

**.nz Dispute Resolution Service**

**DRS Reference: 1238**

**Eat My Lunch Limited v Chris AC  
Lisa King**

**Key words -**

*Domain name*  
eatmydinner.nz eatmydinner.co.nz

*Identical or similar trade mark or name*

Registered mark – similar - unregistered mark

*Rights*

Demonstrable preparations to use - generic – descriptive

*Unfair registration*

*Procedure*

Evidence - remedies

**1. Parties**

**Complainants:**

Eat My Lunch Limited  
Lisa King  
5 Galatos Street  
Auckland Central 1010  
New Zealand

Represented by: In Sook Scorgie, DLA Piper New Zealand

**Respondent:**

Chris AC  
Auckland  
New Zealand

**2. Domain Name/s**

eatmydinner.nz  
eatmydinner.co.nz

### **3. Procedural history**

- 3.1 The Complaint was lodged on 4 July 2017 and the Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 17 July 2017. The domains were locked on 14 July 2017, preventing any changes to the record until the conclusion of this proceeding.
- 3.2 No Response was received.
- 3.3 The Complainants paid the DNC the appropriate fee on 4 September 2017 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4 Maria Dew, the undersigned, (“the Expert”) confirmed to the DNC on 18 September 2017 that she knew of no reason why she could not properly accept the invitation to act as expert in this case and that she knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question her independence and impartiality.
- 3.5 On 27 September 2017, the Complainants submitted a further submission. The Respondent was notified of that submission and given a further opportunity to respond. No Response was received.
- 3.6 This decision is based on the submissions and documents provided by the complainant and the DNC registration details and its correspondence with the parties. The Complaint submitted invited the Expert to view the Respondent’s website and a number of other websites which has also been done and these are referenced below.

### **4. Factual background**

- 4.1 The Complainants, Lisa King and Eat My Lunch Limited, have alleged that the domain names ‘*eatmydinner.nz*’ and ‘*eatmydinner.co.nz*’ held by the respondent, Chris AC, is an Unfair Registration. Under the Policy, DNC has the power to transfer, suspend or cancel or otherwise amend a domain name registration which is found by an Independent Expert to be an Unfair Registration. The Complainants seek a transfer of both of the domain name registrations.

#### ***Eat My Lunch (EML)***

- 4.2 Eat My Lunch Limited (EML) is a New Zealand registered company incorporated in October 2014 and trading since early 2015. EML operates a catering service,

preparing and delivering individual meals to order. For every meal bought from EML, a lunch is given to a child in need in New Zealand. One-off meals and corporate catering can be purchased from EML, but it appears to primarily operate as a service subscribed to by individuals.

- 4.3 Ms King is a director and shareholder of EML. She has owned Trade Marks registered with the Intellectual Property Office of New Zealand (IPONZ) including marks that are images incorporating the words “Eat My Lunch” registered since 13 March 2015 and 8 May 2015 respectively, and the Trade Mark ‘Buy One. Give One’. Since October 2014, Ms King has also owned the domain names ‘[www.eatmylunch.co.nz](http://www.eatmylunch.co.nz)’ and ‘[www.eatmydinner.co.nz](http://www.eatmydinner.co.nz)’. Ms King had licensed use of these Trade Marks and domain names to EML. The further submission on behalf of the Complainants states that since filing the complaint, Ms King has assigned both Trade Marks to the EML.
- 4.4 EML currently operates its business in Auckland, Wellington and Hamilton. The Complainants state EML delivers approximately 1,500 lunches to children each day and has over 6,000 customers. They also state EML has sold over 450,000 lunches (and given a corresponding number of lunches) in 48 schools across Auckland, Hamilton and Wellington.
- 4.5 EML provided DNC with brand research from May 2017. The key findings in that research included that nationally, brand awareness was less than 50% but in the “*key market*”, Auckland, brand awareness was at 50%.
- 4.6 In its complaint, EML referred to evidence of its public profile and goodwill. EML has referred to the fact that it is supported by well-known New Zealand chef, Michael Meredith. The Complainant’s evidence made reference to a number of web based links referring to Mr. Meredith and his involvement with EML.<sup>1</sup>
- 4.7 EML also submitted references to online articles detailing public figures who have been involved with EML, including gold medalist Liam Malone<sup>2</sup> and the Hurricanes<sup>3</sup>. EML produced evidence of links to its Facebook page with over 54,000 fans. It also produced evidence of various business awards it has won, including the Westpac

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<sup>1</sup> “Michael Meredith: His Kitchen Rules”, NZ Herald, [http://www.nzherald.co.nz/lifestyle/news/article.cfm?c\\_id=6&objectid=11503150](http://www.nzherald.co.nz/lifestyle/news/article.cfm?c_id=6&objectid=11503150) (published 29.08).

<sup>2</sup> The Project NZ Facebook Page, [https://www.facebook.com/TheProjectNZ/videos/995942860542367/?autoplay\\_reason=gatekeeper&video\\_container\\_type=0&video\\_creator\\_product\\_type=2&app\\_id=2392950137&live\\_video\\_guests=0](https://www.facebook.com/TheProjectNZ/videos/995942860542367/?autoplay_reason=gatekeeper&video_container_type=0&video_creator_product_type=2&app_id=2392950137&live_video_guests=0) (published 11.05.17).

<sup>3</sup> “Hurricanes team up to help feed hungry school kids”, Stuff.co.nz, <http://www.stuff.co.nz/national/health/90563551/hurricanes-team-up-to-help-feedhungry-school-kids> (published 17.03.17).

Supreme Business Excellence Award and awards in the New Zealand Innovation Awards and New Zealand Sustainability Awards.

- 4.8 EML's complaint filed has also evidenced the use of the "Eat My Lunch" Trade Mark, under license to partner companies such as Pump NZ, Café Láffare, New Zealand Kettle Korn and Brinks NZ Chicken. The Complainants contend this further extends recognition of their brand.
- 4.9 The food offered by EML through its Eat My Lunch website is lunch meals consisting of recipes using fresh ingredients. The examples of lunch meals on the EML website are "*beef pretzel roll, corn chips with salsa dip, a mini date loaf and banana*" and "*large roast vegetable salad, Snickadoodle, Hummus and Beetroot Dip with Crackers, Bliss Balls and a piece of fruit*".

### ***Eat My Dinner***

- 4.10 On 13 June 2016, Ms King and EML, publicly announced plans to expand into dinner services. The Complainants have produced the web link to this public announcement published on "*idealog*" the website on that date. The article records EML's growth over its first year in business and that Ms King "*plans to expand to dinner*", with one lunch to be given to a child for every dinner bought.<sup>4</sup>
- 4.11 This article is the only public announcement presented by the Complainants, as evidence of EML's plans to expand into dinner meals. The phrase "*eat my dinner*" is not used in the article. There is no evidence presented by the Complainants of any other publicly available reference to EML providing dinner services made prior to 30 June 2016.
- 4.12 On 30 June 2016, the Respondent registered the domain name '*eatmydinner.co.nz*'. On 2 July 2016, the Respondent registered the domain name '*eatmydinner.nz*'. There is no evidence presented by the complaint that the Respondent has taken any active steps to use either domain name in connection with any business.
- 4.13 On 1 February 2017, Ms King applied to IPONZ for a Trade Mark incorporating the words "Eat My Dinner". The application was filed on 1 February 2017 and accepted on 22 February 2017. No opposition to the registration of the Trade Mark was received. The trademark was registered and accepted on 2 August 2017.

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<sup>4</sup> "Eat My Lunch toasts to turning one with big plans for the future"  
<http://idealog.co.nz/venture/2016/06/eat-my-lunch-toasts-turning-one-big-plans-future> (published 13.06.16, viewed 26.09.17).

- 4.14 The Complainants state they were not aware the Respondent had registered the domain names 'eatmydinner.nz' and 'eatmydinner.co.nz', when Ms King applied for the "Eat My Dinner" Trade Mark.
- 4.15 In September 2017, EML and Ms King launched the "Eat My Dinner" segment of EML's business. From 4 September 2017, the launch of "Eat My Dinner" has been promoted on the Eat My Lunch Facebook page.
- 4.16 EML commenced delivering dinners to various suburbs throughout Auckland on 18 September 2017. The dinners advertised on the EML website are "*Chipotle Chicken & Barley Wild Rice: Chipotle chicken breast, roasted beetroot & wilted kale with barley/wild rice, honey glazed carrots, whipped feta, toasted almonds and a miso dressing*" and "*Moroccan Lamb Tagine: Moroccan spiced rubbed lamb shoulder, savoury couscous, mint and cucumber yoghurt, topped off with toasted cashews*".
- 4.17 As at the date of this determination, the Eat My Dinner business is operated through EML's website, "[www.eatmylunch.nz](http://www.eatmylunch.nz)".

## **5. Respondent**

- 5.1 The Respondent has not filed any evidence or submissions. The Expert is necessarily limited to the evidence presented by the Complainants, which includes reference to the Respondent's website [www.letseat.co.nz](http://www.letseat.co.nz) and the Complainants correspondence with the Respondent during August 2017.
- 5.2 The Complainants have produced their correspondence with the Respondent, named as Chris Ah Chee, Let's Eat Catering at the email address "chris@letseat.co.nz".
- 5.3 The Respondent's website notes that it operates a commercial catering business, "Ah Chee Sons, Let's Eat Catering", with the place of business given as 275 Church Street, Onehunga. The records of the registrations of the Domain Names record the registrant's contact address as also being 275 Church Street, and email address being [accounts@letseat.co.nz](mailto:accounts@letseat.co.nz).
- 5.4 The "about" page of the Respondent's website advertises "Let's Eat Catering" as "*a family owned business offering affordable catering anywhere in the greater Auckland region*". The website also states "*Let's Eat Catering is one of the most trusted names in corporate catering, event catering, and private party catering throughout Auckland*" and "*With 25 years catering for Eden Park and other major Auckland event venues, Let's Eat Catering have become a household name throughout Auckland*". The

website states that the business specialises in corporate catering and catering weddings and other large private functions.

- 5.5 The examples of catering pictured on the website include children's birthday cakes, gourmet sweets, fruit platters, noodle boxes, sushi platters and various finger foods. Menus available on the website advertise lunch options consisting mainly of sandwiches and other bread based meals. A buffet menu is also available on the website which advertises a large variety of salads, hot vegetable dishes, various meat and fish based mains and various dessert recipes. There is no specific dinner menu available on the website. There is also no indication on the website that individual dinner meals are sold by the Respondent.

## **6. Attempts to resolve issues**

- 6.1 On 1 April 2017, the Complainants contacted the Respondent, stating they would like to purchase the Domain Names. The Complainants have produced a copy of a text message in April 2017, sent to the Respondent. The Complainants advise in the text *"we own the trade mark in nz for eatmydinner and eat my lunch. We have been advised that you are infringing on our trademark"*.
- 6.2 On 26 April 2017, the Respondent responded with a text message, stating *"sorry to say but have a use for the domain"*.
- 6.3 On 4 July 2017, the Complainants lodged this complaint. The Respondent was sent a copy of this complaint on 17 July 2017.
- 6.4 On 19 July 2017, the Respondent contacted the Complainants about the possibility of the Complainants purchasing the Domain Names. During negotiations between the parties, the Respondent stated by email *"...we are in effect a competitor of the same/similar business"* as EML. The Respondent then elaborated in subsequent email correspondence in August 2017, *"We have a Dinner pack supply for two people, a family or individual meals on a weekly base"*, and stated that this was the reason for registering the Domain Names.
- 6.5 The parties have been unable to agree on a sale price for the Domain Names. The Complainant has disclosed the last offers between the parties and it appears the Respondent's last offer to sell was \$4,000 for 'eatmydinner.co.nz' and \$2,000 for 'eatmydinner.nz'. The Complainants offered \$4,000 in total for both domain names.

- 6.6 As at the date of this determination, there is no evidence presented by the Complainant that either of the Domain Names is being used in business by the Respondent.

## **7. Parties' contentions**

### ***Complainant rights***

- 7.1 The Complainants submit they have rights in respect of names/marks "Eat my Lunch" and "Eat my Dinner" that are both similar and/or identical to the Domain Names. They rely on both registered and unregistered Rights to found the complaint.
- 7.2 The Complainants claim the Domain Names "Eat my Dinner" were confusingly similar to their existing registered Trade Mark name "Eat My Lunch" at the time of registration of the Domain Names. The Complainants maintain that their established business "Eat My Lunch" also gave them unregistered rights to the name "Eat My Dinner" at the time of registration, as they assert both names allude to services involving food as well as the social enterprise aspect of EML's business.
- 7.3 Secondly, the Complainants rely on the registered Trade Mark rights to the name "Eat My Dinner", filed on 1 February 2017 and registered and accepted on 22 February 2017.

### ***Unfair registration***

- 7.4 The Complainants make the following submissions in support of their complaint of Unfair Registration:
- (a) Traders other than EML would not, without improper motive, want to use the same names, or similar names, in connection with describing their own business, as the names would not be used in the ordinary course of business to describe catering services. The names "Eat My Lunch" and "Eat My Dinner" allude to services involving food as well as the concept that a meal is donated to a child in need for each meal purchased.

- (b) Ms King has owned “Eat My Lunch” Trade Marks since October 2014, and her application for the “Eat My Dinner” Trade Mark was accepted by IPONZ in February 2017.
- (c) The Respondent registered the Domain names after EML started trading and after Ms King and EML announced plans to expand into dinner services.
- (d) EML has significant goodwill. The potential for confusion between EML and other traders creates a risk to EML and Ms King’s reputation, particularly given the social enterprise aspect of the business.
- (e) The name “Eat My Dinner” is sufficiently similar to the name “Eat My Lunch” so that another trader could not reasonably have hoped to have registered a Trade Mark with IPONZ for “Eat My Dinner” without the express permission of Ms King.
- (f) The Respondent has not used the Domain Names in connection with a genuine offering of goods or services or made legitimate non-commercial use or fair use of the Domain Names.
- (g) The Complainants are not aware of any other trader who operates or intends to operate under the “Eat My Dinner” name, and if so such a trader would likely be in breach of Ms King’s Trade Mark rights.
- (h) The Respondent operates a catering company. If the Respondent uses the Domain Names, there is some significant risk consumers will associate the Domain Names with the EML business, which will take advantage of and pose a risk to Ms King’s and EML’s goodwill in the names they own/licence.
- (i) The Respondent has informed the Complainants it intends to use the Domain Names.
- (j) The sale price asked by the Respondent for the Domain Names is significantly more than the Respondent’s out-of-pocket costs directly associated with acquiring or using the Domain Names, given there has been no use of the Domain Names by the Respondent.

7.5 In general, the Complainants submit the circumstances of the registration of the Domain Names at the time of registration take unfair advantage of, or are unfairly

detrimental to the Complainants' rights. In particular, they assert under DRS 5.1.1 and 5.1.2:

- (a) The Domain Names were registered in order to be sold at a price well in excess of the out of pocket costs of registration;
- (b) The Domain Names were registered as a blocking registration;
- (c) The Domain Names were registered to unfairly disrupt the Complainants' business; and/or
- (d) The Domain Names were registered to be used in a misleading or deceptive way.

7.6 Finally, the Complainants submit that as they now have Trade Mark rights over the name "Eat My Dinner" any future use of the domain names by the Respondent will infringe the Trade Marks Act 2002 and could amount to the tort of passing off or a breach of the Fair Trading Act 2002.

7.7 The Complainants seek transfer of the Respondent's domain names registration to it.

## **8. The Policy**

8.1 The Dispute Resolution Service Policy ("the DRS Policy"), paragraph 4.1, sets out the test that applies in respect of any complaint of Unfair Registration. The Complainant is required to prove to the Expert, on the balance of probabilities, that the following two elements are present:

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

8.2 An Unfair Registration is defined, in paragraph 3 of the DRS Policy, as:

***"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."*

8.3 This definition of Unfair Registration involves under (i) a consideration of the evidence of whether it was an unfair registration at the time the registration took place. Then under (ii) there is the opportunity for an alternative consideration of whether the registration has subsequently been used or is likely to be used unfairly.

*Evidence of Unfair Registration*

8.4 The DRS Policy, paragraph 5, also sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration including, as may be relevant to this present case:

(a) DRS 5.1.1 - Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

(i) 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; or

(ii) as a blocking registration against a name or mark in which the Complainant has Rights; or

(iii) for the purpose of unfairly disrupting the business of the Complainant (DRS 5.1.1).

(b) DRS 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.

8.5 There is no evidence or argument in this case, that other provisions of DRS 5.1.3 to 5.1.5 are applicable in the present case.

- 8.6 It is noted that under DRS 5.2, the 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.

*Evidence that may demonstrate the domain name is not an unfair registration*

- 8.7 The DRS Policy, at paragraph 6, also sets out a non-exhaustive list of factors which may be relied on by a Respondent as evidence the Domain Name is not an Unfair Registration. Although the Respondent has not engaged in this complaint, the following factors remain relevant to assessing whether this is an unfair registration.

- 8.8 Under DRS 6.1.1, it will be relevant to consider whether there is evidence that before the Respondent was aware of the cause for complaint if it did any of the following:

- (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.

- 8.9 Under DRS 6.1.2, it is also relevant whether the Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character.

- 8.10 Under DRS 6.1.4, it will also be a factor that may demonstrate fair registration if it is not part of a pattern of registrations significantly different from other domain names registered by the Respondent.

**9. Expert discussion and findings**

***Do the Complainants have relevant rights?***

- 9.1 The Expert is satisfied on the evidence presented that the Complainants have enforceable Trade Mark rights under the Trade Marks Act 2002 in respect of both the "Eat My Lunch" and "Eat My Dinner" Trade Marks. The former Trade Mark was registered in October 2014 and the latter as from 1 February 2017.

- 9.2 There is insufficient evidence to find that the Complainants had any unregistered rights, enforceable under New Zealand law, in the term or name “Eat My Dinner”, at the date of registration of the Domain Names in dispute. The only evidence that the Complainants produced of operating a business under that name prior to 30 June 2016, was the *Idealog* website article dated June 2016. This article simply referred to plans to expand into dinners. This is insufficient to establish unregistered rights in the name prior to 30 June 2016.
- 9.3 The Complainants contend that the Trade Mark rights and reputation that existed in the business name “Eat My Lunch” prior to 30 June 2016, was sufficient to create unregistered rights in the similar name “Eat My Dinner” before that date.
- 9.4 The Expert has not been presented with evidence that supports this assertion. While the Complainants make this contention based on the trading reputation of “Eat My Dinner”, there was no market research or any other evidence presented that supported this statement. Without more, it appears equally plausible that another business trading in catering or food services with a distinct identity, logo and target market, could have used the domain name “Eat My Dinner”, without any confusion with “Eat My Lunch”, at the time of registration in June 2016. This would not be possible now that the Complainants have the registered trademark for “Eat My Dinner”.
- 9.5 Nevertheless, the Complainants have established current Trade Marks rights in the name “Eat My Lunch”, which satisfies the first limb of the test of unfair registration.

***Are the domain names in the hands of the respondent unfair registrations?***

- 9.6 It is then necessary to go on to consider whether the “Eat My Dinner” domain names in the hands of the Respondent are unfair registrations. This involves a consideration of the factors in DRS Policy 5 and 6, as outlined above.
- 9.7 The Expert is not satisfied that there is sufficient evidence of an Unfair Registration, taking into account the factors relating to unfair registration in paragraphs 5 and 6 of the DRS Policy. This is for the reasons set out below:
- (a) There is not sufficient evidence to establish that the Respondent registered the Domain Names for the purposes of selling them to the Complainant or a competitor for consideration in excess of his out of pocket costs. In this regard, it is noted:
- i. There is no material evidence as to the Respondent’s intention at the time of registration. While he did complete the registration in

the same month as the Complainants announced their move into the dinner market, without more this is not sufficient evidence of an intention to sell at an inflated price.

- ii. There is no evidence that the Respondent took any steps to sell the Domain Names between June 2016 and April 2017, until the Complainants approached the Respondent;
  - iii. When the Respondent was first approached to sell the Domain Names by the Complainants, he declined to do so and stated in his reply text dated 26 April 2017 *"Thanks for the contact laan. Sorry to say but I have a use for the domain."*
  - iv. The subsequent offer to sell the domain names for the sum of \$6,000 in total, appears greater than the Respondent's out of pocket costs for registration. However, this does not without more establish the Respondent's purpose at the time of registration that must be examined under DRS 5.1.1. This offer to sell in April 2017 is, in this case, too distant to assist in establishing the Respondent's purpose at the date of registration given the other evidence before April 2017.
- (b) There is no sufficient evidence that the Respondent registered the Domain Names as a blocking registration. There is some issue as to whether the timing of the announcement by "Eat My Dinner" and the Respondent's conduct in registering the Domain Names in the same month of June 2016, was related. However, there is no evidence that the Respondent knew of this announcement. In any event, it was not a blocking registration at the time, as the Complainants did not at that date have any rights in the name "Eat My Dinner".
- (c) There is no sufficient evidence that the Respondent registered the Domain Names for the primary purpose of unfairly disrupting the Complainants business. It appears on the evidence that it is equally plausible that the Respondent registered the Domain Names for a legitimate business purpose. The Respondent operates a catering business and when approached by the Complainants advised he intended to use the Domain Names.
- (d) The Respondent is not using the Domain Name, therefore DRS 5.1.2, is not engaged. Offering the Domain names for sale does not amount to "use".<sup>5</sup>

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<sup>5</sup> *Yellow Holdings Ltd v Eurobelt*, DRS 1116, para 14.4

- (e) Failure to use the domain names is not in itself evidence of an unfair registration as provided under DRS 5.2.

9.8 There is similarly insufficient evidence that the Respondent is likely to use the domain names in an unfair manner. There is no evidence that he has taken any active preparatory steps towards using them which may display a likely unfair use.

9.9 Finally, it is noted that there are some factors that indicate the Domain Names are not unfair registrations, under DRS 6.1. In particular, the Domain Names are at the more generic or descriptive end of names that might be used in the catering or food services industry. It is not a wholly distinct name such as “Nike” or another unique word or phrase. It is a phrase adopted from common usage. Further, the registrations are not part of a wider pattern of a series of registrations which are significantly different from the Respondent’s other domain name “letseat”.

## **10. Decision**

10.1 The Expert has determined that the registrations are not Unfair Registrations. The Complainants application for transfer of the domain names is declined.

**Place of decision: Auckland**

**Date: 7 November 2017**

**Expert Name: Maria Dew, Barrister**

**Signature**

A handwritten signature in blue ink, appearing to be 'M Dew', written in a cursive style.