



## ADMINISTRATIVE PANEL DECISION

### Genuine Benefits Pty Ltd v. Mr Justin Hankinson

LEADR Case No. auDA 08\_06

**Domain Name:** www.buyaustralian.com.au  
**Name of Complainant:** Genuine Benefits Pty Ltd  
**Name of Respondent:** Mr Justin Hankinson  
**Provider:** LEADR  
**Panel:** M J Sophocles

#### 1. THE PARTIES

- 1.1 The complainant is Genuine Benefits Pty Ltd of Melbourne, Victoria (**'the Complainant'**).
- 1.2 The respondent is Mr Justin Hankinson of 3 Skye Street, MacLeod, Victoria 3085 (**'the Respondent'**).

#### 2. THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 2.1 The domain name in dispute is '*www.buyaustralian.com.au*' (**'the Disputed Domain Name'**).
- 2.2 The registrar of the Disputed Domain Name is Distribute.IT Pty Ltd of 5/4 Homer Street, Moonee Ponds, Victoria 3039 (**'the Registrar'**).
- 2.3 The provider in relation to this administrative proceeding is LEADR (**'the Provider'**).

#### 3. PROCEDURAL HISTORY

- 3.1 This matter was submitted for decision in accordance with the auDRP Policy (**'the Policy'**), the auDRP Rules (**'the Rules'**) and the Provider's Supplementary Rules.
- 3.2 The Complainant lodged the complaint with the Provider on 10 July 2006 (**'the Complaint'**).
- 3.3 On 11 July 2006 the Provider sent to the Respondent, by Express Post, a dispute notification letter and a copy of the Complaint (including all annexures).

- 3.4 On 12 July 2006, the Provider e-mailed the Respondent a copy of the Complaint (without annexures).
- 3.5 In addition, the Provider sent a copy of the Complaint by Express Post to Mr Andrew McRobert of Deacons (Melbourne) on 12 July 2006 in accordance with information provided on page 2 of the Complaint which indicated that Mr McRobert had previously acted as the Respondent's solicitor.
- 3.6 On 14 July 2006, the Respondent informed the Provider via e-mail that he had received a copy of the Complaint.
- 3.7 On 11 July 2006 the Provider notified the Registrar of the Complaint and sent copies of the Complaint and dispute notification letter to the Registrar.
- 3.8 The Registrar, by e-mail dated 11 July 2006, advised the Provider that it had locked the website.
- 3.9 The Provider advised auDA of the Complaint on 11 July 2006.
- 3.10 On 12 July 2006, the Panel was approached by the Provider.
- 3.11 On 12 July 2006, the Panel confirmed that there was no conflict of interest and accepted the appointment in respect of this dispute.
- 3.12 A response from the Respondent was due by 7 August 2006. A response from the Respondent, dated 31 July 2006 ('**the Response**'), was received by the Provider on 1 August 2006 (by e-mail) and 2 August 2006 (by post).
- 3.13 The Panel was informed on 2 August 2006 that the dispute was being sent to the Panel for adjudication.
- 3.14 The Provider sent copies of the Complaint, the Response and a procedural history for the Complaint to the Panel on 2 August 2006 via Express Post. The Panel had not received those documents by 7 August 2006 and the Provider contacted Australia Post that day in an attempt to track down the package. Australia Post could not provide any information regarding its whereabouts.
- 3.15 On 9 August 2006, however, the Panel received the package of materials which had been sent by the Provider on 2 August 2006.

#### **4. FACTUAL BACKGROUND**

- 4.1 The following chronological outline, taken from the Complaint and the Response, consists of those facts which do not appear to be in dispute.
- 4.2 On 14 February 1999 the Complainant registered the domain name [www.buyaustralian.com](http://www.buyaustralian.com).
- 4.3 On 26 July 1999 the Respondent registered the Victorian business name '*Buy Australian*' (registered Victorian Business Number B1453063E). That Victorian business name was later deregistered on 26 July 2002. The Respondent says that the registration was allowed to lapse due to inadvertence.

- 4.4 On 26 July 1999 the Respondent registered the Disputed Domain Name in the Respondent's then registered Victorian business name of *'Buy Australian'*. Accordingly, the registrant of the Disputed Domain Name was originally the registered owner of the *'Buy Australian'* business name, being the Respondent.
- 4.5 As at the date of the Complaint, however, the registrant of the Disputed Domain Name was *'Justin Hankinson'* (i.e., the Respondent). This has been so since 16 May 2006.
- 4.6 The Complainant previously owned the registered Victorian business name *'BuyAustralian Bookstore'* (registered Victorian Business Number B1640900W) which was registered on 12 July 2001. However, that Victorian business name was deregistered on 12 July 2005. The Complainant says that the registration was allowed to lapse due to inadvertence.
- 4.7 On 23 March 2004 the Complainant's director, Nathan Barrie, sent an e-mail to the Respondent which said:

*'Hi Justin*

*I got your details from the whois database.*

*I run the buyaustralian.com site, and I was wondering if you would consider transferring your domain name (buyaustralian.com.au) to us so we could avoid confusion between our sites.*

*Please let me know if you'd like to discuss this further.*

*Regards*

*Nathan Barrie'.*

- 4.8 The Respondent sent an e-mail in reply on 23 March 2004 which said:

*'Sorry but no we have spent a lot of money in the development of this site.*

*Thanks*

*Justin'.*

- 4.9 There the matter appears to have rested for more than two years.
- 4.10 On 1 May 2006 the Complainant registered the Victorian business name *'BuyAustralian Bookstore'* (registered Victorian Business Number B1918702G).
- 4.11 On 2 May 2006 the Complainant's solicitors sent a letter to the Respondent. For present purposes, it is sufficient to note that the letter:
- (a) asserted that the Respondent is not eligible to be the registrant of the Disputed Domain Name and stated that:

*'We have been unable to find any evidence of you having a company or trading name, organisation or association name or a trade mark in any way connected with the phrase "Buy Australian"; and*

- (b) demanded that the Respondent transfer the Disputed Domain Name to the Complainant.
- 4.12 On 3 May 2006 the Respondent applied for registration of the Victorian business name '*Buy Australian Search Engine*' (registered Victorian Business Number B1919311U) which was registered on 8 May 2006.
- 4.13 On 17 May 2006 the Respondent applied for an Australian registered trade mark (application no. 1114053) in respect of '*buyaustralian.com.au*'.
- 4.14 On 17 May 2006 the Respondent, *via* his solicitors, responded to the letter from the Complainant's solicitors dated 2 May 2006. That letter:
- (a) rejected the assertion that the Respondent is not eligible to be the registrant of the Disputed Domain Name and pointed out that:
- (i) the Respondent registered the Disputed Domain Name on 26 July 1999 at which time the Respondent also held the registered Victorian business name of '*Buy Australian*' which is referred to in paragraph 4.3 of this decision;
- (ii) the Respondent is now the registered proprietor of the Victorian business name '*Buy Australian Search Engine*' which is referred to in paragraph 4.12 of this decision; and
- (iii) the Respondent is also the applicant for registration of the Australian trade mark referred to in paragraph 4.13 of this decision; and
- (b) declined to transfer the Disputed Domain Name to the Respondent.
- 4.15 On 13 June 2006 the Complainant applied for an Australian registered trade mark (application no. 1118286) in respect of '*www.buyaustralian.com*'.
- 4.16 As noted in paragraph 3.2 of this decision, the Complainant lodged the Complaint on 10 July 2006.

## **5. PARTIES' CONTENTIONS**

### **A. The Complainant**

- 5.1 In summary, the Complainant contended that:
- (a) the Respondent registered the Disputed Domain Name which is identical or confusingly similar to names, trade marks or service marks in which the Complainant has rights;
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name has been registered or subsequently used in bad faith.

- 5.2 In relation to paragraph 4(a)(i) of the Policy (which requires the Complainant to prove that the Disputed Domain Name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights), the Complainant contends that the Disputed Domain Name is identical or confusingly similar to:
- (a) the Complainant's '*trading name*' of '[www.buyaustralian.com](http://www.buyaustralian.com)';
  - (b) what the Complainant describes as its '*common law trade mark*';
  - (c) the Complainant's previous and current registered Victorian business names of '*BuyAustralian Bookstore*'; and
  - (d) the Complainant's Australian trade mark application in respect of '[www.buyaustralian.com](http://www.buyaustralian.com)'.
- 5.3 In relation to the '*common law trade mark*', the Complainant says that:
- (a) *'The Complainant has a strong reputation attached to the trading name [www.buyaustralian.com](http://www.buyaustralian.com) and has in the past seven (7) years established [www.buyaustralian.com](http://www.buyaustralian.com) as a common law trade mark in the following ways:*
    - (i) *'since registration of the domain name [www.buyaustralian.com](http://www.buyaustralian.com) in February 1999, the Complainant has spent over \$130,000 on direct media advertising expenses for the website (excluding the cost of producing advertisements) for the purpose of building both the Complainant's "buyaustralian" brand and the Complainant's internet based business';*
    - (ii) *'the Complainant employed a professional design firm to create its visual corporate identity including corporate logos which appear on the website and all other promotional and corporate material of the Complainant'; and*
    - (iii) *'the Complainant engaged an external publicist for the purposes of increasing public awareness of the website [www.buyaustralian.com](http://www.buyaustralian.com)'.*
  - (b) *'The Complainant's use of [www.buyaustralian.com](http://www.buyaustralian.com) as a common law trade mark is further evidenced by the use of <sup>TM</sup> in the Complainant's corporate logo'.*
- 5.4 Examples of the Complainant's corporate logos were included in the Complaint.
- 5.5 The Complaint stated that it was '*... prepared to provide copies of its financial records to the Panel on a strictly confidential basis*' to verify its expenditure of the amount referred to in paragraph 5.3(a)(i) of this decision. The Panel did not consider it necessary or appropriate to have regard to that material, being material not available to the Respondent, and did not take up that invitation.

- 5.6 The Complainant relies on the following in relation to paragraph 4(a)(ii) of the Policy (which requires the Complainant to establish that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name):
- (a) for the purposes of the Policy and the Rules, auDA has determined that '*rights or legitimate interests in respect of the domain name*' are not established merely by a registrar's determination that a respondent satisfied the relevant eligibility criteria for the domain name at the time of registration;
  - (b) '*So far as the Complainant is aware ... there is no evidence of the Respondent's bona fide use of, or demonstrable preparations to use, the [Disputed Domain Name] or a name corresponding to the [Disputed Domain Name] in connection with an offering of goods or services*';
  - (c) '*So far as the Complainant is aware, the Respondent has not been and is not commonly known as [www.buyaustralian.com.au](http://www.buyaustralian.com.au). The Complainant is unaware of any legitimate connection between the Respondent and the [Disputed Domain Name]*';
  - (d) '*The Complainant is unaware of any promotional or advertising activities undertaken by the Respondent in the seven (7) years since registration of the [Disputed Domain Name]*';
  - (e) '*So far as the Complainant is aware, the Respondent is not making a legitimate non-commercial or fair use of the [Disputed Domain Name]*'; and
  - (f) '*The Complainant assumes in all the circumstances that the Respondent registered the [Disputed Domain Name] either:*
    - (i) *in order to prevent the Complainant from registering [the Disputed Domain Name]; and/or*
    - (ii) *to attract users of the Complainant's website away from the Complainant's website, to the detriment of the Complainant*'.
- 5.7 In relation to paragraph 4(a)(iii) of the Policy (which requires the Complainant to establish that the Disputed Domain Name has been registered or subsequently used in bad faith), the Complainant merely states as follows:
- 'The Complainant refers to and repeats the contents of sub-paragraphs 5(B) & (C) above'*.
- 5.8 Sections 5B and 5C of the Complaint contain the points which are summarised in paragraphs 5.2 to 5.6 of this decision.
- 5.9 Drawing together those parts of the Complaint which amount to allegations of bad faith, or invite inferences to be drawn about that issue, the Complainant says that:
- (a) the Respondent registered the Disputed Domain Name on 26 July 1999, '*some five (5) months after the Complainant became the licensee of the domain name [www.buyaustralian.com](http://www.buyaustralian.com) and commenced trading as such*' (although the Complainant does not specifically assert that the Respondent actually knew about the earlier registration and the Respondent expressly denies this. The

Respondent also provided evidence that the Complainant did not post the first page at its [www.buyaustralian.com](http://www.buyaustralian.com) domain until 28 November 1999, some four months after the Respondent registered the Disputed Domain Name);

- (b) *'The Respondent's website has been inactive and/or "under construction" since its registration nearly seven (7) years ago';*
- (c) when the Respondent applied for registration of the Victorian business name 'Buy Australian Search Engine' on 3 May 2006 (referred to in paragraph 4.12 of this decision) it did so *'presumably in response to the letter received from the Complainant's solicitors'* (referred to in paragraph 4.11 of this decision);
- (d) *'To the Complainant's knowledge, the Respondent has not commenced trading as "Buy Australian Search Engine" as at the date of this complaint';*
- (e) the Respondent's application for an Australian registered trade mark (referred to in paragraph 4.13 of this decision) was also a *'reaction'* to the letter from the Complainant's solicitors dated 2 May 2006 (referred to in paragraph 4.11 of this decision);
- (f) the Respondent *'is yet to demonstrate any bona fide intention to use the trade mark, as required as a precursor to registration pursuant to section 27 of the Trade Marks Act 1995 (Cth)';*
- (g) the Respondent registered the Disputed Domain Name:
  - (i) in order to prevent the Complainant from registering the Disputed Domain Name; and/or
  - (ii) *'to attract users of the Complainant's web site away from the Complainant's website, to the detriment of the Complainant'.*

## **B. The Respondent**

5.10 The Respondent submitted a detailed response to the Complaint.

5.11 In summary, the Respondent contended that:

- (a) the Complainant had failed to establish that the Disputed Domain Name is identical or confusingly similar to names, trade marks or service marks in which the Complainant has rights;
- (b) the Complainant had failed to establish that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Complainant had failed to establish that the Disputed Domain Name was registered or subsequently used by the Respondent in bad faith.

- 5.12 The Response identified at least one area of factual dispute. Whereas the Complainant asserted that the Respondent's application to register the Victorian business name '*Buy Australian Search Engine*' on 3 May 2006 was '*presumably in response to*' the letter from the Complaint's solicitors dated 2 May 2006, the Respondent stated that:

*'Contrary to the Complainant's assertions, the Respondent had not yet received the Complainant's solicitors' letter dated 2 May 2006 at the time of applying for registration of the business name'.*

- 5.13 For the reasons given later in this decision, however, nothing turns on that factual dispute.

- 5.14 In relation to paragraph 4(a)(i) of the Policy (which requires the Complainant to prove that the Disputed Domain Name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights), the Respondent made the following points:

- (a) the Complainant is Genuine Benefits Pty Ltd and that company name is not identical or confusingly similar to the Disputed Domain Name;
- (b) *'The Complainant has provided no evidence of trading under its purported trading name "[www.buyaustralian.com](http://www.buyaustralian.com)" other than its bare assertions of having used the trading name "continuously in respect of its internet based business since February 1999";*
- (c) in any event, Note [1] to the Policy makes it clear that a '*name*' that can be relied on is a name '*as registered with the relevant Australian government authority*';
- (d) *'There is no evidence that a trading name for [www.buyaustralian.com](http://www.buyaustralian.com), nor even "buyaustralian" alone, is (or has been at any stage) registered by the Complainant in Australia';*
- (e) when one compares the Complainant's registered Victorian business name of '*Buy Australian Bookstore*' with the Disputed Domain Name:

*'Under well-established Australian trade mark law principles, it is apparent that the Complainant's registered business name "Buy Australian Bookstore" is not confusingly similar to the [Disputed Domain Name] by reason of the overall impression conveyed by the additional qualifying words "Bookstore" (see, eg, Sap Australia Pty Ltd v Sapient Australia Pty Ltd (1999) 48 IPR 593';*

- (f) *'Accordingly, the Complainant has not established relevant rights in a relevant (registered) business or trading name that is confusingly similar to the [Disputed Domain Name]';*
- (g) the Complainant has not established rights in a common law trade mark that is identical or confusingly similar to the Disputed Domain Name; and
- (h) the Complainant's trade mark application in respect of '*www.buyaustralian.com*' does not satisfy paragraph 4(a)(i) because no such trade mark has yet been registered.

5.15 The Respondent makes the following points in relation to paragraph 4(a)(ii) of the Policy (which requires the Complainant to establish that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name):

- (a) it need only be shown that the Respondent has some '*rights or legitimate interests in respect of the domain name*';
- (b) paragraph 4(c) of the Policy sets out a number of circumstances which, if found by the Panel to be established, are taken to demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name. However, those deeming circumstances are not exhaustive and the Panel must be satisfied on the evidence that the Respondent has no rights or legitimate interests in the Disputed Domain Name;
- (c) the Respondent is currently eligible to registration of the Disputed Domain Name by virtue of his registration of the Victorian Business Name '*Buy Australian Search Engine*';
- (d) the Response also demonstrates the Respondent's rights to and legitimate interests in the Disputed Domain Name by establishing the deeming circumstances in paragraphs 4(c)(i) and 4(c)(iii) of the Policy;
- (e) in relation to paragraph 4(c)(i), the materials submitted as part of the Response demonstrate:

*' ... bona fide use of, and demonstrable preparations to use, the [Disputed Domain Name] since at least 2000, some four years prior to the Respondent's first notice of the subject matter of the dispute (by a single email dated 23 March 2004) and some six years prior to further notice and the filing of the Complaint';*

- (f) in particular, the matters referred to in paragraph 5.15(e) above are demonstrated by evidence in the Response of the following matters:
  - (i) a written business plan for '*buyaustralian.com.au*' prepared by the Respondent and dated 13 December 2000 (and submitted as part of the Respondent's entry into the Telstra *Yellow Pages Business Awards 2001*) which involved:
    - (A) providing Australian and foreign consumers with access to '*the BuyAustralian.com.au Search Engine*', enabling them to search a database of Australian goods and services in order to '*choose the Australian alternative*'; and
    - (B) providing Australian businesses with '*an affordable option for obtaining a web presence*';
  - (ii) a meeting between the Respondent and a local Member of Parliament (Christian Zahra) in Latrobe Valley in early 2001 '*in order to promote the concept and business plan for the "BuyAustralian.com.au" Search Engine and generate interest*';

- (iii) evidence of the Respondent's intention, pursuant to the initial business plan dated 13 December 2000, to incorporate a company under the name BuyAustralian.com.au Pty Ltd to operate the 'buyAustralian.com.au' search engine;
- (iv) evidence that, since 1999, the Respondent has expended significant time and cost in developing the 'buyAustralian.com.au' website and business concept, including ongoing construction and enhancement of the website structure and design and the development of a stylised logo for the Respondent's business;
- (v) in particular, evidence that significant work on the website was undertaken in 2001 when the Respondent engaged a professional web design firm, Hot Chilli Media, to assist in the creation of a new logo and web page design [Examples of the original 'Buy Australian' logo and web page design, and the subsequent enhancement of those designs in the ongoing development of the 'buyAustralian.com.au' search engine website were annexed to the Response, together with evidence that the various logos and web page designs, and the various files and images created for the website, were developed by or on behalf of the Respondent between 2001 and 2002];
- (vi) evidence that, since 1999, the Respondent has maintained a business presence and interest in the 'buyAustralian.com.au' search engine website through the e-mail address 'info@buyaustralian.com.au' and 'has continued to respond to all inquiries and expressions of interest in the "BuyAustralian.com.au" Search Engine concept' [Examples of such correspondence were annexed to the Response]; and
- (vii) evidence that, as at the date of the Response, the Disputed Domain Name website (including links to the registration page and other information pages) was scheduled to be activated by 1 August 2006 [Copies of samples of the pages for the website were annexed to the Response].

5.16 The Respondent stated that its business plan had been updated by the Respondent since December 2000 and that:

*'As this document is strictly confidential, the current business plan will be made available to the Panel, on a confidential basis, upon request. However, that business plan will not be made available to the Complainant'.*

5.17 The Panel did not consider it necessary or appropriate to have regard to this material and did not take up that invitation. The Panel was reluctant to examine material which was not available to the Complainant. In any event it is unlikely that doing so would have assisted the Panel because the current business plan would seem to have been prepared after the Respondent first had notice of the subject matter of the dispute (i.e., after 23 March 2004).

- 5.18 The Respondent contended that the evidence referred to in sub-paragraphs 5.15(e) and (f) of this decision is:

*' ... demonstrative of the considerable amount of time and investment that the Respondent has already spent in developing the "BuyAustralian.com.au" Search Engine website in accordance with the "buyAustralian.com.au Search Engine business plans, prior to any notice of the subject matter of the dispute'.*

- 5.19 In relation to paragraph 4(c)(i) of the Policy, the Respondent concluded that:

*'By reason of the matters described above, it is clear that the Respondent is using the [Disputed Domain Name] to describe its own goods and services (in accordance with its own, independently developed business plans) and has demonstrated significant bona fide steps taken to use the [Disputed Domain Name] over the past seven years (paragraph 4(c)(i) auDRP)'.*

- 5.20 The Respondent also contended that:

*'Further, the above matters also demonstrate that the Respondent is making a legitimate non-commercial and fair use of the [Disputed Domain Name], without intent for commercial gain to misleading [sic.] or divert consumers (paragraph 4(c)(iii) auDRP. The slight evidence tendered by the Complainant that some consumers might be diverted to the Respondent's website through their own error does not detract from the Respondent's legitimate rights to use a domain name comprised of generic words that equally describe his own goods and services'.*

- 5.21 One might ask why the Respondent's website was not activated at an earlier date. The Respondent explains this by saying that, although it remains the Respondent's intention to incorporate a company under the name *'buyAustralian.com.au Pty Ltd'* to operate the *'buyAustralian.com.au'* search engine, this has not occurred due to *'financial limitations and other inhibiting factors'* and that:

*'In particular, as the Respondent has been personally responsible for funding the construction of the site, and has maintained a personal involvement in its ongoing development, roll-out of the business plan (including launch of the website) has taken longer than expected'.*

- 5.22 The Respondent also stated that:

*'As a result of, among other things:*

- (1) the ongoing construction and enhancement of the website (including professional development of a new logo and web structure in 2001);*
- (2) intervening changes in technology which have led to new options for web hosting services (the Respondent has now engaged E-vision Pty Ltd to provide web development and hosting support services (see [evision.com.au](http://evision.com.au))); and*
- (3) the simple fact of the Respondent's financial limitations and other personal and professional commitments,*

*there has been a staggered roll-out to the launch of the Respondent's website'.*

- 5.23 In relation to paragraph 4(a)(iii) of the Policy (which requires the Complainant to establish that the Disputed Domain Name has been registered or subsequently used in bad faith), the Respondent stated that:

*'The Complainant has manifestly failed to show that the Respondent registered or subsequently used the [Disputed Domain Name] in bad faith.*

*In particular, the Complainant has failed to show that the Respondent has registered or acquired the [Disputed Domain Name] for any of the purposes set out in paragraph 4(b) auDRP'.*

- 5.24 The Respondent referred to the *'significant bona fide steps taken by him to use the [Disputed Domain Name] for his business over the past seven years'* (as referred to in sub-paragraphs 5.15(e) and (f) of this decision) as rebutting any assertion of bad faith on his part.

- 5.25 The Respondent also stated that:

*'The central contention of the Complainant on the issue of bad faith is that despite being registered in July 1999, the website at the [Disputed Domain Name] has only recently become functional. As noted above, this is simply a product of the Respondent's limited financial resources and is wholly insufficient to establish bad faith'.*

## **6. DISCUSSION AND FINDINGS**

- 6.1 Paragraph 2.1 of the Policy states that:

*'All domain name licences issued in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP. At the time of publication, the open 2LDs are asn.au, com.au, id.au, net.au and org.au. Domain name licences that were issued before 1 August 2002 are not subject to a mandatory administrative proceeding under the auDRP:*

- a) until the domain name licence is renewed; or*
- b) unless the registrant voluntarily elects to be bound by the auDRP before their domain name licence is renewed.'*

- 6.2 The Disputed Domain Name was registered with the Registrar on 26 July 1999 but it does not appear to be disputed that it was last renewed on 6 August 2005.
- 6.3 The Disputed Domain Name is therefore subject to the mandatory administrative proceedings prescribed by the auDRP.

## Elements of a successful complaint

6.4 In order to succeed, the Complainant will need to establish all of the matters set out in paragraph 4(a) of the Policy, namely that:

- (i) the Disputed Domain Name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered or subsequently used in bad faith.

### **Is the Disputed Domain Name identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights?**

6.5 Note [1] to the Policy states that, for the purposes of the Policy, auDA has determined that a '*name... in which the complainant has rights*' refers to:

- 'a) *the complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority; or*
- b) *the complainant's personal name*'.

6.6 On the question of what is meant by '*identical or confusingly similar*', previous domain name dispute decisions have established that:

- (a) '*essential or virtual identity*' is sufficient: see *Ink King v CamerasDirect.com.au Pty Ltd*, LEADR Case No. auDRP 01/2005 (6 April 2005) and the decisions cited in paragraph 6.7(a) thereof; and
- (b) the global top level domain ('**gTLD**') components of domain names (such as '.com' and '.net') have no distinguishing capability and must therefore be ignored when considering whether a domain name is identical or confusingly similar to a name or mark: see *Ink King v CamerasDirect.com.au Pty Ltd*, LEADR Case No. auDRP 01/2005 and the decisions cited in paragraph 6.7(b) thereof; and *Migration Solutions Pty Ltd v Han Chung Lee trading as Australasia Migration Solutions*, LEADR Case No. 02/06 (23 March 2006).

6.7 In relation to paragraph 4(a)(i) of the Policy the Panel makes the following findings:

- (a) the Complainant's name is Genuine Benefits Pty Ltd and that name clearly is not identical or confusingly similar to the Disputed Domain Name;
- (b) accordingly, the question is whether the Complainant can point to any other '*business or other legal or trading name, as registered with the relevant Australian government authority*' in which the Complaint has rights and which is identical or confusingly similar to the Disputed Domain Name;

- (c) the Complainant's registered Victorian business name of '*Buy Australian Bookstore*' is not identical to the Disputed Domain Name because of the additional word '*Bookstore*';
- (d) the Panel also considers that the existence of the additional qualifying word '*Bookstore*' in the registered Victorian business name means that is not '*confusingly similar to*' the Disputed Domain Name: cf. *BlueChip InfoTech Pty Limited v Roslyn Jan and Blue Chip Software Development Pty Limited*, LEADR Case No. 06/2003 (23 December 2003);
- (e) the Complainant's trade mark application in respect of '*www.buyaustralian.com*' does not satisfy paragraph 4(a)(i) of the Policy because no such trade mark has yet been registered. A mere application for a registered trade mark is not sufficient to establish rights under paragraph 4(a)(i): see *TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Interactive Pty Limited*, WIPO Case No. DAU2006-0003 (29 May 2006);
- (f) the next question is whether the Complainant can rely on what it describes as its '*trading name*' of '*www.buyaustralian.com*'. In that regard, what the Complainant seems to be suggesting is that it is entitled to rely on the existence of the domain name it registered in February 1999, and its subsequent use of that domain name as a trading name in connection with its Internet based business, to satisfy paragraph 4(a)(i);
- (g) at first sight this is a surprising proposition because what the Policy is designed to do is prevent parties with no rights or legitimate interests in respect of a domain name from registering or using that domain name in bad faith, but only where the domain name is identical or confusingly similar to a '*name*' (meaning '*the complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority*' or '*the complainant's personal name*'), a trade mark or a service mark in which the complainant has rights;
- (h) the Complainant nevertheless seem to contend that its registration and use of '*www.buyaustralian.com*' satisfies paragraph 4(a)(i) of the Policy. The difficulty with that contention is that it overlooks the need for the Complainant to show that a business or other legal or trading name has been *registered by the Complainant with an Australian government authority* as required by the Policy;
- (i) the Panel is aware of only one decision which might be said to support the Complainant's approach. That was the decision in *Start Corporation Pty Ltd v. Daniel Purser t/a Startcorp (Aust)*, LEADR Case No. 11/2005 (9 November 2005) where the question considered (in paragraph 6.1 of that decision) was whether the disputed domain name of '*www.startcorp.com.au*' was identical or confusingly similar to the complainant's pre-existing domain name of '*www.startcorp.com*'. Although that question was answered in the affirmative, the complaint was denied because the complainant failed to satisfy either paragraph 4(a)(ii) or paragraph 4(a)(iii) of the Policy. It should also be noted that in that case the complainant conducted its business under the name '*Start Corporation Pty Ltd*';

- (j) despite that finding in the *Start Corporation* decision, the Panel is unable to see how the Complainant can overcome the absence of any evidence that a business or other legal or trading name for '[www.buyaustralian.com](http://www.buyaustralian.com)', '*buyaustralian*' or any other company, business or other legal or trading name identical or confusingly similar to the Disputed Domain Name, is (or has ever been) *registered by the Complainant with an Australian government authority* as required by the Policy;
- (k) for these reasons, the Panel does not consider that the Complainant's is entitled to rely on the registration and use of '[www.buyaustralian.com](http://www.buyaustralian.com)' to satisfy paragraph 4(a)(i) of the Policy. If the *Start Corporation* decision was intended to suggest otherwise then the Panel respectfully disagrees with that decision;
- (l) finally, the Complainant relies on what it describes as its '*common law trade mark*' and its contentions on this issue are summarised in paragraph 5.3 of this decision. In that regard it is important to note that the requirement of registration with an Australian government authority which is referred to in note [1] to the Policy applies only to the first limb of paragraph 4(a)(i) of the Policy (dealing with '*names*') and not to the second limb (dealing with trade marks). Previous decisions have recognised that rights in an unregistered common law trade mark may be sufficient for the purposes of paragraph 4(a)(i) of the Policy: see, for example, *SellBuyYourself Pty Limited v. Westpoint Real Estate Pty Limited*, LEADR Case No. 10/2005 (25 October 2005) at paragraph 6.8 and *Just Magazines Pty Ltd v. Computerised Automotive Reporting Service Pty Ltd*, LEADR Case No. 04/2005 (26 May 2005) at page 13;
- (m) notwithstanding the matters referred to in paragraph 5.3 of this decision, the Panel is not satisfied that the Complainant is entitled to rely on '[www.buyaustralian.com](http://www.buyaustralian.com)' as a common law trade mark for the purposes of paragraph 4(a)(i) of the Policy;
- (n) the matters referred to in paragraph 5.3 of this decision indicate that the Complainant has spent a significant sum of money on direct media advertising expenses for its website, created corporate logos and engaged an external publicist '*for the purposes of increasing public awareness of the website*'. In order to demonstrate that it has rights in a common law trade mark, however, what the Complainant must show is that it has an *established reputation* in the mark. The Panel does not consider that there is any sufficient evidence of this in the Complaint;
- (o) although the Complaint contains a bald assertion that the Complainant '*has a strong reputation attached to the trading name "[www.buyaustralian](http://www.buyaustralian.com)" and has in the past seven (7) years established "[www.buyaustralian.com](http://www.buyaustralian.com)" as a common law trade mark*':
- (i) there is insufficient evidence in the Complaint that consumers associate '*buyaustralian.com*' or '*buyaustralian*' with the Complainant's business. On the contrary, as the Respondent pointed out in a telling submission:

*' ... the slight evidence tendered by the Complainant that consumers are going to the Respondent's website and simply*

*assuming that "the Complainant does not have a functional website" more likely suggests that the Complainant has in fact **not** established any common law rights in [www.buyaustralian.com](http://www.buyaustralian.com) nor its corporate logo because if such rights had been established and consumers were familiar with these indicators of the Complainant's business, consumers viewing the website at the [Disputed Domain Name] would realise that it is not the Complainant's site given the prominent display of an entirely different corporate logo';*

- (ii) the Complainant tendered no evidence of 'hits' on its website which might have assisted in showing that its investment of time, money and resources has had the desired effect of creating an established reputation for the Complainant in 'buyaustralian.com' or 'buyaustralian';
- (iii) even if the Complainant had produced evidence of the kind referred to above, it would have faced the difficulty that the words 'buy Australian' are *descriptive* of the nature of the business (and might legitimately be used to describe a number of businesses), rather than being *distinctive* of the Complainant's goods or services: see *Frenbray Pty Ltd v. Weyvale Pty Ltd*, LEADR Case No. 06/2006 (24 June 2006);
- (iv) the Complainant has produced no evidence that 'www.buyaustralian.com.au' has developed a *secondary meaning* such that it signifies to consumers the Complainant's goods and services;
- (v) the following observations in *TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Interactive Pty Limited*, WIPO Case No. DAU2006-0003 (29 May 2006), at page 6, are equally applicable in this case:

*' ... it is difficult to see how such obviously generic words ... acquired secondary meaning and distinctiveness as a common law mark. It is even more difficult for the Complainant to demonstrate that such a mark has acquired distinctiveness as a common law mark in Australia. The Complainant's evidence of its reputation and visits to its website from IP addresses in Australia does not clearly demonstrate the distinctiveness of the mark itself. Merely trading under a name does not make it distinctive. The Complainant makes no explicit argument that TRUELOCAL has acquired distinctiveness as a mark. For all of these reasons, there is insufficient evidence that those combined words give the Complainant common law trade mark rights in them'; and*

- (p) the Complainant therefore has not established that it has rights in a common law trade mark that is identical to or confusingly similar to the Disputed Domain Name.

- 6.8 For these reasons, the Complainant has not satisfied paragraph 4(a)(i) of the Policy.
- 6.9 Even if the Complainant had satisfied paragraph 4(a)(i) of the Policy, however, the Complaint would have been denied for the additional reasons set out below.

**Does the Respondent have any rights or legitimate interests in respect of the Disputed Domain Name?**

- 6.10 A Complainant bears the onus of proving the absence of any rights or legitimate interests of the Respondent in a disputed domain name. However, once a complainant has asserted the absence of such rights or legitimate interests, it is incumbent on the respondent to put forward some evidence to rebut that assertion, because such information may be uniquely within the knowledge and control of the respondent: see paragraph 6.13 of the decision in *Ink King v CamerasDirect.com.au Pty Ltd*, LEADR Case No. auDRP 01/2005 (6 April 2005) and the decisions cited therein.
- 6.11 In this case, the Respondent put forward a detailed response which included evidence of the matters referred to in sub-paragraphs 5.15(e) and (f) of this decision.
- 6.12 Paragraph 4(c) of the Policy sets out a non-exhaustive list of circumstances any of which, if established, will be taken to demonstrate a respondent's rights to or legitimate interests in a disputed domain name. The circumstances are as follows:
- (i) before any notice to the respondent of the subject matter of the dispute, the respondent's bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or
  - (ii) the fact that the respondent has been commonly known by the domain name (even if the respondent has acquired no trade mark or service mark rights); or
  - (iii) the fact that the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trade mark or service mark at issue.
- 6.13 There is evidence before the Panel of the first of these matters. That evidence is summarised in paragraph 5.15 of this decision. The Panel considers that evidence to be sufficient to establish that the Respondent has rights or legitimate interests in the Disputed Domain Name.
- 6.14 For these reasons, paragraph 4(a)(ii) of the Policy has not been satisfied by the Complainant.

**Has the Disputed Domain Name been registered or subsequently used in bad faith?**

- 6.15 Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances which, if established, shall constitute evidence of the registration and use of a domain name in bad faith. These circumstances are as follows:
- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting or

otherwise transferring the domain name registration to another person for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

- (ii) where the respondent has registered the domain name in order to prevent the owner of a name, trade mark or service mark from reflecting that name or mark in a corresponding domain name; or
- (iii) where the respondent has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
- (iv) where, by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation or endorsement of that web site or location or of a product or service on that web site or location.

6.16 In relation to paragraph 4(b)(i) of the Policy, there is no evidence whatsoever to suggest that the Respondent registered the Disputed Domain Name primarily for the purpose of selling or otherwise transferring the registration of the Disputed Domain Name to another person for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the Disputed Domain Name.

6.17 Indeed, the evidence points clearly in another direction, not only because the Respondent has invested significant time and resources in the development of a *'buyAustralian.com.au'* search engine, but because when the Complainant requested that the Disputed Domain Name be transferred to it (in the e-mail dated 23 March 2004 which is referred to in paragraph 4.7 of this decision) the Respondent's immediate response was:

*'Sorry but no we have spent a lot of money in the development of this site'.*

6.18 As to paragraph 4(b)(ii) of the Policy, the evidence does not establish that the Respondent registered the Disputed Domain Name to prevent the owner of a name, trade mark or service mark from reflecting that name or mark in a corresponding domain name.

6.19 In this case, the Complainant had already registered the domain name [www.buyaustralian.com](http://www.buyaustralian.com) before the Disputed Domain Name was registered. The situation at which paragraph 4(b)(ii) of the Policy is directed is one in which a respondent has registered a domain name for the purpose of preventing the owner of a name, trade mark or service mark from reflecting that name, trade mark or service mark in a corresponding domain name. It is not directed at the situation where, as here, a complainant previously registered its own domain name and complains about the respondent's subsequent registration of a similar domain name which the complainant could have registered in the first place, had it chosen to do so.

6.20 For these reasons, the Panel is not satisfied that the circumstances referred to in paragraph 4(b)(ii) of the Policy have been established in this case.

6.21 The Complainant does not suggest that the circumstances referred to in paragraph 4(b)(iii) of the Policy exist. That is not surprising. Although registration of the

Disputed Domain Name may have caused disruption to the Complainant's business, there is no evidence that the Respondent registered the Disputed Domain Name *for that purpose*, let alone *primarily* for that purpose.

- 6.22 In relation to paragraph 4(b)(iv) of the Policy, the Complainant says it '*assumes*' that the Respondent registered the Disputed Domain Name either to prevent the Complainant from registering it or '*to attract users of the Complainant's website away from the Complainant's website, to the detriment of the Complainant*'. That assumption is not borne out by the evidence.
- 6.23 The Respondent referred to the '*significant bona fide steps taken by him to use the [Disputed Domain Name] for his business over the past seven years*' (as referred to in sub-paragraphs 5.15(e) and (f) of this decision) as countering any suggestion of bad faith and said that:

*'In any event, it is trite law that where a complainant chooses to use a highly descriptive name, that might legitimately be used to describe a number of businesses, there is an inherent danger that there might be some prospect of misdirection or confusion (see, eg, Hornsby Building Information Centre Pty Ltd v Sydney Building Information Centre (1978) 140 CLR 216. The prospect of misdirection or confusion by reason of the use of a highly descriptive name does not, of itself, evidence bad faith or an intention to create likelihood of confusion regarding source'*.

- 6.24 The Complainant stated that it was:

*'... in receipt of anecdotal evidence demonstrating that consumers often assume that the Complainant's business, which encourages people to support Australian businesses by using the [www.buyaustralian.com](http://www.buyaustralian.com) website to acquire goods and/or services from Australian businesses, would be registered as a .com.au domain name'*.

- 6.25 As a result of this, the Complainant says, consumers are mistakenly going to the Disputed Domain Name website rather than the Complainant's web site and this is having '*a material detrimental impact on the Complainant's business*'.

- 6.26 The Panel is inclined to agree with the Respondent's contention that:

*'The unsupported assertion that the Complainant is "in receipt of anecdotal evidence" demonstrating that consumers often assume the Complainant's website would be registered as a '.com.au" domain name and are mistakenly going to the Respondent's website ... is wholly insufficient and unsatisfactory'*.

- 6.27 The Panel finds the Respondent's submissions in relation to paragraph 4(b)(iv) of the Policy to be more persuasive than those of the Complainant.

- 6.28 The Panel also notes that the Complainant has not furnished any evidence of *actual* confusion: cf. *Yahoo! Inc v. Jorge O Kirovsky*, WIPO decision D2000-0428 (9 August 2000).

- 6.29 Also, it is well-established that '*re-direction*' alone is not sufficient to satisfy paragraph 4(a)(iii) of the Policy: see, for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO decision DAU2002-0001 (5 March 2003) at paragraph 6.19.

- 6.30 The Panel does not consider that there is any evidence capable of establishing that the Respondent has '*intentionally*' attempted to attract Internet users to its website by creating a likelihood of confusion, as required by paragraph 4(b)(iv) of the Policy. The Respondent states that it was not aware of the Complainant's domain name at the time when it registered the Disputed Domain Name and there is no evidence to suggest that the Respondent was so aware (or that an inference to that effect should be drawn).
- 6.31 Ultimately the Panel considers that any predicament now faced by the Complainant was not caused by any bad faith on the part of the Respondent but rather by the Complainant's decision to register the domain name '*www.buyaustralian.com*', and not the Disputed Domain Name, in February 1999.
- 6.32 As noted in paragraph 2.3 of auDA's '*Domain Name Eligibility and Allocation Rules for Open Second Level Domains (2LDs)*' (Policy No. 2002 – 07):
- 'Domain name licences are allocated on a "first come, first served" basis. Provided the relevant eligibility rules are satisfied, the first registrant to apply for a particular domain name will be permitted to licence it.'*
- 6.33 Paragraph 4(b) of the Policy sets out a *non-exhaustive* list of circumstances which, if established, shall constitute evidence of the registration and use of a domain name in bad faith. Nevertheless, the Panel has not been provided with evidence of any other matters capable of demonstrating that the Respondent's registration or subsequent use of the Disputed Domain Name have been in bad faith.
- 6.34 Accordingly, paragraph 4(a)(iii) of the Policy has not been satisfied.
- 6.35 The Panel notes that issues of acquiescence might also have arisen on the basis that, despite receiving the Respondent's e-mail dated 23 March 2004 (as referred to in paragraph 4.8 of this decision), the Complainant did not lodge the Complaint until 10 July 2006. The Panel would have been entitled to take this matter into consideration pursuant to paragraph 15(a) of Schedule B of the Policy which entitles the Panel to decide a complaint on the basis of matters including '*any rules and principles of law that it deems applicable*': see *John Brigden v. Andom Pty Ltd*, LEADR Case No. 13/2005 (31 January 2006) at paragraph 6.17.
- 6.36 In view of the findings made earlier in this decision, however, it is unnecessary for the Panel to make a determination as to whether principles of acquiescence apply to the Complaint.
- 6.37 For the reasons set out above, the Complaint has not been made out. It may be that this leaves both parties in a less than ideal position because both of them have invested significant time and resources in developing their respective business plans and web sites and because, as the Federal Court stated in *Sydney Markets Ltd v Sydney Flower Market Pty Ltd* [2002] FCA 124, at paragraph [149]:
- ' ... where two domain names are sufficiently similar so as to make it difficult for a member of the public to know in advance exactly which site they will be taken to (as, for example, where the only difference between them is the presence or absence of ".au"), there is considerable scope for the public to be misled.*

....

*The similarity between the website addresses is such that those members of the public who wish to order flowers from the respondent by means of the Internet, might by mistake access one of the applicant's sites, and persons seeking the applicant's site may arrive at that of the respondent'.*

6.38 The Court's solution in that case was to require each party to include an appropriate disclaimer on its website, indicating that it was not associated with the business of the other party. That is obviously a course open to the Complainant and the Respondent if they consider it in their mutual interests to avoid any confusion that might otherwise arise from the similarity between their domain names: cf. *13 Flowers Pty Ltd v. Flowers On The Net Pty Ltd*, LEADR Case No. 03/2005 (8 April 2005) at paragraph 7.23.

## 7. **DECISION**

7.1 The Panel considers that the Complainant has failed to make out all (or indeed any) of the elements of paragraph 4(a) of the Policy.

7.2 The Complaint is therefore denied.

Dated this 23rd day of August 2006

.....  
Michael J Sophocles

Sole Panellist