

.nz Dispute Resolution Service

DRS Reference: 1236

Opinel SAS

v

Hamish Pirie

Key words -

Domain name

opinel.co.nz opinel.nz

Identical or similar trade mark or name

Registered mark

Unfair registration

Unfair registration – unfair use – offer to sell, rent or otherwise transfer – likely to confuse, mislead or deceive – prior relationships between the parties – unfairly disrupting the business of the complainant – blocking registration

1. Parties

Complainant:

Opinel SAS
Simon Gapes
Level 10, 161 Collins
Street Melbourne, VIC
3000 Australia

Respondent:

Hamish Pirie
PO Box 154
Nelson 7040
New Zealand

2. Domain Name/s

opinel.co.nz
opinel.nz

3. Procedural history

- 3.1 The Complaint was lodged on 28 June 2017 and the Domain Name Commission (“DNC”) notified the Respondent of the validated Complaint on 29 June 2017. The deadline for a response was set as 20 July 2017. The domains were locked on 28 June 2017, preventing any changes to the record until the conclusion of these proceedings.

- 3.2 On 12 July 2017, the Respondent sent an email to the DNC where he acknowledged receipt of the Complaint and sought an extension of time for filing a formal response. An extension to 26 July 2017 was granted by the DNC on 13 July 2017.
- 3.3 No response was received by that time, and on 28 July 2017 the Respondent confirmed that he would not be filing a formal response.
- 3.4 The Complainant paid Domain Name Commission Limited the appropriate fee on 09 August 2017 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.5 Kevin Glover, the undersigned, (“the Expert”) confirmed to the DNC on 21 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 is Opinel SAS, a French business which has manufactured and marketed wooden-handled knives since 1890.
- 4.2 The Complainant is the registered proprietor of various trademarks worldwide, including New Zealand trade mark no. 706610 for the word OPINEL in relation to hand tools and hand-operated implements, cutlery, razors and knives. Trade mark no. 706610 has been registered since 6 January 2004.
- 4.3 The Complainant elected to rely only on its registered trade mark, and did not submit any evidence showing that it has rights at common law in New Zealand or supporting a claim that the mark is well-known in New Zealand.
- 4.4 The Complainant has an official New Zealand distributor, who is not the Respondent.
- 4.5 The Respondent registered the domain names opinel.co.nz and opinel.nz on 4 September 2015.
- 4.6 The Complainant’s French attorneys wrote to the Respondent on 7 April 2017 requesting that the Domain Names be transferred to the Complainant. The Respondent replied by email and refused to transfer the Domain Names. In the Respondent’s response to the Complainant’s French attorneys he said that he was a reseller of “Opinel” products in New Zealand, and in 2015 had met Opinel’s international sales manager and visited Opinel’s factory. The Respondent also offered to sell the Domain Names to the Complainant for 5,000 Euros each.
- 4.7 The Complainant did not engage in further correspondence and filed the Complaint through its Australian attorneys.
- 4.8 The Complainant was unable to confirm or deny the matters alleged by the Respondent in his email in April 2017.

4.9 The Complainant alleged that the Domain Names were not being used, in that they did not resolve to websites.

5. Parties' contentions

a. Complainant

5.1 The Complainant says that it sells approximately 15 million knives worldwide annually. It contends that it has rights in the name "Opinel" as a result of its registered New Zealand trade mark (being a word mark). The Complainant says that the OPINEL trade mark has no descriptive meaning.

5.2 Its primary website is located at opinel.com, and it also uses the domain opinel.com.au for its Australian website.

5.3 The Complainant's underlying objection is that the domain names opinel.co.nz and opinel.nz are unfair registrations, and that the domain names were 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. The Complainant further submits that the domain names are used or likely to be used in a manner which will take unfair advantage of or be unfairly detrimental to the Complainant's rights.

5.4 The Complainant makes a number of specific sub-allegations in terms of paragraph 5.1 of the Policy:

- (a) That the Respondent has registered the Domain Names for the purpose of selling them to the Complainant for consideration in excess of the Respondent's costs (para 5.1.1(a));
- (b) That the Respondent has registered the domain names as blocking registrations against a trade mark in which the Complainant has rights in order to unfairly disrupt the business of the Complainant (para 5.1.1(b));
- (c) That the Respondent is using or likely to use the domain names in a way which is likely to mislead consumers into believing that the domain names are registered or authorised by the Complainant (para 5.1.2);
- (d) That the domain names were registered arising out of a relationship between the Complainant and the Respondent in circumstances indicating that it was intended the Complainant would be the registrant (para 5.1.5); and
- (e) That the Respondent has no legitimate interest or rights in the domain names.

b. Respondent

5.5 The Respondent did not file a formal response to the Complaint.

6. Discussion and findings

6.1 This complaint is governed by the Policy.

6.2 Under clause 4.1 of the Policy, the Complainant is required to prove on the balance of probabilities:

- That the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Names (paragraph 4.1.1); and

- That in each case the Domain Name, in the hands of the Respondent, is an Unfair Registration (4.1.2).

6.3 The term “Unfair Registration” is defined paragraph 3 of the Policy 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.

6.4 Paragraph 5 of the Policy sets out matters relevant to determination of whether a respondent's registration or use of a domain name amounts to an 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 trademarks 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.

6.5 Further, the meaning of “Unfair Registration” has been discussed in a number of DRS cases over the years, including a comprehensive review recently in the *Yellow Holdings Limited v Eurobelt Limited* appeal (DRS 1116). There, the Appeal Board distinguished between the principles applicable to initial unfair registration and use unfair registration.

6.6 The Appeal Board summarised the principles relating to “initial unfair registration” as follows at paragraph 13.18:

“The principles applicable to a case like the present one can therefore be summarised as follows:

- (a) Where reliance is placed on para 5.1.1 to establish unfair registration, the focus lies solely on the respondent’s purpose at the time of registering the domain name.
- (b) For that kind of unfair registration, events after registration could be relevant only if they retrospectively indicate what the respondent’s purpose is likely to have been at the time of registration.
- (c) Because the possibility of a connection between original purpose and subsequent conduct recedes over time, a respondent’s actions many years after registration are unlikely to shed light on the purpose for which the domain name had been originally registered.
- (d) The last point is reinforced by para 5.4 of the Policy which precludes an expert from taking into account evidence of acts or omissions amounting to unfair registration or use which occurred more than three years before the date of the complaint.
- (e) There is no principle that an adverse inference will normally be drawn as to the respondent’s purpose if the complainant’s mark was well known at the time of registration and the respondent has not used the domain name since. These are simply two out of an infinite number of potentially relevant considerations.
- (f) Lack of active use of a domain name could never, without more, justify an adverse inference as to the purpose for which it had been registered.
- (g) Whether a respondent had one of the purposes referred to in para 5.1.1 is ultimately a question of fact which must be decided according to the evidence presented in the particular case.”

6.7 Alternatively, the Complainant must show 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”.

A. Rights

The first step is to consider the Complainant’s rights in relation to the word OPINEL.

The Complainant has had a registered trade mark for the word OPINEL since 2004. This provides a proper basis for asserting rights in the name “Opinel”, being identical to the name appearing in the Domain Names.

For completeness, the Complainant asserted in its complaint that the OPINEL mark is “well-known”, in the context of contending that the alleged past discussions between the parties do not entitle the Respondent to register domain names containing the mark.

The Complainant has not filed any evidence which would provide a basis for finding that the mark being well-known in New Zealand, such as sales figures or the number of retailers selling OPINEL-branded products.

The Complainant has shown that it has rights in the name OPINEL and as such it remains to consider whether the Domain Names are “unfair registrations” in the hands of the Respondent.

B. The domain names were registered primarily for the purpose of sale to the Complainant (para 5.1.1(a))

The Complainant has contended that the Domain Names were registered in order to sell them to the Complainant. As noted by the Appeal Board in *Yellow Holdings Limited v Eurobelt Limited*, the critical timing for allegations regarding paragraph 5.1.1(a) is the time of registration, being September 2015. The issue is whether the Domain Names were acquired primarily for the purpose of re-sale at that time. The Complainant bears the onus of showing that the Domain Names were registered primarily for the purpose of re-sale.

The Complainant refers to correspondence between its French attorneys and the Respondent in May 2017, and in particular the Respondent's offer to sell the Domain Names in his reply. This is the primary evidence which it relies upon in support of the allegation that the Domain Names were registered for the purpose of selling the Domain Names to the Complainant for consideration in excess of the Respondent's costs.

The evidence regarding the exchange in May 2017 does not advance matters in relation to the Respondent's intentions as at September 2015. There is no contemporaneous evidence from that time which shows an intention to sell the Domain Names to the Complainant. In this case the offer to sell was made in response to the approach by the Complainant's attorneys. While a domain name registrant making a proactive approach to a rights holder at the time of registration or shortly afterwards could be evidence of registration for the purpose of resale, a reactive offer to sell does not necessarily amount to evidence of an unfair registration.

In the circumstances, there is insufficient evidence to support the Complainant's argument regarding paragraph 5.1.1(a). The Complaint does not succeed on this ground.

C. The Domain Names were registered primarily as blocking registrations to prevent registration by the Complainant (para 5.1.1(b))

The Complainant says that the Domain Names have been registered as blocking registrations in order to unfairly disrupt the business of the Complainant by preventing it from registering the Domain Names, in terms of para 5.1.1(b). It says that it is possible that the Respondent registered the Domain Names in order to unfairly obtain leverage in desired negotiations with the Complainant in relation to distribution of its products in New Zealand.

As with the allegation under paragraph 5.1.1(a), the onus is on the Complainant to show that the Domain Names were registered in September 2015 primarily in order to prevent the Complainant from registering them.

There is no evidence to support this. The Respondent's email to the Complainant's French attorneys in April 2017 suggested that his primary intention was to use the Domain Names to host websites which sold genuine Opinel products, and the Complainant did not adduce any evidence contrary to this.

The allegation that the Domain Names were registered primarily to block the ability of the Complainant to register them is not made out on the evidence before the Expert.

D. Using the domain names in a way which is likely to mislead consumers (para 5.1.2)

The Complainant submits that the Domain Names do not resolve to live websites. It asserts that the current use of the Domain Names is likely to mislead consumers into believing that the Domain Names have been registered or authorised by the Complainant. It further contends that active use of the Domain Names by the Respondent would be likely to take advantage of or be unfairly detrimental to the Complainant's rights.

The DNC file confirms that, as at the date of the Complaint, neither Domain Name resolved to a live website.

Paragraph 5.2 of the Policy is relevant to consideration of this issue. That paragraph provides:

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

The Expert's decision in *Salvatore Ferragamo S.p.A. v Yan Sun* (DRS 1181: *ferragamo.nz*) is also relevant. In that case, the Expert held that the complainant's distinctive and well-known mark, coupled with the respondent's failure to use the domain name, amounted to an unfair registration in terms of paragraph 5.1.2. This was on the basis that consumers visiting the domain name and finding that it did not resolve to a website could be discouraged from locating the genuine site, being unfairly detrimental to the Complainant's Rights.

The matter is finely balanced in this case. The name "Opinel" is distinctive although, unlike *Ferragamo*, the Complainant has not proved that it is well-known.

The Respondent's position, as set out in his email of 7 April 2017 annexed to the Complaint, was that he had intended to use the Domain Names in relation to genuine goods, and was already selling OPINEL-branded products through another channel (albeit that this was not specified).

The credibility of this assertion was undermined, however, by the Respondent's delay in actually establishing a website and his failure to file a response or any material to corroborate his contention. While paragraph 5.1.2 provides that a failure to use the Domain Names is not "in itself" evidence that the Domain Name is an Unfair Registration, the Respondent's failure to explain its delay is material.

In the absence of a formal response explaining and corroborating the position the Complainant has shown that the registrations are "unfair" in this case. The Expert is satisfied on balance that consumers would likely be misled if they were to visit the Domain Names on the basis that they expect to be visiting the Complainant's New Zealand site or that of its New Zealand distributor. Moreover, any use of the Domain Names by the Respondent for email would be highly likely to mislead or deceive, since the recipients would be receiving messages from someone whose email address ended in "opinel.co.nz" or "opinel.com".

For completeness, the Expert visited both of the Domain Names in September 2017. The domain name opinel.nz still did not resolve but there was a website located at opinel.co.nz. That website was activated on an unknown date which must have been between the date of complaint (28 June 2017) and the date when it was visited (1 September 2017).

The Respondent's website located at opinel.co.nz has Opinel-branded products for sale. It is not possible to determine whether or not those products are genuine and sourced from the Complainant's New Zealand distributor, parallel imported or counterfeit, but for the purposes of this analysis it is assumed that they are legitimate.

The website contains a prominent disclaimer at the top of the home page, which reads:

"This website is operated by Gearshop, a NZ retailer of Opinel products and is in no way affiliated to Opinel France. We are an authorised reseller supplied by the official NZ Opinel distributor."

In the ordinary course of things, the complaint should be determined based on the position as at the date on which it was submitted. Evidence of earlier matters can also be relevant. In some cases subsequent conduct might be relevant, but in fairness to the complainant and to avoid the possibility of complaints needing to be amended this should only happen where it provides further grounds for complaint rather than allowing the respondent to remedy the situation having received the complaint and that further action being weighed in its favour.

For this reason, the website and its disclaimer are not relevant to determination of the Complaint, which is assessed on the basis of events up until 28 June 2017. The addition of the website does not affect the conclusion that the Complainant has shown evidence relevant to paragraph 5.1.2 of the Policy.

The Complainant succeeds in relation to the allegation that consumers are likely to be misled as alleged in relation to both of the Domain Names, and that being detrimental to the rights associated with the Complainant's registered trade mark for the word "OPINEL" these are Unfair Registrations for the purposes of the Policy.

E. Registrations arise out of a relationship (para 5.1.5)

The Complainant contends that the Domain Names were registered arising out of a relationship between the Complainant and the Respondent in circumstances indicating that it was intended the Complainant would be the Registrant. It says this in light of the claim by the Respondent that the parties have been discussions.

Paragraph 5.1.5 of the Policy provides that the factors which may be evidence that the Domain Names are Unfair Registrations include:

"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..."

The Complainant is required to prove (on the balance of probabilities) that there was a joint intention for the purposes of paragraph 5.1.5. It is more apposite for situations where there was a joint venture or distribution relationship with either an express or implied term as to ultimate entitlement to the domain name, on a contractual or quasi-contractual basis.

In this case the Respondent's decision to register the Domain Names seems to have been without specific reference to or permission from the Complainant. The Complaint cannot be sustained based on paragraph 5.1.5 in those circumstances.

F. The Respondent has no legitimate interest or rights in the domain names

Finally, it is contended that the Respondent has no legitimate interest or rights in the Domain Names.

In terms of the Policy, this is not necessarily evidence of an Unfair Registration of itself. A party does not need to justify their choice of a domain name, although the absence of an explanation may be relevant to the overall assessment of whether or not the registration is unfair. It is not a ground in itself.

This allegation does not lead to a finding of the Domain Names being unfair registrations.

Summary as to findings

The Domain Names are “unfair registrations” for the purposes of the Policy, since they could mislead members of the public at present and their use by a party other than the Complainant or its official New Zealand distributor is likely to mislead or deceive. While the other grounds of the Complaint are not upheld, the Expert is satisfied that the Domain Names have been used or are likely to be used in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant’s Rights.

7. Decision

Complaint upheld, transfer of opinel.co.nz and opinel.nz ordered.

Place of decision **Auckland**

Date **13 September 2017**

Expert Name **Kevin Glover**

Signature

