

.nz Dispute Resolution Service

DRS Reference: 1234

Dell, Inc.

v

Jason Moul

Key words -

Domain name
dellshop.nz

Identical or similar trade mark or name

Registered mark - unregistered mark - well-known mark - similar - generic –
descriptive - overall impression - mark with generic word

Unfair registration

Unfair registration - offer to sell, rent or otherwise transfer - monetary demands, non-
monetary demands - unfairly disrupting the business of the complainant - blocking
registration

Procedure

Transfer

1. Parties

Complainant:

Dell, Inc.
a Delaware corporation
One Dell Way
Round Rock
Texas 78682
United States of America

Represented by: Stacey Campbell, AJ Park

Respondent:

Jason Moul
15 Top Road
Pukekohe
Auckland 2021
New Zealand

2. Domain Name

dellshop.nz (the "Domain Name")

3. Procedural history

- 3.1. The Complaint was lodged on 16 June 2017 and Domain Name Commission ("DNC"), notified the Respondent of the validated Complaint on 20 June 2017. The Domain Name was locked on 20 June 2017, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. The Respondent did not file a response.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 26 June 2017 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").
- 3.4. Robert Fisher QC, the undersigned, ("the Expert") confirmed to the DNC on 3 August 2017 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 Dell, Inc is a corporation registered in Delaware, United States of America. It is a well-known multinational computer technology company that develops, sells, repairs and supports computers and related products and services. The company was founded in 1984.
- 4.2. The Complainant owns numerous New Zealand trade mark registrations for the word DELL, the first being registered on 26 April 1988. The DELL word and combined marks are in classes 2, 9, 36, 37, 40 and 42.
- 4.3. In addition the Complainant trades DELL branded computers, computer parts and other goods in New Zealand online and through authorised retailers such as JB Hi Fi. It has done so for some 20 years. The Complainant has helpfully provided in its annexures evidence of its use of the DELL mark in trade in New Zealand.
- 4.4. In October 2015 the Respondent Jason Moulton registered the domain names <dellshop.co.nz> and <dellshop.nz>.
- 4.5. In November 2015 the Respondent asked the Complainant for permission to use its trade marks. He sought to enter into a business relationship with the Complainant. In December 2015 the Complainant wrote to the Respondent refusing to grant consent to the use of its trade marks and requesting transfer of the domain names immediately.

- 4.6. In January 2016 the Respondent agreed to transfer the domain names. He provided a signed Domainz Change of Name Holder form to the Complainant but did not provide the UDAI codes necessary to complete the transfer.
- 4.7. The Complainant's lawyers sought the codes from the Respondent without success for several months. On at least two occasions the Respondent would promise to provide the codes within days but fail to provide them.
- 4.8. On 3 July 2016 the Respondent advised the Complainant's lawyers that: "I'm not using them and have not [sic] intention of using them so when I get around to it I will send it to you."
- 4.9. On 15 August 2016 the Respondent provided the UDAI code relating to <dellshop.co.nz>. The Complainant transferred that domain to itself. However the Respondent has failed to provide a UDAI code for <dellshop.nz>, which is the Domain Name at issue.
- 4.10. More recently the Respondent stopped responding to the Complainant's attempts to contact him.

5. Parties' contentions

a. Complainant

- 5.1. The Complainant claims it has rights in the word DELL and relies on both its registered trade marks and its extensive use and promotion of the DELL trade mark. It submits that the word "shop" is non-distinctive and that the domain name is essentially identical to the trade mark DELL in which the Complainant has both registered and unregistered rights.
- 5.2. The Complainant argues that the unfair registration arises out of the Respondent registering the Domain Name, which he knew to be identical or similar to the Complainant's trade marks, and attempting to enter into a business relationship on the basis of his ownership of the Domain Name.
- 5.3. The Complainant also argues that the Domain Name was registered as a blocking registration against the DELL mark in which the Complainant has rights. The Complainant says the registration was done primarily for the purpose of unfairly disrupting the business of the Complainant. Lastly the Complainant says the Respondent has acted unfairly by agreeing to transfer the domain names to the Complainant and signing a document to that effect and subsequently failing to provide all the UDAI codes necessary to allow the transfer.

b. Respondent

The Respondent has not provided a response.

6. Discussion and findings

- 6.1. The dispute is governed by the Policy issued by Domain Name Commission Ltd on behalf of InternetNZ. Critical portions of the Policy for present purposes are:

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;

...

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. □

...

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;

...

- 5.2 Failure on the Respondent's part to use the Domain Name for the purposes of email or a web-site is not in itself evidence that the Domain Name is an Unfair Registration.

...

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

- 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:

...

- 6.4 Trading in Domain Names for profit, and holding a large portfolio of Domain Names, are of themselves lawful activities. The Expert will review each case on its merits. □

- 6.2. It will be seen that to support a complaint of the present kind (as distinct from complaints regarding sub-domains) 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 Names (para 4.1.1); and
- c) Unfair registration in the hands of the Respondent (para 4.1.2).

(a) Rights in respect of a name or mark

- 6.3. The Complainant has demonstrated rights in respect of the name DELL based on its New Zealand registered trade marks and its business activities in New Zealand using that name.

- 6.4. I accept that the Complainant has rights in respect of the name DELL. This requirements is satisfied.

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

- 6.5. The second requirement is to show that the Complainant's name or mark is identical or similar to the Domain Name.

- 6.6. The generic word "shop" in the Domain Name "dellshop" adds nothing to the word "dell" other than to suggest the website sells products or services related to or in association with Dell. It does little to deflect attention from the only word of substance in the term, namely "dell". The word "shop" does not sufficiently differentiate the term from the Complainant's marks.

- 6.7. I am satisfied that the Domain Name is similar to DELL. This requirement is satisfied.

(c) Unfair registration in the hands of the Respondent

- 6.8. The third requirement is unfair registration. The Policy includes a non-exhaustive list of factors that may be evidence of unfair registration (paras 5.1.1 to 5.1.5).
- 6.9. I accept that registration primarily for unfair gain is a reasonable inference. I make this inference from:
- 6.9.1. the well-known nature of the mark "DELL",
- 6.9.2. the failed attempt by the Respondent to enter into a business relationship with the Complainant immediately after he had registered the Domain Name, and
- 6.9.3. his agreement to transfer the Domain Name and subsequent unexplained delays in effecting the transfer.
- 6.10. Although the correspondence relating to the Respondent's attempts to enter into a business relationship were unavailable, it is reasonable to infer that the direct or indirect object of the Respondent was to force the Complainant to purchase or rent the Domain Name at a profit to the Respondent. As such it was and is an unfair registration within the meaning of para 5.1.1.
- 6.11. The third and final element is therefore satisfied.

7. Decision

- 7.1. All three elements identified in para 6.2 above having been satisfied I determine that the disputed Domain Name should be transferred to the Complainant

Place of decision Auckland

Date 10 August 2017

Expert Name Hon Robert Fisher QC

Signature

A handwritten signature in blue ink, appearing to read 'R. Fisher', written in a cursive style.