

.nz Dispute Resolution Service

DRS Reference: 1361

**The British United
Provident Association
Limited
Matthew McIlroy**

v

Mr Carl Taylor

Key words –

Domain name
bupa.net.nz

Identical or similar trade mark or name

Registered mark - unregistered mark

Unfair registration

Unfair registration – unfair use – offer to sell, rent or otherwise transfer

Registrar -

1. Parties

Complainant:

The British United Provident Association Limited
Matthew McIlroy
Level 2, 109 Carlton Gore Road
Newmarket
Auckland
New Zealand

Respondent:

Mr Carl Taylor
Carl Taylor
10 Cassis Place
Crofton Downs
Wellington
New Zealand

2. Domain Name/s

bupa.net.nz

3. Procedural history

- 3.1. The Complaint was lodged on 14 May 2019 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 16 May 2019. The domain/s were locked on 15 May 2019, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. No Response was submitted.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 16 October 2019 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 30 October 2019 that s/he knew of no reason why s/he could not properly accept the invitation to act as expert in this case and that s/he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his/her independence and/or impartiality.

4. Factual background

- 4.1. The Complainant ("Bupa") is an international healthcare company incorporated in 1947. In 2018, the Bupa group had a global revenue of £11.9bn, £4.656bn of which was derived from Australia and New Zealand.
- 4.2. On 8 July 2005 Bupa incorporated a wholly-owned subsidiary, Bupa Care Services New Zealand Limited. It has over 4,500 employees, operates around 50 aged care homes with beds available for almost 4,000 residents, is a provider of dementia care, and has over 30 retirement villages with approximately 1,700 units available, 7 rehabilitation facilities and 25 dental clinics.
- 4.3. Bupa is a well-known name in the New Zealand retirement village and aged care sector. In 2008 it registered the domain name bupa.co.nz which it uses in the course of its business. It also has registered trade marks containing the name "bupa".
- 4.4. In 2017 Bupa applied for resource consent to build a new three to five storey Care Home in the Wellington suburb of Crofton Downs. Consent was initially given. Local residents then combined to appeal against the proposal in the form sought by Bupa. The Respondent, Mr Taylor, was a member of the residents' appeal group.
- 4.5. Bupa and the appeal group settled their dispute at a mediation held on 6 April 2018. At the mediation was another member of the group, Mr Turk. By the date of the mediation Mr Turk had already registered the domain name bupa.nz. Compensation for surrendering that name to Bupa was discussed, but not resolved, at the mediation.
- 4.6. Two days after the mediation the Respondent registered the Domain Name now in dispute. It has lain inactive ever since.
- 4.7. On 16 April 2018 Bupa emailed the Respondent to negotiate a transfer of the Domain. He responded that he was prepared to discuss it and asked for Bupa's terms for the transfer. Bupa offered to pay his documented out-of-pocket expenses associated with acquiring or using the Domain. He dismissed this stating that it was not worth his time and that as he had no documented costs

and or time costs and as this is not for a business he could not accurately state a dollar figure.

5. Parties' contentions

- a. Bupa contends that it has rights in the name Bupa, that the disputed domain name is confusingly similar, and that the Respondent's registration was and is an unfair registration.
- b. No response has been filed on behalf of the Respondent.

6. Discussion and findings

6.1 The dispute is governed by the Policy issued by Domain Name Commission Ltd on behalf of InternetNZ. The foundation for a complaint is found in these extracts from paras 3 and 4 of the Policy:

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;

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. ^[11]_{SEP}

6.2 It will be seen that to support a complaint of the present kind, the Complainant must satisfy three requirements:

- a) It has rights in respect of a name or mark (para 4.1.1);
- b) The name or mark and the Domain Names are identical or similar (para 4.1.1); and
- c) Registration of the Domain Name was or is unfair in the hands of the Respondent (para 4.1.2).

(a) Rights in respect of a name or mark

6.3 The Complainant has two independent sources of the right to use the name "Bupa". One emanates from the reputation it has built up as a retirement and health care provider using that name (technically a common law mark protected by an action for passing off). The other is its registration of a succession of trade marks using that name. This requirement is satisfied in the present case.

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

6.4 The second requirement is that the Complainant's name or mark be identical or similar to the Domain Name. The word "bupa" is common to both the Complainant's name and the Domain Name. This requirement is also satisfied.

(c) Unfair registration in the hands of the Respondent

6.5 The third requirement is unfair registration. Unfair registration is governed by paras 3 and 5 of the Policy which materially provide:

3. Definitions

...

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;

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;

...

6.6 The following considerations are a guide to the Respondent's purpose in registering the Domain Name:

6.6.1 The Respondent registered the name two days after a discussion between Bupa and another member of his group over the price Bupa would be prepared to pay to recover a Domain Name containing its own name.

6.6.2 The Respondent must have been well aware of Bupa and the use of that acronym as a highly unusual name when he elected to register the Domain Name.

6.6.3 The Respondent has not put the Domain Name to any use.

6.6.4 Although ready to sell the Domain Name to Bupa, the Respondent was not prepared to do so for the documented out-of-pocket expenses incurred in acquiring the Domain.

6.7 In those circumstances it is difficult to think of any purpose the Respondent could have had in registering the name other than to sell it to Bupa at a profit.

6.8 I conclude that the third and final requirement for a successful complaint is satisfied.

7. Decision

7.1 The disputed Domain Name is to be transferred to the Complainant.

Place of decision Auckland, NZ

Date 1 November 2019

Expert Name Robert Fisher

Signature

