

.nz Dispute Resolution Service

DRS Reference: 1301

Leafly Holdings, Inc.

v

Tricia Polkinghorne

Key words -

Domain name

leafly.co.nz

Identical or similar trade mark or name

Registered mark - unregistered mark

Rights

legitimate non-commercial or fair use

Unfair registration

Procedure

Parties

Deserae Weitmann
71 Columbia Street
Suite 200
Seattle
United States

Respondent:

Tricia Polkinghorne
67 Waldorf Crescent
Orewa
Auckland 0931
New Zealand

1. Domain Name/s

leafly.co.nz

2. Procedural history

The Complaint was lodged on 14 May 2018 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 16 May 2018. The Domain was locked on 16 May 2018, preventing any changes to the record until the conclusion of these proceedings.

No Response was received.

The Complainant paid Domain Name Commission Limited the appropriate fee on 06

July 2018 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).

Sheana Wheeldon, the undersigned, (“the Expert”) confirmed to the DNC on 11 July 2018 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/or impartiality.

3. Factual background

- 3.1 The Complainant is Leafly Holdings, Inc. of Seattle, USA (through its Corporate Counsel, Deserae Weitmann).
- 3.2 According to the Complaint, the Complainant was founded in 2010 and is the world’s largest and fastest growing cannabis technology company. It offers information and services through various websites and social media platforms including the domain leafly.com. This website receives over 12 million visits monthly.
- 3.3 The Complainant describes itself as “the market leader in providing a vehicle for individuals to discover information about cannabis, cannabis goods and services, as well as relevant breaking news relating to global regulation of cannabis”.
- 3.4 It owns several other GTLD and ccTLDs including leafly.ca, leafly.de, leafly.es and fr.leafly.fr. It also owns several US trade mark applications and registrations comprising or incorporating the trade mark LEAFLY. The oldest of these, registration no. 4, 420, 910 LEAFLY in classes 9, 35, 39, 42 and 44, was filed on 17 December 2012 and claimed first use of this mark on 20 September 2010.
- 3.5 The Complaint asserts, “[The] LEAFLY brand and its products, including content curated specifically for the New Zealand market, are well known to individuals in the greater south Pacific region. Indeed, Leafly’s websites and social media are well-trafficked by New Zealanders, with over 120,000 visits by kiwis in the last month alone (that’s nearly 3% of the country’s population)”. This is the only information in the Complaint that relates specifically to New Zealand.
- 3.6 The Respondent is Tricia Polkinghorne of Orewa, north of Auckland. According to Whois look up results provided by the Complainant she registered the Domain Name on 30 May 2017. She filed no Response so what follows is taken from the Complaint itself.
- 3.7 Attached to the Complaint is a printout of what is described as a screenshot of the landing page for the Domain Name. This states “This site cannot be found” and suggests the owner meant <http://leafly.com> (the Complainant’s website). However it is clear from the printout that it was in fact generated by keying in “leafly.com.nz”, not the Domain Name. The Expert has disregarded this exhibit.
- 3.8 The Expert has gone through the exercise of entering the Domain Name in a browser and notes that this currently leads to the message “404 Page not found Please check your URL or try again later”.
- 3.9 The Complainant sent a letter by email to the Respondent on 27 February 2018 and has provided a copy with the Complaint. (The letter indicates it was also sent by registered mail). It contains essentially the same information

concerning the Complainant and its activities as are set out in the Complaint, suggests that the Respondent transfer the Domain to the Complainant, and adds that the Complainant may “seek resolution of this issue via the relevant Domain dispute authority”.

3.10 The Respondent did not respond to that letter.

4. Parties' contentions

Complainant

- 4.1 The Complainant seeks to have the Domain Name transferred to it from the Respondent.
- 4.2 The Complainant asserts that the Respondent has registered the Domain Name in bad faith following the Complainant's use of the Leafly-formative GTLD. It says the Respondent's non-response to its letter of 27 February 2018 evidences “bad faith registration”.
- 4.3 The Complainant also says it can find no evidence the Respondent has made any legitimate, non-commercial use of the Domain Name.
- 4.4 The Complainant makes a number of assertions regarding the landing page reached on entering the domain leafly.com.nz in a browser, but as noted earlier this was the wrong domain name. The only one of these assertions that is relevant to the current situation as experienced by the Expert is that a “less careful web navigator seeking country-specific coverage by [the Complainant] may give up and not continue to the leafly.com domain”.
- 4.5 The Complainant is also concerned that if the Respondent develops a website in the future, she will “benefit from the confusion and detract from [the Complainant's] use of its trade mark in connection with its web services”.
- 4.6 The Complaint makes no reference to the Dispute Resolution Service Policy (“Policy”) or any of its provisions.

Respondent

- 4.7 As mentioned earlier the Respondent filed no response.

5. Discussion and findings

Relevant Provisions of the Policy

- 5.1 The Complainant is required to prove that it has met the requirements in paragraph 4 of the Policy namely 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.
- 6.2 Paragraph 4.2 requires the Complainant to prove to the Expert that both elements are present on the balance of probabilities.
- 6.3 The Policy provides that ‘Unfair Registration’ means a Domain Name which either:

- a. 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
- b. 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.

Application of the Policy in this case

6.4 The first question is whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name. Rights may be registered or unregistered and it has generally been found that they must be enforceable under New Zealand law.

Complainant's rights

6.5 The Complainant has trade mark registrations in respect of LEAFLY in the USA. It appears to have used the LEAFLY trade mark on a significant scale for some time, at least through its website. However the Complaint is short on detail, including as to the precise activities of the Complainant, how the trade mark is used, and what use of the mark was made before the Respondent registered the Domain on 30 May 2017.

6.6 As to New Zealand specifically, the Complainant has no trade mark registrations. Its evidence concerning any reputation it might have in New Zealand is limited to the statement set out above, to the effect that its "websites and social media" had "over 120,000 visits by kiwis in the last month alone". Presumably this is a reference to the month before the Complaint was lodged – that is, mid-March to mid-April 2018.

6.7 There are a number of deficiencies in this evidence, in terms of establishing a reputation (and hence enforceable rights) in New Zealand. These include:

- a. This period is well after 30 May 2017, the date the Respondent registered the Domain Name.
- b. There is no evidence of the number of visits by New Zealanders before that date.
- c. In any event there is no information on the methodology of counting "visits" by New Zealanders – for example whether these were identified based on IP addresses, what exactly comprised a "visit", and how a visitor may have been exposed to the LEAFLY trade mark being used during a "visit".
- d. In short, this bare statement is insufficient to give any real basis for a finding that the Complainant had a reputation in its LEAFLY trade mark in New Zealand on 30 May 2017, or indeed that it has one now.

6.8 The Expert has considered whether rights outside New Zealand, and in particular the Complainant's US trade mark registrations, could amount to Rights under paragraph 4.1.1 of the Policy (Rights being defined in the Policy as *including, but not limited to*, rights enforceable under New Zealand law).

6.9 It has generally been accepted by Experts that rights enforceable under New Zealand law are a requirement, but the definition on its face is not limited in that way. This Expert is indebted to the Expert in Complaint DRS1272 (simbasleep.co.nz) for his in-depth consideration of this issue. She agrees with and adopts that analysis which, to paraphrase paragraphs 6.2.2 and 6.23 of that decision, concludes that:

- a. A complainant who does not have rights which are enforceable in

New Zealand must show that they at least have a reputation in New Zealand, or that there are some special circumstances which mean that they have a claim to rights in a name which has been included in the domain name.

- b. The simple use of a name overseas, without sales being directed at New Zealanders, does not provide a basis for finding a Complainant has “Rights” in New Zealand which would allow it to object to another party’s domain name registration.
- 6.10 On this approach, the Complainant has not shown on the balance of probabilities that it has Rights in a name which is identical or similar to the Domain Name.
- 6.11 That finding is sufficient to dispose of the Complaint. However for completeness the Expert notes that:
- a. The Complainant did not refer to any factor relating to either the Respondent’s registration or its use of the Domain Name, that could be evidence of an Unfair Registration, as is required by paragraph 4.1.2 of the Policy.
 - b. There is no evidence to suggest the Domain Name is likely to be used in an unfair manner.
 - c. The fact the Respondent may not have made any “legitimate, non-commercial use” of the Domain Name is not positive evidence of an Unfair Registration.
 - d. Neither is the fact the Respondent did not reply to the Complainant’s letter of 27 February 2018.
 - e. As mentioned above, the Complaint suggests that a “less careful web navigator” seeking country-specific coverage may give up and not continue to the leafly.com domain. This outcome would however be due to the fact the Complainant does not have a New Zealand specific website, rather than the fact the Respondent has registered the Domain Name, without more.
 - f. The Respondent’s potential future activities, such as a website associated with the Domain Name, are not relevant.
 - g. There is nothing else in the Complaint that would have supported a finding of an Unfair Registration under the Policy.
- 6.12 Therefore the Expert would also have found that the Complainant has not shown, on the balance of probabilities, that the Domain Name is an Unfair Registration.

6. Decision

- 6.1 In view of the above findings the Complaint is dismissed.

Place of decision: Auckland

Date: 25 July 2018

Expert Name: Sheana Wheeldon

Signature:

A handwritten signature in blue ink, appearing to read "Sheana W", enclosed in a thin black rectangular border.