

Disputed Domain Name: www.ozfax.com.au
Name of Complainant: Ozefax Pty Limited
Name of Respondent: OzMedia Pty Limited
Provider: LEADR
Sole Panellist: David Lieberman
Date of Determination: 19 April 2010

1. The Parties

- a. The complainant in this proceeding is Ozefax Pty Limited of c/o Anthony Alder, Alder IP, PO Box 336, HORNSBY, NSW 2077, Phone 0438008550 (the "Complainant");
- b. The respondent is OzMedia Pty Limited of PO Box 3227, Wamberal, NSW 2260, Attention David Hutchinson, Phone 02 4385 5452 (the "Respondent").

2. The Domain Name, Registrar and Provider

- a. The domain name subject to this proceeding is www.ozfax.com.au (the "Disputed Domain Name").
- b. The Disputed Domain Name is registered in the name of the Respondent c/o Ricardo Accounting.
- c. The Registrar of the Disputed Domain Name is MDWebhosting (the "Registrar").
- d. The Provider in this proceeding is LEADR of Level 1, 13 Bridge Street, Sydney, 2000, NSW (the "Provider").

3. Procedural Matters

- a. The Provider made available to the Panel a summary document entitled "Procedural History" substantially as below.
- b. The complaint was submitted for decision in accordance with the (auDRP) Policy and Rules, which were approved by auDA in 2008 and commenced operation on 1 March 2008 and the Provider's Supplementary Rules (collectively the "auDA Policy").
- c. The complete application was received from the Complainant by the Provider on **10 March 2010**.
- d. On **12 March 2010** LEADR send by **post + email** to the Respondent a dispute notification letter and a copy of the complaint submitted.

- e. On **12 March 2010** LEADR send by **post + email** to the Registrar the dispute notification letter and a copy of the complaint submitted. At the same time the Provider requested the Registrar to lock the domain name in dispute.
- f. On **12 March 2010** LEADR advised auDA of the complaint by email.
- g. The Registrar confirmed that the website was locked on **17 March 2010**.
- h. On **6 April 2010** LEADR approached the Panellist. The Panellist confirmed his availability, informed LEADR that he had no conflict issues with the parties nor any prior relationship with their respective advisors and was impartial and independent as required by the auDA Policy and accepted the matter on **6 April 2010**.
- i. On **7 April 2010** the Provider sent by **email** a supplemental submission from the Complainant.
- j. On **12 April 2010** the Panel directed the Provider to send to the Respondent a copy of Annexure I of the Complaint.
- k. In reading the Respondent's Response to the complaint it was apparent to the Panel that the Respondent had not received the DVD enclosed as Annexure I of the Complainant's submission. Accordingly the Panel directed the Provider on 12 April 2010 to forward a copy of that DVD to the Respondent.
- l. On **14 April 2010** the Provider sent by **email** a supplemental submission by the Respondent.

4. Jurisdiction

- a. Jurisdiction for this Panel flows from clause 2.1 of the *.au Dispute Resolution Policy (auDRP)* ("Rules").
- b. The Disputed Domain Name is an open 2LD and its registration was established in 2008 and is therefore subject to the mandatory administrative proceedings prescribed by the auDRP.
- c. The Panel makes no determination regarding any possible trade mark infringement or other possible actions such as passing off.
- d. Paragraph 15(a) of the Rules states:

"A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy (auDRP Policy), these Rules and any rules and principles of law that it deems applicable."
- e. The Complainant on 7 April 2010, the day after the appointment of the Panel sent through the Provider a Supplemental Submission regarding the statutory Trade Mark filings of each party. The Respondent on 14 April 2010 also sent

through the Provider a supplemental submission. Under Clause 12 of the Rules, the Panel may permit further statements or documents and pursuant to that rule, The Panel accepted the Supplemental Submissions.

5. Complainant's position

a. In summary the Complainant states:

i. that since 1998, initially through its current executive director, Mr David Dixon and in its subsequent incorporation as Ozefax Pty Limited (which acquired such rights as Mr Dixon held) the Complainant:

I) Since 1998 has been successfully trading "as a faxing solution for efficient and economical documentary delivery using the internet" and as such has built up a business known to customers and suppliers in Australia and New Zealand;

II) In 1998 registered the business name "Ozefax";

III) In 1999 registered the domain name www.ozefax.com.au;

IV) In 2003 registered a company Ozefax Pty Limited; and,

V) In June 2004 the registration of a statutory trademark "Ozefax" in conjunction with a distinctive twisted circle, under Class 38 was granted;

ii. The Respondent's use of the Disputed Domain Name is identical or confusingly similar to their own name and their common law and statutory trademarks; and,

iii. The Respondents have no rights or legitimate interest in respect of the Disputed Domain Name; and,

iv. The Disputed Domain Name has been registered or subsequently used in bad faith pursuant to the description of bad faith in the auDA Policy.

b. The Complainant has supplied to the Panel filing records in respect of its business name, corporate and trade mark registrations and made submissions in respect of each of points 4 a. ii, iii and iv above.

6. Request by Complainant

a. The Complainant seeks to have the Respondent transfer the Disputed Domain Name to the Complainant in accordance with and subject to registration requirements.

7. Response by Respondent

- a. In summary the Respondent questions some of the statements in point 4 i and denies the allegations in each of points 4 a. ii, iii and iv above.
- b. The Respondent states that it has a registered trademark, its business was substantially different to the Complainant's business and its conduct throughout had been undertaken independently of the Complainant.

8. Consideration

- a. Paragraph 4(a) of the Rules provides that a person is entitled to complain about the registration or use of a domain name if the following criteria are satisfied:
 - i. the 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 to the complaint 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.
- b. Prior decisions in domain name disputes under the Rules have found that *all three criteria* of this Paragraph 4(a) are required to be proven for any complaint to be upheld. In respect of criteria iii above, it is sufficient to establish that criterion if either registration or subsequent use was in bad faith.
- c. The Complainant bears the onus of proof in respect of each of these criteria.

9. Basis of decision

Each of the above criteria is considered in light of the materials provided by the parties.

Criteria i) The Domain Name is identical and confusingly similar to names or trade marks

- a. The Complainant must establish that it has a name, trademark or service mark.
- b. The Panel is satisfied from the materials supplied to the Panel that the Complainant has established a business and a reputation in the word "Ozefax" including common law rights, company registration and business name registration and since 1999, a domain name www.ozefax.com.au. The Complainant registered as a Statutory Trade Mark, the word *Ozefax* in June 2004 in class 38 "*Telecommunications, Internet communications services and faxing services*".

- c. The Panel is satisfied that the Complainant has established that it has a name, trademark or service mark in the word "Ozefax".
- d. It is noted that in order to be eligible to be allocated a domain name in the com.au 2Ld space under AuDA Policy *Domain Name eligibility and Allocation for Open 2LDs (Policy number 2005-01)* the domain name must:
 - 1. exactly match, acronym or abbreviations of the registrant's company or trading name, organisation or association name or trademark; or
 - 2. be otherwise closely and substantially connected to the registrant.
- e. Through the above registrations the Complainant has demonstrated its rights in the use of the domain name www.ozefax.com.au.
- f. The Complainant's business has involved, amongst other offerings to customers, a fax based service operating without the use of a fax machine. The Complainant has run TV advertisements for this service and such services appear to be the Complainant's primary offering. Mr Dixon, who appears to be the founder of the business and is today an executive director of the Complainant, describes the business "as a faxing solution for efficient and economical document delivery using the internet".
- g. The Complainant states since the registration of the Disputed Domain Name there has been confusion amongst its potential customers and includes by way of support Statutory Declarations by Mr David Dixon and Ms Lisa Dixon, letters from 3 employees and five letters from Customers and Suppliers of the Complainant.
- h. The Complainant refers to similarity in the colours used by in the Disputed Domain Name with the colours used by the Complainant together with the prominent use of what appears to be a copy of the Microsoft Internet Explorer "E" symbol on the banner of the Respondent's web site.
- i. The Respondent states that the colours were to fit in with colours used on the www.ozmedia.com site and that the use of what bears a strikingly similar resemblance to the Microsoft Internet logo in a large format and on the other side of the page avoids any confusion.
- j. The Respondent also states that its searches on the web demonstrated many examples of the use of both "oz" and "oze" coupled with another word e.g. www.ozemotorsport.com and www.ozmotorsport.com. That may be the case but the Panel gave that no weight in its consideration to those examples as the Panel is limited to the consideration of the Disputed Domain Name.
- k. The Respondent also states that its business is in the provision of fax data and as such confusion is unlikely to occur.
- l. The Respondent is critical of the Statutory Declarations, letters from employees, customers and suppliers of the Complainant pointing out the similarity of language in some cases. The Respondent acknowledges that it

has had 3 or 4 occasions over 14 months where persons seeking to speak with Ozefax had contacted them.

- m. The Disputed Domain Name is not identical to the Complainant's Domain Name. Therefore to establish that this criterion has been met, it is necessary for the Complainant to establish that the Disputed Domain Name is "confusingly similar".
- n. Confusion in this context, in the sense of bewilderment or failing to distinguish between things, may be regarded as a state of wondering whether there is an association, rather than a state of erroneously believing that there is one. An appropriate formulation might be: "Is it likely that, because of the similarity between the domain name on the one hand and the Complainant's trademark on the other hand, people will wonder whether the domain name is associated in some way with the Complainant?": *SANOFI-AVENTIS v. Jason Trevenio*, WIPO Case No. D2007-0648.
- o. Both parties supplied a substantial amount of materials relating to the appearance of the respective websites. It is settled that in domain name determinations such material is not taken into account for the purpose of establishing this Criterion i.

In the Panel's view the Disputed Domain Name is confusingly similar to the Complainant's Domain Name and the Complainant's trademark.

The Panel determines that the Complainant has satisfied the requirement of Paragraph 4(a)(i) of the auDRP.

Criteria ii) Respondent has no rights or legitimate interests in respect of the Domain Name

- a. It is noted that in order to be eligible to be allocated a domain name in the com.au 2Ld space under AuDA Policy *Domain Name eligibility and Allocation for Open 2LDs (Policy number 2005-01)* the domain name must:
 - 1. exactly match, acronym or abbreviations of the registrant's company or trading name, organisation or association name or trademark; or
 - 2. be otherwise closely and substantially connected to the registrant.
- b. The Respondent was registered as an Australian company on 23 April 2007.
- c. The domain name www.ozfax.com.au was registered by MDWebhosting, an auDA Accredited Registrar, on 26 September 2008 to the Respondent.
- d. The Respondent applied for registration of the Trademark "Ozfax" with a distinctive Kangaroo shadow background in April 2009 and the Trademark was registered on 16 November 2009 under class 35 *Office function; office administration services (for others); business administration; business management*. (Note the Complainant's Trademark registration in the word

"Ozefax" is for class 38 "Telecommunications, Internet communications services and faxing services").

- e. The Complainant argues in its Supplemental Submission dated 7 April 2010 that the Respondent has no legitimate rights to the Statutory Trademark "Ozfax".
- f. In its Supplemental Submission dated 14 April 2010, the Respondent challenges that view put forward by the Complainant and states that in any event, the validity of its trademark is "not a matter that can be decided by any tribunal other than a court".
- g. While the overall burden of proof rests with the Complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the auDRP.
- h. The Respondent argues that it properly registered its trademark in a different class and that *its primary business focus for faxing is in the supply and maintenance of good quality fax marketing data, cleaning and washing of data lists and subsequent transmission of these faxes as an outsourced service.*
- i. In the Panel's view the registration of its Trademark in "Ozfax" by the Respondent gives it a legitimate interest and rights in respect of the Disputed Domain Name.
- j. The Panel forms no view as to whether the Respondent has legitimate rights to its Trademark "Ozfax. If the Complainant is correct, that is a matter for the Courts to rectify and not this Panel.

The Panel determines that the Complainant has failed to satisfy the requirement of Paragraph 4(a)(ii) of the auDRP.

Criteria iii) Domain Name was registered or is being used in Bad Faith

- a. Paragraph 4.b of Schedule A of the Policy sets out considerations, without limitation, which may be taken into account to determine if the "Domain Name" was registered or is being used in "Bad Faith". In particular subparagraphs 4.b. (iii) and (iv) state:

"4(b) (iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or,

4(b) (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 likelihood of confusion with the complainant's name, or mark as to source, sponsorship or affiliation, or endorsement of that website or location or of a product or service on that website or location."*

- b. The Complainant states that the Respondent has deliberately designed its web site and registered the Disputed Domain Name for the purpose of diverting traffic from the Complainant to the Respondent.
- c. The Respondent provided materials showing that it engaged a third party to design its web site and that the colours were consistent with those used by the Respondent in its primary website at www.ozmedia.com.au. The Respondent further states that its business is substantially different from that of the Complainant.
- d. The Complainant states that the Respondent's website was set up in response to the Complainant's recent television advertising campaign. The Respondent provides materials demonstrating that the registration of the Disputed Domain Name and the development of the Disputed Domain Name website commenced well before the Complainant's television advertisements commenced.
- e. The Complainant supplied letters and statutory declarations which it states indicates that there was indeed confusion and the Respondent acknowledges that it did receive 3- 5 incidents of confusion.
- f. The Complainant states that, in summary, as evidence of bad faith that in January 2010 in emails and telephone calls with the Respondent it brought to the Respondent's attention its concerns and required the Respondent to cease and desist using the Disputed Domain Name. Further the Complainant states that the Respondent made a number of admissions that the Respondent had no legitimate right to use the Disputed Domain Name. Notwithstanding these admissions by the Respondent the Complainant's request for the Disputed Domain Name to be transferred to the Complainant was refused and that this refusal was further evidence of bad faith.
- g. The Respondent challenges the factual content and interpretation placed on the telephone calls and emails by the Complainant.
- h. Notwithstanding the Panel's view that the Complainant has satisfied the onus on it to establish that Respondent's web page is confusingly similar to customers or potential customers of the Complainant, the Panel is not convinced that the Complainant has established that the Disputed Domain Name was registered or is being used being used in bad faith as required by Paragraph 4.b of Schedule A of the Policy.
 - 1. The timing of the development and establishment of the Respondent's website and trademark registration do not appear to have been undertaken with any consideration of the Complainant in mind,

2. The number of complaints does not support the action of the Respondent being to damage the business of the Complainant nor the diversion of business away from the Complainant;
3. The nature of the respective businesses and client base are substantially different so that there is little reason for the Respondent to wish to attract customers or business from the Complainant; and,
4. The Respondent put forward a legitimate business interest for wishing to establish the Disputed Domain Name.

The Panel determines that the Complainant has failed to satisfy the requirement of Paragraph 4(a)(iii) of the auDRP.

10. Decision

- a. The Panel concludes for the reasons stated that:
 - The Panel agrees that the Disputed Domain Name is confusingly similar to the Domain Name of the Complainant;
 - The Complainant has failed to persuade the Panel that the Respondent does not have any legitimate rights in the Disputed Domain Name; and,
 - The Complainant failed to persuade the Panel that the Respondent acted in bad faith in registering or using the Disputed Domain Name.
- b. For the reasons outlined, the Complainant has not satisfied the elements of the auDRP.

The Panel orders that the Complaint be dismissed.

Dated this 19th day of April 2010



David Lieberman
Sole Panellist