

**.nz Dispute Resolution Service**

**DRS Reference: 781**

**Home Instead, Inc. v Brian Hunter**

Key words:

*Identical or similar trade mark or name*

Registered mark – identical

*Unfair registration*

Unfair registration – offer to sell, rent or otherwise transfer – monetary demands, non-monetary demands – prior relationships between the parties

**1. Parties**

Complainant:

Home Instead, Inc.  
13323 California Street  
Suite 200  
Omaha, Nebraska  
UNITED STATES  
Represented by: Christopher M. Bikus

Respondent:

Brian Hunter  
PO Box 520  
PARAPARAUMU  
NZ (NEW ZEALAND)  
Represented by: Brian Hunter

**2. Domain Name/s**

homeinstead.net.nz ("the Domain Name")

**3. Procedural history**

- 3.1. The complaint was lodged on 07/05/2012 and the Domain Name Commission ("DNC") notified the Respondent of the validated complaint on 10/05/2012. The domain was locked on 07/05/2012, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. The Respondent filed a Response to the Complaint on 25/05/2012 and the DNC so informed the Complainant on 28/05/2012. The Complainant filed a Reply to the Response on 08/06/2012. The DNC informed the parties on 28/06/2012 that informal mediation had failed to achieve a resolution to the dispute.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 13/07/2012 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 18/07/2012 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. Factual background**

- 4.1. The Complainant is a Nebraska corporation providing in-home, non-medical care to seniors. It provides its services in New Zealand via a network of franchisees.

- 4.2. The Complainant has two trade marks registered in New Zealand. One is a word trade mark for “Home Instead”, registered on 7 July 2003. The other is a design trade mark consisting of a logo formed by the words “Home Instead Senior Care” deemed to have been registered on 23 March 2011.

- 4.3. The word trade mark is registered in respect of class 44, which is described as:

Provision of home care, companionship care, day care and healthcare services; provision of home care, companionship care, day care and healthcare services for senior citizens; information and consultancy services in relation to all the aforesaid.

- 4.4. The design trade mark is registered in respect of class 45, which is described as:

Providing care assistance in activities of daily living, for senior citizens in their residences; social services, namely, companionship services for senior citizens.

- 4.5. These trade marks are seen on the websites [www.homeinstead.com](http://www.homeinstead.com) and [www.homeinstead.co.nz](http://www.homeinstead.co.nz).

- 4.6. The Respondent is an individual provider of IT services with an address in Paraparaumu. In that role he has had frequent contact with individual franchisees within the New Zealand franchise network of Home Instead, Inc..

- 4.7. The Respondent registered the disputed domain name [homeinstead.net.nz](http://homeinstead.net.nz) on 19 February 2012.

- 4.8. There is no website at [homeinstead.net.nz](http://homeinstead.net.nz).

#### **5. Complainant’s contentions**

- 5.1. The Complainant alleges that the registration was unfair. It is said that the Respondent registered the disputed domain without authority and that he has since attempted to sell the domain name to the Complainant for more than the costs associated with registration.

#### **6. Respondent’s contentions**

- 6.1. The Respondent contends that the registration was not unfair. He says that he registered the domain name for the benefit of the Complainant’s franchisees.

He says that the Complainant had shown no interest in owning the disputed domain name before the Respondent's registration.

## **7. Discussion and findings**

7.1. 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;”

...

7.2. It follows 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).

7.3. Each will be considered in turn.

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

8.1. The Complainant has demonstrated rights in respect of the name “Home Instead” by virtue of its ownership of the registered word trade mark (IP number 669943).

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

9.1. The second requirement is that the Complainant’s name or mark is identical or similar to the Domain Name.

9.2. 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.

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

- 10.1. The third requirement is unfair registration. The form of unfair registration relevant here is registration for the purposes of sale, blocking or disrupting (para 5.1.1).
- 10.2. Whether this was such an unfair registration turns on the Respondent's primary purpose in registering the domain name. The issue is the Respondent's state of mind at the time of registration. There can never be direct proof of purpose. Such matters can be resolved only by deciding whether an adverse inference is justified having regard to all the surrounding circumstances.
- 10.3. The Respondent chose the disputed Domain Name so that email addresses under this Domain Name could effectively substitute email addresses under homeinstead.co.nz. This was done without authorisation from the holder of the trade mark. The effect was to place the email addresses of Home Instead franchisees under the control of the Respondent.
- 10.4. The Respondent runs an IT business. It is reasonable to infer that at the time of registration, he would not have intended to service the email needs of the franchisees without recompense for very long. The Respondent noted that although he has so far assisted franchisees without charge, he intended for others to remunerate him for his services. The details of his offer to exchange the domain name for \$5,000 is evidence of this. The sum sought is not the equivalent of documented out-of-pocket costs directly associated with acquiring or using the Domain Name. The \$5,000 demanded is said to reflect the time spent dealing with issues raised by the franchisees.
- 10.5. Despite any commendable intentions the Respondent may have with regard to the alleged plight of the franchisees, he may not legally withhold the Domain Name for consideration beyond documented registration costs. The Respondent made the unilateral decision to assist the franchisees. He has not shown any legal right to use the name.
- 10.6. I conclude that the Respondent registered the Domain Name for the primary purpose of gaining valuable consideration from the Complainant in excess of costs directly associated with acquiring or using the Domain Name. It was an unfair registration. The third requirement of the complaint is satisfied.

## **11. Decision**

- 11.1. The complaint is upheld. I direct that the disputed Domain Name "homeinstead.net.nz" be transferred to the Complainant Home Instead, Inc or its nominee.

### **Place of decision:**

Auckland

**Date:** 3 August 2012

**Expert Name:** Hon Robert Fisher QC

**Signature:**