

# **.nz Dispute Resolution Service**

**DRS Reference: 1279**

**SKY INTERNATIONAL AG**

**v**

**Trove International Limited**

**Key words – identical or similar trade mark - generic or descriptive – Unfair Registration – likely to confuse, mislead or deceive.**

## **1. Parties**

### **Complainant:**

SKY INTERNATIONAL AG  
Lucia Morariu  
Stockerhof, Dreikönigstrasse  
31a, CH-8002  
Zürich ☐  
Switzerland

### **Respondent:**

Trove International Limited  
Suite 394, 2a Byron Ave. ☐  
Takapuna ☐  
Auckland ☐  
New Zealand

## **2. Domain Name/s**

skynews.nz

## **3. Procedural history**

The Complaint was lodged on 23 January 2018 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 01 February 2018. The domain was locked on 26 January 2018, preventing any changes to the record until the conclusion of these proceedings.

The Respondent filed a Response to the Complaint on 23 February 2018 and the DNC so informed the Complainant on 5 March 2018. The Complainant filed a Reply to the Response on 14 March 2018. The DNC informed the parties on 12 April 2018 that informal mediation had failed to achieve a resolution to the dispute.

The Complainant paid Domain Name Commission Limited the appropriate fee on 18 April 2018 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).

Barry Paterson QC, the undersigned, (“the Expert”) confirmed to the DNC on 07 May 2018 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, Sky International AG, is incorporated in Switzerland. It is a member of the Sky Group of Companies which include amongst others, Sky plc, Sky UK Limited, Sky Deutschland and Sky Italia (the Sky Group).
- 4.2. The Sky Group together with its predecessors in title and associated companies uses the brand SKY including words and logo marks comprising or incorporating SKY and has done so for more than 25 years. It says that the Sky Group has consistently been one of the most active advertisers in the media sector and enjoys extensive press coverage.
- 4.3. The Sky Group claims to be Europe’s leading entertainment company and serves over 20 million customers across Europe and offers the best and broadest range of content, delivers market-leading customer service and uses innovative new technology to give customers a better TV experience.
- 4.4. The Complainant’s licensees include Australian News Channel Pty Limited (ANC) which operates SKY NEWS a 24-hour multi-channel multi-platform news service in Australia. ANC’s services include SKY NEWS LIVE, SKY NEWS BUSINESS, SKY NEWS WEATHER, SKY NEWS MULTIVIEW AND SKY NEWS NEW ZEALAND. SKY NEWS NEW ZEALAND is on the Sky Network Television Limited subscription platform in New Zealand (Channel 85). The mark SKY NEWS appears prominently on screen during the screening of its news’ bulletins.
- 4.5. The Sky Group is the registered proprietor and applicant for the registration of a large number of UK EU and NZ trademarks and domain names many of which include the words SKY, SKY NEWS and SKY SPORTS.
- 4.6. In New Zealand the Complainant is the registered holder of 5 trademarks upon which it relies, namely trademarks 725481, 725482, 727118, 727120 and 814189. The registration date in respect of each of these five trademarks well predates the registration of the Domain Name.

4.7. Trademark 725482 is for the mark SKY NEWS. In respect of the NICE Classification Schedule 8, it relates to Classes 16, 38 and 41. In summary, the classes of services described are:

- 16 Books publication and printed matter.
- 38 Television broadcasting and television communication services, broadcasting and television programmes including news and current affairs, and radio news programmes.
- 41 Television entertainment services including news, current affairs and entertainment provided by film, television and/or radio and other electronic means.

4.8. Trademark 725481 is for the mark SKY NEWS ACTIVE NEWS ON DEMAND, trademark 727118 is for the mark SKY NEWS NOW – NEWS TO GO, trademark 727120 is for the mark SKY NEWS NOW and trademark 814189 is for SKY NEWS BUSINESS NOW. All five trademarks are registered for class 38.

4.9. The Respondent, Trove International Limited, has its address at Byron Avenue, Takapuna, Auckland. In its Response it gave very little information about itself other than to say how it proposes to use the Domain Name. This proposed use is referred to below.

4.10. There are also several domain names in New Zealand held by members of the Sky Group. They include skynews.co.nz, skynews.net.nz, skynewsbusinesschannel.co.nz, skynewsradio.co.nz, skynewsradio.net.nz, skynewssport.co.nz, skynewsweatherchannel.co.nz, and skysportsnews.co.nz.

## **5. Parties' contentions**

### **a. Complainant**

5.1. The Complainant's position is that the registration of the Domain Name was an Unfair Registration under the Policy as it is identical to a trademark in which the Complainant has rights and which existed well before the Domain Name was registered on 27 October 2017.

5.2. It submitted that the use of the Domain Name constitutes an unauthorised use of the mark in the course of trade and takes unfair advantage of, and/or is

detrimental to, the distinctive character and/or the reputation of the Sky Marks.

- 5.3. Further, it submitted that visitors to any website hosted under the Domain Name may be confused into thinking that the Domain Name is somehow connected to the Complainant and the Sky Group. Because the Domain Name is identical to the registered trademark SKY NEWS, consumers are likely to believe that any service provider on the website at the Domain Name is associated with or authorised by the Sky Group or the Complainant.
- 5.4. It is further submitted on behalf of the Complainant that the Domain Name was registered for the purposes of either disrupting the Sky Group's business activities, or intentionally capitalising on Sky Group's reputation, whether that is to block the Complainant's own use of its trademarks or to direct Internet traffic to the website, and/or to achieve a higher resale price on the Domain Name whether from the Complainant or a third party.
- 5.5. Although not expressed as relying on an unregistered mark, the submission notes that given the Sky Group's reputation in news and as a leading provider of news channels, it is highly likely that consumers will see the Domain Name and believe it provides services under or associated with the SKY NEWS brand.
- 5.6. The Complainant also provided a list of 27 other domain names registered in the name of the Respondent or its shareholder and director, some of which are identical or confusingly similar to well-known trademarks. The submission was this shows an intent on the part of the Respondent to avail itself of the goodwill built up in the Sky marks by the Complainant for the purpose of attracting Internet users to websites linked to the Domain Name, and/or seek to profit financially from the sale of the Domain Name to the Sky Group.

**b. Respondent**

- 5.7. In a brief Response, the Respondent has advised that it is its intention to operate a website with the broad theme of current or novel events relating to astronomy and the weather. That is news about the Sky.
- 5.8. It responds that the Domain Name was not 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 and has not been and will not

be used in a manner which takes unfair advantage of, or is unfairly detrimental to the Complainant's rights. It is suggested that this is impossible in view of Sky Group's global reach and resources.

- 5.9. It is also submitted that the Domain Name is generic or descriptive and the Respondent intends making fair use of it in a way which is consistent with its generic or descriptive character.
- 5.10. Finally, it was submitted that it is not the Respondent's intention, but it notes that fair use may include sites operated solely in criticism of the business.
- 5.11. In its response, the Respondent does not refer to its other business activities, whatever they may be, or respond to the allegation that it has registered 27 other domain names many of them of well-known brands. There is no claim to having an existing business dealing with astronomy and the weather and no evidence that the Respondent operates a news service.

**c. Complainant's Response**

- 5.12. In a reply the Complainant made three points, namely:
  - (a) Its research has not revealed any connection between the Respondent and the astronomy or weather news fields. It submits that the Respondent has no registered or unregistered trademark rights in these fields.
  - (b) It rejects the claim that the Domain Name will not be used in a manner which takes unfair advantage of the Complainant's Rights. The Domain Name is identical to a trademark in which the Complainant has Rights. The Complainant and the Sky Group operate amongst others the SKY NEWS NEW ZEALAND television channel which contains weather content. It makes available in New Zealand content from the SKY NEWS WEATHER channel by digital media including websites and social media presence.
  - (c) The SKY mark is not descriptive and this has been indicated around the world by many courts and administrative bodies determining that the SKY brand is distinctive and/or has enhanced distinctiveness. It attached a list of decisions in Sky Group's favour from around the world as at July 2016 in which the reputation and the distinctiveness of

the SKY mark has been expressly recognised. It has however not provided the decisions themselves and it has not been possible to consider those decisions. Further, it is not necessary to consider them in reaching a decision on the Complaint.

## 6. Discussion and findings

6.1. Under paragraph 4 of the Policy the Complainant is required to establish on the balance of probabilities:

4.1.1 The Complainant has Rights in respect of the 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.

6.2. There are two definitions in the Policy which are relevant, namely:

(a) **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.

(b) **Unfair Registration** means a domain name which either:

(i) was registered or otherwise acquired in the 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.

6.3. This Complaint raises three issues:

(a) Does the Complainant have Rights in respect of the name or mark which is identical or similar to the Domain Name?

(b) If the Complainant has Rights in such a name or term, are those Rights wholly descriptive of the Complainant's business? and

- (c) If the Complainant does have rights in respect of a name or mark which is identical or similar to the Domain Name, is the Domain Name in the hands of the Respondent an Unfair Registration?
- 6.4. While the Complainant relies upon five trademarks, it needs only in my view to rely on one trademark to establish rights in the name SKY NEWS. Trademark 725482 which is current and has been so for more than eight years, is a word trademark in SKY NEWS. The other New Zealand trademarks mentioned above are supportive of the Complainant's right in the mark SKY NEWS.
- 6.5. Although the Complainant does not expressly rely upon the common law rights in the name SKY NEWS, there is evidence to suggest that the Complainant does have such rights which could possibly sustain an action for "passing off". It is not necessary to consider the overseas trademarks held by the Complainant.
- 6.6. The Complainant, as registered holder of trademark 725482 does hold Rights in the words Sky News.
- 6.7. When considering whether a name or mark in which Rights are asserted is identical or similar to the Domain Name, the ".nz" is not considered. Clearly, the mark SKY NEWS is identical or similar to "sky news" even though there is no gap between "sky" and "news" in the Domain Name. The fact that the words are lower case in the Domain Name does not matter.
- 6.8. I determine that the Domain Name is identical or similar to the mark SKY NEWS in which the Complainant has Rights.
- 6.9. The Respondent contends that the mark SKY NEWS is wholly descriptive of the Complainant's business.
- 6.10. The Sky Group is in the television and radio entertainment business. It is not in the business of "the sky". Sky News is part of that business but is only one part. The term "Sky News" is not wholly descriptive of the Sky Group's business which is an entertainment business.
- 6.11. I therefore find that the Complainant does have Rights in a mark which is not wholly descriptive of its business and that that mark is similar or identical to the Domain Name.

6.12. It remains therefore to determine whether the registration in the hands of the Respondent is an Unfair Registration.

6.13. Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration. That list includes:

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.

6.14. Paragraph 6.1 of the Policy contains a non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration. Those factors which have been raised either directly or indirectly in submissions include the following:

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; or

6.1.2 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;

...

6.1.4 In relation to paragraphs 5.1.3 and/or 5.3; that the Domain Name is not part of a wider pattern or series of registrations because the Domain Name is of a significantly different type or character to the other domain names registered by the Respondent.

- 6.15. In addition, paragraph 6.2 of the Policy provides that fair use “may include sites operated solely in tribute to or in criticism of a person or business”. The Respondent’s submission on this paragraph is ambivalent. It draws it to attention but says that it does not intend to use the site in that manner. It can therefore be disregarded.
- 6.16. While the Complainant relies in part on some of the provisions of paragraph 5.1.1, particularly subparagraph (a), it is not necessary to determine this Complaint solely on the basis of the provisions of that paragraph. However, the evidence produced by the Complainant and the failure of the Respondent to respond to that evidence does lead to an inference that the provision applies.
- 6.17. The relevant subparagraph is 5.1.2. This paragraph refers to the Respondent “using” the Domain Name and there is no evidence of such use but this is not the end of the matter. This is because the definition of Unfair Registration includes that the Domain Name “is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s rights”. Thus, if the likely use 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”, it is an Unfair Registration.
- 6.18. The Respondent has advised that its intended use is “to operate a website with the broad theme of current or normal events related to astronomy and the weather, i.e., news about the sky”. The issue is whether that proposed use will confuse, mislead or deceive in terms of paragraph 5.1.2 of the Policy.

- 6.19. The Complainant has Rights in “Sky News”. Sky News is regularly shown on New Zealand television on Channel 85 and its news bulletins clearly signify it is “Sky News”. “Sky News” is the mark of the broadcaster and is not a reference to news about the sky. It is not necessary to establish as contended by the Complainant, that the Respondent’s advice of its intentions is not genuine, to determine that an organisation using the Domain Name and providing news, even on limited subjects, 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.
- 6.20. In my view, the likely use of the Domain Name as advised by the Respondent falls clearly within the provisions of paragraph 5.1.2 of the Policy and is therefore an Unfair Registration as it is likely to be used in a manner which will take unfair advantage of or be unfairly detrimental to the Complainant’s Rights. The registration is therefore an Unfair Registration.
- 6.21. The inference referred to in paragraph 6.16 supports this finding.
- 6.22. The Respondent seeks to rely on the “generic or descriptive” provision of paragraph 6.2 of the Policy. “Sky News” is not descriptive of the Complainant’s business and is not in my view “generic or descriptive” of what the Respondent claims is its intended use of the Domain Name. Even if that intention is genuine, and the Respondent has not provided evidence that it is, the fact that SKY NEWS is a registered trademark suggests either that it is not generic or descriptive, or that the Complainant has established that notwithstanding its generic nature it is so involved with the business of the Sky Group that it has acquired a secondary meaning in the minds of consumers as applied to the Sky Group. Paragraph 6.2 does not assist the Respondent.

## **7. Decision**

- 7.1. The registration of the Domain Name was an Unfair Registration.
- 7.2. It is directed that the Domain Name be transferred from the Respondent to the Complainant.

**Date** 21 May 2018  
**Expert Name** Hon Barry Paterson QC  
**Signature**