

.nz Dispute Resolution Service

DRS Reference: 1267

**Antler Farms NZ Ltd
Colin Lee**

v

**Braithwaite Holdings Ltd
Ngaire Carline**

Key words -

Domain name
antlerfarms.co.nz

Identical or similar trade mark or name
Registered mark – unregistered mark – identical

Rights

Unfair registration
Unfair registration – prior relationship between the parties – blocking registration

Procedure
Evidence

1. Parties

Complainant:

Antler Farms NZ Ltd
Colin Lee
8A Dalefield Drive
Cashmere
Christchurch
New Zealand

Respondent:

Braithwaite Holdings Ltd
Ngaire Carline
PO Box 372 Waiuku
Waiuku
Auckland 2341
New Zealand

2. Domain Name

antlerfarms.co.nz (the "Domain Name")

3. Procedural history

- 3.1. The Complaint was lodged on 15 December 2017 and the Domain Name Commission (“DNC”), notified the Respondent of the validated Complaint on 19 December 2017. The Domain Name was locked on 15 December 2017, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. The Respondent did not file a Response.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 29 January 2018 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4. Robert Fisher QC, the undersigned, (“the Expert”) confirmed to the DNC on 7 February 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. Antler Enterprises LLC (operating as Antler Farms) was registered as a limited liability company in Arizona, USA on 10 October 2012. It is wholly owned by Mr Kevin Hung HWANG. Since incorporation the company has been in the business of selling New Zealand-manufactured health products, particularly Deer Antler Velvet and Extract products, in the United States and elsewhere.
- 4.2. Antler Enterprises LLC registered the word mark ANTLER FARMS with the United States Patent and Trademark Office (“USPTO”) on 12 August 2014. The registration was for international class 5 (reg no. 4,586,329). A certificate from the USPTO indicates that the mark was first used commercially on 25 September 2012.
- 4.3. The Complaint says “Antler Farms LLC currently owns antlerfarms.com domain name and it operates its e-commerce store from this domain”. The Complainant has not explained the relationship between itself (“Antler Farms NZ Ltd”), on the one hand, and Antler Farms LLC or Antler Enterprises LLC, on the other. The website <antlerfarms.com> makes no reference to either corporation. In the WHOIS record, the entry under “Registrant Name” is “Registration Private”. The creation date for the domain was coincidentally recorded as 25 September 2012, the date which the USPTO certificate records as the first use of the word mark ANTLER FARMS. I infer that the reference to Antler Farms LLC in the Complaint was a typographical error and that Antler Enterprises LLC also owns <antlerfarms.com>.
- 4.4. On 11 June 2017 Antler Farms NZ Ltd (“the Complainant”) was incorporated in New Zealand. It too is wholly owned by Mr Hwang. The Complaint explains that the purpose of the NZ registration was to give the Antler Farms business a more permanent presence in its New Zealand manufacturing base and to improve access to Asian markets. Mr Colin Gregory Lee was appointed the sole Director of the Complainant.

- 4.5. On 25 September 2017 the Domain Name was registered by Braithwaite Holdings Ltd. The WHOIS record for the Domain Name gives the name Ms Ngaire Carline as the administrative and technical contact for the respondent. The Complainant identified Ms Carline and her partner Mr Ian Carline as the operators of Silberhorn International Ltd, a New Zealand based producer of health products. The products are said to include Deer Antler Velvet products.
- 4.6. Mr Lee is a past associate of Mr and Ms Carline and is well-known in the deer velvet manufacturing industry. Mr Carline has filed lawsuits against Mr Lee personally and against organisations associated with Mr Lee. Mr and Ms Carline are likely to be aware of Mr Lee's appointment as director of Antler Farms NZ Ltd.
- 4.7. The Complaint also annexed a European Union Intellectual Property Office certificate of registration for the word mark ANTLER FARMS, with registration date 8 November 2017. However neither the certificate nor the Complaint identifies the owner of that word mark. No evidence has been offered to suggest that that registered word mark belongs to the Complainant or one of its related companies.
- 4.8. The Complainant lodged the Complaint on 15 December 2017.

5. Parties' contentions

a. Complainant

- 5.1. The Complainant submits that the Respondent, Braithwaite Holdings Ltd, has no material claim to the name ANTLER FARMS.
- 5.2. It says the registration was an unfair registration and relies on para 5.1.1(b) and 5.1.1(c) of the Policy. It says the registration is an attempt to block or interfere with the Complainant, to prevent the Complainant from establishing itself in New Zealand; and a continuation of personal vexatious attacks against Mr Lee and his businesses.

b. Respondent

- 5.3. The Respondent has not provided a response.

6. Discussion and findings

- 6.1. The dispute is governed by the Policy issued by Domain Name Commission Ltd on behalf of InternetNZ. Critical portions of the Policy for present purposes are:

3. Definitions ...

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;

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;

...

4. Dispute Resolution Service

4.1 This Policy and Procedure applies to Respondents when a Complainant asserts to the DNC according to the Procedure, 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.

4.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

...

5. Evidence of 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;

...

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

...

6. How the Respondent may demonstrate in its Response that the Domain is not an Unfair Registration

- 6.1. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in paragraphs 6.1.1 – 6.1.4:

...

- 6.4 Trading in Domain Names for profit, and holding a large portfolio of Domain Names, are of themselves lawful activities. The Expert will review each case on its merits.

- 6.2. It will be seen that to support a complaint of the present kind (as distinct from complaints regarding sub-domains) the Complainant must satisfy three elements:

- a) Rights in respect of a name or mark (para 4.1.1);
- b) Identity or similarity between that name or mark and the Domain Names (para 4.1.1); and
- c) Unfair registration in the hands of the Respondent (para 4.1.2).

(a) Rights in respect of a name or mark

- 6.3. There is no evidence that the Complainant itself has registered or reputational rights in the name ANTLER FARMS. The mere registration of a company with the name "Antler Farms NZ Ltd" is not sufficient use to support a claim in passing off. Nor has the Complainant spelled out its legal relationship with Antler Enterprises LLC or the registered mark ANTLER FARMS. These matters must all be approached as a matter of inference.

- 6.4. Antler Enterprises LLC has rights in respect of the name ANTLER FARMS due to its United States trade mark. Although the trade mark is not registered in New Zealand, the definition of "rights" in the Policy is not limited to rights enforceable under New Zealand law. The definition is sufficiently wide to encompass trade marks registered in the United States.

- 6.5. In the circumstances of this case it can be inferred that Antler Enterprises LLC provided the Complainant with an informal exclusive licence to use its United States trade mark and any reputational rights associated with the commercial use of that name. That conclusion is justified having regard to the following:

- 6.5.1. Both companies are wholly owned by Mr Hwang.

- 6.5.2. Both companies are part of the same overall Antler Farms business.

6.5.3. The <antlerfarms.com> website markets products to customers in the United States using the name ANTLER FARMS and identifies a New Zealand address as the relevant physical address.

6.6. I accept that the Complainant has Rights in respect of the name ANTLER FARMS stemming from an exclusive licence to use the United States registered trade mark and reputational rights of its related company Antler Enterprises LLC. This requirement is satisfied.

(b) Identity or similarity between the name or mark and the Domain Name

6.7. The second requirement is to show that the Complainant's name or mark is identical or similar to the Domain Name.

6.8. The word mark ANTLER FARMS is identical to the Domain Name. This requirement is satisfied.

(c) Unfair registration in the hands of the Respondent

6.9. The third requirement is unfair registration. The Policy includes a non-exhaustive list of factors that may be evidence of unfair registration (paras 5.1.1 to 5.1.5). In this case the Complainant relies on paras 5.1.1(b) and (c) in particular.

6.10. I find that this element satisfied also, on the basis that the registration is unfair as a blocking registration. Given the business in which the Respondent is engaged, its principals' history with the director of the Complainant and the lack of use of the domain name it is not difficult to infer that the primary purpose of this registration was to use it as a blocking registration.

7. Decision

7.1. The three elements identified in para 6.2 above having been satisfied I determine that the disputed Domain Name should be transferred to the Complainant.

Place of decision Auckland

Date 20 February 2018

Expert Name Hon Robert Fisher QC

Signature

