



ADMINISTRATIVE PANEL DECISION

TINA ARENA v. ENIGMATIC MINDS PTY LIMITED

Case No. LEADR-auDRP01/07

Domain Name: tinaarena.com.au
Complainant: Tina Arena
Respondent: Engimatic Minds Pty Limited
Provider: LEADR
Panelist: Sara Delpopolo

1. THE PARTIES

- 1.1 The complainant is Tina Arena C/- TressCox Lawyers of Level 20, 135 King Street, Sydney NSW 2000 (**Complainant**).
- 1.2 The respondent is Enigmatic Minds Pty Limited of 25 Beddows Street, Burwood VIC 3125 (**Respondent**).

2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name is <tinaarena.com.au> (**Domain Name**). The registrar is AussieHQ Pty Limited.

3. PROCEDURAL HISTORY

- (a) The Domain Name was the subject of a previous complaint with LEADR (Matter auDRP15/06), which was withdrawn and this complaint was subsequently filed.
- (b) The complaint 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).
- (c) The complete application was received from the Complainant by LEADR on 8 January 2007. Administrative proceedings commenced on 9 January 2007.
- (c) On 8 January 2007, the Complainant sent a copy of the application to the Respondent by email.
- (d) On 9 January 2007, LEADR express posted and emailed to the Respondent a dispute notification letter and a copy of the application.

- (e) A copy of the application and a copy of the dispute notification letter were also posted to the registrar AussieHQ on 9 January 2007. The Registrar confirmed that the website was locked from 9 January 2007 (the website had been locked due to the previous complaint which was withdrawn prior to the current complaint being lodged).
- (f) LEADR advised auDA of the complaint via email on 9 January 2007.
- (g) On 31 January 2007, LEADR approached the Panelist. The Panelist confirmed her availability, accepted the matter and confirmed to LEADR that there was no conflict of interest.
- (h) The response was due on 30 January 2007. It was received by LEADR in electronic format and hardcopy on this date. On 22 January 2007, the Respondent requested that the administrative proceedings for this matter be suspended due, based on allegations by the Respondent that the complaint was invalid. This request was denied. A request for an extension of one day for the response was made on 25 January 2007 and was granted.
- (i) The Panelist was informed that the documents for adjudication were being sent on 31 January 2007.
- (j) On 12 February 2007, the Complainant requested that a further statement be considered by the Panelist in order to clarify issues raised by the Respondent. This statement was forwarded to the Respondent by email on the same day. On 13 February 2007, the Respondent requested that, in the event the Panelist allows the Complainant's further statement, he be allowed to provide a response. This correspondence was forwarded to the Panelist on 14 February 2007 for consideration.
- (k) Rule 10(b) of the auDRP Rules states that the Panelist will ensure that the parties to a dispute are treated equally and that each party is given a fair opportunity to present its case. Further, Rule 10(c) of the auDRP Rules grants the Panelist unilateral power to extend the period of time fixed by the Rules.
- (l) On 15 February 2007, the Panelist allowed the further statement submitted by the Complainant and a further statement in answer by the Respondent pursuant to Rule 12 of the auDRP. A deadline of 20 February 2007 was given to the Respondent.
- (m) On 20 February 2007, the Respondent submitted a further statement to LEADR by email (which was also sent to the Complainant). This statement was forwarded to the Panelist on 21 February 2007.
- (n) On 20 February 2007, the Complainant wrote to LEADR advising that the further statement lodged by the Respondent contained correspondence that was clearly marked "without prejudice". In particular, this correspondence was initiated by the Respondent on the basis that the matter could be settled and, further, that it contains statements that are false and defamatory of the Complainant (and therefore should not be published).
- (o) On 21 February 2007, the Respondent sent further email correspondence to LEADR arguing that his submissions did not contain "without prejudice" information, or was no longer considered "without prejudice". This

correspondence was copied to the Complainant, and forwarded to the Panelist by LEADR.

- (p) On the same day, the Complainant sent a response to the Respondent's claim confirming that the correspondence was at all times made on a "without prejudice" prejudice. This correspondence was forwarded to the Panelist on the same day by LEADR.
- (q) Further submissions were received by LEADR (and copied to the Complainant) on 22 February 2007 regarding the "without prejudice" correspondence and a response to this email was sent by the Respondent. This correspondence was also sent to the Panelist on the same day.
- (r) On 22 February 2007, the Panelist requested that notification be sent to the parties that no correspondence after 20 February 2007 will be considered and the parties should immediately cease any further communication in respect of this matter.

4. FACTUAL BACKGROUND

4.1 The Complainant

The Complainant is a well-known entertainer and public figure who has used "Tina Arena" (**her Name**) in a professional capacity over the past three decades. The Complainant was a child star on the television music program "Young Talent Time", and released her first album in the mid-1970s.

The Complainant's industry achievements include winning 6 Aria Awards, performing at the opening ceremony of the 2000 Sydney Olympics, winning an Australian Performing Rights Association Award in 1996 for "Song of the Year" and she is Australia's highest selling female recording artist.

The Complainant has made a significant investment in her Name and profile in the music and entertainment industry, so much so that the Name is now readily associated in the minds of the public with the Complainant. The Complainant's Name has been used over the past thirty years in respect of entertainment and musical services.

Throughout the Complainant's career, she has invested in advertising her Name through the promotion of various performances, albums, merchandise and tours. Accordingly, the Complainant has developed substantial goodwill and a significant international reputation, and has acquired common law rights in her Name and trade mark (**Trade Mark**). The Complainant requests a transfer of the Domain Name.

4.2 The Respondent

The Respondent does not dispute that the domain name <tinaarena.com.au> (**Domain Name**) is 'similar' to the Complainant's Name. The Respondent submits that the Domain Name was registered in good faith for the bona fide offering of goods and services namely:

- "a) *offering official Tina Arena CDs and DVDs (offering of products)*
- b) *offering a site with information for fans of Tina Arena (offering of services)*

c) *facilitating a forum for fans of Tina Arena (facilitation of activities)*”

The Respondent states that at the time of registering the Domain Name it was aware that <tinaarena.com> is the Complainant’s official website but that it has a legitimate right and interest in and to the Domain Name for the reasons set out under each element below.

5. PARTIES’ CONTENTIONS

5.1 Complainant

(a) ***The Complainant relies on the following in support of paragraph 4(a)(i) of the auDRP:***

The Complainant is the owner of the following:

- (i) her Name; and
- (ii) the common law trade mark “TINA ARENA” in respect of music and entertainment services, and associated goods.

(together the ***Trade Marks***)

The Complainant is also the registrant of <tinaarena.co.uk> and <tinaarena.com>.

The Complainant has been known nationally and internationally by her Name and Trade Mark for some thirty years. The Trade Mark not only identifies the Complainant, but it also distinguishes her goods and services from the goods and services of other artists and traders in the community.

The Complainant therefore submits that the Domain Name identical to her Name and Trade Mark in which she has acquired substantial common law rights.

(b) ***The Complainant relies on the following in support of paragraph 4(a)(ii) of the auDRP:***

Prior to receiving notice of the dispute, the Respondent asserted that the Domain Name will be used for the bona fide offering of goods or services regarding the Complainant. At no time did the Respondent advise of the specific nature of these goods or services, nor was the Domain Name actually being used by the Respondent in relation to any trade, business or other commercial activity.

The Complainant states that the Respondent is neither known by the Domain Name nor does it reflect any business name, trade mark or service provided by the Respondent. The Complainant submits that placing a disclaimer on the Domain Name is not sufficient to overcome the initial interest and confusion by Internet users that the Domain Name is owned or endorsed by, or connected with the Complainant. Therefore, selecting the Domain Name (which is identical to the Complainant’s Name and Trade Mark) creates the impression that the Respondent is affiliated with, or has the sponsorship or approval of the Complainant when this is not the case.

Prior to notice of this complaint, the Complainant sought the transfer of the Domain Name on the basis that it would pay the Respondent's out-of-pocket costs associated with it. This was rejected by the Respondent on the grounds that *"For us to simply transfer this domain name to you would nullify part of our investment and also put an end to any future earnings that may come from the content and services of the website associated with this domain name."* The Respondent advised that it would transfer the Domain Name in return for *"fair and reasonable compensation to offset our costs and loss of future income"*.

In the circumstances, the Complainant submits that the Respondent registered the Domain Name in order to obtain a commercial benefit. The Respondent was well aware of the Complainant's reputation, goodwill and rights in the Name and Trade Mark when it registered the Domain Name, as shown by correspondence received from the Respondent on 26 October 2006, which confirms that *"the great respect we have for Ms Arena was a key motivator for wanting to pursue this project."*

The Complainant relies on the findings in *Bianjade Enterprises Pty Limited v Leigh Michael Connelly* WIPO Case No. DAU2003-03 at pg 5 (***Bianjade Enterprises***) to support its contentions that it is likely the Respondent knew of the Complainant's online activities at the time of registering the Domain Name. Further, until registration of the Domain Name by the Respondent, it was previously registered by the Complainant (through her agent).

(b) ***The Complainant submits that the Respondent has registered or subsequently used the Domain Name in bad faith under paragraph 4(a)(iii) of the auDRP:***

In 1994, the Complainant's record company (who was Sony Music Australia) registered the Domain Name, which it operated until 2004. The Domain Name was used for promoting and providing information about the Complainant including tour dates, discography and biographical information.

In 2004, the domain name <tinaarena.com> was also registered on behalf of the Complainant, and all traffic to the Domain Name was re-directed to this website (***Official Website***). Since that date (and presumably until the Respondent's registration of the Domain Name) approximately 1500-3000 redirections from the Domain Name took place each month.

After the conclusion of the Complainant's contract with SonyBMG Australia, the Complainant set up a recording company Positive Dream Pty Limited (***Positive Dream***). The Complainant at all times intended for the Domain Name to be transferred to Positive Dream.

On 9 September 2006, the Website Shop (acting for the Complainant) instructed its domain name registration agent HOSTEUROPE to transfer the Domain Name to Positive Dream. This request could not be completed, as HOSTEUROPE was unable to provide .com.au domain name transfers. On 10 September 2006, the Website Shop then requested that its other domain name agent EURODNS transfers the Domain Name to Positive Dream. Again, the Website Shop was advised by EURODNS that it also was unable to provide for .com.au domain name transfers.

The Domain Name expired on 11 September 2006.

On 5 October 2006, the Website Shop applied to re-register the Domain Name directly through Melbourne IT. The application was approved and pending completion, but it was not processed by Melbourne IT on 6 October 2006 as the ABN

for Positive Dream had inadvertently been omitted from the application.

On 10 October 2006, the application was resubmitted to include the ABN for Positive Dream. However, this application was rejected by Melbourne IT on 11 October 2006, as the Domain Name had already been registered by a third party (the Respondent) earlier that day.

On 13 October 2006, the Website Shop wrote to the Respondent explaining the circumstances and requesting the transfer of the Domain Name. On the same day, the Respondent refused the transfer as it intended to use the Domain Name for a new business that would be launched shortly.

The Respondent then wrote to Mr Bruce Pawsey, the Complainant's agent, on 16 October 2006 advising that it was willing to discuss the transfer of the Domain Name further. On 18 October 2006, TressCox Lawyers wrote to the Respondent confirming the Complainant's rights in the Domain Name, explaining the circumstances surrounding the non-renewal and again requesting that it be transferred to Positive Dream.

The Respondent replied on 26 October 2006 that it was willing to consider settlement and a transfer of the Domain Name upon payment of an amount for compensation of costs and loss of future profits. TressCox Lawyers forwarded to the Respondent a copy of a draft complaint and advised it that the Complainant intended to commence proceedings under the auDRP should the Domain Name not be transferred. The Respondent replied on 17 November 2006 that it proposed a way to settle the dispute and transfer the Domain Name to the Complainant.

Following a request for details of this proposed settlement, the Respondent wrote to TressCox Lawyers on 22 November 2006 advising that the Domain Name could be transferred for an amount of AUD\$9,500. The Respondent admitted it did not have any records to substantiate these costs but that this figure was arrived at by estimating the costs website development to date to be \$3,000, the profit from the website over the following 6 months to be \$3,500 and that the dispute had cost the Respondent \$3,000 so far.

On 29 November 2006, the Respondent's offer was formally rejected as there was no justification for the amount being claimed, and TressCox Lawyers suggested AUD\$1,000 in full and final settlement. The Respondent rejected this counter-offer on 1 December 2006 and invited the Complainant to commence proceedings under the auDRP.

In summary, the Complainant submits that:

- the Respondent does not intend to use the Domain Name for any legitimate or commercial purpose
- there has never been any business relationship between the parties, nor has the Complainant authorised the Respondent to use her Name and Trade Mark in respect of the goods and services
- the Respondent was aware of the famous Name and Trade mark when it registered the Domain Name, and likely that the Respondent was also aware that the Complainant had been the previous registrant and user of the Domain Name (which was operated for over 10 years prior to its expiry)
- registration of the Domain Name by the Respondent has caused a loss of profile of the Complainant, as Internet users who visit the Domain Name are no longer redirected to her Official Website as previously occurred (which were between 1,500-3,000 redirections per month).

Under the circumstances, the Complainant therefore contends that the Respondent registered the Domain Name:

- a) primarily for the purpose of selling or otherwise transferring the Domain Name to the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket expenses; and/or
- b) in order to prevent the owner of the Name and Trade Mark from reflecting that Name/Trade Mark in a corresponding domain name; and/or
- c) primarily for the purpose of disrupting the business or activities of the Complainant; and/or
- d) to attract users to the future website of the Respondent and from which it proposed to operate a commercial business venture.

Accordingly, the Complainant requests that the Domain Name be transferred to its company Positive Dream.

5.2 Respondent

The Respondent responded to the complaint as follows.

- a) That mere allegations and opinions about whether or not the Respondent has rights or legitimate interest in a Domain Name is not sufficient to establish a prima facie case that it does not. The Complainant never asked or sought to understand for what purpose the Domain Name was registered, or the nature of the goods or services. As such, the Respondent was not given an opportunity to show the development work done on the website and the official nature of the merchandise.
- b) The Complainant is not able to establish a prima facie case as it has based the complaint on a prejudicial assumption only, namely, that the Respondent is a cybersquatter despite being told that this is not the case. In support of this, the Respondent refers to a message left by Mr Bruce Pawsey (the Complainant's manager) on 13 October 2006: *"I believe you pimped our website from Australia, highly unethical as far as I'm concerned, please call me directly...we can discuss the transfer."*
- c) The Respondent company was established in 2003, and a new business unit responsible for bringing the project to market was established on 25 September 2006 (two weeks before registration of the Domain Name). At this stage the website was yet to be launched and following the above message from Mr Pawsey development of the website was put on hold pending resolution.
- d) The Respondent upholds that not having an active website does not show an absence of a right or legitimate interest, especially as a website can take weeks or months to develop. Further, that it is not necessary to have a right in a *name* to establish a right or legitimate interest, as there are several ways to establish a right or legitimate interest in a domain name (such as use for a legitimate commercial purpose).
- e) The Respondent responds to the Complainant's arguments pursuant to paragraph 4(a)(ii) of the auDRP as follows:
 - (i) the fact that the Respondent was aware of the Complainant's reputation, goodwill and rights in the Name when it chose the Domain Name has

nothing to do with the absence of a right or legitimate interest in the Domain Name. The Respondent openly admits the choice of Domain Name was deliberate as it was chosen on the basis of the nexus with the goods and services offered;

- (ii) the suggestion that the Respondent was aware of the Complainant's right to the Domain Name on the basis of and Internet presence is an abuse of administrative proceedings, and is essentially a falsification of facts and an embellishment of references. The Respondent submits that the statements made by the panel in the case of *Bianjade Enterprises* only had the effect of shifting the onus of proof to the respondent, and as the respondent in this case did not discharge this onus the panel concluded there was no right or legitimate interest;
- (iii) the Respondent was not aware of the Complainant's use of the Domain Name or <tinaarena.co.uk>, it was only aware of the Official Website. The Complainant has not provided any proof to support this claim whereas the Respondent has submitted a statutory declaration in support.

The Respondent's statutory declaration of 29 January 2007 confirms that it was only aware of the Official Site and that there was no malice or ill intent intended by registration of the Domain Name. Further, the Domain Name was registered for bona fide offering of goods and services (offering official Tina Arena CDs and DVDs, information for fans and a forum for fans) and that significant preparation had commenced to launch the Respondent's website;

- (iv) the disclaimer used by the Respondent would be sufficient to overcome any confusion by Internet users as supported by *Oki Data Americas, Inc. v ASD, Inc.* WIPO case D2001-0903 (**Oki Data**), which states that "*there can be no such 'initial interest confusion' where the Respondent's use of the domain name is, itself, legitimate under the Policy*". As there is a clear and legitimate nexus between the Domain Name and the goods and services offered, use by the Respondent is therefore not misleading; and
 - (v) the Complainant's refers to the note in paragraph 4(a)(iii), which states that rights or legitimate interests in a domain name are not established merely because a registrar determines an applicant has satisfied the relevant eligibility criteria for a domain name at the time of registration. The Respondent submits that the Complainant's reliance on this is an abuse of administrative proceedings and that 'rights and legitimate interests' are also established by bona fide offering of goods and services (which the Respondent confirmed to the Complainant as the purpose for registering the Domain Name on 26 October 2006).
- f) the Respondent refers to paragraph 4(c) of the auDRP, which allows the Respondent to demonstrate a right *or* legitimate interest (not both) and that a domain name does need to be in use as "*demonstrable preparations to use*" are sufficient. In support, the Respondent states as follows:
- (i) the website was under development at the time of being contacted by the Complainant regarding the unauthorised registration and transfer of the Domain Name, and it demonstrated the bona fide nature of the goods and services;

- (ii) the origins of this project came from a previous website that the Respondent had created for fans of the celebrity chef, Jamie Oliver in respect of which the domain name <jamieskitchen.com.au> was registered on 7 September 2006. In creating this website, the Respondent discovered this was a 'win-win' situation as it had an Australian focus (and therefore benefited Australian fans). The Respondent's website could assist the Complainant by increasing exposure and sales of the goods (as well as benefiting the Respondent by offering the goods and services);
 - (iii) the Respondent says that there is a tendency to focus on international markets rather than the Australian market, and this causes Australian fans to feel ostracised (especially were the Official Website forums are dominated by non-Australian participants);
 - (iv) the Complainant's Official Website focuses on the UK and France, and offers no content specific to Australia. The Respondent states that the Complainant merely wants the Domain Name to redirect traffic to the Official Website, and that it therefore does not want the Domain Name to build an Australian site or for trade within Australia;
 - (v) on 25 September 2005, the Respondent established a new business unit "Fansites" and registered the corresponding Victorian business name (VIC B1956201K). The purpose of Fansites is to create websites for fans to *"come together and share their passion and find goods and services related to the subject, all with an Australian focus. This provides a win-win for everyone, most of all the subject of the website."* The Respondent confirms that the website does not compete with the Official Website.
- g) In relation to the allegation of registration or subsequent use in bad faith, the Respondent states as follows:
- (i) the Complainant has provided a history of registration of the Domain Name which was actually registered by a third party on its behalf (and therefore the Complainant never actually held a licence). In any event, confusion by Internet users is highly unlikely since the Official Website has been established for many years and is heavily promoted globally;
 - (ii) the alleged figures of 1500-300 redirections per month is a gross exaggeration, as the current number of visitors to the Domain Name is but a fraction of this;
 - (iii) the fact that the Domain Name was neither successfully transferred or registered on the Complainant's behalf by the Website Shop does not evidence bad faith by the Respondent, it only shows that the Complainant is trying to acquire the Domain Name in a manner contrary to auDA policy;
 - (iv) a representative from the Website Shop contacted the Respondent under instructions from the Complainant's UK company "Sing Can't Dance", no mention was made of Positive Dream;
 - (v) the letter dated 18 October 2006 from TressCox Lawyers stated that the Respondent could not register the Domain Name as there was no 'close and substantial connection' with their client. The Respondent replied that this 'close and substantial connection' was established as it intended to offer products, services and the facilitation of activities, and that this

prohibition only referred to domain names registered for “domain monetisation”;

- (vi) the Respondent advised the Website Shop in its email of 13 October that the Domain Name was acquired legitimately and for a legitimate purpose, it was not a cybersquatter, it had no intention to sell the Domain Name and its use of the Domain Name is well within auDA guidelines. This was also relayed to Mr Pawsey by email on 16 October 2006;
 - (vii) the Respondent offered to settle this dispute in response to threats of legal action made by TressCox Lawyers. Further as the Complainant seeks to recover costs in this matter, the Respondent therefore seeks the same;
 - (viii) the Complainant has implied that only authorised/approved users can offer goods and/or services in relation to the Complainant, this is rejected by the Respondent on the grounds that the Complainant’s goods are already being sold worldwide and on the basis of the Aston Martin case;
 - (ix) there can be no loss of profile for the Complainant by the Respondent holding the Domain Name, as it promotes the Complainant and her website and assists to raise her profile;
 - (x) it has never been the intention of the Respondent to create confusion with the Complainant;
- h) Lastly, the Respondent claims that:
- (i) this complaint falls under the auDRP Rules, which states “*Reverse Domain Name Hijacking means using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name*”. In particular, this is due to the Complainant’s attempt to mislead and deceive the Panel (by falsifying facts, fabricating statements, making exaggerated claims etc) so as to alter the outcome of these proceedings;
 - (ii) the Complainant has initiated auDRP proceedings despite the fact that the Complainant is ineligible to licence the Domain Name;
 - (iii) these proceedings are being used as a ‘tactical weapon’ rather than being based on a genuine claim, which is shown by the Complainant’s failure to show there has been any breach of the auDRP.

6. FURTHER STATEMENTS ISSUED BY THE PARTIES

Further statements were allowed to be submitted by the parties to this complaint for the Panel’s consideration.

It was not possible to consider all of the further statements submitted by the Respondent as the Complainant raised concerns relating to the unauthorised disclosure of “without prejudice” communications. The submissions and evidence provided by the Respondent do in fact refer to such communications. I therefore agree with the position and have only referred to those statements that do not contain “without prejudice” disclosures.

6.1 *The Complainant*

- (a) At no stage prior to lodging this complain did the Respondent give the Complainant any information about the types of goods and services intended to be provided under the Domain Name. Nor did the Respondent disclose its intention to use the Domain Name as part of a business known as "Fansites".
- (b) The Complainant maintains that there are certain materials and products in which it owns rights (including copyright) and that the Respondent cannot use these without permission. The Respondent did not provide any details regarding its business plan in the response to this complaint, and the Complainant is not aware of the extent to which the Respondent intends to offer products and services relating to the Complainant. The development website does not indicate any services that will be offered at the Domain Name that relates to the Complainant.
- (c) The third party registrant of the Domain Name has always been an entity acting as agent of the Complainant.
- (d) In the case of Oki Data, it was considered whether or not the authorised sales agent of trade marked goods was also able to use the relevant trade mark in a domain name. In this dispute, the Respondent is not an authorised sales agent of the Complainant and there is no business or legal relationship between the parties.
- (e) In applying the Oki Data principles to the facts of this case, the Respondent still fails to meet all of the requirements necessary for an offering to be bona fide. In particular:
- at no stage has the Respondent previously offered the goods or services, it only has the intention to do so (as indicated by the development website provided by the Respondent), and no evidence has even been provided by the Respondent to support this intended use
 - the development website indicates that it sell trade marked goods (CDs and DVDs), but there is no evidence to suggest that the Respondent will be using the website for only the trade marked goods or for other trade marked goods as well
 - the disclaimer placed on the development website is insufficient to overcome initial interest confusion in being directed to the Respondent's website, as it is the first hit when the Complainant's name is searched at Google Australia
 - registration of the Domain Name has deprived the Complainant using it, which it had done so previously since 1994
 - the Respondent has indicated an intention to run a business of registering celebrity names as domain names for the purpose of operating websites for fans
- (f) The reason that the Complainant has commenced these proceedings is to obtain transfer of the Domain Name that it had been using since 1994 to promote and provide information about the Complainant. If the Respondent wishes to operate an unofficial fan site, there were several other domain name options open to the Respondent.
- (g) The intended sale of CDs and DVDs by the Respondent at the Domain Name in which the Complainant had control from 1994 relies on the Complainant's

established reputation and indicates that the Respondent has the Complainant's authority, approval or has an affiliation with the Complainant.

- (h) There is no evidence that the intended website at the Domain Name will have an Australian focus or will add any value to the Australian market. In any event, the biography appearing at the development website is substantially identical to the one found at the Official Website.
- (i) The Respondent has not provided evidence that the Domain Name will provide fans or consumers with any goods or services that cannot already be found on the Internet and, in particular, on the Official Website. The 'discography' lists the songs on each CD or DVD and is presented in a similar manner as found on the Official Website. It can hardly be said that the Respondent has created any original work or concepts for the development website, or anything with an "Australian flavour".
- (j) The website for Jamie Oliver at <jamieskitchen.com.au> referred to by the Respondent differs substantially from the development website. The Respondent's Jamie Oliver website only contains a forum for fans (it does not contain any images of this celebrity, offer to sell products produced by this celebrity nor is it based substantially on that celebrity's official website).
- (k) The Complainant's initial offer to pay the Respondent was for AUD\$800 (which included the Respondent's out-of-pocket costs and the transfer costs). This was rejected by the Respondent.

6.2 The Respondent

The Respondent responds as follows.

- (a) Although the Complainant has based these proceedings are based on the objection to the use of the words "Tina Arena", what they the Complainant is actually objecting to is use of <.com.au>. This is supported by the Complainant's further statement that it does not object to the Respondent running a fan site and that there are many other domain names that could be used for this purpose.
- (b) The Complainant has now received the response, it is therefore fully aware of the purpose for which the Domain Name was registered.
- (c) The Complainant's relationship with Sony Music Australia concluded in 2003 and in 2005 the Complainant signed with Columbia Records France. Despite this, Sony Music Australia continued to hold the Domain Name until 11 September 2006 when there was no authorisation or agreement in place with the Complainant. This negates the Complainant's assertions regarding the requirement of authorisation or agreement, as well as the claim that the Domain Name was under its control.
- (d) The Complainant has misled the Panel by stating that prior to the Official Website it had used the Domain Name. The Respondent states that the Complainant was previously using <tina-arena.com.au> as the official website. The Respondent is not certain whether any other Australian domain name was ever registered by the Complainant, but is certain that the Complainant had never been the registrant of the Domain Name.

- (e) The Respondent states that the evidence shows that Sony Music was acting as agent for the Complainant in respect of producing and distributing her music, but not as agent for the purpose of registering the Domain Name. If this was the case, the Complainant would have transferred it in accordance with the auDA registrant transfer policy.
- (f) The Complainant registered <tina-arena.com.au> to compete with the Sony Music branded website at the Domain Name. From July 2005 to September 2005, the Domain Name was used to redirect visitors to the Sony Music branded website for Augie March, which the Respondent claims would not have happened if the Domain Name was in fact under the Complainant's control. The Complainant's claims in the Domain Name are therefore invalid.
- (g) The Respondent then provides information as to the registration of <tinaarena.com>, showing that from 2001 to about October 2006 Sony Music Australia was the registrant, followed by A4 Internet (on behalf of the Complainant), and then the Complainant from 7 November 2006. Further, that the website at <tinaarena.com> resolves to the webpage for the Complainant at Sony Music's website www.sonymusic.com. In conclusion, the Respondent submits that the Domain Name was registered by Sony Music Australia for its own commercial interest and not for the Complainant.
- (h) The Respondent states that it was under no obligation to provide full details of its intended use of the Domain Name to the Complainant prior to these proceedings, and that it had cooperated by confirming that it was for the provision of bona fide goods and services. Further the Complainant never sought to obtain any details regarding the Respondents "new business" that would be launched soon.
- (i) The Respondent does not intend to breach copyright of the Complainant. The goods that are displayed at the development website are all official products and the Respondent has no intention of offering unauthorised products.
- (j) The Respondent acknowledges that there is no direct relationship between the parties, however it is highly unlikely that anyone selling products relating to the Complainant has a direct relationship as this is done via authorised distributors and agents. The Respondent claims it is offering official merchandise sourced through an authorised channel and therefore an appropriate and sufficient relationship exists.
- (k) As proof of sale of goods or services relating to the Complainant prior to the Domain Name registration, the Respondent provides a photocopy of an invoice from Fansites dated 9 October 2006 for the cash sale to an unknown recipient of "Tina Arena Greatest Hits Live (CD/DVD)" for \$29.95.
- (l) Any Google search by Internet users is likely to be global search, rather than for Australia only, therefore the example provided by the Complainant at paragraph 6.1(e) above is not accurate. The Respondent states that it is not where a particular domain name ranks in a search that matters for the purpose of confusion, but it is the wording used to describe the website. So, an Internet user clicking on the link to the Respondent's website will know that it is the "unofficial website of Tina Arena" and there will be no initial confusion. To avoid any further confusion, the Respondent has also placed a link to the Official Website at its website.

- (m) Again, the Respondent confirms its position that the Domain Name will only be used to redirect traffic to the Complainant's Official Website and there is no evidence that an Australian website will be established.
- (n) The Respondent states that the biographical information used at the development website is based on the information available at Wikipedia, which is freely available for use. The images shown at the development website are of actual products being offered. Further the fact that the development website contains more information than that of the website at <jamieskitchen.com.au> adds to the legitimacy of the Domain Name under the auDRP.
- (o) The Respondent upholds its view that the Complainant is ineligible to hold the Domain Name licence.

7. DISCUSSION AND FINDINGS

In order to have the Domain Name transferred to it, the Complainant must make out each of the following elements under the auDRP:

- (a) the Respondent's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights (paragraph 4(a)(i)); and
- (b) the Respondent has no rights or legitimate interests in the domain name (paragraph 4(a)(ii)); and
- (c) the Respondent registered or subsequently used the domain name in bad faith (paragraph 4(a)(iii)).

General Observations

As stated above, I have not made any reference to or based my decision on any "without prejudice" correspondence. Further, I note that the submissions made by both parties were substantial, but not all of the submissions made supported a particular element under the auDRP. I have included some general observations below on the basis that they may assist to clarify some of the submissions put forward by the parties.

The Respondent claims that the Complainant is acting on a 'prejudicial assumption' in commencing these proceedings. However, it would be unlikely that any proceedings in respect of a domain name dispute would be commenced unless a complainant believed that registration of that domain name infringed their rights in the first place.

The Respondent also makes reference to the fact that it tested auDA by submitted a total of 395 domain names that were potentially breaching the auDA policy. The Respondent then used the information gained in respect of the technicalities of auDA's policy so as not to be in breach of the auDA policy. This information does not provide any relevant evidence or assistance in relation to the actual complaint and I have therefore made no comment in relation to this.

Further, the Respondent makes lengthy submissions regarding the history of the Official Website which is irrelevant to these proceedings. I have only commented on the use of the Official Website in relevance to the registration of the Domain Name which is the subject of this complaint.

A. Identical or Confusingly Similar to a Name, Trade Mark or Service Mark in Which the Complainant has Rights.

The Complainant submits that the Domain Name is identical to its well known Name and Trade Mark TINA ARENA. Further, that at no time has the Respondent been authorised by the Complainant to register the Domain Name or to sell any official merchandise on her behalf.

The Respondent does not deny this, but states that this has nothing to do with having legitimate rights to register the Domain Name, as it was chosen on the basis of a nexus with the goods and services offered. The Respondent has made allegations against the Complainants that commencing proceedings on the basis that the Domain Name is identical to the Complainant's Name and Trade Mark is an abuse of the auDRP.

It is difficult to see how the Respondent considers how the Complainant's actions are an abuse of the auDRP, or how this negates the fact that the Domain Name is identical to the Complainant's Name and Trade Mark. The only thing that the Complainant needs to establish to commence proceedings under the auDRP is that the Domain Name is identical or deceptively similar to a Name or Trade Mark in which it has rights. The Respondent's assertions in this regard are simply unfounded.

Whilst the Complainant had suggested it was not adverse to the Respondent setting up an unofficial fan site, it seems appropriate to me that the Respondent could have used the name of its new business division "Fansites" for this purpose (for which there is already a domain name). The Complainant having clearly established rights in her Name and Trade Mark, has a right to register corresponding domain names over and above anyone else.

The claim that the Complainant is not trading in Australia on the basis that the Domain Name was used to redirect traffic to the Official Website is hardly proof that the Complainant does not have rights or a legitimate interest. The fact is that the Respondent is preventing the Complainant from registering its Name and Trade Mark as a corresponding domain name in Australia.

In considering the facts before me, and pursuant to paragraph 4(a)(i) of the auDRP, I can only find that the Domain Name is identical to the Complainant's Name or Trade Mark "TINA ARENA".

The Complainant has therefore established this element of its case and meets the criteria of Paragraph 4(a)(i) of the auDRP.

B. The Respondent has no Rights or Legitimate Interests in the Domain Name

In order to assert a right or legitimate interest in the Domain Name, the Respondent must have made bona fide use or preparations to use the Domain Name in connection with offering goods or services.

The Respondent has already acknowledged that the Domain Name is identical to the Complainant's Name and Trade Mark. It has not made any submissions that it was commonly known or referred to by the Name or Trade Mark reflected in the Domain Name.

The Respondent claims that as the Complainant was not itself the registrant of the

Domain Name, it is therefore ineligible. The Complainant has established that the registrant of the Domain Name was authorised to register and manages the Domain Name on its behalf. At all times, the owner of a trade mark has the exclusive right to use, or authorise the use, of a trade mark. Therefore, whether or not the Complainant had itself registered the Domain Name prior to these proceedings is not a requirement for it to be able to assert its rights or legitimate interests in the Domain Name on the basis of its Name and Trade Mark.

At no time has the Complainant authorised the Respondent to register the Domain Name, or act as an authorised sales agent on its behalf. The Respondent's asserts that it in fact has an 'indirect' relationship with the Complainant as the goods to be sold at the website are being sourced from the Complainant's authorised distributors and agents. No evidence was offered of any agreement between the Respondent and any authorised distributors and agents in respect of the sale of these official goods for the purpose of a commercial business venture (whether online or otherwise).

The Respondent has submitted that the fact that its website was inactive does not prove it does not have rights or legitimate interests in the Domain Name. This is certainly true where the Respondent is able to show either actual use or demonstrable preparations to use the Domain Name in relation to the actual offering of goods or services.

At no time prior to lodging this auDRP complaint did the Respondent give the Complainant any details of the nature of goods or services intended to be provided. The Complainant was not made aware of the Respondent's business plans (ie Fansites) and the website to which the Domain Name resolved did not provide any relevant information either. It could be concluded that the development website upon which the Respondent relies may have in fact been created after notice of the dispute.

In response to the Complainant, the Respondent has provided a statutory declaration stating that it will be offering official Tina Arena CDs and DVDs, information and a forum for fans. However, this evidence can only be considered in relation to the Respondent's use *after* notice of the subject matter of this dispute. The Respondent was first notified of a dispute regarding the Domain Name on 13 October 2006 by both Mr Pawsey and the Website Shop.

The Respondent cannot rely on the fact that registration of the Domain Name was granted to support its case. As it clearly states in the auDRP at Note 2 to paragraph 4(a)(ii), this is not enough to establish a right or legitimate interest in the Domain Name.

From the Respondent's own submissions, the only evidence provided to the Complainant as at 13 October 2006 (and until these proceedings) of any actual use or demonstrable preparations to use the Domain Name for offering bona fide goods or services was the mere confirmation by the Respondent that it intended to do so. The evidence provided by both parties confirms this rather broad and vague statement of the Respondent's bona fide intention with respect to use of the Domain Name in respect of goods and services relating to the Complainant.

According to the Respondent, its affirmations should be taken as sufficient evidence of its cooperation with the Complainant and the Respondent was in any event, under no obligation to provide the Complainant with any details of the goods or services prior to these proceedings (at paragraph 6.2(i) above). It was also suggested by the

Respondent that the onus was on the Complainant to request further information about the specific nature of the goods and services. Again, evidence supports that the Respondent remained persistently vague about the goods and services to be offered under the Domain Name despite the Complainant's enquiries.

The Respondent asserts that it does not have to show a greater right or interest in the Domain Name than the Complainant, as domain names are registered on a first-come, first-served basis. However, this is clearly not the case as it would defeat the purpose of the auDRP.

I agree with the Complainant in respect of its interpretation of the *Bianjade* case as the Internet is accessed globally irrespective of whether it is via a <.com> or <.com.au> domain name. The Respondent has admitted that it had full knowledge of the Complainant's international fame and reputation as well as her global online presence (which extends to Australia) prior to registering the Domain Name. The Respondent even admits that her fame and reputation was the catalyst for registering the Domain Name in the first place, apparently for the new business division.

The Complainant submits that the Respondent registered the Domain Name in order to obtain a financial benefit. The settlement negotiations failed between the parties after the Complainant's offer to pay for substantiated out-of-pocket expenses was rejected by the Respondent. Copies of emails between the parties in this regard were provided and it is clear that the Respondent was unable to substantiate the amount of AUD\$9,500 being claimed. Certainly it goes against auDA policy and in favour of the Complainant that the Respondent was requesting not only out-of-pocket expenses, but also compensation for loss of future profits.

In respect of the disclaimer, the Domain Name currently resolves to a website (which is on hold pending the outcome of these proceedings) which contains the following statement:

"This website has not yet launched.

When it does, it will offer products, services and activities related to the domain name.

This website is not owned, operated, sponsored or approved by the signer Tina Arena (born: Filippina Lydia Arena) nor does it have any direct or official affiliation with her. If you seek the official website of the singer Tina Arena it is: www.tinaarena.com"

The argument was put forward by the Respondent that the above disclaimer would overcome any confusion by Internet users looking for the Complainant. However, I do not see this is sufficient to show the Respondent has rights or legitimate interests in the Domain Name. The Complainant has confirmed that the Respondent was at no times authorised to use the Domain Name and that, considering the Official Website offers substantially the same information about the Complainant, it can be concluded that the Domain Name could cause confusion. In any event, the Respondent was in fact only willing to transfer the Domain Name to the Complainant if it was compensated for an amount exceeding its out-of-pocket expenses. This fact alone shows the Respondent is in breach of the auDA policies.

It is clear that the Respondent has clearly misinterpreted the auDRP. In its submissions, the Respondent has indicated that the Complainant has been unable to provide sufficient evidence that the Respondent does not have legitimate rights or

interests in the Domain Name. However, once the allegation is made by the Complainant, the onus is then on the Respondent to show that it does have a right and legitimate right in the Domain Name.

On the basis of the evidence submitted and submissions made, I find that the Respondent has failed to discharge the onus of proving that it does have rights in or a legitimate interest in the Domain Name, and that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. The Domain Name has been Registered or Subsequently Used in Bad Faith

The Domain Name was previously registered on the Complainant's behalf by its agent and was used to promote the Complainant and her goods. I do not believe that the fact that the Domain Name was used only for redirection to the Official Website is an issue, as this is not unusual where the registrant has a global presence. The fact is that registration by the Respondent has prevented the Complainant from reflecting its Name and Trade Mark in the corresponding Domain Name (which it previously used).

The Respondent has provided no evidence that it was actively engaged in any business on the Internet or otherwise, other than to assert that the Domain Name will be used for the bona fide offering of the goods and services (the nature of which were only disclosed after this complaint was filed).

As admitted by the Respondent, the Domain Name continues to generate traffic from Internet users who may in fact be searching for the Complainant's Official Website. It is irrelevant whether these numbers are substantially lower than the 1500-3000 redirections as stated by the Complainant (the Respondent did not provide any figures). This only goes to show that during the period of time between the lapsing of the Domain Name by the Complainant and the registration of it by the Respondent, Internet users in Australia have been searching for the Complainant's Official Site. Therefore, I am satisfied that the Respondent's unauthorised use of the Domain Name this is disrupting the business and activities of the Complainant.

Submissions made by both parties also support the fact that the Respondent only agreed to transfer the Domain Name to the Complainant if it was paid an amount exceeding its out-of-pocket expenses and included an amount for future profits. This supports the Complainant's contention that the Domain Name was registered primarily for the purpose of selling or otherwise transferring it for valuable consideration contrary to auDA policy.

It is clear the Respondent is relying on the goodwill and reputation built up by the Complainant in her Name and Trade Mark over the past thirty years in generating this future profit. By the Respondent's own admission, it was the Complainant's fame and reputation that caused the Respondent to register the Domain Name. Use of the Domain Name by the Respondent in respect of offering 'official goods' is misleading or deceiving Internet users into believing that the Respondent is authorised, affiliated or has the approval of the Complainant when this clearly is not the case.

I am satisfied that the Complainant has satisfied the requirements of paragraph 4(a)(iii).

8. DECISION

Any suggestion made by the Respondent that these proceedings were brought by the Complainant as an abuse of the auDA policies or in an attempt to reverse hijack the Domain Name has not been substantiated with any evidence of bad faith on the part of Complainant. Further, the only remedies available to the parties under the auDRP are cancellation or transfer of the Domain Name. The question of an award of costs cannot be considered by me.

I find that the Complainant has made out all of the elements of paragraph 4(a) of the auDRP Rules. Accordingly, the domain name <tinaarena.com.au> is to be transferred by the Registrar, AussieHQ Pty Limited, to the Complainant.

Sara Delpopolo
Sole Panelist

17 March 2007