

.nz Dispute Resolution Service

DRS Reference: 1183

**New Zealand Detector Dog
Services Limited**

v

Wildlife Contractors Ltd

Key words –registered trade mark – one domain name identical – two confusingly similar – Unfair Registration: unfair use – likely to confuse, mislead or deceive – unfairly disrupting complainant's business

1. Parties

Complainant:

New Zealand Detector Dog Services Limited
4 Gilberd Place
Torbay 0630
Auckland
New Zealand

Represented by: Mr Ben Cain of James & Wells, Solicitors & Patent Attorneys,
Hamilton

Respondent:

Wildlife Contractors Ltd
1559 Rangiora Road, RD 8
Te Puke
New Zealand

2. Domain Name/s

nzdetector dogs.nz
detector dogs.co.nz
detector dogs.nz

3. Procedural history

The Complaint was lodged on 16 August 2016 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 17 August 2016. The domain/s were locked on 16 August 2016, preventing any changes to the record until the conclusion of these proceedings.

The Respondent filed a Response to the Complaint on 24 August 2016 and the DNC so informed the Complainant on 5 September 2016. The Complainant filed a Reply to the Response on 12 September 2016. The DNC informed the parties on 06

October 2016 that informal mediation had failed to achieve a resolution to the dispute.

The Complainant paid Domain Name Commission Limited the appropriate fee on 12 October 2016 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").

Sir Ian Barker, the undersigned, ("the Expert") confirmed to the DNC on 18 October 2016 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

- 4.1. The Complainant is a New Zealand company, registered on 21 May 2009, and established by Mrs Janet Williams, its sole director.
- 4.2. The Complainant provides a range of canine detection services to commercial and governmental agencies deploying trained staff and dogs in the detection and deterrence of drug use. Its services cover drug detection for Police, for the Biosecurity arm of the Ministry for Primary Industries and for private employers.
- 4.3. The Complainant owns New Zealand Trade Mark registration No. 852137 with registration date 9 November 2011 for a service mark incorporating the words NZ DETECTOR DOGS (NZPD) and a paw icon. The Complainant has traded under the "NZ Detector Dogs" name exclusively since late 2010/early 2011.
- 4.4. The Complainant is the registrant of the domain names <nzdetector dogs.co.nz> and <nzdetector dogs.com>. Visitors to the latter site are redirected to the first-named site.
- 4.5. Evidence produced in considerable detail by the Complainant confirmed that since March 2011 the Complainant has traded extensively under the NZDD name: that its website had received many visits: that the Complainant's activities had been the subject of a television series which achieved popularity amongst viewers and on which the NZDD logo was prominent: that the Complainant has achieved coverage for its activities in the print media and on the Internet and social media: that the Complainant has received many positive testimonials from customers.
- 4.6. The Respondent is a New Zealand company incorporated in 1998 as Aotearoa Wildlife Export Ltd. It changed its name to Wildlife Contractors Ltd in 2008. It also traded as "International K9" for the training of conservation and mustelid dogs.
- 4.7. The director of the Respondents is Mr Guus Knopers who is also director of K9 Detector Dog Services Ltd ("K9") which is the Complainant's only competitor in New Zealand.
- 4.8. In October 2010, the parties, (the Complainant and the Respondent) entered into a Memorandum of Understanding for 12 months (MOU) and a Joint

Venture Project under which the Complainant agreed to provide dog services under the NZDD mark.

- 4.9. The above arrangements were terminated by the parties on 13 October 2013.
- 4.10. The Respondent registered the disputed domain names <detectordogs.co.nz> on 13 September 2014, <detectordogs.nz> on 1 October 2014 and <nzdetectordogs.nz> on 9 April 2015.
- 4.11. None of the disputed domain names is currently linked to an active website.
- 4.12. The Complainant's former solicitors wrote to the Respondent and Mr Knopers on 26 February 2016 complaining that he/they were making unauthorised use of the Complainant's forms and other documentation and operating procedures and confidential information after the termination of the contracts referred to in paragraph 4.8 above. The letter referred to a video interview by Mr Knopers in the "Bay of Plenty Times" on 29 October 2015 in which he stated that he worked for the Complainant. The letter asked the addressees to "cease and desist" from infringing the Complainant's rights and to cease using the disputed domain names.
- 4.13. No response was received by the Complainant or its solicitors to the above letter nor to a "follow-up" letter dated 24 March 2016.
- 4.14. The Complainant has instituted the High Court proceedings against, *inter alia*, the Respondent and Mr Knopers. The Expert has perused the Statement of Claim in these proceedings which do not apply to the disputed domain names.

5. Parties' contentions

a. Complainant

- 5.1. The disputed domain names are identical and/or confusingly similar to the Complainant's registered trade mark.
- 5.2. The Respondent registered the disputed domain names after its relationship with the Complainant had ended acrimoniously at a time when the Respondent knew well the Complainant's reputation and goodwill as a provider of dog detection services.
- 5.3. The disputed domain names are used as a "blocking" registration against the mark in which the Complainant has rights: they were registered to disrupt the Complainant's business unfairly and in order to allow the Respondent to pass itself off as the Complainant. Internet users can be misled into thinking that the Complainant is no longer trading.
- 5.4. The disputed domain names are unfair registrations under the Policy.

b. Respondent

- 5.5. There are several entities that have lodged vexatious complainants against the Respondent. All have been dismissed. The husband of Mrs Williams, the director of the Complainant, has been charged by the Police with assault and

trespass regarding an incident at Rangitoto College in connection with her perceived and warped view of “my business dealings”.

- 5.6. The Complainant did not take the opportunity to register the .nz domain names under the Preferential Registration Eligibility (PRE) period which expired on 30 March 2015 and which was available to registrants of .co.nz names such as the Complainant.
- 5.7. The Respondent secured the .nz sites with the intention to promote “our educational/charitable arm of our business where the brand of Night Zoo (NZ) Detector Dogs was to provide our youth an insight into the wildlife we encounter through our extensive use in the BioSecurity sector within the public sector and government contracts we hold. I wish to pursue my legal right to carry out business using this site.”
- 5.8. The Respondent and the Complainant have attempted resolution through lawyers. The .nz site was offered to be released on the open market but the Complainant did not accept “the offer of resolutions”. The Respondent denies wrongdoing and seeks costs.

c. Complainant's Reply

- 5.9. Neither the Complainant nor Mrs Williams has made vexatious complaints. The Respondent has never replied to letters from the Complainant's lawyers such as those referred to earlier. The Complainant has had no settlement offers from the Respondent and does not know who its lawyers are.
- 5.10. The alleged assault/trespass incident did not involve Mrs Williams and Mr Knopers who can have no personal knowledge of it.
- 5.11. The Complainant was unaware of the PRE. However, failure to register with the PRE period is not a bar to pursuing a complaint.
- 5.12. There is no evidence or website reference to support the claim to a charity or a business for Night Zoo Detector Dogs.
- 5.13. The Respondent's response demonstrates the Respondent's ill-will towards the Complainant and Mrs Williams. It is not entitled to an award of costs.

6. Discussion and findings

- 6.1. Relevant provisions of the Policy are as follows:

3. Definitions ...

Rights includes, but is not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business;

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.

Part A – Policy

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.
- 4.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

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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 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;

...

6. How the Respondent may demonstrate in its Response that the Domain Name is not an Unfair Registration

- 6.1 A non-exhaustive list of factors which may be evidence that the Domain Name is 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;

...

B2 The Complaint

...

B2.4 The Complaint may relate to more than one Domain Name, provided that those Domain Names are registered in the name of the Respondent.

6.2. The Complainant must therefore prove to the Expert on the balance of probabilities the following:

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

6.3. The requirement for a Complainant to prove Rights in respect of a name or mark is not a high threshold.

6.4. In view of the facts set out in Part 4 hereof, the Expert is satisfied on the balance of probabilities that the Complainant has rights in the trade mark NZ DETECTOR DOGS by virtue of the registration of that trade mark in November 2011.

6.5. The disputed domain name <nzdetectordogs.nz> is identical to the registered trade mark. The disputed domain names <detectordogs.co.nz> and <detectordogs.nz> are obviously confusingly similar to the registered trade mark.

6.6. The fact that the Complainant did not register the .nz names within the PRE is irrelevant is not a bar to the Complainant filing a complaint seeking transfer of the registration if the requirements of the Policy are satisfied.

6.7. The Expert is satisfied on the balance of probabilities that, in all the circumstances, the Domain Name is an Unfair Registration because the facts set out in part 4 and elsewhere in this decision demonstrate that:

- (a) the disputed domain names were registered in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights (para 3 of the Policy); and/or
 - (b) the use of the disputed domain names will take unfair advantage of, and be unfairly detrimental to, the Complainant's Rights (para 3 of the Policy); and/or
 - (c) the Respondent registered the disputed domain names as a blocking registration against a name or mark in which the Complainant had Rights (para 5.1.1(b) of the Policy); and/or
 - (d) the Respondent registered the disputed domain names primarily for the purpose of unfairly disrupting the business of the Complainant (para 5.1.1(c) of the Policy' and/or
 - (e) the Respondent had not demonstrated that the Domain Name is not an Unfair Registration as set out in paragraphs 6.1.1 and 6.1.2 of the Policy. The Domain Name has not been, and is not being, used for a legitimate purpose. In particular:
 - (i) there is no content on the websites accessed by the disputed domain names.
 - (ii) the disputed domain names were registered after the Respondent and the Complainant had terminated their business relationship;
 - (iii) there is no evidence to support the Respondent's claimed reason for the registration of the disputed domain names.
- 6.8. The Expert has not traversed details of the complaints or alleged complaints about the Complainant referred to in the Response. The reason is that these complaints are completely irrelevant to the enquiry that the Expert must make. Even more irrelevant is the hearsay reference by the Respondent to an allegation of assault and trespass against the husband of the director of the Complainant.
- 6.9. The Expert has considered the Statement of Claim filed in the High Court in proceedings brought by the Complainant and Mrs Williams against the Respondent Mr Knopers. The proceedings are not concerned with the disputed domain names and therefore they too are irrelevant and do not need to be considered by the Expert. Nor should the present Complaint be stayed because of the High Court proceedings.
- 6.10. There is no jurisdiction to make an order for legal costs as the Respondent seeks.

7. Decision

In view of the findings above, the Expert determines that the disputed domain names <nzdetector dogs.nz>, <detector dogs.co.nz> and <detector dogs.nz> be transferred to the Complainant.

Place of decision	Auckland
Date	31 October 2016
Expert Name	Hon Sir Ian Barker, QC

Signature


