



ADMINISTRATIVE PANEL DECISION

PFD Food Services Pty Ltd v Terence Bergagna

LEADR - auDRP11/06
www.pfd.com.au

1 The Parties

The Complainant is PDF Food Services Pty Ltd, a company incorporated in Victoria having its registered office at Knoxfield, Victoria.

The Respondent is Terence Bergagna carrying on business as “Prototype Font Design” at Brunswick, Victoria.

2 The Domain Name and Registrar

The Disputed Domain is <pfd.com.au>. The registrar of the Disputed Domain is Melbourne IT.

3 Procedural History

This is an administrative proceeding pursuant to the .au Dispute Resolution Policy adopted by auDA on 13 August 2001, which commenced operation on 1 August 2002 (“auDRP”); the auDA Rules for .au Dispute Resolution Policy (“Rules”) and the LEADR Supplemental Rules to Rules for .au Domain Name Dispute Resolution Policy (“LEADR Supplemental Rules”).

The complete application was received from the Complainant by LEADR on 25 September 2006. The Respondent contacted LEADR via phone and confirmed that the application had been received by him on 26 September 2006 via email.

On 26 September 2006 LEADR express posted and emailed to the Respondent a dispute notification letter and a copy of the application, in which the Respondent was advised that he had until 16 October 2006 to submit all materials he wished to have considered by the Panel.

A copy of the application and a copy of the dispute notification letter were also posted to the Registrar on 26 September 2006. On 27 September 2006 the Registrar acknowledged receiving notice of the Complaint and confirmed that it had locked the Disputed Domain pending the determination of this proceeding.

All other procedural requirements appear to have been satisfied.

4 Factual Background

The Complainant is one of Australia's largest privately owned food service companies. The company's origin dates back to 1864. Currently, the Complainant has an annual turnover of \$600 million and a customer base of more than 50,000 customers. The Complainant has registered a number of trade marks which include the acronym "PFD". These trade marks were lodged with the Australian Trade Mark Office during 2000 and 2001 and include:

- Trade mark no. 854647 "PFD"
- Trade mark no. 854648 "PFD Services- Reliability- Tradition"
- Trade mark no. 868670 "PFD Foodservices 100% Australian owned"
- Trade mark no. 882453 "PFD Ocean Fresh"
- Trade mark no. 882455 "PFD Best of the Best"

Trade marks 854647, 854648 and 868670 are registered in classes 3, 16, 21, 22, 29, 30, 31, 32 and 39. Broadly, these classes relate to food, beverages, cleaning products and paper and packaging products.

The Respondent, on the other hand, owns a business called "Prototype Font Design" which engages in the design and programming of fonts and custom lettering for use.

The Respondent first registered the business name "Prototype Font Design" on 23 April 1993. The Respondent some time thereafter registered the Disputed Domain <pdf.com.au>. The Complainant asserts that the date on which the Disputed Domain was registered was 11 May 2004.

On 23 April 2005 the business name was deregistered. From the Business Name Extract provided by the Complainant it seems that the Respondent's business name lapsed due to failure to renew the registration on the required date.

The Respondent renewed the Disputed Domain on 11 May 2006 and, four days later, re-registered the business name "Prototype Font Design".

On 26 May 2006, after the Respondent renewed the Disputed Domain and re-registered the business name "Prototype Font Design", the Complainant's solicitors sent a letter of demand and email to the Respondent. On 7 June 2006, a further email was sent to the Respondent. On 9 June 2006, the Complainant's solicitor spoke to the Respondent. A detailed outline of this conversation has not been provided in the Complaint. However, the Complaint records that during this conversation the Respondent stated that he wished to retain the Disputed Domain.

5 Parties' Contentions

5.1 Complainant

The Complainant makes the following principal contentions:

A. The Disputed Domain is identical or confusingly similar to a name trademark or service mark in which the Complainant has rights.

- The Complainant has a right in the mark “PFD” as the Complainant has used the mark “PFD” since 1943 and has registered the company name “PFD Food Services Pty Ltd” since 1988.
- The Complainant is the registered owner of the five trade mark registrations, referred to above, which all include “PFD”.
- The Complainant has acquired substantial rights and established a reputation in “PFD” in relation to its goods and services, Australia wide.
- The Disputed Domain is identical and confusingly similar to the Complainant’s well known company name and registered trade marks and therefore paragraph 4(a)(i) of the auDRP must be regarded as satisfied.

B. The Respondent has no rights or legitimate interests in respect of the Disputed Domain.

- The Respondent has not registered, or applied to register any trade mark reflecting the Disputed Domain name.
- The Respondent’s business name had lapsed during the period from 23 April 2005 to 15 May 2006 and therefore during this period the Disputed Domain did not satisfy the Australia domain Name Eligibility and Allocation Rules for Open 2LDs.
- To the Complainant’s knowledge, the Respondent has not used the domain name or a name corresponding to the domain name in connection with an offering of goods or services. Additionally, at the date of the Complaint, the Respondent did not appear to be using the Disputed Domain to actively engage in business on the Internet.

C. The Disputed Domain was registered and is being used in bad faith.

- At the date of registration (11 May 2004 according to the Complainant) the Complainant had already acquired substantial rights and established a reputation in the name “PFD” in Australia. Therefore, the Respondent was likely or ought to have been aware of the Complainant’s right to the name.
- The Respondent’s business name was deregistered on 23 April 2005. The Respondent continued to use the Disputed Domain and therefore did not satisfy the auDA rules.
- The Respondent renewed the registration for the Disputed Domain on 11 May 2006, four days before the business name was re-registered by the Respondent. Therefore, at the time of renewing the registration for the Disputed Domain, the Respondent would not have satisfied the auDA rules.
- The Respondent registered, subsequently used and renewed the Disputed Domain in order to prevent the owner of the name and trade mark “PDF” from obtaining the Disputed Domain.

5.2 Respondent's Response

The Respondent submitted no Response.

6 Discussion and Findings

Paragraph 15(a) of the auDRP Rules requires the Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the auDRP, the auDRP Rules, and any rules and principles of law that it deems applicable.” The Panel is also permitted to have regard to any publicly available information.

Paragraph 4(a) of the auDRP requires a Complainant to prove that:

- (i) the Disputed Domain 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 ; and
- (iii) the Disputed Domain has been registered or subsequently used in bad faith.

The onus of proof is on the Complainant in relation to all three of these elements, even where the Respondent has failed to respond to the Complaint.

6.1 Identical or Confusingly Similar to a name in which the Complainant has rights

The registration of a trade mark “PFD” along with other trade marks which include the acronym “PDF”, the registration of the company name “PFD Food Services Pty Ltd” and use of the “PDF” mark in association with the Complainant’s business since 1943 demonstrate that the Complainant has rights to the name and trade mark “PDF”.

Accordingly, for the purposes of paragraph 4(a)(i) of the auDRP, the Panel finds that the Disputed Domain is identical to a name and trade mark in which the Complainant has rights.

6.2 Rights or Legitimate Interests

The auDRP acknowledges that more than one party may have rights or legitimate interests in a domain name. Therefore, in order to succeed, the Complainant must demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain.

In particular, the Domain Name Eligibility and Allocation Rules for Open 2LDs envisage that a number of persons may be entitled to a single domain name. Schedule C of that policy sets out a range of bases on which a person is considered eligible in respect of a .com.au domain name. These include:

- (a) an Australian registered company; or
- (b) trading under a registered business name in any Australia State or Territory; or
- (c) an Australian partnership or sole trader; or
- (d) a foreign company licensed to trade in Australia; or

- (e) an owner of a Australian Registered Trade Mark; or
- (f) an applicant for an Australian Registered Trade Mark; or
- (g) an association incorporated in any Australian State or Territory; or
- (h) an Australian commercial statutory body.

Additionally, according to Schedule C, a domain name in the .com.au 2LD must:

- (a) exactly match, or be an acronym or abbreviation of the registrant's company or trading name, organisation or association or trademark; or
- (b) be otherwise closely and substantially connected to the registrant.

The Wayback Machine (www.archive.org) shows that as early as 12 December 1998, the Disputed Domain resolved to a website with the message:

“Under Construction. New Prototype Font Design site launching soon.”

The Wayback Machine also shows that the Dispute Domain has been active at least from 12 November 1999 to 16 May 2001. The Wayback Machine on 12 November 1999 captured the entry page of the website showing an image of a roadside sign which reads:

“PFD Council of Australia.
DANGER
No fades, bevels or drop shadows past this point
The site is best viewed with open eyes”

The use of graphic design terminology on the Disputed Domain's home page suggests that the Respondent was at least from November 1999 planning to use the site to promote or conduct his business.

At the time of the Respondent acquiring the Domain Name, whether that be on 11 May 2004 or sometime prior to that date, the Respondent had the business name, Prototype Font Design, registered in Victoria, Australia. Although the Respondent was trading before the assumption by auDA in 2001 of responsibility for the .au ccTLD, he was after that time entitled to register in the .com.au 2LD a domain name that was an acronym of the business name Prototype Font Design, that is <pdf.com.au>. Thus, the Respondent, at the time of acquiring the Disputed Domain, had a right or a legitimate interest in the Disputed Domain <pdf.com.au>.

The Respondent apparently still trades as Prototype Font Design, in Victoria, Australia. He plainly has rights or legitimate interests in respect of the Disputed Domain.

During the period from 23 April 2005 to 14 May 2006 the Respondent apparently did not maintain the registration of the business name Prototype Font Design. Whether this was a conscious decision made by the Respondent or one of mere inadvertence has not been established, and largely does not matter, except to observe that the re-registration of the business name does not appear to have been prompted by any correspondence with the Complainant or its solicitors.

The Complainant submits that the Respondent has no rights or legitimate interests in the Disputed Domain because the Respondent let his business name lapse for a period of time

and that, during this time, the Respondent renewed the registration for the Disputed Domain. However, this is not fatal to the Respondent having a right or legitimate interest in the Disputed Domain.

In fact, auDA's Guidelines for Accredited Registrars on the Interpretation of Policy Rules for Open 2LDs indicates that the lapsing of a business name is not fatal to a registrant's right or interest in a domain name. Under the Guidelines, where a business name registration has lapsed, a registrant will still be entitled to the domain name if it is entitled to re-register the business name and actually re-registers the business name. The mere fact that the business name lapses for a period of time does not disentitle a registrant to the domain name.

The Respondent renewed his registration for the Disputed Domain four days before he re-registered the business name Prototype Font Designs. At the time of acquiring the Disputed Domain the Respondent had a right or legitimate interest in the Disputed Domain name. During the period from 23 May 2005 to 14 May 2006, during which the Respondent had allowed his business name to lapse, the Respondent's right to the Disputed Domain derived from the Respondent's previous registration of the business name "Prototype Font Design" and his ability to re-register the business name. As a result, the Respondent currently has, and has had since 15 May 1993, a right to the Disputed Domain, being an acronym of the Respondent's business name.

In any event, at the time the Complainant notified the Respondent of its interest in the Disputed Domain, the Respondent had already re-registered his business name "Prototype Font Design" and was therefore entitled to register the Disputed Domain as a result of that registration.

Accordingly, the Complainant has not made out paragraph 4(a)(ii) of the auDRP.

6.3 Registered and used in Bad faith

Paragraph 4(a)(iii) of the auDRP requires the Complainant to demonstrate that the Disputed Domain was registered *or* subsequently used in bad faith. The Complaint, asserts that the Disputed Domain was both registered and is now being used in bad faith.

The Complainant submits that the necessary element of bad faith is established as the Respondent registered the Disputed Domain on 11 May 2004 whilst the Respondent's business name had lapsed and that the Respondent's subsequent re-registration of the business name, 4 days later demonstrates that the Respondent was intending to keep the Disputed Domain in bad faith, that is, without having a right or legitimate interest in the Disputed Domain.

It is hard to see how the Complainant could make good its assertion that the Respondent has registered, subsequently used and renewed the Disputed Domain "in order to prevent the Complainant from obtaining the domain name". The Complainant submits that the Respondent should have been aware of the Complainant's trade mark "PFD". Even if the Respondent was aware of the Complainant's mark, which may not necessarily be the case, the Respondent had registered his business, which engaged in the design and programming of fonts and custom lettering, on 23 April 1993. Indeed the Respondent could have registered a trade mark himself since his products were different from those in respect of which the Complainant's marks were to be registered. The registration of the Respondent's business name preceded lodgment of any of the Complainant's trade marks. Even if it were established that the Respondent had a close and substantial connection to

the mark “PFD” and therefore entitled to the Disputed Domain prior to 1993, which this Panel finds he almost certainly did, the Complainant did not register the Disputed Domain or, it seems, make enquiries about the Disputed Domain until 2006. This allowed other persons with an interest in the Disputed Domain to legitimately apply for and be granted a licence in respect of the Disputed Domain.

The Complainant neither asserts nor demonstrates that the Respondent was not entitled to register or renew the business name Prototype Font Designs. In the circumstances, the Respondent was well within his rights to acquire the Disputed Domain, being an acronym of his business name. The Respondent also used the Disputed Domain in connection with his business as is demonstrated from pages captured by The Wayback Machine (www.archive.org). The Panel cannot find that the existence of the Complainant’s trade marks embodying “PFD” demonstrate that the Respondent has registered or used the Disputed Domain in bad faith. On the contrary, the Respondent’s business name amply supports his domain name registration.

The Respondent was not on notice of the Complainant’s interest in the Disputed Domain when he re-registered the business name on 15 May 2006. It was not until 26 May 2006, **after** the Respondent had renewed the domain name and re-registered the business name, that the Complainant, through its solicitors, approached the Respondent asking that the licence to the domain name be returned to Melbourne IT so that the Complainant could acquire the Disputed Domain. The Panel notes that in that letter the Complainant’s solicitor incorrectly refers to the auDRP as “legislation” and goes on to describe administrative proceedings such as this in a way calculated to deter the Respondent from defending his rights. The Panel cannot see any justification for this overly robust approach, despite the conciliatory language which followed in an attempt to have the Respondent voluntarily surrender his domain name.

The Complainant has failed to make out paragraph 4(a)(iii) of the auDRP.

7 Decision

The Complainant having failed to make out all of the elements of paragraph 4(a) of the auDRP, the Panel directs that the Complaint be denied.

Dated this 2nd day of November 2006

P Argy

Philip N Argy

Sole Panellist