



ADMINISTRATIVE PANEL DECISION

Aston Martin Lagonda Limited v. Frenbray Pty Ltd

LEADR Case No. auDA 09_06

Domain Name: www.astonmartin.com.au
Name of Complainant: Aston Martin Lagonda Limited
Name of Respondent: Frenbray Pty Ltd
Provider: LEADR
Panel: D S Ellis

THE PARTIES

- 1 The complainant is Aston Martin Lagonda Ltd.
- 2 The respondent is Frenbray Pty Ltd.

THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 3 The domain name in dispute is www.astonmartin.com.au (“the Domain Name”).
- 4 The registrar of the Domain Name is Enetica Pty Ltd (“Enetica”).
- 5 The provider in relation to this administrative proceeding is LEADR (“the Provider”).

PROCEDURAL HISTORY

- 6 The complaint was submitted under the auDRP Policy No 2002/22 (“the Policy”), the auDRP Rules (“the Rules”) and the Provider’s Supplementary Rules.
- 7 The Provider provided a document entitled “Procedural History” from which it appears:

- (a) The completed application was received from the complainant by the Provider on 14 August 2006;
 - (b) A copy of the application was sent by the complainant to the respondent on 14 August 2006;
 - (c) A full copy of the application was received by the respondent on 18 August 2006;
 - (d) auDA and Enetica were advised of the complaint by e-mail on 15 August 2006.
 - (e) The response was received from the respondent on 6 August 2006, that is within the time limit contemplated by the rules.
- 8 By an e-mail dated 8 September 2006, the solicitors for the complainant sought permission for the additional material set out in that email to be considered by the Panel. The email of 8 September 2006 dealt with the following matters:
- (a) submissions made by the Respondent in relation to the “Oki Data” principles, a reference to the decision in *Oki Data Ams, Inc v ASD Inc* (WIPO Decision D2001 – 0903) (“Oki Data”);
 - (b) factual assertions made by the respondent that the complainant considered the matter settled;
 - (c) allegations of harassment and entrapment made in the response; and
 - (d) the correspondence at Annexure 4 of the response.
- 9 The Rules do not contemplate the submission of responsive materials by a complainant in the ordinary course of events. While the panel has the ability to allow further materials to be provided under Rule 12, this power should be exercised sparingly. In so far as the submissions relate to "Oki Data", the issue is one which the complaint’s solicitors could reasonably have anticipated. The complaint refers to a number of domain name decisions, including cases which deal with issues closely allied to the Oki Data decision. The issue should have been dealt with in the complaint. In so far as the proposed additional submissions

relate to assertions that there was a settlement or that the complainant's solicitors harassed and entrapped the respondent, the allegations raise factual disputes involving a conflict of oral evidence. Proceedings of this nature are not appropriate for the determination of disputes of this nature. Although I note that the complainant denies the respondent's allegations, receipt of additional materials from the complainant will not enable me to resolve these disputes. I do not regard the correspondence at Annexure 4 of the response as relevant to the matters in issue in these proceedings. Accordingly, I will not allow the additional materials to be submitted.

- 10 On 20 September 2006 I extended the time limit for the provision of this decision. The time limit was extended because I was unable to adequately attend to preparation of these reasons due to circumstances which arose after I was appointed and which were beyond the my control.

FACTUAL BACKGROUND

- 11 It appears from the materials submitted by the parties that:
- (a) The complainant is a company incorporated under the laws of the United Kingdom and carries on business under the name, "Aston Martin". "Aston Martin" is a well known brand of luxury car.
 - (b) The complainant is registered as the owner in Australia of the trade marks numbered 374456, 392919, 403681 and 403680 (together the "Trade Marks") in respect of:
 - (1) The expression "Aston Martin" registered in class 12 in respect of motor vehicles and their parts and fittings;
 - (2) The expression "Aston Martin" in class 37 in respect of maintenance and servicing of motor vehicles and other services relating to motor vehicles;
 - (3) The wings logo in class 12 in respect of motor land vehicles and their parts and fittings; and

- (4) The wings logo in class 37 in relation to the repair and maintenance of motor land vehicles.
- (c) The Domain Name was registered on 5 December 2004 in the name of the respondent.
- (d) The respondent carries on business as “Private Fleet”, utilising amongst other means, the www.privatefleet.com.au website.

The Policy

12 Pursuant to Rule 15 of the Rules, the Panel is required to determine the dispute in accordance with the Policy, the Rules, any rules of the Provider and any additional rules and principles of law that it deems applicable.

13 Paragraph 4(a) of the Policy sets out the matters which must be established by the Complainant:

- “(i) [the respondent’s] domain name is identical or confusingly similar to a name, trademark (sic) or service mark in which the complainant has rights; and
- (ii) [the respondent has] no rights or legitimate interests in respect of the domain name; and
- (iii) [the respondent’s] domain name has been registered or subsequently used in bad faith.

These elements are cumulative. The complainant bears the onus of establishing each element.

14 Paragraph 4(c) of the Policy elaborates on matters relevant to paragraph 4(a):

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the subject matter of the dispute, your 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 you have acquired for the purpose of selling, renting or otherwise transferring); or

- (ii) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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, trademark or service mark at issue.”

DELIBERATIONS

15 It is convenient to consider each of the elements of paragraph 4(a) of the Policy in turn.

Paragraph 4(a)(i): Similarity between the domain name and a trade mark in which the complainant has rights.

16 The Domain Name is identical to the trade marks 374456 and 392919, apart from the addition of “www” and “com.au” at either end. The Domain Name is confusingly similar to the written trade marks.

Paragraph 4(a)(ii): Respondent’s rights or legitimate interests in respect of the domain name.

17 Paragraph 4(c) of the Policy sets out matters which will demonstrate rights or legitimate interests in a disputed domain name.

18 The complainant invited the Panel to infer that the respondent has no right or legitimate interest in respect of the Domain Name from the following:

- (a) The respondent has not been authorised to use the Domain Name by the complainant;
- (b) There is not and never has been any business relationship between the complainant and the respondent;
- (c) The nature of the website found at the Domain Name. The complainant alleges that the website is a “bait and switch” operation; and
- (d) There was no “bona fide” use of the of the Domain Name before the dispute arose. The date on which the respondent received notice of the dispute was 14 December 2005. Notice was given by means of the

complainant's solicitors' letter of that date, which appears to have been couriered to the respondent.

The matters set out at paragraphs 18 (a) and (b) do not appear to be disputed by the respondent.

19 The assertions at paragraphs 18(c) and (d) are disputed and require a description of the site in some detail. The site was accessed by the Panel on 2 October 2006.

20 The home page displays "AstonMartin.com.au" prominently, together with a picture of an Aston Martin car. Beneath the Domain Name is the slogan "Find the best deals on Aston Martin's (sic) right here!". A menu runs down the left side of the screen. The menu comprises the following items: Home, Contact us, About Us, Links and Resources, Buy a New Aston Martin, Buy a Used Aston Martin, Finance an Aston Martin, Insure an Aston Martin, Protect an Aston Martin, Advertising Enquiries, Aston Martin News and Forum. The banner and the menu also appear on the other pages of the website.

21 The home page contains text describing the site including the following: "So whether you are looking to buy, finance or just find out more about the cars, as big fans of the marque, we hope you will find this website to be of value." "Buy" and "finance" in this sentence are hyperlinks. The "buy" hyperlink takes the viewer to the "Private Fleet" web page. The "finance" hyperlink takes the viewer to the "Finance an Aston Martin" page on the Domain Name's website. The home page does not contain any statement setting out the relationship between the website and the complainant. The home page also contains other links, identified as "Ads by Goooooogle". At paragraph 4.2.1 of the response, the respondent asserted that, apart from the link to Private Fleet on the "Links and Resources" page, there was no hyperlink to the www.privatefleet.com.au page. In light of the "buy" hyperlink on the home page, paragraph 4.2.1 is not correct.

22 The "Contact Us" page is an email form enabling the viewer to send an email to the proprietors of the website.

- 23 The “About Us” page does not contain any information about the respondent. The page states that the site has been “created to give owners, enthusiasts and casual browsers information on all things Aston Martin”.
- 24 The “Links and Resources” page contains a number of links associated with Aston Martin, including www.astonmartin.com (described as “the Aston Martin official site”), www.astonmartin.org.au, the Aston Martin Owners Club of Victoria, as well as other sites which have no association with Aston Martin such as www.pitstop.net.au and www.marque.com.au (which are automotive bookshops). There are links to “FinCar Finance” and “Private Fleet” sites. The foot of this page reads:
- “Note: www.astonmartin.com.au may receive a referral fee or commission from the above websites for successful referred business. However these links are placed here first and foremost for your enjoyment. If you have any suggestions for inclusions here then please let us know. Please also be aware that above links do not imply that there is any affiliation between www.astonmartin.com.au and the said relevant companies.”
- 25 The “Buy a New Aston Martin” page is an advertisement for Private Fleet, although there is no link to Private Fleet’s website on that page. The page indicates that several “accredited” Aston Martin dealers” are within the “Private Fleet National Network”. This page also contains the following disclaimer:
- “**Please note that in no way are Private Fleet directly affiliated with Aston Martin Lagonda Ltd. As a broker, all we do is assist in organizing the purchase of new cars. Should you purchase a new Aston Martin through Private Fleet, it is important to note that your financial and purchasing transaction will be directly with an authorised Aston Martin dealer”.
- 26 The main feature of the “Buy a Used Aston Martin” page is a series of 4 advertisements for Aston Martin cars, together with an advertisement for Victorian number plates, “DB9V12” which are described as “Aston Martin suitable number plates”. The advertisements for the cars are a brief description

and a telephone number accompanied by a colour photograph of the relevant car. Interested persons are invited to telephone the owners direct. The advertisements on the site when it was accessed by the Panel on 2 October 2006 were the same as those which appeared on the capture of the site provided by the complainant dated 13 February 2006.

27 The “Finance an Aston Martin” page is an advertisement for FinCar Finance. The page states “we at AstonMartin.com.au recommend FinCar Finance”. The page provides a hyperlink to FinCar Finance. Similarly, the “Insure an Aston Martin” page is an endorsement of and referral to “Dawes Motor Underwriting Group”. The “Protect an Aston Martin” is an advertisement for “Covercraft” products, featuring an Aston Martin shrouded in a Covercraft product. The page states: “AstonMartin.com.au has negotiated some very special prices for these covers so please contact sales@astonmartin.com.au for any further information or visit the Covercraft website.”

28 The “Advertising Enquiries” page solicits advertising enquiries in respect of products or services which may be of value to visitors. A variety of “promotional opportunities” are offered.

29 The “Aston Martin News and Forum” page is apparently more extensive. It contains brief “headline” news items linked with Aston Martin cars, largely by way of hyperlinks to other sites. The page is updated as it refers to events which have happened only recently, such as a win by Aston Martin cars in the Petit Le Mans, in September 2006. It appears, however that this information is provided by an entity called “Affiliate Data Feeds”. The Affiliate Data Feeds website indicates that the business provides news feeds for websites on nominated topics.

30 The respondent relied on the principles enunciated in the decision in *Oki Data* to assert that its use of the domain name prior to the dispute arising was bona fide. The requirements enunciated in the *Oki Data* case are as follows:

“(1) Respondent must actually be offering the goods or services at issue.

- (2) Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods.
- (3) The site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents.
- (4) The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name." (citations omitted)

31 An issue arose whether it was necessary for the respondent to be an authorised reseller of the trade marked goods. It appears that an "authorised relationship" is not necessary. The sale of second hand goods or spare parts for vehicles may form the basis for legitimate use of a Domain Name incorporating trade marks: *Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent* (WIPO Case No. D2004-0481). In my opinion, it is not necessary that the disputed Domain Name be devoted entirely to the sale of the trade marked goods, provided that the sale of other goods or services is peripheral and provided that those goods or services were not competitive with the trade marked goods.

32 In the present case:

- (a) The respondent is not authorised by the complainant in any way. As indicated above, the lack of authorisation does not preclude a legitimate interest in respect of the Domain Name. The respondent's lack of authorisation is not, however, made sufficiently plain by the website. There is the disclaimer (set out above) on the "Buy a New Aston Martin" page. However, that disclaimer deals with the relationship between "Private Fleet" and the complainant. The disclaimer does not address the relationship between the complainant and the "astonmartin.com.au" website and does not make it plain that "astonmartin.com.au" is not affiliated with or endorsed by the complainant. The note at the foot of the "Links and Resources" page does not state that there is no relationship between "astonmartin.com.au" and the complainant. These omissions are significant in light of the following statements on the website:

“That's why we at AstonMartin.com.au recommend FinCar Finance for anyone looking for a lease, loan or other finance structure for their new purchase.”

“That's why we recommend Dawes Motor Underwriting Group, specialist insurers for prestige motor vehicles.”

“At AstonMartin.com.au, we believe your vehicle demands the best protection money can buy. That's why when it comes to custom car covers for your Aston Martin - we recommend only one brand - Cover Craft, the world largest manufacturer of custom car covers.”

Additionally, the disclaimer is not prominently displayed on the website. It appears only in the context of the “Buy a New Aston Martin” page. A viewer of the website might not be interested in buying a new Aston Martin and would not have the (limited) benefit of viewing the disclaimer. A viewer of the website following the “buy” and “finance” hyperlinks on the home page would by-pass the disclaimer altogether.

The website does not satisfy the third of the Oki Data principles.

- (b) The “buy” hyperlink takes the viewer direct to the “Private Fleet” webpage. That page offers access to cars other than the complainants’. In *Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent* (WIPO Case No. D2004-0481) the Panel said:

“The links to similar websites for used Jaguar cars, used Ferrari cars and used racecars lead to websites that do indeed offer such expected products (i.e. Ferrari, Jaguar and other race cars respectively) under different domain names. Clearly designated links to websites, under which other brands or products are offered, cannot be considered as the offering of other brands or products under the Domain Names, provided they take up only a minor part of the site and the overall impression of that site remains that of a site offering corresponding goods.”

It is accepted that the Private Fleet website is not strictly part of the website associated with the Domain Name so that competing products are not directly offered on the site itself. Also, the Private Fleet home page can be utilised by potential Aston Martin purchasers to buy an Aston Martin car. The Private Fleet website does not necessarily involve the

viewer being diverted to competing products. However, the “buy” hyperlink is not a clearly designated link and militates against the overall impression of the site offering only goods legitimately associated with the complainant.

- (c) One feature of the website which has not changed in the period between 13 February 2006 and 2 October 2006 is the advertisements featured on the “Buy a Used Aston Martin” page. The same cars and number plates are featured. While it is conceivable that advertisements of this nature might be placed but not updated on a community site, the lack of any change during this period suggests that the service is not offered on a bona fide basis.
- (d) The principal products and services on the website are those of Private Fleet, FinCar Finance, Dawes Motor Underwriting Group and Covercraft. While these services and products may be utilised in connection with the complainant’s cars, they are not intrinsically connected with the complainant’s products. They could as well be used in connection with any other brand of car.
- (e) The respondent did not, however, seek to “corner the market” in relevant Domain Names.

33 The relevant date for consideration of bona fide use is 14 December 2005, when the dispute first arose. The website has changed since that date. The version captured on 13 February 2006 shows that there was no specific purpose “home page” and hence no “buy” hyperlink in the text presently found on the home page. However, there was a link to “Private Fleet” on the “Buy a New Aston Martin” page, which took the viewer straight to the “Private Fleet” home page. No disclaimer of any relationship between the complainant and Private Fleet or the Domain Name appeared on the website.

34 In the circumstances set out in paragraphs 20 to 33 above, I am not satisfied that there was, prior to notification of the subject matter of the dispute, a bona fide use of the Domain Name or a name corresponding to the Domain Name in connection

with an offering of goods or services within paragraph 4(c)(i) of the Policy. The limited scope and the lack of prominence of the disclaimer in the context of endorsements apparently made by “astonmartin.com.au” are particularly significant.

35 The respondent asserted at paragraph 6.1.2 that it had made “bona fide” preparations to use the Domain Name in that it “has been planning to run a forum on the [Domain Name]”. However, no details of the preparations were provided and this aspect of the response was not affirmed by statutory declaration. I am not satisfied that “demonstrable preparations” were made which were sufficient to satisfy paragraph 4(c)(i) of the Policy were made.

36 The respondent suggested at paragraph 6.1.3 that it was commonly known by the Domain Name. It referred to the results of Google searches, emails sent and received by reference to email addresses connected to the Domain Name and references to the Domain Name on the web. None of this material establishes that the respondent, Frenbray Pty Ltd, was known by or associated with the Domain Name.

37 I consider that the respondent does not have rights or legitimate interests in respect of the Domain Name.

Paragraph 4(a)(iii): “bad faith” registration or use.

38 The complainant must also establish that the Domain Name has been registered or subsequently used in “bad faith”. Paragraph 4(b) provides a list of matters which provide evidence of bad faith registration or use of a domain name, if the Panel finds that they exist. It reads:

- “(i) circumstances indicating that [the respondent has] registered or [the respondent has] 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) [the respondent has] registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or

- (iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
- (iv) by using the domain name, [the respondent has] have 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 website or location or of a product or service on that website or location.”

Bad faith use may be established by other matters as well.

39 As to paragraph 4(b)(i) of the Policy, the complainant provided evidence of a conversation between an employee of the complainant’s solicitors, a Mr Gleeson, and Mr Lye of the respondent, in which the respondent is alleged to have “requested \$80,000 “compensation” based on the fact that he must “look into the future and look at the potential earnings of the site”. The respondent did not dispute that the offer was made by Mr Lye.

40 The respondent sought to justify the \$80,000 figure on the basis that \$80,000 was standard brokerage on the sale of as few as 10 new Aston Martin cars. However, the statutory declaration of Mr Fuller dated 21 July 2006 gave evidence of a further conversation with Mr Lye of 22 December 2005:

“Mr Lye stated or agreed that the Domain name was not essential to his business as Aston Martin vehicles are generally purchased by high net worth individuals. Mr Lye agreed with me that customers planning to purchase an Aston Martin motor vehicle were unlikely to require the assistance of Frenbray Pty Ltd (trading as Private Fleet) to negotiate a favourable price when purchasing an Aston Martin motor vehicle.”

Although the response took issue with a number of aspects of the complainant’s evidence in relation to conversations between the complainant’s solicitor’s employees and Mr Lye, it did not dispute this aspect of that record. The respondent’s justification of the \$80,000 figure was not persuasive in light of the conversation of 22 December 2005.

41 Nevertheless, I am not satisfied that the Domain Name was registered primarily for the purpose of trafficking in the Domain Name within paragraph 4(b)(i) for the following reasons:

- (a) The respondent did not approach the complainant seeking payment in consideration for transferring the Domain Name to the complainant. The offer was only made after the solicitors for the complainant had sent a letter of demand to the respondent alleging contravention of the auDRP policy and infringement of various rights of the complainant. It is not uncommon for disputes to be resolved by a monetary settlement and for the settlement process to involve both ambit claims and haggling.
- (b) It appears to have been the representative of the complainant who first broached the subject of a payment, albeit on the basis of compensation for expenses.
- (c) The respondent put some effort into the website associated with the Domain Name. The respondent has arranged various advertisements on the website and actively solicited further advertising approaches. The website also advertises the services of Private Fleet. The respondent might anticipate some income from these sources, even if the income is not such as might justify an \$80,000 price tag. In the circumstances, a reasonable alternative hypothesis is that the site was registered to further the respondent's own commercial interests rather than for the purpose of trafficking. The complainant has not provided evidence which dispels this hypothesis.

42 As to paragraphs 4(b)(ii) and 4(b)(iii) of the Policy, the panel is not prepared to conclude that the Domain Name was registered in order to prevent the complainant reflecting its trade marks in a corresponding Domain Name or to disrupt the business of the complainant. As indicated above, the complainant has not dispelled the hypothesis that the Domain Name was registered to advance the respondent's own commercial interests.

43 As to paragraph 4(b)(iv) of the Policy:

- (a) The Domain Name is confusingly similar to the trade marks of the complainant.
- (b) The respondent was undoubtedly aware of the reputation of the complainant and the good will associated with the trade marks in selecting the Domain Name. The choice of Domain Name was deliberate.
- (c) The selection of the Domain Name creates the impression that the website is affiliated with or has the sponsorship or endorsement of the complainant. The impression is strengthened by the prominent display of the Domain Name on the website and by the language of endorsements set out at paragraph 32(a) above.
- (d) The impression of an affiliation, sponsorship or endorsement between the site and the complainant is not negated by the disclaimer, for the reasons given in 32(a).
- (e) In addition, the services and products of FinCar Finance, Dawes Motor Underwriting Group and Cover Craft are products or services on the website. The language set out at paragraph 32(a) above creates a likelihood of confusion as to whether those services and products are endorsed by the complainant.

44 Accordingly, I find that the complainant has made out the elements of paragraph 4(b)(iv) of the Policy.

SUMMARY

45 I am satisfied that the complainant has made out each of the elements of paragraph 4 of the Policy.

OTHER MATTERS

46 The respondent alleges that the complainant's solicitor represented on or about 12 January 2006 that "his client considered the matter settled". The respondent asserts that the complaint should be dismissed on the grounds of estoppel. It is not clear that an estoppel is a matter which the Panel is entitled to take into account. It is not a matter referred to in the Policy. In any event, the respondent

has not alleged that it relied to its detriment on the statement made by the complainant's solicitor on 12 January 2006. Detrimental reliance is an essential element of estoppel.

- 47 The respondent requested that the Panel find that the complaint was brought in bad faith and was an attempt at reverse Domain Name hijacking. As I have upheld the complaint, I reject this request. There was no evidence of a lack of good faith on the part of the complainant.

RELIEF

- 48 The complainant sought revocation of the respondent's registration in respect of the Domain Name and transfer of the disputed name to the complainant. The respondent did not dispute that the complainant was entitled to be registered in respect of the Domain Name.

- 49 In the circumstances, it is appropriate that the Domain Name be transferred to the complainant.

DECISION

- 50 The Panel is satisfied as to the elements of paragraph 4(a) of the Policy and directs that the Domain Name be transferred to the complainant.

Date: 3 October 2006.

DS Ellis
Sole Panelist