

Domain Name: www.perpetual.net.au
Name of Complainant: Perpetual Limited (ACN 000 431 827)
Name of Respondent: Perpetual Financial Solutions Pty Limited (ACN 119 592 979)
Provider: LEADR
Panel: John E. McDermott

1. THE PARTIES

- 1.1 The Complainant in these proceedings is Perpetual Limited of Level 12: 123 Pitt Street, Sydney in the State of New South Wales ("**Complainant**").
- 1.2 The Respondent is Perpetual Financial Solutions Pty Limited (ACN 119 592 979) ("**Respondent**").

2. THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 2.1 The domain name in dispute is 'www.perpetual.net.au' ("**Domain Name**") or Disputed Domain Name.
- 2.2 The Registrar of the Domain Name is NetRegistry Pty Limited (ACN 080 859 721) of 97 Rose Street, Chippendale in the State of New South Wales ("**the Registrar**").
- 2.3 The Provider in relation to this proceeding is LEADR ("**Provider**")

3. PROCEDURAL MATTERS

- 3.1 These proceedings concern a complaint ("**Complaint**") with respect to which the Provider and the Panellist have provided a procedural history as follows:
- i. The Complainant was submitted for decision in accordance with the (auDRP) Policy and Rules which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's supplementary Rules (LEADR is the Provider).
 - ii. The complete application was received from the Complainant by LEADR on 18 December 2008.
 - iii. LEADR contacted the Respondent via telephone and confirmed that the application had been received on 24 December 2008 by express post.
 - iv. On 22 December 2008, LEADR express posted to the Respondent a dispute notification letter and a copy of the application.
 - v. A copy of the application and a copy of the dispute notification letter were also posted to the registrar NetRegistry Pty Limited on 22 December 2008.
 - vi. LEADR advised auDA of the complaint on 22 December 2008 via email.
 - vii. On 21 January 2009, the provider approached the Panellist. The Panellist confirmed his availability, informed LEADR that they had no conflict issues with the parties and accepted the matter on 21 January 2009.

- viii. The response was due on 16 January 2009. A response was received by that date.
- ix. The Panellist was informed on 22 January 2009 that the package was being sent for Adjudication and the package was received by the Panellist on 23 January 2009.
- x. On 27 January 2009, the Panellist informed the Provider that a decision would be available on or before 6 February 2009 and that any further submissions from either party should be received no later than 2 February 2009.
- xii. On 27 January 2009, the Panellist received the Complainant's further submissions and confirmation from the Provider that both parties had been advised of the deadline for any further submissions at 5pm on 2 February 2009.

4. **FACTUAL BACKGROUND**

Facts alleged by the Complainant

- 4.1 In submissions attached to its Complaint and/or in its supplementary submissions, the Complainant raised extensive factual matters, some of which are reflected in subsequent sections hereof. Others included:
- a. The Complaint is based on Perpetual's ownership of the Perpetual trademark and other trademarks that contain the word 'PERPETUAL'.
 - b. Perpetual is one of Australia's first financial services institutions with a history spanning over 120 years. Perpetual and its predecessors in business have been using the 'Perpetual' name and mark in relation to financial services since as early as the 1880s. As such, Perpetual has substantial and exclusive common law rights in the 'Perpetual' name and mark in relation to financial services.
 - c. In addition, Perpetual owns numerous trademark registrations in Australia that comprise or contain the mark 'Perpetual'. Details extracted from the Trade Marks Office database in respect of Perpetual's Australian trademark registrations for marks that include the word 'Perpetual' (copies were provided as Exhibit 5).
 - d. Those trademark registrations include the following Australian trademark registrations ("**the Perpetual Marks**"):
 - i Australian trademark registration 730677 for 'Perpetual' in classes 16 and 36 dated 25 March 1997 (full trademark registration details and history are attached as Exhibit 6); and
 - ii Australian trademark registration 783265 for the Perpetual and device mark in classes 16 and 36 dated 18 January 1999.

Facts alleged by the Respondent

- 4.2 In its submissions received in the Provider's office on 20 January 2009 and signed by Mr Daniel O'Brien, the Respondent (said by the Complainant to have been previously legally represented but making submissions on its own behalf) elected not to respond in terms of Paragraph 4 of the auDispute Resolution Policy (auDRP) (**the "Policy"**).

Paragraph 4(c), paraphrasing as to part, indicates without limitation that a Respondent might satisfy Paragraph 4(a)(ii) (see below) by adducing evidence as to:

- a. Bona fide use or demonstrable preparations to use the Domain Name; or
- b. That the Respondent had been commonly known by the Domain Name; or
- c. That the Respondent was making a legitimate commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert customers or to tarnish the name, trademark or service market at issue.

4.3 The Respondent chose, in lieu of concentrating on Paragraph 4(c), to make amongst others the following points which went more towards rhetoric than a consideration of the contents of the Policy:

- a. It is not possible to trademark a website, just to purchase the Domain Name;
- b. The reason that this Domain Name was chosen is because no other suitable name was available.
- c. The website is not active.
- d. Although the parties are both in the financial world, they operate in different areas of it.
- e. Because the Complainant can use the Raine & Horne Financial Services website, it has not developed the website for the Disputed Domain Name.
- f. Like the Complainant, the Respondent has won numerous industry awards.
- g. The Complainant is harassing the Respondent and if it wants this website, which is not really for sale, it should purchase it.

5. THE PARTIES' CONTENTIONS

The Complainant's Contentions

5.1 The Complainant, which bears the onus of proving its case under all three portions at Paragraph 4(a) of the Policy, alleges pursuant to that Paragraph that:

A: The Domain Name is identical or confusingly similar to a name and trademark in which Perpetual has rights – Paragraph 4a(i).

This is said to be because:

- a. Perpetual owns numerous trademark registrations in Australia that comprise or contain the mark PERPETUAL in relation to financial services and related goods and services.
- b. On occasions, the single word Perpetual has been registered and on one occasion, it was registered as distinctive rather than descriptive.
- c. The Complainant has acquired common law rights in the name "Perpetual" owing to its longstanding and widespread use.

In all, the Complainant makes thirty-seven paragraphs of submissions which accentuate the extensive investment and the very widespread use and

recognition of the name Perpetual in its hands and are sufficient to satisfy me both that this extends to the Australian mortgage lending industry.

I am also persuaded by Paragraph 36 of the Complainant's submissions which is to this effect:

"The .net.au top-level domain extension in the Disputed Domain Name can be disregarded because it is generic. As such, the Disputed Domain Name is essentially the word 'PERPETUAL', which is identical to Perpetual's name and mark".

B: The Respondent has no rights or legitimate interest in respect of the Disputed Domain Name – Paragraph 4a(ii).

This is said to be because:

- a. The Respondent was a proprietor of the New South Wales business name Perpetual Financial Services (PFS Business). The Respondent clearly intended to use the Disputed Domain Name in relation to the PFS Business since he listed the ABN associated with the PFS Business in the Whois data for the Disputed Domain Name.
- b. The historic names extract in respect of the PFS Business specifies the nature of the business as "mortgage broker" – a financial service. Clearly the Respondent intended to use the Disputed Domain Name in connection with a financial services business.
- c. The Respondent has no connection or affiliation with Perpetual and has not received any licence or consent, express or implied, to use the Perpetual Marks in a domain name or in any other manner in relation to financial services. Furthermore, the Respondent is no longer a proprietor of the PFS Business.
- d. Where a mark is well known, as is the case with Perpetual Marks, it is "not one traders would legitimately choose unless seeking to create an impression of an association" with the complainant. See "Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No D2000-2003, at 7.2 (February 18, 2000)". Accordingly, a "trader" such as the Respondent could have no legitimate interest in the Perpetual Marks Id.
- e. Even if the Respondent were providing financial services, he would have no rights or legitimate interests in the Disputed Domain Name because of Perpetual's rights in the Perpetual Marks.

The Respondent cannot claim that the word 'Perpetual' is descriptive in relation to financial services since the word has no application to such services. In addition, as pointed out above, Perpetual has been able to register the word 'Perpetual' as a trademark because the mark is distinctive – not descriptive.

- f. For the same reasons, PFSPL has no rights or legitimate interests in the Disputed Domain Name because of Perpetual's rights in the Perpetual Marks.

I shall return to the Complainant's use of the phrase "the Respondent is no longer a proprietor" but in the interim note that the phrase "legitimately choose" in Paragraph (d) above could equally well read "logically choose".

The Respondent's own submissions about its extensive searches for a Domain Name acceptable to it must inevitably have highlighted the patently obvious connection between the final choice and PERPETUAL.

C: The Disputed Domain Name has been registered or subsequently used in bad faith – Paragraph 4a(iii).

Once again the submissions on this issue are sufficiently brief to reproduce here.

- a. It is inconceivable that the Respondent was unaware of Perpetual's rights in the 'Perpetual' Marks. The Complainant's rights in the 'Perpetual' Marks also would have been obvious through basic domain name and trademark searches, which are readily assessable online.
- b. Due to fame of the Perpetual Marks within the financial industry and amongst the public, it is clear that the Respondent registered the Disputed Domain Name in an attempt to attract customers by creating a likelihood of confusion with the Perpetual Marks.
- c. The Respondent has registered the Disputed Domain Name in bad faith by doing so with knowledge of Perpetual's rights in the 'Perpetual' Marks.

See "Singapore Airlines Limited v Scott Hoggett and Meredith Hoggett CIARB-0301 [29 August 2003] (finding bad faith and stating that "to misleadingly divert consumers to its website by offering a link that the consumer would immediately associate with a well known and trusted brand name thereby ensuring a flow of customers who could be enticed to purchase the Respondents' own ...products which were unconnected with the Complainant's ..brand"); Napoleon Perdis Cosmetics Pty Limited v Rebecca Jones, WIPO Case No. DAU2006-0014 (31 January 2007)'.

- d. In or around November 2007, an agent retained on behalf of Perpetual (the "Agent") undertook investigations to ascertain the nature and extent of the business being conducted by PFSPL.

The Agent's inquiries revealed that PFSPL offers a range of financial services and products to clients including home loans, investment loans, business loans, motor vehicle finance, refinancing and financial planning.

- e. The Agent was also provide with a business card of the sole director of PFSPL, Daniel O'Brien. The business card includes a reference to the Disputed Domain Name and an email address daniel@perpetual.net.au. A copy of that business card is attached as Exhibit 13.

There is currently no website at the url listed on that business card (see printout of screenshot taken on 18 December 2008 in Exhibit 14). The

site is simply listed as “under construction” and does not clarify that there is no connection between Perpetual and PFSPL or the Respondent.

- f. As such the Disputed Domain Name is being used, whether by the respondent or not, in connection with financial services. This use clearly infringes Perpetual’s intellectual property rights and risks creating confusion amongst consumers and the financial industry.

The Respondent’s Contentions

5.2 The Respondent does not, as stated, focus on defeating the Complainant’s submissions pursuant to Paragraph 4(a) of the Policy either by arguing legitimacy pursuant to Paragraph 4(c), see above, or in any other detailed manner.

A: The Domain Name is identical or confusingly similar to a name and trademark in which Perpetual has rights – Paragraph 4(a)(i).

There is nothing in the Respondent’s submissions that would dissuade me that the Disputed Domain Name is not identical or similar to the Complainant’s own name and trademarks.

The Respondent makes no realistic attempt to dissuade me on this issue.

B: The Respondent has no rights or legitimate interest in respect of the Disputed Domain Name – Paragraph 4a(ii).

I have referred above to three tests pursuant to Paragraph 4(c) of the Policy which “in particular but without limitation” can be used to demonstrate the Respondent’s Rights to and Legitimate Interests in the Domain Name.

The Respondent has not attempted to so demonstrate. I have nevertheless myself reviewed the position on the relevant tests as regards which:

- 4c(i) Notwithstanding the Complainant’s first submission as regards Paragraph 4(a)(ii), there has been no bona fide use of (as opposed to a mere reference to) the Domain Name. The website is still said to be “under construction” with no indication as to any future content or any future date for it.

Although it is not clear from the materials before me when the site was first “constructed”, it does appear that it must have been existing at least in or around November 2007 when the Complainant’s agent carried out an investigation.

On this basis, it appears unlikely that there was any bona fide intent to use the name when it was first adopted.

The Complainant asserts, based on its submissions with regard to the Respondent’s business card, again apparently as it existed during or about November 2007, that there is a use of the Disputed Domain Name.

Since those submissions were made, I have of course received the Respondent’s submissions as previously referred to. The letterhead bears, at the foot, a clear reference to an email address

daniel@perpetual.net.au and this is consistent with the use of the business card.

None of this however is consistent with any use of the Domain Name for practical purposes because the website, being under construction as has apparently been the case for an extended period, leads nowhere and serves no purpose in "connection with an offering of goods or services".

Nor is there any indication of any "preparations to use". The Respondent asserts, counter-productively in this context, that "I just use Raine & Horne's website instead of developing my own".

- 4c(ii) The Respondent has not attempted to prove that it has been commonly known by the Domain Name or that it has acquired any trademark or service mark rights. As regards the first, the inference to be taken from the Respondent's submissions is that the business is mainly presented as "Raine & Horne financial services".

To the extent that the Respondent's submissions are under a PFS or Perpetual Financial Solutions' letterhead, there is no representation that this letterhead is so frequently used as to satisfy the phrase "commonly known".

To the extent that it is, the major identification is PFS. An email address at the foot of the letterhead does not provide any basis for arguing that the Respondent is commonly known by the Disputed Domain Name. No persuasive material has been put to me to support such an argument.

Clearly, by way of contrast, the Complainant enjoys a considerable reputation using the name PERPETUAL, which word constitutes the entire Disputed Domain Name apart from the generic portion.

- 4c(iii) As far as making a legitimate non-commercial or fair use of the Domain Name is concerned, there is no practical use, for the above reasons.

I am satisfied, without needing to repeat them, from Paragraphs 29 to 35 of the Complainant's submissions and from numerous exhibits to them that the Complainant is heavily involved in the mortgage industry as is the Respondent.

It is, further, clear from the Respondent's own submissions, although the Respondent would necessarily have an awareness somewhat heightened above that of the ordinary individual, that the Complainant is seen as being as significant a participant in the mortgage industry as the Complainant itself asserts.

More sophisticated members of the financial community might well be able to distinguish between the two entities but websites are accessed by members from every section of the community. Typically they are accessed by people who are seeking information rather than those in possession of it.

The possibility that a person who accessed the website for the Disputed Domain Name, if it was active, would confuse its proprietorship with that of the Complainant must be judged to be high.

The Respondent's PFS letterhead has the sub-heading "Home Loans. Investment Loans. Business Loans" and the Complainant does, as previously stated, have a considerable reputation in the finance industry which would be likely to deceive (in terms of Section 52 of the Trade Practices Act) many members of the community.

If the website was active, it could easily divert consumers to the Respondent's business. Given that the range of services is somewhat different and the Complainant presents itself as somewhat more of a "high-end" financier, any such confusion could, moreover, result in tarnishing the Complainant's image.

To the extent that the services of the Complainant and the Respondent overlap, the diversion of customers could be detrimental in a different way.

6. **The Disputed Domain Name has been registered or subsequently used in bad faith – Paragraph 4a(iii).**

The Respondent's submissions do assert, in brief form, that the Disputed Domain Name has been registered in good faith and that the Complainant is indulging in "school yard bullying".

Evidence of Bad Faith

Paragraph 4(b) of the Policy, addressed to Respondents, instances the following circumstances, in particular, which "if found by the Panel to be present shall be evidence of the registration and use of a Domain Name in bad faith":

- i circumstances indicating that you have registered or you have acquired a 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 your documented out-of-pocket costs directly related to the domain name; or
- ii you have 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 you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
- iv by using the domain name, you 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.

These are not cumulative instances. Any one taken alone is sufficient.

As regards use in bad faith, I note that:

- a. It has been said in “Yaffa Publishing Group Pty Limited v Go Boating Publications (auDRP01/08-LEADR)” that:

“The question of the Respondents’ bona fides is really a question of credit which the auDRP, like the UDRP, is usually ill-equipped to decide. Occasionally however, as is the case here, a Respondent’s contentions simply cannot be believed or accepted based on one’s experience and logic”.

- b. The Respondent must inevitably have been aware, from its Domain Name searches and its knowledge of the industry, of the Respondent’s trademarks, common law rights, recognition of, use of and promotion of the use of the word “Perpetual” in its various representations, all of which place the emphasis on the single word PERPETUAL at the time that the application for the Domain Name was made.

The Respondent’s own trading banner for PFS or Perpetual Financial Solutions, to the extent that it may be used, does not place the focus on the word “Perpetual” but on the descriptive phrase “financial solutions”.

I see no bona fide reason why the Respondent would wish to emphasize the word ‘Perpetual’ in a Domain Name. Taken alone it would be likely to mislead people to believe they were dealing with the Complainant.

Taken alone, there is nothing to suggest to people that in searching a website connected with this Domain Name, they would be accessing “financial solutions” at all unless in connection with the Complainant.

On this issue, I accept the Complainant’s suggestions that there were other names available which would have a more obvious connection with the Respondent. The Respondent’s credibility is central to the submissions made and is clearly shaken by the Complainant’s search details.

The Respondent now, protesting that any sale would be reluctant, now invites the Complainant to purchase the website.

In the circumstances of this matter, where 4(b)(ii) and 4(b)(iii) do not apply, common sense experience and logic compel a conclusion that:

- a. Use of the Domain Name, with virtually the sole emphasis on the word “Perpetual” falls within Clause 4b(iv); or
- b. More likely the registration of this name with the emphasis on the word “Perpetual”, the allowing of it to remain dormant and the current offer for sale in circumstances where there appears to be no current intention to fully construct the site, attracts the provisions of Clause 4b(i).

Identification of the Respondent

This Application was commenced by the Complainant against the Respondent which is an Incorporated Body. In Paragraph 40 of its submissions, the Respondent refers to the fact that “the Respondent is no longer a proprietor of the PFS business”.

It could be said that there is some uncertainty as to whether the proper Respondent in these proceedings is Mr KC Smith, as stated on the front sheet of the Complainant’s submissions Perpetual Financial Solutions Pty Limited as stated on the second page of those submissions Mr Daniel O’Brien, who has made submissions under the letterhead of

Perpetual Financial Solutions (apparently a business name) with no indication as to who is "trading as", or some other owner of the business name Perpetual Financial Solutions.

The Complainant has provided me with a registration of the business name Perpetual Financial Solutions in the name of Mr O'Brien and Mr Smith and an ASIC search of Perpetual Financial Solutions Pty Limited indicating that the Directors were Mr O'Brien and Mr Smith.

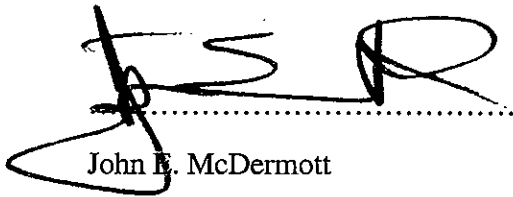
Mr O'Brien has put himself forward as being in a position to speak for the owner of the Disputed Domain Name without making it clear whether he does so as an individual, as a Proprietor of the Business Name or as a Director of the Incorporated Body.

I am satisfied that the interests of the owner of the Disputed Domain Name have been represented and that the Complainant is entitled to the benefit of the decision below.

7. DECISION

7.1 The Complainant has satisfied all of the requirements of the Complaint to be upheld and has requested that the Disputed Domain Name be transferred to it.

7.2 The Panel directs that the name www.perpetual.net.au be transferred by NetRegistry Pty Limited to the Complainant.



John E. McDermott

Dated: 6 February 2009