

.nz Dispute Resolution Service

DRS Reference: 1388

Altra LLC

v

**Global Internet
Development**

Key words

Unfair registration

Unfair registration – likely to confuse, mislead or deceive – pattern of registration – unfairly disrupting the business of the complainant – blocking registration

Registrar: 1API GmbH

1. Parties

Complainant:

Altra LLC
Utah 1500 s 1000 w Logan Utah
84321
Logan
United States

Represented by: Cecilia Borgenstam

Respondent:

Global Internet Development
Mbx 1391 London Road
Leigh on Sea
United Kingdom

Registrar: 1API GmbH

2. Domain Name

altrarunning.co.nz

3. Procedural history

3.1. The Complaint was lodged on 25 March 2020, and the Domain Name Commission (DNCL) notified the Respondent of the validated Complaint on 25 March 2020. The domain was also locked on 25 March 2020, 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 02 June 2020 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy (“the Policy”).
- 3.4. Kevin Glover, the undersigned, (“the Expert”) confirmed to the DNC on 22 June 2020 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.
- 3.5. The Complainant’s submissions were provided to the Expert on 22 June 2020.

4. Factual background

- 4.1. The Complainant was founded in 2011. The Complainant’s two founders, Golden Harper and Brian Beckstead, are running enthusiasts. The Complainant says that its core business comprises the sale of running shoes, and that it is engaged in the design, development, marketing, and sale of footwear, including road running and trail running shoes.
- 4.2. The Complainant says that it has registered the mark ALTRA as a trade mark in numerous countries, including New Zealand. In particular, the Complainant is the registered proprietor in New Zealand of trade mark registration no. 976352 for the word mark ALTRA in class 25. The goods for which the mark is registered include athletic apparel, triathlon clothing, running shoes, cross country shoes, hiking shoes, and trail running shoes. The New Zealand trade mark’s deemed date of registration is 26 April 2013.
- 4.3. The Complainant also submits that as a result of extensive use, advertising and revenue associated with its trade mark ALTRA, including in New Zealand, it enjoys a high degree of renown. No specific evidence of New Zealand use, advertising and revenue was provided, however, other than evidence of archived screen shots of the New Zealand distributor’s website.
- 4.4. The Complainant and its parent company, VF Services, Inc, have registered a number of domain names containing the term “altra”, including altrarunning.com, altraco.uk, and altrarunning.com.au.
- 4.5. In New Zealand, the Complainant’s former distributor, Araroa Imports Limited, operated a site at www.altrarunning.co.nz for a period of time from at least 2016 onwards. Ultimately, though, the domain name registration was allowed to lapse and was registered by the Respondent.

The Domain Name and its use

- 4.6. The Respondent registered the domain name on 09 December 2019.
- 4.7. The website at altrarunning.co.nz is currently inactive. According to the Complainant’s submissions, however, at the time the Complaint was filed the domain name resolved to a website that appeared at first glance to be a running blog, but which was, in the Complainant’s submission, simply a pretext for cybersquatting.

- 4.8. The Complainant notes, for example, that there were similarities in the names and dates used on the site and the names and dates that appeared on the website formerly operated by the Complainant's distributor. In addition, the owner of the blog site was identified as "Alexander Turnbull". According to the Complainant, there is no living person in New Zealand with that name. The name is, however, famously associated with the Alexander Turnbull Library.

5. Parties' contentions

Complainant

- 5.1. The Complainant submits that as a result of the extensive advertising and use of the Complainant's mark, the Respondent would have been well aware of the Complainant's rights before registering and using the domain name in a manner that took unfair advantage of the Complainant's rights, and was detrimental to those rights.
- 5.2. As noted above, the Complainant suggests that the content on the website at altrarunning.co.nz was fabricated. It alleges that the website was not genuine and was added in the hope that the Complainant would seek to purchase the Domain Name from the Respondent. The Complainant alleges that the site was designed at first glance to appear to be a blog site, but in fact was not. It notes that the website operated by the Respondent comprised a Wordpress site with an installation designed to improve Search Engine Optimization and increase traffic to the site. It submits that this was likely to have been done in an attempt to increase the value of the Domain Name.
- 5.3. The Complainant submits that the registration and use of the Domain Name would give rise to initial interest confusion. It says that internet users would visit the site in the hope and expectation that the website was operated or authorised by, or otherwise connected with, the Complainant – especially since the website at that address was previously operated by the Complainant's distributor.
- 5.4. The Complainant further submits that the Respondent has demonstrated a pattern of conduct of domain names in which it has no rights. It notes, for example, that the Respondent has been ordered to transfer domain name registrations in a number of previous proceedings, including the following:
- a. WIPO Case DSE 2019-0040 (December 2019) (Sweden);
 - b. WIPO Case DNU 2018-0001 (June 2018) (Niue);
 - c. WIPO Case DSE 2018-0012 (May 2018) (Sweden);
 - d. Nominet DRS Case D00020628 (November 2018) (UK);
 - e. Nominet DRS Case D00018986 (August 2017) (UK); and
 - f. Nominet DRS Case D00018473 (March 2017) (UK).

Respondent

- 5.5. As noted above, the Respondent did not file a Response.

6. Discussion and findings

- 6.1. In terms of the Policy, a Complainant is entitled to the transfer of a domain name where:

- a. it has Rights in a name which is similar or identical to the domain name, and
- b. the domain name was registered or has been used in circumstances which make it an Unfair Registration.

Rights

- 6.2. I accept that the Complainant has Rights in the mark ALTRA, which is similar to the Domain Name. This is based on, at least, the Complainant's registration of ALTRA as a word trade mark in New Zealand.
- 6.3. In addition, the Complainant has Rights in the specific domain name altrarunning.co.nz arising from the fact that it uses the word "running" in conjunction with the ALTRA mark on its Australian website, www.altrarunning.com.au, both in the copy and the Domain Name.
- 6.4. For completeness, I do not find that the previous New Zealand domain name alone is sufficient to show Rights in the name. This is because the Complainant advises that the site was run by its distributor, but the complaint does not provide any details such as the nature of that relationship (and entitlement to goodwill), website traffic, value of sales made through the site or promotional activities directed to the New Zealand website specifically.

Unfair Registration

- 6.5. The next step is to consider whether the Domain Name, in the hands of the Respondent, is an Unfair Registration. The Complainant bears the onus of proving this, on the balance of probabilities.
- 6.6. Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors which may indicate that a registration is an Unfair Registration. I consider the following provisions to be of most relevance:

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;

5.1.3. 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;

6.7. In assessing whether or not the Domain Name is an Unfair Registration in the hands of the Respondent, I take into account the following matters:

- a. ALTRA is an invented word, and is used by the Complainant in conjunction with the word running and in relation to running-related subject matter. It is towards the distinctive end of the distinctive-descriptive spectrum.
- b. The Respondent has chosen not to file a Response which could explain the matters raised by the Complainant.
- c. The Respondent's explanation of the genesis and development of the site on the website hosted at the Domain Name at the time the complaint was filed is inconsistent with the timing, namely its registration in December 2019. It appears to have created a basic website intended to give a veneer of genuine use, but which does not bear scrutiny.
- d. The Respondent has engaged in a pattern of registration of trade marks in which the Respondent has no apparent rights, including the six decisions identified and relied upon by the Complainant.

6.8. I find that, on the balance of probabilities, the Respondent registered the Domain Name in order to block the registration of the Domain Name by the Complainant, and in order to unfairly disrupt the Complainant's business, and that in registering the Domain Name it was aware of the Complainant's use of corresponding domain names overseas and/or the previous registration and use of www.altrarunning.co.nz by the Complainant's distributor.

6.9. The most likely motivation for the registration of the Domain Name was to sell, rent or otherwise transfer the Domain Name to the Complainant or to a competitor of the Complainant.

6.10. The Respondent's conduct in relation to the Domain Name is consistent with the Respondent's prior pattern of abusive registrations as found by complaints to Nominet and WIPO.

6.11. I find the registration to be an Unfair Registration in terms of the Policy.

7. Decision

Complaint successful, transfer ordered.

Place of decision **Auckland**

Date **7 July 2020**

Expert Name **Kevin Glover**

Signature

