

## DISPUTE RESOLUTION SERVICE

DRS 9416

### Decision of Independent Expert

New Zealand Milk Brands Limited

and

New Media Services Limited

#### 1. The Parties

Complainant:	New Zealand Milk Brands Limited 9 Princes Street Auckland New Zealand
Respondent:	New Media Services Limited Mail Box 9F 10 Dubnov Street Tel Aviv 64732 Israel

#### 2. The Domain Name

*anchorbutter.co.uk* (the "Domain Name")

#### 3. Procedural History

- 3.1 The Complaint was filed 20 January 2011. It was validated on 24 January 2011 and a copy was sent to the Respondent on the same date by post and by email to two

separate email addresses. While one email address returned an "undeliverable" message, the other did not. There is therefore nothing to suggest that at least one of the emails did not reach the Respondent.

- 3.2 A Response reminder was sent by email to the Respondent on 10 February 2011. Still no Response was received. Again, only one of the email addresses used returned an "undeliverable" message. On 15 February 2011 a No Response notification was sent to the parties, including the Respondent, by post and email.
- 3.3 This DRS proceeding is therefore to be treated as a 'no response' case.
- 3.4 On 15 February 2011 Nominet wrote to the Complainant informing it that the Respondent had not responded to the Complaint by the deadline, which meant that there could be no mediation. It gave the Complainant the option of paying a fee for the appointment of an independent expert to provide a summary or a full decision. On 15 February Nominet also wrote to the Respondent in similar terms. The Complainant opted for a full decision.
- 3.5 The Independent Expert was appointed on 4 March 2011.

## **4. Factual Background**

- 4.1 The Domain Name was registered by the Respondent on 29 October 2006.
- 4.2 The Domain Name is currently pointing to a domain parking page.
- 4.3 The Complainant, New Zealand Milk Brands Limited, is a subsidiary of Fonterra Brands (New Zealand) Limited, a co-operative owned by approximately 11,000 New Zealand dairy farmers. One of the brands marketed and distributed by Fonterra is Anchor butter, a brand which has been in existence since 1886.

## **5. Parties' Contentions**

### Complaint

- 5.1 The Complainant owns 14 UK and Community trade marks incorporating the ANCHOR name, including:
  - 5.1.1 ANCHOR SWIRLS word mark and device in Class 29 registered with effect from 7 March 1997 (UK trade mark no. 2107971);
  - 5.1.2 ANCHOR THE FREE RANGE BUTTER CO word mark and device in Class 29 registered with effect from 30 May 2008 (UK trade mark no. 240004);
  - 5.1.3 ANCHOR PREMIUM word mark and device in Class 29 registered with effect from 7 March 1997 (UK trade mark no. 2107972);

- 5.1.4 ANCHOR word mark and device in Class 29 registered with effect from 30 December 1987 (UK trade mark no. 1250524);
  - 5.1.5 ANCHOR word mark and device in Class 29 registered with effect from 28 December 1962 (UK trade mark no. 834786);
  - 5.1.6 ANCHOR word mark in Class 29 registered with effect from 22 August 1923 (UK trade mark no. 433513);
  - 5.1.7 ANCHOR LIGHTER word mark in Class 29 registered with effect from 23 February 2007 (UK trade mark no. 2429620);
  - 5.1.8 ANCHOR MINIATURES word mark in Class 29 registered with effect from 17 August 2001 (UK trade mark no. 2263965);
  - 5.1.9 ANCHOR; ANKER (series) word mark in Class 5 registered with effect from 20 January 1989 (UK trade mark no. 1249473);
  - 5.1.10 ANCHOR; ANKER (series) word mark in Class 29 registered with effect from 10 March 1989 (UK trade mark no. 1249474);
  - 5.1.11 ANCHOR; ANKER (series) word mark in Class 30 registered with effect from 10 March 1989 (UK trade mark no. 1249475);
  - 5.1.12 ANCHOR; ANKER (series), UK trade mark no. word mark in Class 32 registered with effect from 20 January 1989 (UK trade mark no. 1249476);
  - 5.1.13 ANCHOR word mark in Classes 5, 29 and 30 registered with effect from 01 March 2006 (CTM no. 4076832);
  - 5.1.14 ANCHOR SO SOFT stylised word mark and device in Class 29 registered with effect from 18 January 2001 (CTM no. 1283233).
- 5.2 All the above trade mark registrations are evidenced by the Complainant.
- 5.3 The Complainant asserts that it has developed substantial goodwill and reputation in the above trade marks in the UK and around the world in the course of its business, through its licensee (not identified), in the production, marketing and distribution of butter, butter substitutes (aka "spreadables") and cream products, under the ANCHOR name in the UK and more generally in the European Union since "at least 2001".
- 5.4 It says that the annual turnover in the UK of goods sold under the ANCHOR name is £85.5 million, though this is not evidenced.
- 5.5 The Complainant says that through its UK licensee it spends approximately £6 million annually on marketing, including advertising, Anchor products in the UK, though again no evidence is provided in support of that assertion (save for some examples of the advertisements themselves).

- 5.6 The Complainant says that it is registrant of the *anchor.co.nz* domain name and that at least since August 2005 it has operated a website under this domain name, through its parent Fonterra Brands (New Zealand) Limited, advertising Anchor butter products.
- 5.7 It further asserts that its parent is also the registrant of the *anchorbutter.com* domain name. The Complainant exhibits historic versions of the *anchor.co.nz* website and the *anchorbutter.com* website from 2005 and 2006. It asserts that these archived website pages demonstrate use of the ANCHOR name by the Complainant in relation to butter and dairy products and that Anchor products were advertised on those websites.
- 5.8 The Complainant also asserts common law rights in the ANCHOR name, by reference to a number of the facts as outlined above, and says that when the Domain Name was registered the ANCHOR mark was "*exclusively associated with the Complainant in the UK*".
- 5.9 As for the similarity between the ANCHOR mark and the Domain Name, the Complainant contends that the addition of the word "butter", which is descriptive of the product sold by the Complainant by reference to the mark in question, is insufficient to distinguish the Domain Name from the name in which the Complainant has rights. Indeed, it contends that the use of the word "butter" with the Anchor mark "*adds to the similarity*".
- 5.10 The Complainant asserts that the Domain Name in the hands of the Respondent is an Abusive Registration as defined in the DRS Policy (the "Policy"). In support of that contention it relies on a number of factors, as follows:
- 5.10.1 At the date of registration of the Domain Name (29 October 2006) the Complainant, via its licensee, had already been advertising and selling dairy products in the UK under the Anchor mark "*for more than five years*" and had therefore built up significant reputation and goodwill in the ANCHOR mark.
- 5.10.2 The Complainant believes that the Respondent was "*well aware of the Complainant and the Complainant's licensee's trading activities under the ANCHOR name around the world and in the UK, and its rights in the ANCHOR name in the UK well before the date of registration of the Domain Name*". No reason is provided for this assertion, let alone any evidence supporting it.
- 5.10.3 The Respondent is using the Domain Name on a parking page which provides sponsored links to a number of businesses including those of competitors of the Complainant, such as Dairy Crest and Flora. The Complainant further points out that the page contains a number of 'Related Searches', which themselves lead to further sponsored listings, some of which are related to food and dairy products.
- 5.10.4 The Complainant therefore concludes that it is "*highly likely*" that the Respondent is earning revenue on a pay per click basis from that parking page.

- 5.10.5 The Domain Name uses the entire name of the Complainant's product, Anchor Butter, notwithstanding that the word "anchor" is highly distinctive in association with butter or dairy products.
- 5.10.6 As identified in paragraph 3(a)(i)(B) of the Policy, the Respondent is using the Domain Name as a blocking registration, because the Complainant is being prevented from registering the Domain Name for *"legitimate use in relation to its Anchor Butter business"*.
- 5.10.7 As identified in paragraph 3(a)(i)(C), the Respondent is seeking to disrupt the business of the Complainant by diverting customers looking for the Complainant's products to its own website which provides links to the sites of competing products.
- 5.10.8 Finally, as identified in paragraph 3(a)(ii), the Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant and that it is therefore being used in a manner which is unfairly detrimental to the Complainant's Rights. In this regard, the Complainant relies on the fact that the Respondent uses *"the entire name of the Complainant's product"*, i.e. Anchor Butter. It also relies on the Respondent having made *"extensive use of the 'Anchor' and 'Anchor butter' names in relation to butter products and provides links to butter and dairy related products"* and that it is therefore *"highly likely"* that visitors to the Respondent's Domain Name parking page *"will be confused into believing the Domain Name is in some way connected with the Complainant"*.

#### Response

- 5.11 As recorded in paragraph 3.2 above, the Respondent appears to have decided not to file a Response.

## **6. Discussions and Findings**

#### General

- 6.1 To succeed under the Policy, the Complainant must prove on the balance of probabilities, first, that it has Rights (as defined in the Policy) in respect of a name or mark that is identical or similar to the Domain Name (paragraph 2(a)(i) of the Policy), and secondly, that the Domain Name is an Abusive Registration in the hands of the Respondent (paragraph 2(a)(ii) of the Policy).

- 6.2 Abusive Registration is defined in paragraph 1 of the Policy in the following terms:

*"Abusive 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 used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."*

#### Complainant's rights

- 6.3 Paragraph 2(a)(i) of the Policy requires the Complainant to prove that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*". Rights means "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*".
- 6.4 The Complainant relies, first, on its statutory rights in the ANCHOR mark. It is well established that the threshold to establish Rights is not high. It is plain from the Complainant's registered word and device marks (see paragraph 5.1 above) that it satisfies this threshold, so far as the ANCHOR mark is concerned.
- 6.5 Secondly, on a belt and braces basis, the Complainant also relies on its common law rights in the Anchor name. It asserts that it has substantial goodwill and reputation in the Anchor name in the UK and worldwide. However, no evidence of either its investment in promoting the Anchor name or of the annual revenue generated by Anchor products is provided. Further, it is not at all clear how such goodwill and reputation is said to accrue to the Complainant, as distinct from either its parent company or its licensee in the UK.
- 6.6 For these reasons, if the Complainant was relying on its common law rights alone, it is doubtful that it would have discharged its burden of proof.
- 6.7 Thirdly, the Complaint hints at, but fails expressly to plead, let alone develop or evidence, the beginnings of an argument that the Complainant owns rights, either statutory or at common law, in the ANCHOR BUTTER mark and/or name. In those circumstances, it has plainly failed to establish any such rights.
- 6.8 However, given its registered trade marks in ANCHOR mark (see 6.4 above), the position in relation to its rights at common law and/or any Rights in the ANCHOR BUTTER mark and/or name (6.5 to 6.7 above), is not in any event determinative of the position under the DRS.
- 6.9 While the Domain Name is not identical to the name in which the Complainant has established Rights, it is now settled under the DRS that the inclusion of generic or descriptive words together with a name or mark in which the Complainant has Rights does not mean that the Domain Name in question is so dissimilar that it falls outside paragraph 2(a)(i) (see *natwestloans.co.uk* (DRS3390), *tescoestateagents.co.uk* (DR3962), *replicarolex.co.uk* (DRS5764) and *veluxblind.co.uk* (DRS6973), by way of examples).
- 6.10 Accordingly, the Expert finds that the Complainant satisfies paragraph 2(a)(i) of the Policy.

## Evidence of Abusive Registration

- 6.11 The Complainant does not put its case on Abusive Registration particularly clearly. In part, it appears to assert, in the most general terms, that the Respondent has taken unfair advantage of its Rights (as defined), while, on the other hand, also relying on three of the specific examples of Abusive Registration set out in paragraph 3 of the Policy.
- 6.12 So far as the latter are concerned, the Complainant relies, in the first place, on paragraph 3(a)(i)(B) of the Policy, which provides that circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily as blocking registrations against the name or mark in which the Complainant has Rights may constitute evidence of Abusive Registration.
- 6.13 The Complainant cites in support of this contention the fact that the Respondent "*is using the entire name of the Complainant's product in the Domain Name*". However, the relevant test is whether the Domain Name was registered primarily as a blocking registration, i.e. to prevent the Complainant from itself registering and using the Domain Name.
- 6.14 The Complainant has not submitted, much less adduced any evidence, that it had plans to register *anchorbutter.co.uk* in addition to *anchorbutter.com*, let alone that the Respondent had knowledge of any such intentions. In those circumstances, it is difficult to see how the Respondent could be said to have registered the Domain Name primarily as a blocking registration. The test is one of intention at the time of registration. The Complaint therefore fails to establish evidence of Abusive Registration under this head.
- 6.15 Secondly, the Complainant relies on paragraph 3(a)(i)(C) of the Policy, which provides that circumstances indicating that the Respondent has registered or otherwise acquired the Domain Names primarily for the purpose of unfairly disrupting the business of the Complainant may constitute evidence of Abusive Registration. Again, the question is one of the Respondent's intention in registering the Domain Name.
- 6.16 The Complainant says that the Respondent is seeking to disrupt its business by diverting consumers who are looking for its products "*to the website operated by the Registrant providing links to competing products*". However, the Complainant has provided no evidence of any such disruption, let alone evidence that an intention to cause any such disruption was the Respondent's primary motivation in registering the Domain Name. For this reason, the Complaint fails under this head as well.
- 6.17 Thirdly, the Complainant relies on paragraph 3(a)(ii) of the Policy, which provides that circumstances indicating that the Respondent is using the domain name in a way which has confused or is likely to confuse people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant may be evidence of Abusive Registration.
- 6.18 In support of this contention, the Complainant relies on the fact that the Domain Name comprises its mark and the word "butter", which itself constitutes "*the entire name of the Complainant's product*", and that the web page to which the Domain

Name points *"makes extensive use of the 'Anchor' and 'Anchor Butter' names in relation to butter products and provides links to butter and dairy related products"*. The Complainant says that it is therefore "highly likely" that internet users seeing that web page *"will be confused into believing the Domain Name is in some way connected with the Complainant"*. However, no evidence is provided of such confusion or the likelihood of such confusion.

- 6.19 The web page in question does not appear to include any Anchor Butter branding. The chances of an internet user thinking that the Complainant would be using the Domain Name in such a way on a domain parking page, rather than, for example, to operate a website promoting Anchor Butter to its UK market, would appear to be relatively low. Accordingly, the Complaint fails under this head also.
- 6.20 That therefore leaves the Complainant's generalised assertion that the Respondent has taken unfair advantage of the Complainant's Rights either at the date of registration of the Domain Name or in the manner in which the Domain Name has been used.
- 6.21 So far as the former is concerned, i.e. in reliance on the definition of Abusive Registration under paragraph 1(i) of the Policy, the Complainant relies on its assertion that at the date of registration the Complainant had, through its licensee, been trading in the UK for more than five years and that it believes that the Respondent was well aware of the Complainant having traded by reference to the Anchor name. While the Expert accepts that the Anchor brand is reasonably well known in the UK, and while the Complainant might have argued (though it did not) that the fact that the Respondent coupled the word "butter" with the word "Anchor" raises an inference of such awareness, the Complainant is unable to point to any evidence that the Respondent (based in Israel) was aware of the Anchor brand at the date of registration. For example, no evidence is provided of the extent of sales in Israel of Anchor butter products.
- 6.22 There is some authority in DRS, and more particularly UDRP, proceedings for the proposition that where a mark is particularly well known, a presumption is raised that the Respondent was acting in bad faith in registering a domain name which infringes the rights in that mark, in essence because common sense would suggest that the Respondent must have been aware of the existence of that mark. Whether that proposition can be said to apply in this particular case is less clear.
- 6.23 However, the point is in any event moot because the Complainant also relies on the second limb of the definition of Abusive Registration, namely that the Domain Name has been used in a manner which took unfair advantage of the Complainant's Rights. The Complainant relies in this regard on the Respondent's use of the Domain Name to point to a parking page which provides sponsored links to a number of businesses (including those of competitors of the Complainant, such as Dairy Crest and Flora) and which contains a number of 'Related Searches', which themselves lead to further sponsored listings, some of which are related to food and dairy products.
- 6.24 The Expert accepts that it is indeed "highly likely" that the Respondent will be earning revenue on a pay per click basis from such use of the Domain Name, which plainly piggy-backs on the Complainant's Rights in the ANCHOR mark.



6.25 Accordingly, the Expert is satisfied, on the balance of probabilities, that such use of the Domain Name takes unfair advantage of the Complainant's Rights in the ANCHOR mark.

## **7. Decision**

7.1 Accordingly, the Expert finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7.2 It is therefore determined that the Domain Name be transferred to the Complainant.

Signed **David Engel**

**Date** 25 March 2011