
- [www.paintballgames.co.uk](http://www.paintballgames.co.uk).

- 5.2. The domain [www.paintballing.co.nz](http://www.paintballing.co.nz) was registered in November 2007. The website appears to be the primary channel by which the Complainant conducts business as “Delta Force Paintball”. The website features reciprocal links to the other websites named above. All the websites feature an identical “Delta Force Paintball” logo and highly similar page design.

- 5.3. It seems reasonable to infer that the Complainant is a New Zealand licensee of the multi-national business Delta Force Paintball, which appears to be the largest paintball sports business in the world.

- 5.4. There is little direct evidence as to the business operations of the Complainant, but the oldest of the three related Delta Force companies, Delta Force NZ Limited, was incorporated in December 2008. I conclude that for an unknown period, but at least since December 2008, the Complainant has been trading as “Delta Force Paintball”.

- 5.5. On 14 February 2011 Mr Gass filed a New Zealand trade mark application in respect of the words “Delta Force Paintball”. The trade mark was registered on 13 August 2011. The deemed date of registration is 14 February 2011.

- 5.6. The trade mark is registered in respect of the following classes and specifications:

### **Class Goods and Services Descriptions**

- 9135** Advertising; operation and supervision of loyalty and incentive schemes; advertising services provided via the internet; retail services connected with the sale of paintball paraphernalia.

**9 | 41** Provision of paintball sports activities, paintball entertainment.

- 5.7. An established paintball sports business operates from 1060 Mcleans Island Road, Mcleans Island under the name "Mcleans Island Paintball - The Ultimate Game". It advertises via the website [www.paintballgames.co.nz](http://www.paintballgames.co.nz). The registrant of [www.paintballgames.co.nz](http://www.paintballgames.co.nz) is The Ultimate Game (NZ) Limited. As noted, the Respondent is sole director and shareholder of this company and other companies registered to 1060 Mcleans Island Road. It is reasonable to infer that the Respondent is the operator of Mcleans Island Paintball.
- 5.8. On 25 February 2010 the Respondent registered the disputed Domain Name. The Domain Name is currently used to redirect visitors to [www.deltaforcepowderball.co.nz](http://www.deltaforcepowderball.co.nz), a website registered by the Respondent on 13 December 2011.

## **6. Complainant's contentions**

- 6.1. The Complainant alleges that the Respondent registered the Domain Name in order to prevent the Complainant from establishing successful business operations in Christchurch.

## **7. Respondent's contentions**

- 7.1. The Respondent has not filed any response.

## **8. Discussion and findings**

- 8.1. The dispute is governed by the Policy issued by the DNC on behalf of InternetNZ. Critical portions of the Policy for present purposes are these:

### **"3. Definitions ...**

**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

...

### **4. Dispute Resolution Service**

- 4.1 This Policy and Procedure applies to Respondents when a Complainant asserts to the DNC according to the Procedure 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.

...

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

5.1.5. The Domain Name was registered arising out of a relationship between the Complainant and the Respondent, and the circumstances indicate that it was intended by both the Complainant and the Respondent that the Complainant would be entered in the Register as the Registrant of the Domain Name;”

...

8.2. It will be seen that to support a complaint of this kind the Complainant must satisfy three elements:

- (a) Rights in respect of a name or mark (para 4.1.1);

- (b) Identity or similarity between that name or mark and the Domain Name (para 4.1.1); and
- (c) Unfair registration in the hands of the Respondent (para 4.1.2).

**9. (a) Rights in respect of a name or mark**

- 9.1. The Complainant has demonstrated rights in respect of the name "Delta Force Paintball" by virtue of his ownership of the registered trade mark (IP number 837156).
- 9.2. It also appears that the Complainant has at least nominal common law rights in the name "Delta Force Paintball". Little information has been provided as to the factual background but the complaint is proceeding on an undefended basis. It seems reasonable to infer that the Complainant had and has developed goodwill in New Zealand, trading since at least 2008 under the aegis and banner of the world's largest paintball business.

**10. (b) Identity or similarity between the name or mark and the Domain Name**

- 10.1. The second requirement is to show that the Complainant's name or mark is identical or similar to the Domain Name.
- 10.2. In the present case the disputed Domain Name consists of the precise words over which the Complainant asserts his rights. This requirement is also satisfied.

**11. (c) Unfair Registration in the hands of the Respondent**

- 11.1. The third requirement is unfair registration. The Policy includes a non-exhaustive list of factors which may be evidence of unfair registration (paras 5.1.1 to 5.1.5).
- 11.2. The Policy's definition of unfair registration has two limbs. The first is satisfied only if it is shown the Respondent took unfair advantage of or was unfairly detrimental to the Complainant's Rights at the time of registration. The second limb is concerned with continuing interference with the Complainant's Rights.
- 11.3. I begin with the first limb of unfair registration.
- 11.4. At the time that the Respondent registered the Domain Name, "Delta Force Paintball" had not yet been registered as a trade mark. However, I have found that the Complainant had common law rights to the unregistered mark. These rights are sufficient to constitute Complainant's Rights.
- 11.5. It must be more than coincidence that the Respondent registered the precise words of the Complainant's mark as a Domain Name. By that stage the Complainant had already been in business for at least 18 months. "Delta Force" is an unusual turn of phrase. A web-search of the words in question would have immediately led to the Complainant's website. It is highly improbable that prospective participants in a niche industry like paintball sports in New Zealand would not take the basic step of checking for the name on the internet when establishing a business. I accordingly find the third requirement is also satisfied.

- 11.6. Although not strictly necessary to go further, the second limb of unfair registration is also applicable. The domain name deltaforcepowderball.co.nz was registered on 13 December 2011. By the time the Respondent set up a web page redirect from the disputed Domain Name to deltaforcepowderball.co.nz, the Complainant's Rights had been reinforced by the registration of "Delta Force Paintball" as a trade mark.
- 11.7. The evidence supports the conclusion that the Respondent is and has been using the disputed Domain Name for the purpose of unfairly disrupting the business of the Complainant. If a web user enters the trademarked words followed by the .co.nz domain suffix into a browser address bar, they are directed to the Respondent's website. That site can best be described as a holding one. The page carries the banner "Delta Force Powderball" and states that "Powderball – the Latest Innovation" is "Coming Soon to Christchurch". It lists a contact email and phone number but is otherwise devoid of content. It is most unlikely that the page represents a genuine signal to the public that a new paintball business is about to open.
- 11.8. As previously noted, the Respondent appears to operate a paintball sports business "Mcleans Island Paintball – The Ultimate Game" from 1060 Mcleans Island. It not credible that he would expand his paintball sports business under a new and highly esoteric name like "powderball" which lacks mainstream cache and advertise that venture as "coming soon" without any more details or reference to existing services. Rather, the purpose of the website deltaforcepowderball.co.nz appears to be to confront those who enter the Complainant's trade mark into an address bar with either a dead end or, should they take the trouble to follow the website's contact details, divert those potential customers to the Respondent. On that basis the third requirement is satisfied.
- 11.9. It follows that for two distinct reasons the current registration of the domain name is an unfair registration.

## **12. Decision**

- 12.1. The complaint is upheld. I direct that the disputed Domain Name "deltaforcepaintball.co.nz" be transferred to the Complainant Duncan Gass or his nominee.

### **Place of decision:**

Auckland

**Date:** 3 April 2012

**Expert Name:** Hon Robert Fisher QC



**Signature:**