

# .nz Dispute Resolution Service

DRS Reference: 1379

**AB Electrolux  
Cecilia Borgenstam**

**v**

**Bambi Rodriguez**

## **Key words –**

*Domain name*  
vintec.co.nz

*Identical or similar trade mark or name*

Registered mark - unregistered mark - identical

*Unfair registration*

Unfair registration – unfair use – likely to confuse, mislead or deceive - false contact details –unfairly disrupting the business of the complainant – blocking registration — respondent having no connection with name or trade mark

**Registrar: PDR Limited**

## **1. Parties**

### **Complainant:**

AB Electrolux  
Cecilia Borgenstam  
Strandvägen 7A  
Stockholm  
SE

### **Respondent:**

Bambi Rodriguez  
604 Fairfax Drive  
Mira Loma  
United States

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

vintec.co.nz

## **3. Procedural history**

- 3.1.** The Complaint was lodged on 12 September 2019 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 23 September 2019. The domain was locked on 23 September 2019, preventing any changes to the record until the conclusion of these proceedings.

- 3.2. No response was received.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 17 November 2019 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4. Sheana Wheeldon, the undersigned, (“the Expert”) confirmed to the DNC on 20 January 2020 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.

#### 4. Factual background

##### *The Complainant’s rights*

- 4.1. The Complainant is AB Electrolux of Stockholm in Sweden. It was founded in 1901 and is described in the Complaint as “one of the world’s leading producers of appliances and equipment for kitchen and cleaning products and floor care products”.
- 4.2. In 2016 the Electrolux group acquired Vintec, described in the Complaint as “the leading specialist and expert in climate-controlled wine cellars in Australia, New Zealand and Asia Pacific”.
- 4.3. According to the Complaint the Vintec brand was created in 2000 by two Frenchmen who collaborated with Danish designers to introduce “a range of stylish, functional and accessible wine preservation systems”. The Complainant owns a number of domain names containing the word “vintec”, including vintec.com and vintec.com.au. It uses these to connect to a website through which it informs potential customers about its VINTEC trade mark and its products and services.
- 4.4. The Complainant has provided images from the website at [www.vintec.com](http://www.vintec.com) showing wine cabinets and coolers. The Complainant’s local Vintec site for New Zealand is at <https://www.vintec.com/en-nz/>.
- 4.5. The Vintec coolers can be purchased online from Harvey Norman in New Zealand and the Complainant has provided a screenshot (undated) showing three types of wine cooler advertised on that site at prices between NZ\$2,000 and \$3,000.
- 4.6. The Complainant says it has rights in the VINTEC trade mark “through their wholly owned subsidiary Electrolux Contracting AB”. It has provided details of New Zealand trade mark registration no. 315929 owned by Electrolux Contracting AB. This registration is for the trade mark VINTEC in a slightly stylised form. It is in class 11 and covers “refrigerating apparatus and machines, refrigerating appliances and installations, refrigerating cabinets, refrigerating chambers and refrigerators”. Its deemed registration date is 8 September 1999.
- 4.7. The Complainant’s evidence includes a certificate signed by the Head of Corporate Legal and the Head of Group Intellectual Property of Electrolux AB, certifying that Electrolux Contracting AB is its subsidiary.

- 4.8. The Complainant has also provided details of other overseas registrations of VINTEC. Some are owned by Electrolux Contracting AB while others are owned by the Complainant.
- 4.9. According to the Complaint the Complainant enjoys a high degree of renown around the world due to “extensive use, advertising and revenue associated with its VINTEC mark worldwide including in New Zealand”.

*The Respondent's activities*

- 4.10. The Respondent is Bambi Rodriguez whose address is in the United States.
- 4.11. The Complainant notes that the Respondent does not reside in New Zealand, has chosen a registrar located in India, and has a Russian email address.
- 4.12. The Respondent acquired the Domain Name on 2 September 2019. At the time of the Complaint the Domain Name resolved to a website that appeared to promote New Balance shoes for sale (“Respondent’s Website”). The Complainant has provided a screenshot showing the Respondent’s Website. The screenshot includes the notation “*Copyright © 2019 www.vintec.co.nz*”.
- 4.13. The Complainant considers the shoes being promoted are counterfeit, based on the fact the prices being offered represent discounts of more than 50% on the original prices.
- 4.14. The Complainant points out that New Balance has an official website in New Zealand located at <https://www.newbalance.co.nz/>. The Expert has viewed this website and notes its appearance is different from that of the screenshot of the website at [www.vintec.co.nz](http://www.vintec.co.nz) supplied by the Complainant. According to the Complaint the Respondent’s website was installed immediately after the Domain Name was registered.

*Other relevant history*

- 4.15. The Complainant has also provided some information on the history of the Domain Name. It says the Domain Name was originally registered by a former distributor of the Complainant as early as 2012. The Complaint also states the Domain Name was registered by “previous Vintec representative in New Zealand”. Presumably these are references to the Vintec business prior to its acquisition by the Complainant.
- 4.16. Copies of archived screenshots dated 26 March 2012 and 12 March 2018 have been provided. These show the promotion of VINTEC wine cabinets on a website at [www.vintec.co.nz](http://www.vintec.co.nz). The 2018 screenshot shows a contact email address of [customerservice@electrolux.co.nz](mailto:customerservice@electrolux.co.nz). It includes the following wording:

*“VINTEC is New Zealand’s leading specialist in wine storage solutions and wine preservation systems. In fact, that is all we do. Our wine serving and cellaring cabinets range from small 30 bottle Home Wine Bars, to 4,000 bottle Walk-In Cellars, and are available in an extensive array of styles and functions. With over 35 models, Vintec and Transtherm Wine Cabinets have a wine storage and serving solution to suit every need”.*

- 4.17. The 2018 screenshot includes an image of a “*Vintec ‘NOIR’ Two-Door Wine Cabinet*”. It prominently displays the trade mark VINTEC in the stylised form of the trade mark registration, as does the 2012 screenshot.
- 4.18. It is therefore clear that the Domain Name was previously connected to an official Vintec site and, at least in 2018, to Electrolux in New Zealand.
- 4.19. According to the Complainant, it had a verbal agreement with the prior owner of the Domain Name to gain ownership of it when Electrolux acquired the Vintec business, however instead of transferring the Domain Name the former owner cancelled it (or allowed it to lapse). This allowed a third party to acquire it. The Complainant believes the Respondent used a backorder tool to purchase the Domain Name.

## 5. Parties’ contentions

### *Complainant*

- 5.1. The Complainant seeks to have the Domain Name transferred to it from the Respondent.
- 5.2. The Complainant asserts that it has Rights in respect of the VINTEC trade mark (through its wholly owned subsidiary Electrolux Contracting AB). It has clearly asserted its registered trade mark rights. It has not formally asserted unregistered trade mark rights in respect of the mark VINTEC though, as mentioned earlier, it says it enjoys a high degree of renown due to its activities associated with the VINTEC mark worldwide including in New Zealand.
- 5.3. The Complainant says the Domain Name is an Unfair Registration. Its main assertions in this regard are:
- a. The Domain Name incorporates the Complainant’s trade mark VINTEC in its entirety. The addition of .co.nz does not add any distinctiveness. Therefore the Domain Name should be considered as identical to the registered trade mark VINTEC.
  - b. Internet users will visit the website connected to the Domain Name either by using search engines or by guessing the relevant website address expecting it to be operated or authorised by, or otherwise connected with, the Complainant. This will cause initial interest confusion in that the content on the site has nothing to do with the name Vintec or the trade mark VINTEC. It will also create confusion because the Domain Name resolves to a website promoting New Balance shoes (which the Complainant considers are counterfeit).
  - c. The Respondent would have been well aware of the Complainant’s name before registering and using the Domain Name in a manner which takes unfair advantage of and/or which is detrimental to the Complainant’s Rights.
  - d. Because the Respondent resides in the United States not New Zealand, has chosen a registrar in India and has a Russian email address, the Complainant suggests it could be providing false whois details to the registrar.

- e. Because the Domain Name was previously connected to a Vintec website and then directly registered by a third party when it lapsed, the Complainant believes the Respondent used a backorder tool to purchase the Domain Name.
- f. The Complainant's registration and use of the Domain Name blocks the Complainant from registering the Domain Name.
- g. The Respondent's registration and use of the Domain Name takes unfair advantage of the Complainant's rights and is unfairly detrimental to those rights. It does so by making a commercial gain, accruing revenue from a commercial website. The Complainant believes the Respondent intentionally chose the Domain Name based on its registered and well known trade mark in order to generate more traffic to its website.

*Respondent*

5.4. The Respondent has filed no response.

**6. Discussion and findings**

6.1. Given the absence of a Response, the Expert is able to consider only the information and submissions provided by the Complainant, which are undisputed, and to make appropriate inferences from the available facts.

*Relevant Provisions of the Policy*

6.2. 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.

6.3. Paragraph 4.2 requires the Complainant to prove to the Expert that both elements are present on the balance of probabilities.

6.4. 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.

6.5. Paragraph 5.1 of the Policy sets out a series of non-exhaustive factors which may be evidence that a Domain Name is an Unfair Registration. They include the following:

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; or
  - 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;
- 5.1.4 The Complainant can demonstrate that the Respondent has knowingly given false contact details to a Registrar and/or to the DNC;

*Application of the Policy in this case*

- 6.6.** 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 must be enforceable under New Zealand law and may be registered or unregistered.

*Complainant's rights*

- 6.7.** The Complainant asserts registered trade mark rights based on New Zealand trade mark registration no. 315929. That trade mark is not owned by the Complainant but by its wholly owned subsidiary Electrolux Contracting AB. The Expert finds that the Complainant can rely on registration no. 315929 for two reasons.
- 6.8.** First, the Complainant owns its subsidiary, which in turn owns the trade mark registration. It is reasonable to infer that the Complainant controls the trade mark owner and so controls ownership of the registration. It is common for large organisations to arrange their affairs so their registered trade marks are held by a different entity from the trading entity. Therefore from a practical perspective it can be said the Complainant owns the registered trade mark rights.
- 6.9.** Second, this finding is consistent with principles of trade mark law. In certain situations it is necessary to determine whether the owner of a registered trade mark has *authorised and controlled* its use by another party. This question often arises when a registration is under attack for non-use, and the owner has not itself used the mark but is attempting to rely on use by another party.
- 6.10.** On occasion in that context a company related to the owner has used the trade mark, but without any formal licence. Commercial reality has sometimes led to findings that use by a related company in these situations was authorised and controlled by the owner.

- 6.11.** A New Zealand example is *DB Breweries Ltd v Tui AG*<sup>1</sup> in which the use was by a related company. In Australia the Federal Court recently considered<sup>2</sup> a situation where a parent company was using trade marks actually owned by its wholly owned subsidiary. The Court found that the parent's use was authorised, and so did amount to use of the trade marks by its subsidiary, the registered owner.
- 6.12.** Applying this reasoning, the fact that the Complainant holds its New Zealand trade mark registration in the name of a subsidiary does not weaken the registration. Hence there is no reason to depart from the practical approach of finding that the Complainant owns the registered trade mark rights although their legal owner is its wholly owned subsidiary.
- 6.13.** While the Complainant has alluded to unregistered trade mark rights in VINTEC, it has not formally asserted unregistered rights. In any event there is insufficient evidence to prove unregistered rights in New Zealand.
- 6.14.** The Domain Name is vintec.co.nz while the Complainant's trade mark is VINTEC. Therefore the Complainant's trade mark is identical to the Domain Name.

*Is the Domain Name, in the hands of the Respondent, an Unfair Registration?*

- 6.15.** Under paragraph 4.1.2 of the Policy the Complainant must show, on the balance of probabilities, that the Domain Name is an Unfair Registration in the hands of the Respondent.
- 6.16.** The definition of Unfair Registration includes 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.
- 6.17.** The Domain Name was registered on 2 September 2019. Therefore the circumstances around the Respondent's registration of the Domain Name are relevant.
- 6.18.** The following factual circumstances that existed when the Respondent acquired and began using the Domain Name are relevant to whether the Domain Name is an Unfair Registration:
- a.** The Domain Name had for several years previously been connected to the Complainant's Vintec business.
  - b.** The Complainant's VINTEC products had at least some presence in New Zealand and that had been the case for some time.

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<sup>1</sup> [2010] NZIPOTM 31

<sup>2</sup> *Trident Seafoods Corporation v Trident Foods Pty Ltd* [2019] FCAFC 100

- c. It is possible but not certain that the Respondent was aware of the Complainant's VINTEC business and deliberately chose it to generate more traffic to its website, as the Complainant suggests.
- d. The Domain Name was registered by a third party when it lapsed, which the Complainant believes indicates the Respondent used a backorder tool to purchase it.

*Respondent acquired and/or is using the Domain Name primarily for the purposes of selling it, or as a blocking registration, or for the purpose of unfairly disrupting the business of the Complainant (paragraph 5.1.1)*

- 6.19.** The Complainant had a verbal agreement with the prior owner of the Domain Name to gain ownership of it so clearly it wished to have the Domain Name itself. New Zealand internet users looking for the local Vintec website are likely to try the Domain Name or be directed to it by a search engine, and some will already have been aware of the Domain Name when it was connected to the Complainant's Vintec business.
- 6.20.** The Respondent is using the Domain Name in relation to a business with no connection to the Complainant, and with no connection to the name Vintec.
- 6.21.** Although there is no direct evidence of the Respondent's intentions, her registration of the Domain Name has had the effect of blocking the Complainant from registering it. Her registration and use of the Domain Name have had the effect of disrupting the Complainant's business.
- 6.22.** In all the circumstances it is reasonable to infer that the Domain Name was registered and is being used primarily as a blocking registration and/or for the purpose of unfairly disrupting the business of the Complainant.

*Respondent is using the Domain Name in a way which is likely to deceive, mislead and/or confuse (paragraph 5.1.2 of the Policy)*

- 6.23.** Relevant to this factor is the fact that while the Domain Name comprises the word and trade mark VINTEC, the Respondent has been using it for a website offering for sale New Balance shoes. Whether or not the shoes in question are counterfeit, the Expert accepts that internet users looking for the Complainant's website relating to its VINTEC products will be confused if they arrive at the Respondent's website.
- 6.24.** This effect is exacerbated by the appearance on the Respondent's website of the notation "Copyright © 2019 [www.vintec.co.nz](http://www.vintec.co.nz)".
- 6.25.** The history of the Domain Name is also relevant here. As well as those internet users who use search engines or guess at the Complainant's Vintec website in New Zealand, there will presumably be others who were aware of the official Vintec website operated at that address, apparently from at least 2012 – 2018. These users will be confused and may be misled into believing the Complainant no longer has a website in New Zealand. This would be detrimental to the Complainant.
- 6.26.** In these circumstances the Expert finds on the balance of probabilities that the Respondent is using the Domain Name in a way likely to confuse, mislead or deceive people (paragraph 5.1.2).



*Respondent has knowingly given false contact details to a Registrar (paragraph 5.1.4 of the Policy)*

**6.27.** The Complainant has suggested that the Respondent may have provided false whois details. This is on the basis that she has an address in the United States, has chosen a registrar located in India, and has a Russian email address.

**6.28.** While these facts appear contradictory there is insufficient basis on which to find that the Respondent has knowingly provided false contact details.

#### *Unfair Registration generally*

**6.29.** Stepping back from the non-exhaustive list of factors that may be evidence of an Unfair Registration, the Expert agrees with the Complainant's assertion that the Respondent is likely to be gaining revenue from its website selling shoes, due to the use of the name Vintec in which the Complainant has rights. This is an additional basis for finding that the Domain Name was registered and is being used in a manner which took unfair advantage of the Complainant's Rights.

**6.30.** As mentioned earlier, the Respondent has filed no Response, so has not disputed the Complainant's assertions.

**6.31.** There is no evidence of any of the factors listed in paragraph 6.1 of the Policy as potential evidence that the Domain Name is not an Unfair Registration.

**6.32.** The Expert is satisfied that the Complainant has shown that the Domain Name is an Unfair Registration.

## **7. Decision**

**7.1.** In view of the findings made above the Expert directs that the Domain Name vintec.co.nz be transferred to the Complainant.

**Place of decision:** Auckland

**Date:** 29 January 2020

**Expert Name:** Sheana Wheeldon

**Signature:**

