

**IN THE HIGH COURT OF NEW ZEALAND
AUCKLAND REGISTRY**

**I TE KŌTI MATUA O AOTEAROA
TĀMAKI MAKĀURAU ROHE**

**CIV-2018-404-000218
[2018] NZHC 1521**

BETWEEN

MARTIN CHRIS DOUGIAMAS
First Plaintiff

THE MOODLE TRUST
Second Plaintiff

MOODLE PTY LTD
Third Plaintiff

AND

123 INTERNET LIMITED
First Defendant

MOODLE PARTNERS NEW ZEALAND
LIMITED
Second Defendant

ONLEARN LIMITED
Third Defendant

GARY TREVOR BENNER
Fourth Defendant

Hearing: 22 June 2018

Appearances: G Williams for Plaintiffs
No appearance for Defendants

Judgment: 22 June 2018

ORAL JUDGMENT OF VENNING J

Solicitors: Lowndes Ltd, Auckland
Counsel: G Williams, Auckland

[1] In these proceedings the plaintiffs claim the defendants' use of the trade mark Moodle breaches the Fair Trading Act 1986 (FTA) in various ways and constitutes the tort of passing off. They also seek relief in relation to the trade mark itself.

Background

[2] The background is set out in the affidavit of Mr Dougiamas, the first plaintiff. He is also a director of the second plaintiff, The MOODLE Trust, and a majority shareholder and director of the third plaintiff, MOODLE Pty Limited.

[3] The MOODLE Platform is a free and open-source learning management system written in PHP and distributed within the GNU General Public License. Mr Dougiamas started developing the MOODLE platform in 1999. In short it enables educators across the world to create internet-based educational communities, courses, and websites. It has been in continual development and its development is currently led by a team at MOODLE Pty Limited at its base in Perth.

[4] The development of the MOODLE Platform is financially supported by a network of over 90 licensed and certified MOODLE Partner service companies around the world. They provide services to users of the MOODLE Platform, including hosting, training, customisation, and content development. Currently there are two certified MOODLE Partners operating in New Zealand, Catalyst IT Limited and Human Resource Development International Limited (HRDIL).

[5] Mr Dougiamas first adopted the word MOODLE as the name for the Platform in 1999. Originally it stood for his first name, Martin's Object Oriented Dynamic Learning Environment, but it now represents Modular Object-Oriented Dynamic Learning Environment. In 1999 he registered the domain name moodle.com and launched a website of that domain relating to the MOODLE Platform. Mr Dougiamas has also taken steps to register MOODLE as an Australian word trade mark in several classes of goods and services.

[6] Mr Dougiamas has secured trade mark registration for the word mark MOODLE in a number of countries around the world and in a number of classes. He also, jointly with his then wife, applied for registration of the word trade mark

MOODLE in classes 9 and 42 in New Zealand, obtaining registration in October 2006. Following the parties' separation and divorce his wife's interest in the New Zealand trade mark was transferred to Mr Dougiamas. Unfortunately the trade mark expired on 22 July 2016 as a result of one of MOODLE Pty Limited's employees inadvertently failing to pay the relevant renewal fee.

[7] In late 2003, early 2004, Mr Dougiamas developed two logos incorporating the MOODLE trade mark. The first was the word MOODLE with a stylised black mortarboard hat tilted over the top of the letter M. The second related to the Moodle Partners' Programme consisting of the word MOODLE immediately above the word Partner with the word partner having a stylised black mortarboard hat tilted over the top of the letter P. Subsequently further logos were developed from a MOODLE Partner Mortarboard Hat Logo. They consist of the logo together with the words Certified Services Provider.

[8] In 2004 the MOODLE Trust, the second plaintiff and an entity of which he was and remains a director was created to undertake the role of a primary developer and copyright owner of the MOODLE Platform software. Mr Dougiamas authorised the MOODLE Trust to use the moodle.com and moodle.org domains to publish websites relating to the Platform. The MOODLE Trust was also the entity initially used to provide services to certified MOODLE Partners and was authorised to grant licences.

[9] The third plaintiff MOODLE Pty Limited was incorporated on 4 October 2005 and since incorporation has assumed responsibility for the core development of the MOODLE Platform. It now maintains and develops the Platform community websites and manages the MOODLE Partner Certified Services Provider Programme. The website operated by MOODLE Pty Ltd and moodle.org is used to enable the MOODLE community to learn about the open and collaborative effort of one of the largest open sourced teams in the world, i.e. MOODLE.

[10] Mr Dougiamas has given evidence of the use of the MOODLE Platform. For example, as at 16 May 2018 101,234 universities, corporations and educational facilities used the MOODLE Platform throughout the world; 14,901,277 courses were offered using the MOODLE Platform; and 129,749,842 users were recorded. The

statistics show that the platform was used in at least 228 countries, including New Zealand. Mr Dougiamas says however that the statistics only relate to institutes and corporate entities that have volunteered their information. There are many more users who have not formally registered their use of the Platform.

[11] Since mid-2015 MOODLE Pty Ltd has provided MOODLECloud hosting services to customers in New Zealand and the trade mark MOODLE and MOODLE Mortarboard Hat Logos have been used continuously in New Zealand by or under licence from the plaintiffs since at least 2004 and a substantial reputation in the mark MOODLE and the MOODLE Mortarboard Hat Logos has been built up throughout New Zealand by virtue of that use. The Platform is used extensively throughout New Zealand, particularly in the academic sector. As at 16 May 2008 there were, for example, 329 registered sites using the MOODLE Platform software based in New Zealand. Two hundred and forty three of them requested not to be publicly listed on the MOODLE websites when established so are not expressly named in the New Zealand section of the published register of MOODLE site's database.

[12] Catalyst IT Limited is a global group of open software specialists with teams in the United Kingdom, Australia and New Zealand. It has been a certified MOODLE partner since October 2004 and since 2004 has been licensed to offer and provide its MOODLE services using the MOODLE trade mark and the MOODLE Mortarboard Hat Logos as a MOODLE Partner to clients in New Zealand. For example, it has provided MOODLE services to the New Zealand Inland Revenue Department.

[13] Human Resource Development International Limited has been a MOODLE partner since September 2006 and provides a full range of MOODLE Partner services in New Zealand, including hosting all levels of training, customisation, themes, support and development. It has provided services as a MOODLE Partner to a number of clients, including New Zealand Blood Service, Human Rights Commission, Massey University, Auckland Institute of Studies, New Zealand Institute of Sport, Training for You Limited, and the Centre of Excellence for Agricultural Science and Business. Between them, Catalyst IT Ltd and Human Resource Development International Limited have provided MOODLE Services to over 150 client organisations in New Zealand since becoming MOODLE partners in 2004.

The defendants

[14] In or around August 2004 the fourth defendant Mr Benner approached Mr Dougiamas and discussed the possibility of doing MOODLE hosting and other services in New Zealand. As a result MOODLE Trust entered into a MOODLE Partners Agreement to provide MOODLE services with Flexilearn Ltd and 123 Internet Ltd, the latter company being one of which Mr Benner was a director. Flexilearn Ltd was a provider of e-learning technology in New Zealand, while 123 Internet Limited was at the time an Auckland based hosting provider. Flexilearn Ltd was headed by Mr Stanley Frielick.

[15] Mr Dougiamas has provided a copy of the MOODLE Partner Agreement signed by and on behalf of Flexilearn Ltd and 123 Internet Ltd. The copy annexed to his affidavit is not executed by the plaintiffs but Mr Dougiamas believes he signed a copy of the agreement and says the parties operated pursuant to it.

[16] From 28 September 2004 until 27 September 2005, when the MOODLE Partner Agreement to provide MOODLE services ended, Flexilearn Ltd and 123 Internet Ltd were a MOODLE Partner and authorised to act as such. As a partner they were granted a limited licence to use the MOODLE trade mark and MOODLE Mortarboard Logos. One of the first things Flexilearn Ltd and 123 Internet Ltd did as a MOODLE partner was to organise and hold New Zealand's first MOODLEMoot. This was held in early 2005 in Rotorua. Apart from that however, from the plaintiffs' point of view, their relationship was otherwise unsuccessful.

[17] On 30 April 2005 Mr Dougiamas sent an email to Mr Benner asking, among other things, how the business was going. The email was prompted because Mr Dougiamas noted they had acquired no customers according to the MOODLE Partners customer database. Mr Benner replied that they had obtained a first customer namely Massey University. In any event only one loyalty payment was ever paid by Flexilearn Ltd and 123 Internet Ltd under the MOODLE Partner Agreement. That was made in mid-July 2005 relating to Massey University Activate Project. The royalty paid was less than \$125.

[18] On 15 October 2005 Mr Frielick advised that Flexilearn Ltd had decided not to continue working with 123 Internet Ltd as a MOODLE Partner and would not be renewing its part of the relevant MOODLE Partner Agreement. By this time the Moodle Partner Agreement between the MOODLE Trust, Flexilearn Ltd, and 123 Internet Ltd had expired. Despite reminders the renewal fee did not get paid.

[19] About this time Mr Dougiamas had his attention drawn to a complaint regarding the failure of the MOODLE Partner. Inquiries led to Mr Dougiamas discovering that apparently Mr Benner had taken on a MOODLE customisation contract in the capacity of a MOODLE Partner that appeared to be outside his ability to deliver. There were substantial delays and there was an issue about the possibility of court action being taken by the customer. Mr Dougiamas resolved that, if necessary he would cancel the relevant MOODLE Partner Agreement, but in fact that was unnecessary as 123 Internet Ltd had taken no steps to review it. To make his position clear Mr Dougiamas sent an email to Mr Benner on 27 June 2006 officially terminating the partnership. Mr Benner responded expressing some surprise, and Mr Dougiamas replied on 28 June 2006 confirming his position.

[20] In early to mid-June 2016 the plaintiffs learned that a website operated by 123 Internet Ltd and/or Mr Benner from a domain moodle.org.nz and to which the domains moodle.co.nz, moodle.school.nz and moodle.net.nz were redirected was using one of the MOODLE mortar board hat logos. As a consequence, on 10 June 2016 Mr Michael Blake, the MOODLE Partner Manager of MOODLE Pty Ltd sent a cease and desist letter to Mr Benner. Mr Benner responded on 15 June 2016 purporting to rely on permission granted by Mr Dougiamas dating back to 2007. Mr Dougiamas responded to Mr Benner on 16 June 2016 recording among other things, that Mr Benner did not have permission for the use.

[21] By 11 June 2016 the home page of the website on moodle.org.nz had been changed. The website no longer related to the MOODLE Platform but had been changed to a site relating to New Zealand Moodle Breeders purporting to be a website relating to a hybrid breed of dog produced by breeding a Maltese with a toy or miniature Poodle.

[22] On 21 July 2016 Mr Benner registered the domain's moodle.cloud.nz and moodle.cloud.co.nz and subsequently published a website at these domains. The website suggested that MoodleCloud New Zealand had been launched to provide a one-stop shop for the necessary systems and support for provision of on-line learning in New Zealand. Mr Dougiamas was concerned that the website suggested the entity was an authorised MOODLE Partner when it was not and the services offered at moodle.cloud.nz or moodle.cloud.co.nz were offered by a certified MOODLE Partner and were endorsed by MOODLE Pty Ltd when they were not. The records of MOODLE Partners New Zealand Ltd records show Mr Benner to be its sole director.

[23] On 22 July 2016, the day after the New Zealand trade mark registration for the MOODLE trade mark was no longer able to be restored to the New Zealand register by reason of oversight, Mr Benner applied to register the trade mark MOODLE in New Zealand in relation to goods and services in classes 9, 41 and 42. Mr Dougiamas corresponded further with Mr Benner in December 2016, noting that Mr Benner had not complied with the request to take down his trademark-infringing site and more than that, had established MOODLECloud.nz site. He advised the likelihood of further action.

[24] By 18 September 2016 the website found at moodle.org.nz once again contained information relating to the MOODLE Platform and offered MOODLE Services.

[25] As at 11 June 2018, the date of Mr Dougiamas' affidavit, the moodle.co.nz, moodle.school.nz, moodle.net.nz domains all remained "pointed" or directed to the website published at moodle.org.nz domain, appearing to be a site apparently authorised by the plaintiffs when it was not.

[26] On 2 December 2016 Michael Blake, the MOODLE Partner Manager of MOODLE Pty Ltd sent another cease and desist letter to Mr Benner. This one related to the use of the moodlecloud.nz domain. There was no response and US attorneys were instructed. Mr Benner responded to the US attorneys stating the situation was complex and that he would need to obtain advice and would respond further, then subsequently raised an issue about the ownership of the MOODLE trade marks.

[27] On 25 January 2017 the trade mark MOODLE was registered in New Zealand in the name of Mr Benner with a deemed registration date of 22 July 2016, the date on which the application for the mark had been made. Mr Dougiamas' US attorneys wrote again to Mr Benner. Mr Benner responded and inter alia said that he held the current New Zealand trade mark for MOODLE as well as having "first use" unregistered trade mark that had existed since 2004, so that any claims against him were invalid. As a result Mr Dougiamas instructed his US attorneys and New Zealand solicitors to initiate trade mark invalidity proceedings against Mr Benner before the Intellectual Property Office of New Zealand seeking a declaration of invalidity. However, as Mr Benner and his companies' activities were also considered to amount to passing off and misleading and deceptive conduct, those proceedings were discontinued and Mr Dougiamas' solicitors were instructed to commence this proceeding in this Court.

These proceedings

[28] The proceedings were issued out of this Court on 12 February 2018. The plaintiffs raise causes of action for breach of the Fair Trading Act, passing off, invalidity of registration or, in the alternative, revocation of registration in relation to the trade mark. The proceedings were served on the defendants on various dates between 20 and 27 February 2018. None of the defendants have taken any steps or entered an appearance. Although they have taken no steps in the proceedings the ownership of moodle.org.nz; moodle.school.nz; moodle.net.nz; and moodle.co.nz domains have recently been transferred from Mr Benner to the second defendant MOODLE Partners New Zealand Ltd. Similarly Mr Benner has recently assigned New Zealand Trade Mark Registration Number 1047356 to MOODLE Partners New Zealand Ltd.

[29] On 17 May 2018 Mr Dougiamas re-applied for the trade mark MOODLE in New Zealand in classes 9, 41 and 42 in respect of goods and services. The re-application has been made on the basis of Mr Dougiamas and the plaintiffs' license of the use of the trade mark MOODLE in respect of those classes of goods or services in New Zealand continuously since 2004. However, the application cannot proceed to

registration until Trade Mark 1047356 in the name of MOODLE Partners New Zealand Ltd is either declared invalid or revoked.

[30] As the defendants have taken no steps the plaintiffs' counsel Mr Williams has sought and obtained a formal proof hearing scheduled for today. At the outset of the hearing the defendants were formally called. No appearances have been entered for them. Mr Williams has addressed the Court in relation to the causes of action raised by the pleading in support by the evidence of Mr Dougiamas and seeks relief.

[31] Dealing first with the cause of action for breach of the Fair Trading Act the plaintiffs allege misleading and deceptive conduct and misleading conduct in relation to services and false or misleading representations. The plaintiffs submit the defendants' ongoing use of the relevant domains as described above has the capacity to mislead or deceive a hypothetical reasonable person and therefore amounts to a breach of s 9 of the Fair Trading Act. Similarly the use of the company name, which incorporates both the plaintiffs' trade mark MOODLE and the word "Partners" following it is inherently likely to mislead or deceive given the plaintiffs pre-existing reputation in that trade mark for its MOODLE Partner Certified Services Provider Programme in New Zealand. That is exacerbated by the use of the second defendant of a service MOODLECloud from a website found at the domain's moodlecloud.nz and moodlecloud.co.nz.

[32] The evidence clearly establishes that the second defendant is not, and indeed none of the defendants are, authorised MOODLE Partners. They are in no way associated with, approved or endorsed by the plaintiffs. For those reasons the conduct of the defendants described in Mr Dougiamas' evidence is in breach of s 9 of the Act. It also amounts to breaches of s 13(b), (e) and (f) of the FTA as it amounts to a false and misleading representation that the services offered are:

- (a) supplied by a person who has particular characteristics, namely by an official MOODLE Partner when they are not;
- (b) approved or endorsed by the plaintiffs when they are not; and

- (c) that the second defendant is approved or endorsed by the plaintiffs as a MOODLE Partner when it is not.

It is inevitable that such activity is likely to cause confusion and deception.

[33] In addition the plaintiffs pursue a cause of action in passing off. Again, on the basis of the evidence of Mr Dougiamas I am satisfied the plaintiffs have acquired a reputation and good will in the mark MOODLE and the MOODLE Mortarboard Hat Logos in New Zealand in respect of relevant goods and services. They have continuously used those marks in New Zealand in connection with the MOODLE software platform and in connection with the MOODLE Partner Certified Services Programme in New Zealand since at least 2004.

[34] I accept Mr Williams' submission that harm to the plaintiffs' goodwill is a reasonably foreseeable consequence of the defendants' use of the marks. The actions of the defendants in the present case are particularly egregious. I note and adopt the passages from Professor Wadlow in his treatise, *The Law of Passing Off*.¹

The class of actionable misrepresentations in passing-off is not confined to those from which it might be supposed that the goods or business of the claimant and defendant are one and the same. It is potentially actionable to claim any connection with the claimant which is untrue and calculated to cause damage. One form such a misrepresentation may take is that the defendant personally, or his goods or business, is licensed by the claimant, so that the public would rely on the claimant's reputation in doing business with the defendant.

...

If the defendant has voluntarily submitted to taking a licence from the claimant then although there may be no formal estoppel in the sense recognised in patent or leasehold law, it is not difficult to conclude that he will be guilty of passing-off if he continues to use the licensed name or mark outside the scope of the licence or after permission has been withdrawn.

[35] 123 Internet Ltd is a former licensee of the relevant marks. Mr Benner was its director and executed a contract which expressly recognised that 123 Internet Ltd and he were not the owners of the relevant marks. The other defendants are companies of

¹ Wadlow *The Law of Passing Off* (5th ed, Sweet & Maxwell, London, 2016) at 7-91 and 7-98.

which Mr Benner is a director and his knowledge of the ownership situation can properly be imputed to them.

[36] By the defendants' actions they have blatantly breached the plaintiffs' intellectual property rights and sought to pass off themselves as associated with the plaintiffs and the plaintiffs' marks when they have had no entitlement to do so. Their conduct is such that their use of the domain names and the company name MOODLE Partners New Zealand Ltd constitutes misrepresentations and misappropriation of the MOODLE trade mark and good will and reputation. The domain names and company name are effectively instruments of deception in the hands of the defendants or any one of them.²

[37] I accept the submission that the domain names used by the defendants consist of a name or contain a name which by reason of their identity or similarity to the MOODLE trade mark inherently lead to passing off and further that the use of MOODLECloud in domain names and by a company named MOODLE Partners New Zealand Ltd inevitably will lead to confusion of their business with the plaintiffs' MOODLECloud service which was first promoted in New Zealand in or around July 2015. The plaintiffs must also succeed in their cause of action in passing off against the defendants.

[38] The plaintiffs also seek relief in relation to the trade mark, and in particular, seek a declaration of invalidity. A declaration of invalidity can be supported on the following grounds:

- (a) the applicant is not entitled to claim to be the owner of the mark;
- (b) the mark is prohibited from registration, s 17(1)(a);
- (c) the mark is prohibited from registration, s 17(1)(b);
- (d) the mark was registered in bad faith, s 17(2).

² *British Telecommunications Plc v One in a Million Ltd* [1999] FSR 1 (CA); and *Rio Tinto Mining and Exploration Ltd v Rutherford* HC Christchurch, CIV-2011-409-2348, 16 May 2012.

[39] The plaintiffs are persons aggrieved and have standing. I accept on the evidence the first plaintiff is the true owner of the trade mark MOODLE in New Zealand and the second plaintiffs are licensed to use the mark here in New Zealand in various ways.

[40] I deal first with the application under s 17(2), that the application to register the trade mark in New Zealand by the defendants was made in bad faith. The Court has approached the test of such conduct on the basis that it can include dealings falling short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area: *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd*.³ In *Valley Girl Co Ltd v Hanama Collection Pty Ltd* Miller J noted that bad faith is not confined to dishonesty and may be demonstrated by evidence of conduct falling short of reasonable standards of commercial behaviour.⁴ A common situation when bad faith arises is the registration of a principal's mark by a local distributor or agent or former licensee as in the present case. Such a person is fully aware of the adverse claims and rights to the mark.

[41] At the date Mr Benner applied for trade mark registration 1047356, 22 July 2016 the first plaintiff owned all the good will associated with the mark MOODLE in New Zealand as a result of his and his licensee's continuous use of the mark in New Zealand since at least 2004 in relation to the MOODLE Platform software and through the use of the mark and the MOODLE Mortarboard Hat Logos in connection with the MOODLE Partner Certified Services Programme in New Zealand.

[42] Mr Benner was fully aware of the first plaintiff's ownership and continuous use of the MOODLE trade mark in New Zealand at the time he made application for the trade mark MOODLE on 22 July 2016. He had clearly recognised the trade mark MOODLE as the property of the first plaintiff by entering the licence to use it.

[43] Next, before Mr Benner applied for the trade mark MOODLE in New Zealand on 22 July 2016, the plaintiffs had written to him indicating they would take action

³ *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367.

⁴ *Valley Girl Co Ltd v Hanama Collection Pty Ltd* HC Wellington CIV-2004-485-2005, 6 April 2005 at [53].

against him for his unauthorised use of the trade mark. The timing of his application was, as counsel submitted, clearly opportunistic. He applied the very day after the lapse.

[44] Finally, after Mr Benner received a cease and desist letter he changed or authorised the website that appeared at the domain moodle.org.nz to be changed to a static page purporting to be a site relating to the breeding of dogs. I accept counsel's submission that Mr Benner's application for registration of the trade mark was conduct that fell well short of reasonable standards of commercial behaviour. As at the date he applied for the mark he knew he was not the owner of it in New Zealand. The plaintiffs succeed in making out bad faith on his part.

[45] In the circumstances it is strictly unnecessary to consider the other grounds but I also accept that the grounds under s 17(1)(a) are made out and that the conduct of the defendants are such as to be, and the continued registration of the trade mark in the defendants' favour is likely to deceive and cause confusion.

[46] Further, although it is not strictly unnecessary, the plaintiffs have a strong argument for the application of s 17(1)(b).

[47] On the basis of the evidence and the relevant authorities invalidity is established. The Trade Mark Registration Number 1047356 should be removed from the register.

[48] In the circumstances it is again strictly unnecessary to consider the alternative cause of action which seeks revocation of the trade mark, although I observe that if necessary I would have been prepared to find that the grounds for revoking registration of Trade Mark 1047356 were made out under s 66(1)(e).

[49] The discussion above has referred generally to the defendants. I am satisfied that on the evidence before the Court secondary and accessorial liability is established in relation to Mr Benner as a joint tortfeasor. He is secondarily liable for the alleged passing off, and Mr Benner is also liable as an accessory to breaches of the Fair Trading Act.

Relief

[50] That then brings the Court to the issue of the appropriate relief sought. In relation to the FTA cause of action as discussed with counsel I consider the injunctive relief sought appropriate. There may be an issue as to whether under that cause of action it is open to the Court to direct an inquiry at this stage. I do not need to deal with that issue because an inquiry can be directed under the passing off cause of action.

[51] The other issue in relation to relief that is relevant is the request by the plaintiffs for a mandatory injunction requiring the second defendant to immediately assign and transfer various domain names. That was not expressly sought in the statement of claim. However given the evidence and my findings as to the clear and egregious breaches of the plaintiffs' rights by the defendants with the defendants' full knowledge I find there is no legitimate use that the defendants could put those domain names to. To permit them to remain with the defendants, would be to permit the continued use of them as instruments of fraud. That would not be an appropriate outcome. The Court should respond to such egregious behaviour. For those reasons I am prepared to make the further orders sought.

[52] In summary then, there will be following relief under the Fair Trading cause of action:

- (a) An injunction pursuant to s 41 of the Act to restrain the defendants, whether by their directors, officers, servants or agents or any of them or otherwise howsoever from trading under or by reference to the trade mark MOODLE and, in particular, doing so by using it as part of the name of a company operated by them (or any of them) or of which they may be a director in New Zealand or in connection with any website or part of a domain name used by them (or any of them);
- (b) An order under s 43(3)(e) of the Act requiring the second defendant to immediately assign and transfer the following domain names to the first plaintiff:

moodle.org.nz;

moodle.co.nz;
moodle.school.nz
moodle.net.nz
moodlecloud.nz; and
moodlecloud.co.nz

(c) under the passing off cause of action:

(i) an injunction to restrain the defendants, whether by their directors, officers, servants or agents or any of them or otherwise howsoever from trading under or by reference to the trade mark MOODLE and, in particular, doing so by using it as part of the name of a company operated by them (or any of them) or of which they may be a director in New Zealand or in connection with any website or part of a domain name used by them (or any of them);

(ii) a mandatory injunction requiring the second defendant to immediately assign and transfer the following domain names to the first plaintiff:

moodle.org.nz;
moodle.co.nz;
moodle.school.nz
moodle.net.nz
moodlecloud.nz; and
moodlecloud.co.nz

(iii) an enquiry as to damages or at the plaintiffs' election an account of profits and an order that the defendants pay all sums found due upon taking such enquiry or account and interest pursuant to the Interest on Money Claims Act 2016 on the amount found to be due to the plaintiffs.

(d) Under the trade mark invalidity cause of action:

- (i) A declaration that the registration of Registered Trade Mark No. 1047356 was and is invalid and an order cancelling it.

[53] For the reasons given above I do not make an order for revocation.

Costs

[54] The plaintiffs are entitled to costs of the proceedings. Category 3 is appropriate. Time band B is appropriate. Counsel suggested increased costs might be awarded. While I appreciate the assistance of counsel and the full submissions I do not consider they are more than should be required in a case of this nature, given category 3, so costs will be fixed on a category 3 basis, together with disbursements.

Venning J