

# Maximise your chances of success under the DRSP: draft a cogent complaint

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New Zealand's Dispute Resolution Service Policy (DRSP) is showing itself to be a very effective dispute resolution mechanism for complaints in respect of .nz domain name registrations. That 90% of decided complaints in 2010 were resolved in favour of complainants is clearly testament to this – and also how critical it is to draft a complaint correctly.

## What a complainant must prove

For a complaint to succeed, you must prove that:

- You have rights in respect of a name or mark which is identical or similar to the disputed domain name; and
- The disputed domain name, in the hands of the registrant, is an unfair registration, meaning the domain name:
  - 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 your rights; or
  - Has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to your rights.

## Address all the elements

To maximise your chances of success, it is critical that your complaint addresses each of the elements above.

For example, if the complainant is a company which owns a trade mark registration in an identical or similar name to the disputed domain name, but the trade mark registration is in the name of one of the directors, unless that director is named as a complainant the Expert appointed to decide your complaint may find that the complainant (i.e. the company) does not have the necessary rights and the complaint may be dismissed.

## Provide supporting evidence

It is also critical that your argument in respect of these elements is substantiated wherever possible by way of supporting evidence. For example, if you do not have a trade mark registration you will need to provide cogent evidence which establishes the goodwill and reputation you claim you have in a name which is identical or similar to the disputed domain name.

The sort of evidence you can file to do this might include company incorporation details from the Companies Register; examples of advertising and promotional materials, both in print and online; examples of corporate stationery, including letterhead, compliment slips and order books; examples of sponsorship activities and community involvement; and any news and/or reviews pieces in local or national media.

### **Address any possible defences**

To further maximise your chances of success, you must also address any defences which the domain name registrant (the respondent) may put forward. A respondent can argue a range of defences, although the most common ones are that, before being aware of the complainant's objections, he/she/it:

- (a) had used or made demonstrable preparations to use the disputed domain name (or a domain name which is similar to the disputed domain name) genuinely in connection with goods or services; or
- (b) had been commonly known by the disputed domain name or legitimately connected with a mark which is identical (or similar) to the disputed domain name; or
- (c) had made legitimate non-commercial or fair use of the disputed domain name.

Alternatively, if your trade mark is descriptive, many respondents will argue that the disputed domain name is generic or descriptive and he/she/it is making fair use of it in a way which is consistent with its generic or descriptive character.

Fortunately, under the DRSP a complainant has the opportunity to file submissions in reply to a response, so it is not critical that any defences be addressed in the original complaint – but if they are not, they should be addressed in reply.

### **Conclusion**

The DRSP procedure can be very effective – provided your complaint is drafted appropriately to maximise your chances of success.

We are experienced in domain name dispute resolution under the DRSP and can help you with a complaint whether you are the complainant or the respondent. Contact our Litigation team to discuss how we can help you.

### **Disclaimer**

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.

## Drafting a domain name complaint: checklist

In your complaint, have you:

**Demonstrated your rights, by attaching one or more of the following:**

- Copy of any relevant trade mark registrations
- Evidence of the first date on which you have used the name or trade mark
- Evidence of the full range of goods and/or services for which you have used the name or trade mark
- Copies of pages from your website showing use of your name or trade mark
- Samples of advertising and promotional material showing use of your name or trade mark

**Demonstrated the registration is unfair:** for example, has the registrant:

- Offered to sell you the domain name for an excessive price?
- Registered the domain name to stop you from registering the same domain name?
- Unfairly disrupted your business?
- Used the domain name in a way which is likely to

confuse, mislead or deceive people or businesses into believing the domain name is somehow connected to you?

- Registered the domain name as part of a number of domain names using well known names or trade marks in which the registrant has no apparent rights?

**Addressed any possible defences the respondent may raise:** for example, has the registrant:

- Used or made demonstrable preparations to use the domain name in connection with a genuine offering of goods or services?
- Been commonly known by the name or legitimately connected with a trade mark which is identical or similar to the domain name?
- Made legitimate non-commercial or fair use of the domain name?

Or

- Is the domain name generic or descriptive and the registrant is making fair use of it in a way which is consistent with its generic or descriptive character?
- Is the registration by the registrant consistent with an express term of a written agreement entered into by you and the registrant?