

**auDA Overview of Panel Views on Selected auDRP Questions First Edition
("auDA auDRP Overview 1.0")**

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DISCUSSION

1. FIRST AUDRP ELEMENT

1.1 Does ownership of a registered trademark to which the domain name is identical or confusingly similar automatically satisfy the requirements of paragraph 4(a)(i) of the auDRP?

The general position is the **same** as that under the UDRP.

If the complainant owns a registered trademark, then it generally satisfies the auDRP paragraph 4(a)(i) threshold requirement of having rights in a “trademark or service mark” [*n.b.*, throughout this Overview the term “trademark” includes “service mark” unless otherwise indicated]. The location of the trademark’s registration [see question 1.1A below], its date of registration (or first use) [see question 1.4 below], and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trademark or service mark under the first element of the auDRP.

Relevant decisions:

- [TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Limited](#), WIPO Case No. DAU2006-0003 (2006), <truelocal.com.au>, Denial

1.1A Does ownership of a registered trademark outside of Australia to which the domain name is identical or confusingly similar automatically satisfy the requirements of paragraph 4(a)(i) of the auDRP?

The issue **does not arise** under the UDRP.

The auDRP does not restrict a complainant’s trademark rights to a trademark registered with the Australian trademark authority. Thus, a trademark registered outside of Australia satisfies the requirements of the Policy.

Relevant decisions:

- [Doteasy Technology, Inc. v. M Makras and E.A Nahed dba Dot Easy Australia](#), WIPO Case No. DAU2006-0011 (2007), <doteasy.com.au>, Denial
- [American Future Technology Corp. v. Rex Hall](#), WIPO Case No. DAU2009-0007 (2009), <ibuypower.com.au>, Denial
- [Mass Nutrition, Inc. and Todd Rosenfeld v. Mass Nutrition Pty. Ltd. now known as Tweed Holdings, Luke McNally](#), WIPO Case No. DAU2010-0002 (2010), <massnutrition.com.au>, Denial
- [1SaleADay L.L.C. and Benjamin Federman v. LivinWireless, Simon Mochkin and Eli Feiglin](#), WIPO Case No. DAU2010-0016 (2010), <onesaleaday.com.au> *inter alia*, Transfer
- [Smart Voucher Ltd T/A Ukash v. Chowdhury, MD Abu Russel and Sydney Business & Technology Group Pty Ltd](#), WIPO Case No. DAU2013-0006 (2013), <ukash.com.au> *inter alia*, Transfer
- [Marshmallow Skins, Inc. v. Piipiinoo Australia Pty Limited](#), Case No. WIPO DAU2013-0015 (2013), <zipz.com.au> *inter alia*, Transfer
- [Rainbow Sandals, Inc. v. Malua Point Holdings Pty Limited, Anthony Brown / Malua Point Holdings Pty Limited a/k/a Malua Point Merchants](#), WIPO Case No. DAU2013-0014 (2013), <rainbowsandals.com.au>, Transfer / Cancellation

1.1B Does ownership of an unregistered trademark outside of Australia to which the domain name is identical or confusingly similar automatically satisfy the requirements of paragraph 4(a)(i) of the auDRP?

The issue **does not arise** under the UDRP.

Where the complainant does not have a registered trademark, it must establish that it has unregistered trademark rights *in Australia*; evidence that it has unregistered trademark rights outside of Australia is insufficient. For unregistered trademark rights to exist in Australia, the complainant must have a reputation in Australia in respect of the unregistered trademark [see question 1.7 below]. Where there is no evidence (such as sales and revenue data) that the complainant has traded in Australia using the unregistered trademark, it is unlikely the complainant will be able to establish the existence of a reputation for the mark in Australia – with the likely result being that the complainant will not be able to satisfy the requirements of paragraph 4(a)(i) of the Policy.

Relevant decisions:

- [GE Capital Finance Australasia Pty Ltd v. Dental Financial Services Pty Ltd](#), WIPO Case No. DAU2004-007, <carecredit.com.au>, Transfer
- [Sitecore Australia Pty Ltd v. WB Solutions Pty Ltd](#), LEADR Case No. auDRP10/08 (2008), <sitecore.com.au> *inter alia*, Denial
- [We Buy Any Car Limited v. Highway Auto Mart and Jason Collings](#), WIPO Case No. DAU2012-0004 (2012), <webuyanycar.com.au> *inter alia*, Denial

1.1C Does ownership of an application to register a trademark in Australia to which the domain name is identical or confusingly similar automatically satisfy the requirements of paragraph 4(a)(i) of the auDRP?

The general position is the **same** as that under the UDRP.

Most of the panels considering the issue have expressed the view that an application (even an accepted application) for trademark registration in Australia that has not proceeded to grant does not, of itself, satisfy the requirement of the complainant having rights for the purposes of paragraph 4(a)(i) of the Policy. For the complainant to satisfy that requirement, the trademark that is the subject of the application must either: (i) satisfy the test for being a common law or unregistered trademark [see question 1.7 below]; or (ii) constitute a “name” within Note 1 of the Policy – *i.e.*, be the complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority, or be the complainant’s personal name.

One panel has come to a different view, on the basis that an application for an Australian registered trade mark is treated as conferring sufficient rights to support the grant of a domain

name licence under the auDA domain name eligibility and allocation rules (currently ‘2012-04 – Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs’). However, all subsequent cases have unequivocally reached the opposite conclusion. The reasons given by the later cases include: that the basis on which a domain name is granted to a respondent is not the same as the basis on which a complainant may assert its rights under the Policy; that paragraph 4(a)(i) of the Policy is not stated to have any relationship with auDA’s eligibility rule; that there is nothing in the terms of the Policy indicating that a mere trademark application may support a complainant’s rights under paragraph 4(a)(i); that the Policy generally contains notes where there are substantive differences with the UDRP and there is no note on this issue; and that such an approach would be contrary to the great majority of decisions under the UDRP.

Relevant decisions:

- [GE Capital Finance Australasia Pty Ltd v. Dental Financial Services Pty Ltd](#), WIPO Case No. DAU2004-007 (2005), <carecredit.com.au>, Transfer
- [TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Limited](#), WIPO Case No. DAU2006-0003 (2006), <truelocal.com.au>, Denial
- [Telstra Corporation Limited v. Mandino Pty Ltd](#), WIPO Case No. DAU2006-0006 (2006), <yellowbook.com.au> *inter alia*, Denial
- [Marshmallow Skins, Inc. v. Piipiinoo Australia Pty Limited](#), WIPO Case No. DAU2013-0015 (2013), <zipz.com.au> *inter alia*, Transfer
- [Debbie Morgan Macao Commercial Offshore Limited, Missguided Limited v. Samir Vora](#), WIPO Case No. DAU2013-0024 (2013), <missguided.com.au> *inter alia*, Transfer

1.1D Does ownership of a “smart number” or “phone word” to which the domain name is identical or confusingly similar automatically satisfy the requirements of paragraph 4(a)(i) of the auDRP?

The position is *uncertain*.

Different panels have reached different conclusions on the issue of whether a “smart number” or “phone word” (*i.e.*, a telephone number some or all of the digits of which correspond to a word – *e.g.*, 1300lawyer) is a “name” to which the auDRP applies.

The majority of auDRP panels to have considered the issue have concluded that a smart number or phone word, as such, is not a “name” for the purposes of paragraph 4(a)(i) of the Policy. The reasons for this include: (i) the licence granted by the Australian Communications and Media Authority (ACMA) is to the number only (it does not refer explicitly to any word); and (ii) there may be no word that corresponds to the number (*e.g.*, 131111) or there may be many words that correspond to the number (*e.g.*, 13aircraft, 13aircon, 13circle and 13circus for the number 132472). According to these panels, for a smart number or phone word to provide auDRP-relevant rights, it must satisfy the test for being a common law or unregistered trademark [see question 1.7 below].

One panel has come to the contrary view, for the reasons that: (i) the auDRP Note 1 requirement for a “name” is satisfied by the correspondence of the phone number’s digits with the particular letters allocated to that digit on a keypad; and (ii) the auDRP Note 1 requirement for the name to be “registered with the relevant Australian government authority” is satisfied by the role played by the ACMA in granting the licence to use the phone word.

Relevant decisions:

- [John Kolenda v. 1300 Phonewords Pty Ltd](#), WIPO Case No. DA2009-0001 (2009), <1300homeloan.com.au>, Transfer
- [Multi-National Concepts Pty Ltd v. 1300 Directory Pty Ltd](#), WIPO Case No. DAU2009-0002 (2009), <1300accountant.com.au> *inter alia*, Denial
- [Inbound Telecommunications Pty Ltd, Phonename Marketing Australia Pty Ltd v. 1300 Directory Pty Ltd, Demetrio Padilla](#), WIPO Case No. DAU2009-0018 (2010), <1300fitness.com.au> *inter alia*, Denial

1.2 What is the test for identity or confusing similarity, and can the content of a website be relevant in determining this?

The general position is the **same** as that under the UDRP.

The test for identity is that there is “essential or virtual identity” between the domain name and the trademark or name in which the complainant has rights.

The test for confusing similarity is typically undertaken by a comparison of the domain name with the trademark or name alone, independent of the other marketing and use factors that might be considered in a trademark infringement or a misleading and deceptive conduct case. Application of the confusing similarity test typically involves a straightforward visual or aural comparison of the trademark or name with the alphanumeric string in the domain name, to determine the likelihood of Internet user confusion. In order to satisfy the test for confusing similarity, the relevant trademark or name would generally need to be recognisable as such within the domain name. While each case must be judged on its own merits, circumstances in which a trademark or name may not be recognisable as such within a domain name may include where the relied-upon mark corresponds to a common term or phrase which is contained or subsumed within another common term or phrase in the domain name (e.g., the trademarks UPS and UPS ONLINE within the domain name <pickupsonline.com.au>).

Where the domain name contains only part of the complainant's trademark or name and that part is highly descriptive or is generic, the domain name is unlikely to be confusingly similar. The inclusion in the domain name of additional terms that are common or descriptive typically is regarded as being insufficient to prevent threshold Internet user confusion, except where the trademark or name itself is a common or descriptive term or where the additional terms have the effect of changing how a typical Internet user would read the domain name. A reversal of the order of the terms of the complainant's trademark or name may not avoid confusing similarity, at least where those terms are descriptive. Where the domain name consists of the acronym of the complainant's trademark or name, the domain name is unlikely to be considered confusingly similar to the mark or name unless the complainant can establish a reputation in the acronym.

The applicable top-level suffixes in the domain name (e.g., “.com.au”) would usually be disregarded under the confusing similarity test, except in certain cases where one or other, or both, of the top-level suffixes form part of the relevant trademark or name.

auDRP panels generally ignore the content of any website to which the domain name resolves, on the basis that identity or confusing similarity is to be determined simply by way of a string comparison – *i.e.*, by comparison of the domain name's text with the text of the complainant's trademark or name.

Relevant decisions:

- [GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd](#), WIPO Case No. DAU2002-0001 (2003), <globalcentre.com.au> *inter alia*, Transfer
- [The Crown in Right of the State of Tasmania trading as "Tourism Tasmania" v. Gordon James Craven](#), WIPO Case No. DAU2003-0001 (2003), <discover-tasmania.com.au>, Denial
- [The National Office for the Information Economy v. Verisign Australia Limited](#), LEADR Case No. auDRP02/03 (2003), <gatekeeper.com.au>, Transfer
- [Swinburne University of Technology v. Swinner a/k/a Benjamin Robert Goodfellow](#), WIPO Case No. DAU2004-0003 (2004), <swin.com.au>, Transfer
- [Tooling Australia Incorporated v. Austool Limited \(In Liquidation\)](#), IAMA Case No. 3045 (2007), <toolingaustralia.com.au> *inter alia*, Denial
- [WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd](#), WIPO Case No. DAU2007-0003 (2007), <wow.com.au>, Denial
- [Silpro Pty Limited v. Corey De Silva t/a Silva Service Spit Roast Catering](#), WIPO Case No. DAU2008-0013 (2008), <silvasspitroastcatering.com.au>, Denial
- [United Parcel Service of America, Inc. v. Wesley Bryant](#), WIPO Case No. DAU2009-0012 (2010), <pickupsonline.com.au>, Denial

- [Queensland Electricity Transmission Corporation Limited ACN 078 849 233 trading as Powerlink Queensland v. The Trustee for GAMM FAMILY TRUST](#), LEADR Case No. auDRP11/11 (2011), <pq.net.au>, Denial
- [First Alliance Pty Ltd v. Bengamen David Hall](#), IAMA Case No. 5017 (2013), <trade.com.au>, Denial
- [Immihelp, LLC v. Babak Shahafar](#), WIPO Case No. DAU2013-0041 (2014), <immihelp.com.au>, Denial
- [Travel Insurance Direct Pty Limited v. Paul F Quinn](#), WIPO Case No. DAU2014-0007 (2014), <directtravelinsurance.com.au>, Denial

1.3 Is a domain name consisting of a trademark or name and a negative term confusingly similar to the complainant's trademark or name? ("sucks cases")

The position is **unknown**.

It appears that no auDRP case has yet addressed the issue of a domain name consisting of a trademark and a negative or pejorative term, such as <[trademark]sucks.com.au>. Thus, it is not clear whether – and, if so, in what circumstances – such a domain name will be found to be confusingly similar to the complainant's trademark.

1.4 Does the complainant have auDRP-relevant rights in a trademark or name that was registered, or in which the complainant acquired unregistered trademark rights, after the domain name was registered?

The general position is the **same** as that under the UDRP.

The auDRP makes no specific reference to the date on which the owner of the trademark or name must have acquired rights so as to satisfy the requirements of paragraph 4(a)(i) of the Policy. It follows that registration of a domain name before a complainant acquires rights in a trademark or name does not prevent a finding of identity or confusing similarity under the auDRP, although this fact may be relevant to determining whether the second and third requirements of the Policy are satisfied.

The relevant time by which a complainant must establish its rights is at the time of the filing of the complaint.

Relevant decisions:

- [Doteasy Technology, Inc. v. M Makras and E.A Nahed dba Dot Easy Australia](#), WIPO Case No. DAU2006-0011 (2007), <doteasy.com.au>, Denial
- [Lance John Picton v. KK Factory Seconds Online / Dean James Mackin](#), WIPO Case No. DAU2007-0005 (2007), <factoryseconds.com.au>, Denial
- [Yola, Inc. v. Aaron John Peter Johnson / Aaron Johnson](#), WIPO Case No. DAU2010-0017 (2010), <yola.com.au>, Transfer
- [The Crown in Right of the State of Tasmania trading as "Tourism Tasmania" v. Gordon James Craven](#), WIPO Case No. DAU2003-0001 (2003), <discover-tasmania.com.au>, Denial

1.5 Can a complainant show auDRP-relevant rights in a geographical term or identifier?

The general position is **somewhat different** to that under the UDRP.

At least one panel has considered the issue, and has concluded that a geographical term cannot function as a *trademark* or *service mark* for the purposes of paragraph 4(a)(i) of the Policy unless its geographical significance has been displaced by long and extensive use as a brand by a single trader in such a manner as to distinguish that trader's goods and services from those of competitors. However, a geographical term will still be a *name* for the purposes of paragraph 4(a)(i) of the Policy if it is the complainant's company, business or other legal or trading name and is registered with the relevant Australian government authority, or if it is the

complainant's personal name – because Note 1 of the Policy states that each of those is a “name” for the purposes of the Policy.

Relevant decisions:

- [The Crown in Right of the State of Tasmania trading as "Tourism Tasmania" v. Gordon James Craven](#), WIPO Case No. DAU2003-0001 (2003), <discover-tasmania.com.au>, Denial

1.6 Can a complainant show auDRP-relevant rights in a personal name?

The general position is **somewhat different** from that under the UDRP.

Note 1 of the auDRP states that the complainant's personal name is a “name” for the purposes of the Policy. Thus, a complainant has auDRP-relevant rights in a personal name, even where that name is neither a registered trademark nor an unregistered trademark. At least one panel has found that a well-known *nickname* of the complainant is sufficient to constitute a “name” for the purposes of the Policy.

Relevant decisions:

- [Tina Arena v. Enigmatic Minds Pty Ltd](#), Case No. LEADR Case No. auDRP01/07 (2007), <tinaarena.com.au>, Transfer
- [Shane Keith Warne v. Sure Thing Services Pty Ltd](#), LEADR Case No. auDRP08/10 (2010), <warnie.com.au> *inter alia*, Transfer

1.7 What needs to be shown for the complainant to successfully assert common law or unregistered trademark rights?

The general position is the **same** as that under the UDRP.

The requirement that the complainant has rights in a trademark or service mark is satisfied where the complainant can show that a name has acquired “secondary meaning” and become a distinctive identifier associated with the complainant or its goods or services – *i.e.*, that it is a common law or unregistered trademark. Evidence relevant to establishing such secondary meaning includes the length and amount of sales under the name, the nature and extent of advertising using the name, surveys of consumer recognition of the name, and media references to the name. In at least one case, the panel treated as determinative of the issue the findings of an IP Australia Trade Marks Hearing Officer to the effect that the complainant had common law rights in an unregistered trademark.

To constitute a common law or unregistered trademark, the name does not need to be famous or well known. The key requirement is that the name has sufficient distinctiveness so as to be able to act as a badge of origin that distinguishes the goods or services of the complainant from those of other traders. However, merely trading under a name does not make that name distinctive. Where the complainant's alleged unregistered trademark consists of a generic or descriptive word, a strong case will be required to show that the word has become associated with the complainant and its goods or services. Operating a website which corresponds to an unregistered mark, and using that website in connection with business, will not necessarily give common law rights in that mark. Merely appending the domain name to an advertisement alongside other contact details will not suffice.

Where the complainant's trading name has not acquired secondary meaning as a trademark, it will not provide auDRP-relevant rights unless it is registered with the relevant Australian government authority (and thereby is a name within the Note 1 definition).

Relevant decisions:

- [University of Melbourne v. union melb](#), WIPO Case No. DAU2004-0004 (2004), <unimelb.com.au>, Transfer
- [Spanton Media Group Pty Limited v. Lion Global Pty Limited](#), WIPO Cases Nos. DAU2007-0007 and DAU2007-0008 (2007), <barawards.com.au> *inter alia*, Denial
- [WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd](#), WIPO Case No. DAU2007-0003 (2007), <wow.com.au>, Denial

- [Curtain Communications Pty Ltd. v. Leann Webb](#), WIPO Case No. DAU2008-0022 (2008), <alphakids.com.au>, Denial
- [Brilliance Publishing, Inc. v. My Brilliance Pty Ltd / Ceinwen Schneider](#), WIPO Case No. DAU2013-0007 (2013), <brillianceaudio.com.au> *inter alia*, Transfer
- [Stephens Valuation and Consultancy Pty Ltd v. SLR Consulting Australia Pty Ltd](#), WIPO Case No. DAU2013-0026 (2013), <quarryvaluations.com.au> *inter alia*, Denial
- [Automatix Pty Limited trading as Popcake v. Todd Polke](#), IAMA Case No. 3710 (2013), <popcake.com.au>, Transfer

1.8 Can a trademark licensee or a related company to a trademark holder have rights in a trademark for the purpose of filing an auDRP case?

The general position is the **same** as that under the UDRP.

In most circumstances, a licensee of a trademark, or an entity related to the registered holder of a trademark mark (such as a subsidiary or a parent of the holder of the trademark), is considered to have rights in a trademark for the purposes of paragraph 4(a)(i) of the Policy. Evidence of the trademark licence and/or of the consent of the trademark holder to the bringing of the complaint would tend – and may, at least in the case of an unregistered trademark, be necessary – to support such a finding. [See also question 4.16 below in relation to complaints brought by multiple complainants.]

One panel has found that the appointment of the complainant as the “exclusive distributor” in Australia of the product that was sold under the registered trademark, together with an “authorisation” of the complainant to use the “trade name” in Australia, was insufficient to provide the complainant with rights in a name for the purposes of the Policy. The reasoning of the panel seems to be that the authorisation to use the “trade name” did not include an authorisation to use a trademark.

Relevant decisions:

- [Graphisoft Australia v. CAD Australia Pty Limited](#), CIARB Case No. 05/01 (2005), <archicad.com.au>, Denial
- [TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Limited](#), WIPO Case No. DAU2006-0003 (2006), <truelocal.com.au>, Denial
- [Sitecore Australia Pty Ltd v. WB Solutions Pty Ltd](#), LEADR Case No. auDRP10/08 (2008), <sitecore.com.au> *inter alia*, Denial
- [Avid Life Media, Inc. v. Melody Carstairs](#), WIPO Case No. DAU2011-0001 (2011), <cougarlife.com.au>, Transfer / Cancellation

1.9 Is a domain name consisting of a trademark or name and a generic, descriptive or geographical term confusingly similar to a complainant’s trademark or name?

The general position is the **same** as that under the UDRP.

The addition of merely generic, descriptive, or geographical wording to a trademark or name in a domain name would normally be insufficient, of itself, to avoid a finding of confusing similarity under the first element of the auDRP. In such a situation, panels have usually found the incorporated trademark or name to constitute the dominant or principal component of the domain name. However, in certain cases panels have come to a different conclusion, where a trademark or name (especially one that is of a descriptive nature) is incorporated or subsumed within other words or textual elements of the domain name so that the trademark or name is not clearly the dominant component of the domain name.

Relevant decisions:

- [Seek Limited v. Arazac Nominees Pty Ltd](#), WIPO Case No. DAU2006-0010, <seekbusiness.com.au>, Denial
- [United Parcel Service of America, Inc. v. Wesley Bryant](#), WIPO Case No. DAU2009-0012 (2010), <pickupsonline.com.au>, Denial

1.10 Is a domain name which contains a common or obvious misspelling of a trademark or name (i.e., typosquatting) confusingly similar to a complainant's trademark or name?

The general position is the **same** as that under the UDRP.

A domain name that contains a common or obvious misspelling of a trademark or name normally will be found to be confusingly similar to such trademark or name, where the misspelled trademark or name remains the dominant or principal component of the domain name. However, where the variation to the domain name – even if only by a single character – fundamentally changes the meaning of the domain name, the domain name will not be confusingly similar to the trademark.

There appear to be very few auDRP cases concerning obvious misspellings of a trademark or name. The likely reason for this is auDA's policy prohibiting the deliberate registration of a domain name that is a misspelling of an entity, personal or brand name that does not belong to the registrant, in order to trade on the reputation of the other entity, person or brand (currently '2008-09 – Prohibition on Misspellings Policy'). Under that policy, auDA will instruct the registrar to delete a misspelt domain name in the event that a complaint is made to auDA and the registrant is unable to show that the domain name is not a prohibited misspelling.

Relevant decisions:

- [Telstra Corporation Limited v. Mikhail Doubinski and Yury Sharafutdinov trading as AAA Marketing World](#), WIPO Case No. DAU2006-0008 (2006), <whitepage.com.au>, Transfer
- [United Parcel Service of America, Inc. v. Wesley Bryant](#), WIPO Case No. DAU2009-0012 (2009), <pickupsonline.com.au>, Denial
- [Woolworths Limited v. Cracka IP Pty Ltd.](#), WIPO Case No. DAU2011-0028 (2011), <danmurphyswines.com.au> *inter alia*, Transfer

1.11 Are disclaimed or design elements of a trademark considered in assessing identity or confusing similarity?

The general position is **similar** to that under the UDRP.

As figurative, stylized or design elements in a trademark are generally incapable of representation in a domain name, such elements are typically disregarded for the purpose of assessing the identity or confusing similarity of a domain name with a trademark. Accordingly, the assessment is generally made between the alpha-numeric components of the domain name and the dominant textual components of the relevant trademark.

Where the entire textual element of a figurative trademark is disclaimed, a panel may find that the complainant has no trademark rights in that element by virtue of its registration – meaning the complainant does not have a trademark to which the Policy applies unless, through use, the disclaimed element has become distinctive of the complainant's goods or services.

Relevant decisions:

- [Lance John Picton v. KK Factory Seconds Online / Dean James Mackin](#), WIPO Case No. DAU2007-0005 (2007), <factoryseconds.com.au>, Denial
- [Cambridge Nutritional Foods Limited and Cambridge Manufacturing Company Limited v. Cambridge Diet Pty Ltd](#), WIPO Case No. DAU2010-0021 (2011), <cambridge-diet.com.au>, Transfer

2. SECOND AUDRP ELEMENT

2.1 Is the complainant required to prove that the respondent lacks rights or legitimate interests in the domain name?

The general position is the **same** as that under the UDRP.

A complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. The complainant will usually make out a *prima facie* case by establishing that none of the paragraph 4(c) circumstances are present. Once such a *prima facie* case is made, the burden of production shifts to the respondent, requiring it to provide evidence or plausible assertions demonstrating rights or legitimate interests in the domain name. If the respondent fails to provide such evidence or assertions, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy [see also question 4.6 below in relation to respondent default]. If the respondent does provide some evidence or plausible assertions of rights or legitimate interests in the domain name, the panel then weighs all the evidence – with the burden of proof always remaining on the complainant.

Relevant decisions:

- [Jacuzzi, Inc. v. Wangra Pty Ltd](#), WIPO Case No. DAU2005-0001 (2005), <jacuzzispas.com.au>, Denial
- [ESPN Inc. v. IMCO Corporation Pty Ltd](#), WIPO Case No. DAU2005-0005 (2005), <espn.com.au>, Transfer
- [Telstra Corporation Limited v. Mikhail Doubinski and Yury Sharafutdinov trading as AAA Marketing World](#), WIPO Case No. DAU2006-0008 (2006), <whitepage.com.au>, Transfer
- [TeamViewer GmbH v. Nigel Burke](#), WIPO Case No. DAU2012-0027 (2012), <teamviewer.com.au>, Transfer
- [Pindan Pty Ltd v. Kre8 Brand Pty Ltd](#), WIPO Case No. DAU2013-0038 (2013), <switchfeelathome.com.au>, Transfer

2.1A When will a respondent be making a *bona fide* use of a domain name in connection with an offering of goods or services?

The general position is *similar* to that under the UDRP.

Paragraph 4(c)(i) of the auDRP states that a respondent will be taken to have demonstrated rights or legitimate interests in a domain name where, before any notice of the subject matter of the dispute, it has *bona fide* used, or prepared to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services. Unlike the equivalent provision in the UDRP, paragraph 4(c)(i) of the auDRP expressly states that “an offering of domain names that it has acquired for the purposes of selling, renting or otherwise transferring” is not a *bona fide* offering by the respondent for this purpose.

If the domain name contains the whole or a significant part of the respondent’s personal name, the respondent is likely to have rights or legitimate interests in it, even if the respondent cannot establish it has been “commonly known” by the domain name [see also question 2.1B below]. If a respondent is using a descriptive word to describe its goods or services without intending to take advantage of the complainant’s rights in that word, then it has a right or legitimate interest in a domain name that contains that word. It is not necessary for the respondent to do business under the exact term incorporated in the domain name – it is sufficient if there is a “connection” between the domain name’s descriptive meaning and the respondent’s offering of goods or services. However, the respondent’s use of the domain name must not be a “sham”; panels have been alert to disregard a respondent’s use of the domain name to resolve to a website that is “spurious” or a “shell”.

The key issue is whether the respondent’s use of the domain name is *bona fide* – *i.e.*, is in good faith. To determine whether a respondent’s use of a domain name is in good faith requires a consideration of the respondent’s motivation for undertaking that use; which, in turn, requires an evaluation of all the facts and evidence. Relevant facts include: the degree of similarity of the domain name to the complainant’s mark; the respondent’s awareness of the complainant’s business conducted under its mark; the likelihood of customer confusion; and whether the domain name is genuinely being used for its descriptive meaning. [See also question 2.3 below.]

Where there is evidence that the respondent registered the domain name to exploit the value of the complainant’s trademark that it incorporates, a lack of good faith will be inferred in respect of the respondent’s use of the domain name. Where the respondent or associated persons have registered other domain names similar to other well-known trademarks, the

generic nature of the words constituting the domain name will most likely not be sufficient to give the respondent a right or legitimate interest in it. At least one panel has held that where the disputed domain name is identical to the complainant's registered trademark, a rebuttable presumption is raised that the domain name is being used by the respondent to trade off the complainant's rights in that trademark, rather than for its descriptive value [see also question 2.2 below].

Relevant decisions:

- [PA Consulting Services Pty Ltd v. Joseph Barrington-Lew](#), WIPO Case No. DAU2003-0002 (2002), <paconsulting.com.au>, Transfer
- [Telstra Corporation Limited v. Mikhail Doubinski and Yury Sharafutdinov trading as AAA Marketing World](#), WIPO Case No. DAU2006-0008 (2006), <whitepage.com.au>, Transfer
- [Lance John Picton v. KK Factory Seconds Online / Dean James Mackin](#), WIPO Case No. DAU2007-0005 (2007), <factoryseconds.com.au>, Denial
- [Silpro Pty Limited v. Corey De Silva t/a Silva Service Spit Roast Catering](#), WIPO Case No. DAU2008-0013 (2008), <silvasspitroastcatering.com.au>, Denial
- [Informa Australia Pty Ltd v. Reed Business Information Pty Ltd](#), LEADR Case No. auDRP02/09 (2009), <earthmove.com.au>, Transfer
- [Bernard Janes v. L.J. Bubenicek & A. J. Main, A&L Technologies](#), WIPO Case No. DAU2010-0014 (2010), <goballistic.com.au>, Transfer
- [Budget Rent A Car v. Emma Faye Weekly](#), WIPO Case No. DAU2010-0020 (2010), <budgetcarhire.com.au>, Transfer
- [Confo Pty Ltd v. Meridian Project Consulting Pty Ltd](#), LEADR Case No. auDRP20/10 (2010), <buildercpd.com.au>, Transfer
- [Cairns Airport Pty Ltd. v. Chris Ford \(Christopher William Ford\) / C and C Family Discretionary Trust](#), WIPO Case No. DAU2013-0023 (2013), <cairnsairportparking.com.au> *inter alia*, Denial
- [Bendigo Community Telco Ltd v. IT Company Pty Ltd](#), LEADR Case No. auDRP04/14 (2014), <bct.com.au>, Denial
- [Tyre Depot Holdings Pty Ltd v. Tyre Kingdom Pty Ltd.](#), WIPO Case No. DAU2014-0016 (2014), <tyredepot.com.au>, Transfer

2.1B When will a respondent be commonly known by a domain name?

The position is **unknown**.

Paragraph 4(c)(ii) of the auDRP, like the equivalent provision in the UDRP, states that a respondent will be taken to have demonstrated rights or legitimate interests in a domain name where it has been commonly known by the domain name, even though it has acquired no trademark or service mark rights.

It appears that no auDRP case has yet found that a respondent is “commonly known” by a domain name. Thus, it is not clear whether – and, if so, in what circumstances – a respondent will be found to have rights or legitimate interests in a domain name by virtue of being commonly known by it.

2.1C When will a respondent be making a legitimate non-commercial or fair use of a domain name?

The position is **unknown**.

Paragraph 4(c)(iii) of the auDRP, like the equivalent provision in the UDRP, states that a respondent will be taken to have demonstrated rights or legitimate interests in a domain name where it is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or name at issue.

It appears that no auDRP case has yet found a respondent to be making a “legitimate non-commercial or fair use” of a domain name [see questions 2.4 and 2.5 below]. Thus, it is not clear whether – and, if so, in what circumstances – a respondent will be found to have rights or legitimate interests in a domain name by virtue of a non-commercial or fair use of it.

2.2 Does a respondent automatically have rights or legitimate interests in a domain name comprised of a dictionary word(s)?

The general position is the **same** as that under the UDRP.

A respondent cannot rely solely on the fact that the domain name is composed of ordinary language words to ground a claim to rights or legitimate interests in it. If the complainant makes a *prima facie* case that the respondent has no rights or legitimate interests in the domain name, and the respondent fails to show one of the three circumstances under paragraph 4(c) of the auDRP, or any other basis for rights or legitimate interests, then the respondent will lack a legitimate interest in the domain name even if it is comprised of a dictionary, descriptive or generic word or phrase. Where the complainant has a registered trademark to which the domain name is identical, the complainant is entitled to a rebuttable presumption that its mark is distinctive rather than descriptive.

Where the domain name is highly descriptive, the complainant must make a strong case in order to establish, *prima facie*, that the respondent does not have rights or legitimate interests in it. As a general principle, the less distinctive is the complainant's mark or name, the more likely it is the respondent will have rights or legitimate interests in a corresponding domain name.

Factors that are relevant to determining if the respondent has rights or legitimate interests in a descriptive, generic, or dictionary word domain name include the distinctiveness, status and fame of the trademark or name in which the complainant has rights, the likelihood of customer confusion, and whether the respondent was aware of this likelihood prior to registering the domain name. Where the complainant's trademark has a very considerable reputation and there is a strong likelihood of confusion between it and the domain name, the descriptive nature of the words constituting the domain name will not give the respondent rights or legitimate interests in it. Where there is evidence of actual customer confusion between the domain name and the trademark, the descriptive nature of the words constituting the domain name will not give the respondent rights or legitimate interests in it [see also question 2.1A above].

Relevant decisions:

- [Jupitermedia Corporation and Australia.Internet.com Pty Ltd v. Spotpress Pty Ltd. trading as Internet Printing](#), WIPO Case No. DAU2003-0005 (2003), <internet.com.au>, Denial
- [TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Limited](#), WIPO Case No. DAU2006-0003 (2006), <truelocal.com.au>, Denial
- [Telstra Corporation Limited v. Mikhail Doubinski and Yury Sharafutdinov trading as AAA Marketing World](#), WIPO Case No. DAU2006-0008 (2006), <whitepage.com.au>, Transfer
- [QSoft Consulting Limited v. B.S.P.](#), WIPO Case No. DAU2009-0003 (2009), <gaydar.net.au>, Transfer
- [Cognito Software Limited v. Rethink IT Pty Ltd](#), WIPO Case No. DAU2009-0011 (2009), <moneyworks.com.au>, Transfer
- [Environics Pty Ltd v. Connectus Pty Ltd](#), LEADR Case No. auDRP03/09 (2009), <engineer.com.au>, Denial

2.3 Can a reseller/distributor of trademarked goods or services have rights or legitimate interests in a domain name which contains such trademark?

The general position is the **same** as that under the UDRP.

In early decisions under the auDRP, panels were concerned to determine whether the respondent was genuinely using the trademark to indicate that it was a reseller/distributor or rather was using the trademark to induce customer confusion. The more recent decisions of auDRP panels have adopted the principles set out in the UDRP case *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903 (the "Oki Data principles") – although at least one panel has expressed doubt that these principles should be accepted *verbatim*, especially the requirement that there be disclosure of the registrant's relationship with the trademark owner.

Under the *Oki Data* principles, a reseller or distributor can be making a *bona fide* offering of goods and services, and thus have a legitimate interest in the domain name, if its use meets certain requirements. These requirements are: (i) the respondent must actually be offering goods or services related to the trademark in respect of which the domain name is confusingly similar; (ii) the respondent must offer only those goods or services in connection with the disputed domain name; (iii) the respondent must have disclosed its true relationship with the owner of the trademark to which the domain name is identical or confusingly similar, prior to notice of the dispute; and (iv) the respondent must not have attempted to “corner the market” in domain names that reflect that trademark.

These principles have been applied by auDRP panels to a reseller that is unauthorised, as well as to one that is authorised, to use the trademark by the trademark owner. Thus, these principles have been applied to a reseller of the trademarked goods that are second-hand.

These principles have been extended by at least one auDRP panel to apply to an entity acting not as a reseller of the trademarked goods, but as an *agent for the purchaser* of such goods.

At least one panel has considered the situation where a respondent is offering for sale goods or services that are *interoperable* with other goods or services that bear the complainant's trademark. In that situation, the respondent has a legitimate interest in describing its goods or services accurately – and this legitimate interest will extend to the use of a domain name that contains the complainant's trademark so long as that use is descriptive and fair. A descriptive and fair use in the interoperability situation falls within the circumstances specified in paragraph 4(c)(iii) of the Policy as demonstrating the respondent's rights or legitimate interests in the domain name – namely, the circumstances of the respondent making a “fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish” the complainant's trademark.

Relevant decisions:

- [Princess Yachts International PLC v. Graham Stephens](#), LEADR Case No. 08/07 (2007), <princessyachts.com.au>, Transfer
- [Topfield Co. Ltd v. Jai Kemp and Digital Products Group Pty Ltd, t/a Topfield Australia, formerly Paige Communications Pty Ltd](#), WIPO Case No. DAU2008-0002 (2008), <topfield.net.au> *inter alia*, Denial / Transfer
- [Aastra Telecom Inc. v. Spring Mountain Enterprises Pty Ltd.](#), WIPO Case No. DAU2008-0003 (2008), <aastra.com.au>, Transfer
- [GM Holden Ltd v. Blogger Pty Ltd](#), WIPO Case No. DAU2008-0016 (2008), <holdenastra.com.au>, Transfer
- [GM Holden Ltd. v. Bradley John Lawless](#), WIPO Case No. DAU2010-0010, <holdenplatinumservice.com.au> *inter alia*, Transfer
- [GM Holden Ltd v. Publishing Australia Pty Ltd](#), WIPO Case No. DAU2011-0002, <holdendiscounts.com.au>, Denial
- [Bayerische Motoren Werke Aktiengesellschaft v. Publishing Australia Pty Ltd, ACN 120 531 982, Mr. Nicholas Crawshaw](#), WIPO Case No. DAU2011-0024, <bmwdiscounts.com.au>, Denial
- [Clark Equipment Company v. AllJap Machinery Pty Ltd](#), WIPO Case No. DAU2011-0042 (2012), <usedbobcats.com.au>, Transfer
- [Terra Plana International Ltd. v. The Summer House Australia Pty Ltd / Tanya Greenwood](#), WIPO Case No. DAU2012-0025, <vivobarefoot.com.au> *inter alia*, Transfer
- [Google Inc. v. Q Interactive Pty Ltd / Mr. Victor Quinteros](#), WIPO Case No. DAU2012-0026 (2012), <androidappstore.com.au>, Transfer

2.4 Can a criticism site generate rights or legitimate interests in the disputed domain name?

The position is *unknown*.

It appears that no auDRP case has yet addressed the issue of whether a respondent has rights or legitimate interests in a domain name that is used in relation to a website on which the owner of the corresponding trademark or name is criticised. In those cases where the respondent did raise such an argument, panels have not needed to address the issue, either because the respondent's claim was contradicted by the evidence (showing that the

respondent's website was "not a genuine criticism site in any genuine sense at all and was not genuinely promoting the cause of free speech") or because the respondent's use was obviously commercial in nature (and thus the respondent could not satisfy the requirement in paragraph 4(c)(iii) requirement that the respondent's use was "without intent for commercial gain"). In those cases where the facts suggest the respondent might have been able to raise the issue, panels have not been required to address it because the respondent was in default and did not raise the argument.

Relevant decisions:

- [Google Inc. v. Dmitri Rytsk](#), WIPO Case No. DAU2007-0004 (2007), <googlebay.com.au>, Transfer
- [SKYCITY Adelaide Pty Limited v. Trelilian Pty Ltd](#), IAMA Case No. 3353 (2009), <adelaidecasino.com.au>, Transfer

2.5 Can a fan site generate rights or legitimate interests in the disputed domain name?

The position is **unknown**.

It appears that no auDRP case has yet addressed the issue of whether a respondent has rights or legitimate interests in a domain name that is used in relation to a website on which the owner of the corresponding trademark or name is celebrated or discussed. In those cases where the respondent did raise such an argument, panels have not needed to address the issue, either because the respondent provided no evidence to support its assertion of intended use as a fan site, or because the respondent's use of the domain name was obviously commercial in nature (and thus the respondent could not satisfy the requirement in paragraph 4(c)(iii) requirement that the respondent's use was "without intent for commercial gain").

Relevant decisions:

- [Arena Entertainment Pty Ltd v. Alex Haddad](#), LEADR Case No. 05/05 (2005), <rnbssuperclub.com.au>, Transfer
- [Australian Government Department of Education, Science and Training v. Blogger Pty Limited](#), IAMA Case No. 3058 (2007), <questacon.com.au>, Transfer
- [Tina Arena v. Enigmatic Minds Pty Ltd](#), Case No. LEADR Case No. auDRP01/07 (2007), <tinaarena.com.au>, Transfer

2.6 Do parking and landing pages or pay-per-click (PPC) links generate rights or legitimate interests in the disputed domain name?

The general position is **somewhat different** from that under the UDRP.

Use of a domain name to resolve to parking or landing pages, or to generate revenue through pay-per-click (PPC) links advertising, is generally not considered a *bona fide* offering of goods or services under the auDRP.

Relevant decisions:

- [Australian Government Department of Education, Science and Training v. Blogger Pty Limited](#), IAMA Case No. 3058 (2007), <questacon.com.au>, Transfer
- [Insure & Go Insurance Services Limited v. CoverDirect Pty Ltd.](#), WIPO Case No. DAU2008-0019 (2008), <insureandgo.com.au>, Transfer
- [Stardoll AB v. Domain Folio 1 Pty Ltd](#), WIPO Case No. DAU2011-0038 (2011), <stardoll.com.au>, Transfer
- [Freelife International Holdings, LLC and Freelife International Australia Pty Ltd. v. Nick Nastevski dba Health Doctor](#), WIPO Case No. DAU2012-0017 (2012), <chi3.com.au> *inter alia*, Transfer
- [CruiseMart Pty Ltd v. Debretts Travel Services](#), LEADR Case No. auDRP06/12 (2012), <cruiseholidays.com.au>, Transfer

2.7 Does a respondent trademark corresponding to a disputed domain name automatically generate rights or legitimate interests?

The general position is the **same** as that under the UDRP.

auDRP panels have tended to recognise that a respondent's registration of a trademark corresponding to the disputed domain name will normally, but does not necessarily, establish that the respondent has rights or legitimate interests in that domain name. A key issue is whether the respondent's trademark registration is *bona fide*. Where the respondent has chosen its trademark without seeking to create confusion with the complainant's website, products or customers, the existence of its trademark will very likely mean the respondent has rights or legitimate interests in a domain name that corresponds to that trademark. However, where the overall circumstances indicate that the respondent's acquisition of a trademark was not *bona fide* – e.g., where it was obtained primarily to circumvent the application of the auDRP – panels have generally declined to find that the respondent has rights or legitimate interests in the corresponding domain name.

Relevant decisions:

- [PayBurst Financial Technologies and Gregory Fx Iannacci v. Virgin Blue Airlines Pty Ltd](#), WIPO Case No. DAU2006-0001 (2006), <velocityrewards.com.au>, Denial
- [American Future Technology Corp. v. Rex Hall](#), WIPO Case No. DAU2009-0007 (2009), <ibuypower.com.au>, Denial
- [Find Marketing Pty Ltd v. Troy Holland and Taryn Green](#), LEADR Case No. 09/11 (2011), <find.com.au>, Denial

2.7A Does a respondent trademark application corresponding to a disputed domain name automatically generate rights or legitimate interests?

The general position is the **same** as that under the UDRP.

auDRP panels have found that an application by the respondent to register a trademark does not, of itself, automatically generate rights or legitimate interests in a corresponding domain name. The reason is that, although the rights to a trademark registration, once granted, run from the date of the application, a pending application does not confer any enforceable legal rights. However, where the respondent has undertaken other relevant activities in relation to the applied-for trademark, the totality of the respondent's activities may be sufficient for a panel to find either that the respondent has, or that the complainant has failed to prove that the respondent does not have, rights or legitimate interests in the corresponding domain name.

Relevant decisions:

- [Zillow Inc. v. Felix-Hoffman Anne-Simone](#), WIPO Case No. DAU2006-0015 (2006), <zillow.com.au>, Transfer
- [Curtain Communications Pty Ltd. v. Leann Webb](#), WIPO Case No. DAU2008-0022 (2008), <alphakids.com.au>, Denial
- [Vitacost.com, Inc. v. Ronald Lee Bradley](#), WIPO Case No. DAU2012-0003 (2012), <vitacost.com.au>, Transfer

2.7B Does a respondent's registration of a business name or a company name corresponding to a disputed domain name automatically generate rights or legitimate interests?

The issue **does not arise** under the UDRP.

The fact that a respondent has registered a business name or a company name does not, of itself, establish that the respondent has rights or legitimate interests in the domain name that corresponds to the business name or the company name. The reason for this is that the registration of a business name or company name does not provide proprietary rights in the name. The registration of a business name is a legislative requirement that needs to be satisfied where an entity trades under a name that is not its own personal name or company

name. The registration of a company name is a legislative requirement that needs to be satisfied where an entity is incorporated.

The critical issue appears to be whether the respondent has traded under the business name or company name in good faith. The respondent will generally be able to establish that it has rights or legitimate interests in a domain name that corresponds to its registered business name or company name where it has actually traded, or intends to trade, under that name. Where, however, the trading under the business name or company name, or the purpose of the business name or company name registration, is not *bona fide*, neither trade under the name nor the fact of registration of the name will be sufficient to establish that the respondent has rights or legitimate interests in the corresponding domain name.

Relevant decisions:

- [Asset Housing Pty Ltd v. Kitome Pty Ltd](#), CIArb Case No. 0601 (2006), <countrykithomes.com.au>, Denial
- [Technosystems Consolidated Corporation, Invention Submission Corporation t/a Invent Help v. Hugh Godman, Royal Computer Proprietary Ltd.](#), WIPO Case No. DAU2007-0001 (2007), <inventhelpaustralia.com.au>, Transfer
- [Insure & Go Insurance Services Limited v. CoverDirect Pty. Ltd.](#), WIPO Case No. DAU2008-0019 (2008), <insureandgo.com.au>, Transfer
- [Just Magazines Pty Ltd v. Australian Just Bikes of the Northern Rivers](#), LEADR Case No. auDRP06/08 (2008), <justbikes.com.au>, Transfer
- [QSoft Consulting Limited v. B.S.P.](#), WIPO Case No. DAU2009-0003 (2009), <gaydar.net.au>, Transfer
- [General Television Pty Limited v. Laszlo Till](#), LEADR Case No. auDRP08/09 (2009), <heyheyitssaturday.com.au> *inter alia*, Denial
- [Mass Nutrition, Inc. and Todd Rosenfeld v. Mass Nutrition Pty. Ltd. now known as Tweed Holdings, Luke McNally](#), WIPO Case No. DAU2010-0002 (2010), <massnutrition.com.au>, Denial

2.7C Does a respondent's satisfaction of the eligibility requirements for registration of a disputed domain name automatically generate rights or legitimate interests?

The issue **does not arise** under the UDRP.

The fact that a respondent satisfied the eligibility requirements for registration of the domain name does not, of itself, establish that the respondent has rights or legitimate interests in the domain name. This is because Note 2 of the auDRP expressly states that rights or legitimate interests in a domain name are not established "merely by the registrar's determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration".

However, at least one auDRP panel has found that the respondent has rights or legitimate interests in a domain name that was acquired by way of a competitive auction rather than normal registration.

Relevant decisions:

- [Jenna IP Holding Company LLC v. Mobile Alive Pty Limited](#), WIPO Case No. DAU2006-0013 (2006), <clubjenna.com.au>, Transfer
- [Westralia Airports Corporation v. Package Computers Ltd.](#), LEADR Case No. auDRP07/08 (2008), <perthairport.com.au>, Denial
- [Easy Living Home Elevators Pty Ltd v. Lift Shop Pty Ltd](#), LEADR Case No. auDRP09/08 (2008), <domuslift.com.au>, Transfer

3. THIRD AUDRP ELEMENT

3.1 Can bad faith be found if the domain name was registered before the trademark or name was registered or before unregistered trademark rights were acquired?

The general position is **different** from that under the UDRP.

Where a domain name is registered prior to the acquisition of rights by the complainant, auDRP panels have tended to assess the timing issue under the second, rather than the third, element of the Policy. Specifically, auDRP panels have taken the fact of the respondent's prior registration of the domain name into account when considering whether the respondent has used, or prepared to use, the domain name in connection with a *bona fide* offering of goods or services as specified in paragraph 4(c)(i) of the Policy [see question 2.1A above]. This represents a substantial deviation from the UDRP, under which panels have tended to take the fact of the respondent's prior registration of the domain name into account in considering whether the respondent registered the domain name in bad faith.

In any event, paragraph 4(a)(iii) of the auDRP requires that the domain name has been registered or subsequently used in bad faith for the third requirement to be satisfied. Unlike the equivalent provision in the UDRP, the word "and" is not used; thus, the issue of whether a complainant must establish both bad faith registration and bad faith use does not arise. As a result, registration – even one that is demonstrably in good faith – of the domain name prior to the complainant acquiring rights in its mark or name will not protect a respondent from a finding that the third requirement is satisfied where it is established that the respondent subsequently used the domain name in bad faith.

Relevant decisions:

- [Sitecore Australia Pty Ltd v. WB Solutions Pty Ltd](#), LEADR Case No. auDRP10/08 (2008), <sitecore.com.au> *inter alia*, Denial
- [Cobb International Limited v. Cobb Australia & New Zealand \(Pty\) Ltd.](#), WIPO Case No. DAU2013-0005 (2013), <cobb.com.au>, Transfer

3.1A When will an offer to sell, rent or otherwise transfer the domain name to another person constitute bad faith?

The general position is *similar* to that under the UDRP.

Paragraph 4(b)(i) of the auDRP states that evidence of the registration and use of the domain name in bad faith includes circumstances indicating that the respondent registered the domain name in order to prevent the owner of a trademark or name from selling, renting or otherwise transferring the domain name registration to another person for valuable consideration in excess of out-of-pocket expenses directly related to the domain name. Unlike the equivalent provision in the UDRP, paragraph 4(b)(i) of the auDRP does not require that the respondent's offer of transfer be to "the complainant" or "a competitor of that complainant"; an offer of transfer to any person is sufficient.

auDRP panels have drawn a distinction between an offer to transfer that is unsolicited and an offer to transfer that is solicited by the complainant. Where the complainant has solicited an offer of transfer, such as by enquiring if the respondent is willing to sell the domain name, a consequential offer by the respondent to transfer the domain name is generally considered insufficient, of itself, to demonstrate bad faith on the part of the respondent. However, the presence of additional facts – such as a false statement by the respondent to the complainant about the registration and use of the domain name, or "the tone of the correspondence" between the respondent and the complainant – may support a finding that, even though the offer was solicited by the complainant, the respondent registered the domain name with the intention of selling it to the complainant .

Relevant decisions:

- [PA Consulting Services Pty Ltd v. Joseph Barrington-Lew](#), WIPO Case No. DAU2003-0002 (2002), <paconsulting.com.au>, Transfer
- [Gloria Jean's Coffees Holdings Pty Ltd v. Jeremy Paul Cleaver](#), WIPO Case No. DAU2007-0006 (2007), <gloriajeans.com.au>, Transfer
- [AW Faber-Castell \(Aust\) Pty Ltd. v. Pen City Pty Ltd. / Atf Diblasi Jones Unit Trust](#), WIPO Case No. DAU2013-0018 (2013), <fabercastell.com.au>, Transfer
- [Bendigo Community Telco Ltd v. IT Company Pty Ltd](#), LEADR Case No. auDRP04/14 (2014), <bct.com.au>, Denial

3.1B When will conduct preventing a trademark or name holder from reflecting the mark or name in a corresponding domain name constitute bad faith?

The general position is *similar* to that under the UDRP.

Paragraph 4(b)(ii) of the auDRP states that evidence of the registration and use of the domain name in bad faith includes the respondent registering the domain name in order to prevent the owner of a trademark or name from reflecting that mark or name in a corresponding domain name. Unlike the equivalent provision in the UDRP, paragraph 4(b)(ii) of the auDRP does not require that the respondent has “engaged in a pattern of such conduct” [see question 3.3 below]. There is an obvious potential for a respondent’s conduct to fall simultaneously within both this paragraph and paragraph 4(b)(iii) of the Policy, since a domain name registration that prevents the complainant from reflecting its mark or name in a domain name may well have been done to disrupt the business activities of that complainant [see question 3.1C below].

auDRP panels generally have found that registration of a domain name which consists solely (once the second-level and top-level domain extensions are ignored) of the complainant’s trademark or name has the effect of preventing the complainant from reflecting its mark or name in that domain name – and hence is evidence of bad faith.

Relevant decisions:

- [Arena Entertainment Pty Ltd v Alex Haddad](#), LEADR Case No. 05/05 (2005), <rnbsuperclub.com.au>, Transfer
- [The Calvin Klein Trademark Trust and Calvin Klein, Inc v. Yangjae Kim \(t/a Primary Blue\)](#), LEADR Case No. auDRP08/08 (2008), <calvinklein.com.au>, Cancellation
- [Bernard Janes v. L.J. Bubenicek & A. J. Main, A&L Technologies](#), WIPO Case No. DAU2010-0014 (2010), <gobalistic.com.au>, Transfer
- [Statoil ASA v. Creative Domain Pty Ltd. / Christine K. Hoyer](#), WIPO Case No. DAU2013-0012 (2013), <statoil.com.au>, Transfer

3.1C When will disruption of the business or activities of another person constitute bad faith?

The general position is *similar* to that under the UDRP.

Paragraph 4(b)(iii) of the auDRP states that evidence of the registration and use of the domain name in bad faith includes the respondent registering the domain name primarily for the purpose of disrupting the business or activities of another person. Unlike the equivalent provision in the UDRP, paragraph 4(b)(iii) of the auDRP does not require that the respondent has disrupted the business of a “competitor”; it is sufficient that the business or activities of any other person are disrupted. There is an obvious potential for a respondent’s conduct to fall simultaneously within both this paragraph and paragraph 4(b)(ii) of the Policy, since a domain name registration done to disrupt the business activities of the complainant could also be a registration which prevents that complainant from reflecting its mark in a domain name [see question 3.1B above].

auDRP panels have generally found that registration of a domain name that contains the complainant’s trademark or name has the effect of disrupting the business of the complainant, so long as the complainant is actively involved in business *in Australia*. In at least one case, the panel found there was disruption even though the complainant did not have a substantial business presence in Australia, in the special circumstances of the complainant planning to expand its business to Australia, this fact being known to the respondent, the respondent registering the domain name in the same year as the planned expansion, and the respondent being a competitor of the complainant in the overseas jurisdiction where the complainant was based.

Relevant decisions:

- [Arena Entertainment Pty Ltd v Alex Haddad](#), LEADR Case No. 05/05 (2005), <rnbsuperclub.com.au>, Transfer
- [Insure & Go Insurance Services Limited v. CoverDirect Pty. Ltd.](#), WIPO Case No. DAU2008-0019 (2008), <insureandgo.com.au>, Transfer

- [Bernard Janes v. L.J. Bubenicek & A. J. Main, A&L Technologies](#), WIPO Case No. DAU2010-0014 (2010), <gobalistic.com.au>, Transfer
- [Statoil ASA v. Creative Domain Pty Ltd. / Christine K. Hoyer](#), WIPO Case No. DAU2013-0012 (2013), <statoil.com.au>, Transfer

3.1D When will use of the domain name to attract Internet users to a website or other online location constitute bad faith?

The position is the **same** as that under the UDRP.

Paragraph 4(b)(iv) of the auDRP, like the equivalent provision in the UDRP, states that evidence of the registration and use of the domain name in bad faith includes the respondent using the domain name to intentionally attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's mark or name as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service thereon.

Where a domain name is identical or confusingly similar to a trademark or name in which the complainant has rights, auDRP panels typically find that use of the domain name by the respondent to resolve to a website – whether of the respondent or some third party – is use in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

Relevant decisions:

- [GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd](#), WIPO Case No. DAU2002-0001 (2003), <globalcentre.com.au> *inter alia*, Transfer
- [The National Office for the Information Economy v. Verisign Australia Limited](#), LEADR Case No. auDRP02/03 (2003), <gatekeeper.com.au>, Transfer

3.2 Can there be use in bad faith when the domain name is not actively used and the domain name holder has taken no active steps to sell the domain name or to contact the trademark holder (passive holding)?

The position is the **same** as that under the UDRP.

auDRP panels have found that a passive holding of the domain name (*i.e.*, an apparent lack of active use of the domain name – *e.g.*, to resolve to a website – without any active attempt to sell or to contact the trademark holder about the domain name), does not, as such, prevent a finding of bad faith. The panel will examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity. Panels may draw inferences about whether the domain name was used in bad faith from the circumstances surrounding the domain name's registration, and *vice versa*.

Where the domain name is initially registered in good faith pursuant to an agreement (*e.g.*, distributorship) between the complainant and respondent, and the respondent passively retains the domain name after the agreement concludes, this may constitute use in bad faith. This is particularly so if the domain name is seen as being retained by the respondent to assist in its negotiations over a dispute with the complainant.

Relevant decisions:

- [Supre Pty Ltd v. Paul King](#), WIPO Case No. DAU2004-0006 (2004), <supre.com.au>, Transfer
- [Produits Berger v. Lay Tee Ong](#), WIPO Case No. DAU2004-0008 (2004), <lampeberger.com.au>, Transfer
- [Mr. Jean Heitz v. Truly Natural Products PTY. Limited/ Mr. Cordeiro](#), WIPO Case No. DAU2011-0017 (2011), <argiletz.com.au>, Transfer
- [Cobb International Limited v. Cobb Australia & New Zealand \(Pty\) Ltd.](#), Case No. DAU2013-0005 (2013), <cobb.com.au>, Transfer
- [Hill & Smith Limited v. LB International Pty Ltd.](#), WIPO Case No. DAU2014-0008 (2014), <brifen.com.au>, Transfer

3.2A Does the respondent's failure to meet the eligibility requirements for registration of a domain name amount to registration or use in bad faith?

The issue *does not arise* under the UDRP.

A domain name will have been registered or used in bad faith where the respondent registered the domain name despite not meeting the applicable eligibility requirements (currently set out in auDA Policy '2012-04 – Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs'). Paragraph 2 of the auDRP states that by applying to register the domain name, or by requesting maintenance or renewal of the domain name registration, the respondent warrants that statements made in the domain name application are complete and accurate, including those as to the respondent's eligibility for a domain name in the open second-level domains (2LDs).

Where the respondent does not meet the relevant eligibility requirement, the respondent is in breach of the paragraph 2 warranty. auDRP panels have found this breach satisfies the paragraph 4(a)(iii) requirement that the domain name has been registered or subsequently used in bad faith.

One panel has made an exception in the case of a "technical" rather than a "knowing" breach of the warranty. Where the respondent was ineligible to register the domain name but had a *bona fide* belief in its eligibility to do so, a panel has found that such a belief precluded a finding that the registration constituted bad faith use.

Relevant decisions:

- [E.F.G. Nominees Pty Limited v Lenland Property Development Pty Ltd.](#), IAMA Case No. 3658 (2012), <thepointkirribilli.com.au>, Cancellation
- [Private Real Estate Pty Limited v. Chris Papas](#), IAMA Case No. 3665 (2012), <privaterealestate.com.au>, Denial
- [Debbie Morgan Macao Commercial Offshore Limited, Missguided Limited v. Samir Vora](#), WIPO Case No. DAU2013-0024 (2013), <missguided.com.au> *inter alia*, Transfer

3.3 What constitutes a pattern of conduct of preventing a trademark or name holder from reflecting the mark or name in a corresponding domain name?

The general position is *different* from that under the UDRP.

Under paragraph 4(b)(ii) of the auDRP, the complainant is only required to prove that the respondent registered the disputed domain name in order to prevent the complainant from reflecting its trademark or name in the form of a domain name. There is no additional requirement, as there is under the UDRP, that the respondent has "engaged in a pattern of such conduct" [see question 3.1B above]. Accordingly, auDRP panels have not been required to consider, and have not considered, what constitutes a pattern of conduct preventing the complainant from reflecting its trademark or name in the form of the domain name.

3.4 Can constructive notice, or a finding that a respondent "knew or should have known" about a trademark or name, or wilful blindness, form a basis for finding bad faith?

The general position is *somewhat different* from that under the UDRP.

It appears that auDRP panels have not adopted the concept of constructive (*i.e.*, deemed) notice in determinations of bad faith. Instead, panels review evidence relevant to actual knowledge of the complainant's trademark or name, and draw conclusions about the respondent's likely knowledge from that evidence. Where the complainant's trademark or name is extremely well-known, or where there is evidence indicating that the respondent would reasonably have been aware of the trademark or name (*e.g.*, where the complainant and respondent are competitors in the same industry, or where the respondent was previously

a customer or business partner of the complainant), panels are likely to find that the respondent was in possession of the necessary knowledge. This is not a concept of constructive notice; rather, it is a conclusion about actual knowledge, in circumstances that indicate that the respondent was more likely than not aware of the complainant's mark or name .

It appears that auDRP panels to date have not imposed on the respondent a general duty to determine whether a domain name registration infringes on or violates someone else's rights.

Relevant decisions:

- [Ink King v. CamerasDirect.com.au](#), LEADR Case No. auDRP01/05 (2005), <ink-king.net.au>, Transfer
- [Informa Australia Pty Ltd v. Reed Business Information Pty Ltd](#), LEADR Case No. auDRP02/09 (2009), <earthmove.com.au>, Transfer
- [Hertz Systems Inc. v. Throne Ventures Pty. Ltd.](#), WIPO Case No. DAU2009-0013 (2010), <hertzcarrental.com.au>, Transfer

3.5 What is the role of a disclaimer on the web page of a disputed domain name?

The general position is the **same** as that under the UDRP.

The existence of a disclaimer cannot, by itself, cure bad faith when bad faith has been established by other factors. This is typically explained by auDRP panels with reference to the probability of Internet user “initial interest confusion” – *i.e.*, by the time the user reaches and reads any disclaimer on a webpage to which the domain name resolves, any respondent objective of attracting visitors for financial advantage to its website through use of the trademark in the domain name will generally have been achieved [see also question 1.2 above].

A disclaimer may in fact show that the respondent had prior knowledge of the complainant's trademark or name. This, in turn, may support a finding that the respondent has acted in bad faith, as well as a finding that the respondent does not have rights or legitimate interests in the domain name [see also question 2.2 above]. The *lack* of a disclaimer on a website to which the domain name resolves may support a finding that the respondent's use of the domain name is deliberately misleading, and thus may provide evidence of bad faith use, as well as preclude a finding that the respondent has rights or legitimate interests in the domain name [see question 2.3 above].

Relevant decisions:

- [Australian Rugby Union v. Weeks](#), LEADR Case No. 09/05 (2005), <aru.com.au>, Transfer
- [Advanced Medical Institute Pty Limited v. World Wide Internet Services \(Aust.\) Pty Limited](#), IAMA Case No. 3021 (2006), <australianmedicalinstitute.com.au> *inter alia*, Transfer
- [Perpetual Limited v. Perpetual Home Loans Pty Ltd \(ACN 120010657\)](#), WIPO Case No. DAU2009-0009 (2009), <perpetualhomeloans.com.au>, Transfer

3.6 Can statements made in settlement discussions be relevant to showing bad faith?

The general position is the **same** as that under the UDRP.

Evidence of an offer to sell the domain name is generally admissible in proceedings under the auDRP, and is often used to show bad faith. This is so in relation to an offer to sell made by a respondent prior to filing of the complaint, as well as after filing of the complaint. An offer to sell the domain name made in settlement discussions may be seen as a “use” of the domain name for the purposes of showing bad faith, even if that is the respondent's only use of the domain name.

Relevant decisions:

- [Sterling Marine Pty Ltd v. EtoLin Pty Ltd](#), LEADR Case No. auDRP03/13 (2013), <cameroskiboats.com.au>, Transfer

- [Tyre Depot Holdings Pty Ltd v. Tyre Kingdom Pty Ltd.](#), WIPO Case No. DAU2014-0016 (2014), <tyredepot.com.au>, Transfer

3.7 Does the renewal of the registration of a domain name amount to a registration for the purposes of determining whether the domain name was registered in bad faith?

The position is *unknown*.

It appears that no auDRP case has yet addressed the issue of whether a renewal of a domain name amounts to a “registration” for the purposes of the Policy. Thus, it is not clear whether – and, if so, in what circumstances – renewal of a domain name registration in bad faith will be treated as a registration of the domain name in bad faith.

In any event, paragraph 4(a)(iii) of the auDRP requires that the domain name “has been registered or subsequently used in bad faith” for the third requirement to be satisfied. Unlike the equivalent provision in the UDRP, the word “and” is not used; thus, the issue of whether a complainant must establish both bad faith registration and bad faith use does not arise. As a result, the third requirement of the Policy will be satisfied if it is established that the respondent subsequently used the domain name in bad faith, even though the respondent’s initial registration of the domain name was in good faith [see question 3.1 above].

3.8 Can third party or “automatically” generated material appearing on a website form a basis for finding bad faith?

The position is *unknown*.

It appears that no auDRP case has yet addressed the issue of third party or automatically-generated material appearing on a website. Thus, it is not clear whether – and, if so, in what circumstances – third party or automatically-generated material appearing on a website to which the domain name resolves can form a basis for finding use of the domain name to be in bad faith.

3.9 Can use of a privacy or proxy registration service form a basis for finding bad faith?

The position is *unknown*.

It appears that no auDRP case has yet addressed the issue of use of a privacy or proxy registration service. Thus, it is not clear whether – and, if so, in what circumstances – use of such a service by the respondent will be found to be evidence of bad faith.

The reason for this is auDA’s policy prohibiting the use of privacy or proxy registration services (currently ‘2010-07 – Registrant Contact Information Policy’). Under paragraph 2.4(b) of that policy, a registrant must not “do anything which may have the effect of concealing the true identity of the registrant or the registrant contact (e.g. by using a private or proxy registration service), unless specifically permitted otherwise by another auDA published policy”. [See also question 4.9 below.]

3.10 Can the use of “robots.txt” or similar mechanisms to prevent website content being accessed in an on-line archive form a basis for finding bad faith?

The position is *unknown*.

It appears that no auDRP case has yet addressed the issue of use of “robots.txt” or similar mechanisms to prevent website content from being accessed in an on-line archive. Thus, it is not clear whether – and, if so, in what circumstances – use of such mechanisms by the respondent will be found to be evidence of bad faith.

3.11 Can tarnishment of a trademark form a basis for finding bad faith?

The position is **unknown**.

It appears that no auDRP case has yet addressed the issue of “tarnishment” of a trademark. Thus, it is not clear whether – and, if so, in what circumstances – use of the domain name to resolve to a website containing wholly inappropriate material (e.g., pornography) will be found to be evidence of bad faith.

4. PROCEDURAL QUESTIONS

4.1 What deference is owed to past auDRP and UDRP decisions dealing with similar factual matters or legal issues?

The general position is the **same** as that under the UDRP.

Panels deciding cases under the auDRP consider it desirable that their decisions are consistent with prior auDRP panel decisions dealing with similar fact situations. Thus, although the auDRP does not have a formal doctrine of precedent (*stare decisis*), panels tend to follow the approach of prior panels to the same issue, at least where a number of such panels have come to the same conclusion. One panel has gone so far as to state that “in the interests of consistency it is loathe to depart from an interpretation that has been followed by a number of distinguished panels ... even if the result could theoretically result in a conflict with the position under Australian national law”.

Where the relevant provision of the auDRP is the same as its equivalent provision in the UDRP, auDRP panels will treat UDRP decisions on that provision as equally persuasive as auDRP decisions on the issue.

Relevant decisions:

- [GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd](#), WIPO Case No. DAU2002-0001 (2003), <globalcentre.com.au> *inter alia*, Transfer
- [National Dial A Word Registry Pty Ltd and others v. 1300 Directory Pty Ltd](#), WIPO Case No. DAU2008-0021 (2008), <13cars.com.au> *inter alia*, Denial
- [American Future Technology Corp. v. Rex Hall](#), WIPO Case No. DAU2009-0007 (2009), <ibuypower.com.au>, Denial

4.2 Will the auDRP dispute resolution service provider put an unsolicited supplemental filing before a panel, and in what circumstances would a panel accept such filing?

The general position is the **same** as that under the UDRP.

Rule 12 of the auDRP Rules provides that, in addition to the complaint and the response, the panel may request or permit, in its sole discretion, further statements or documents from either of the parties. It appears that the service provider will, as a matter of course, put unsolicited statements before the panel, on the basis that it is for the panel to decide whether to admit such statements into the case record.

In exercising their discretion whether to accept an unsolicited supplemental filing from either party, panels bear in mind the need for procedural efficiency, the obligation to ensure that each party has a fair opportunity to present its case, and the obligation to treat each party with equality. Generally, panels will only accept an unsolicited supplementary filing in “exceptional” circumstances – such as where the information or evidence was unanticipated as relevant, or was unavailable, at the time of the original filing. The party submitting a supplemental filing would normally need to show its relevance to the case and why the circumstances are exceptional. In at least one case, the panel admitted the respondent’s supplemental filings, because they were submitted “only marginally later” than the response and gave details not previously provided to the complainant of a matter on which the

respondent relied in its response; the panel also admitted the complainant's supplementary filing insofar as it addressed that issue.

Panels that have accepted a supplemental filing from one side typically allow the other party the opportunity to file a reply to such supplemental filing. In either scenario, or on its own initiative, a panel may in its discretion request further evidence, information or statements from one or other of the parties by way of an administrative panel order.

Relevant decisions:

- [Jupitermedia Corporation and Australia.Internet.com Pty Ltd v. Spotpress Pty Ltd. trading as Internet Printing](#), WIPO Case No. DAU2003-0005, <internet.com.au>, Denial
- [Jenna IP Holding Company LLC v. Mobile Alive Pty Limited](#), WIPO Case No. DAU2006-0013, <clubjenna.com.au>, Transfer
- [Clark Equipment Company v. AllJap Machinery Pty Ltd](#), WIPO Case No. DAU2011-0042 (2012), <usedbobcats.com.au>, Transfer
- [Terra Plana International Ltd. v. The Summer House Australia Pty Ltd / Tanya Greenwood](#), WIPO Case No. DAU2012-0025 (2012), <vivobarefootaustralia.com.au> *inter alia*, Transfer
- [Brilliance Publishing, Inc. v. My Brilliance Pty Ltd / Ceinwen Schneider](#), WIPO Case No. DAU2013-0007 (2013), <brillianceaudiocollections.com.au> *inter alia*, Transfer
- [Productreview.com.au Pty Ltd v. Jobsearch Business Systems Pty Ltd](#), IAMA Case No. 3763 (2013), <productreviews.com.au>, Denial
- [M/s Info Edge \(India\) Limited v. Harjeet Singh / Harry Singh](#), WIPO Case No. DAU2013-0022 (2013), <99acres.com.au>, Transfer

4.3 What is the proper language of the proceeding and what are the relevant considerations in this regard?

The position is **unknown**.

Paragraph 11 of the auDRP Rules provides that the language of the proceeding is the language of the registration agreement, unless both parties agree otherwise, or the panel determines otherwise having regard to the circumstances of the proceeding.

It appears that no auDRP case has yet addressed the issue of the proper language of the proceedings. Thus, it is not clear whether – and, if so, in what circumstances – the proper language of the proceedings will be other than the language of the registration agreement (as per paragraph 11 of the auDRP Rules).

4.4 Under what circumstances can a refiled case be accepted?

The general position is the **same** as that under the UDRP.

A refiled case is one where the complainant submits a second complaint involving the same domain name(s) and the same respondent(s) as in an earlier complaint that was denied. A refiled case will only be accepted in limited circumstances. These circumstances include: (i) that relevant new actions have occurred since the original decision; (ii) that a breach of natural justice or of due process occurred; or (iii) that there was some other serious misconduct in the original case, such as perjured evidence. A refiled complaint would usually also be accepted if it includes newly presented evidence that was reasonably unavailable to the complainant during the original case.

In certain, highly limited circumstances, a panel in a previous case may have found it appropriate to record in its decision that a future refiled complaint should be accepted if certain conditions are met. Where this has occurred, the extent to which any such previously-stipulated panel conditions have been met may also be a relevant consideration in determining whether the refiled complaint should be accepted.

Relevant decisions:

- [Curtain Communications Pty Ltd. v. Leann Webb](#), WIPO Case No. DAU2008-0022 (2008), <alphakids.com.au>, Denial

- [*Doteasy Technology Inc. v. M Makras & E.A Nahed, Dot Easy*](#), WIPO Case No. DAU2011-0041 (2012), <doteasy.com.au> *inter alia*, Denial
- [*Inbound Telecommunications Pty Ltd, Phonename Marketing Australia Pty Ltd v. 1300 Directory Pty Ltd, Demetrio Padilla*](#), WIPO Case No. DAU2009-0018 (2010), <1300fitness.com.au> *inter alia*, Denial

4.5 May a panel perform independent research when reaching a decision?

The general position is the **same** as that under the UDRP.

Panels have undertaken limited factual research into matters of public record where it has considered this necessary to reach the right decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent and the use of the domain name, consulting an Internet archive repository in order to obtain an indication of how a domain name may have been used in the past, reviewing dictionaries or encyclopedias to determine any common meaning of words, or discretionary referencing of online trademark registration databases. A panel may also rely on personal knowledge.

Relevant decisions:

- [*Frenbray Pty Ltd v. Weyvale Pty Ltd*](#), LEADR Case No. auDRP06/06 (2006), <newcars.com.au>, Denial
- [*Google Inc. v. Dmitri Rytsk*](#), WIPO Case No. DAU2007-0004 (2007), <googlebay.com.au>, Transfer
- [*SKYCITY Adelaide Pty Limited v. Trellian Pty Ltd*](#), IAMA Case No. 3353 (2009), <adelaidecasino.com.au>, Transfer
- [*Virtual Industries Group Ltd v. Mr Simon Totonjian*](#), LEADR Case No. auDRP03/12 (2012), <schoolinterviews.net.au> *inter alia*, Transfer / Denial

4.6 Does failure of a respondent to respond to the complaint (respondent default) automatically result in the complainant being granted the requested remedy?

The general position is the **same** as that under the UDRP.

A respondent's default does not automatically result in a decision in favor of the complainant. Subject to the principles described in question 2.1 above with regard to the second element of the auDRP, the complainant must establish each of the three elements required by paragraph 4(a) of the Policy. However, panels may draw appropriate inferences from a respondent's default, including that the complainant's factual allegations that are not inherently implausible are true, and that any evidence the respondent might have given would not have been in its favour.

Relevant decisions:

- [*MGM Home Entertainment, Metro-Goldwyn-Mayer Lion Corporation, Metro-Goldwyn-Mayer Studios Inc. v. Mclroy Group Management Pty Ltd.*](#), WIPO Case No. DAU2003-0006, <mgm.com.au>, Denial
- [*Supre Pty Ltd v. Paul King*](#), WIPO Case No. DAU2004-0006, <supre.com.au>, Transfer
- [*Jasham Pty Ltd v. Perfume Empire Pty Ltd*](#), LEADR Case No. auDRP01/06 (2006), <jasham.com.au>, Transfer
- [*Harness Racing Australia v. Acronym Wiki Pty Ltd*](#), WIPO Case No. DAU2011-0007, <hra.com.au>, Transfer

4.7 What is the standard of proof under the auDRP?

The general position is the **same** as that under the UDRP.

The general standard of proof under the auDRP is “on balance” – often expressed as the “balance of probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party would typically need to establish that it is more likely than not that the claimed fact is true.

Relevant decisions:

- [WOW Audio Visual Superstores Pty. Ltd. v. Comonoz Pty. Ltd.](#), WIPO Case No. DAU2007-0003 (2007), <wow.com.au>, Denial
- [ESPA International \(UK\) Limited v. Espa of Australia Pty Ltd.](#), WIPO Case No. DAU2011-0010 (2011), <espa.net.au>, Transfer
- [Victoria's Secret Stores Brand Management, Inc. v. Linda Cameron Pickard](#), WIPO Case No. DAU2012-0015, <victoriassecrets.com.au>, Denial

4.8 Under what circumstances may further domain names be added to a filed complaint?

The position is *unknown*.

Paragraph 3(c) of the auDRP Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain holder [see question 4.8A below]. However, the Rules and the Policy are silent on when additional domain names may be *added* to a complaint after it has been filed.

It appears that no auDRP case has yet addressed the issue of adding further domain names to a complaint that has already been filed. Thus, it is not clear whether – and, if so, in what circumstances – additional domain names may be added to a complaint after it has been filed.

4.8A Under what circumstances may a complaint be filed in relation to multiple domain names?

The position is *uncertain*.

Paragraph 3(c) of the auDRP Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain holder.

One auDRP panel, citing advice from auDA that the paragraph 3(c) proviso is intended to apply strictly, has refused to permit a single complaint to be brought in relation to multiple domain names where the registrant of each domain name was not the same person, even though the complainant contended that the registrants “had a unity of interest under related control”. However, another auDRP panel has permitted a single complaint to be brought in relation to multiple domain names even though the registrant of each was a separate legal entity, in circumstances where: (i) the two registrants were sufficiently closely associated or related to mean that the domain names were subject to common control (the first, an individual, was the Director and Company Secretary of the second, a company); and (ii) there was no denial of a relationship between the two respondents made in the single response filed (by the first respondent).

[See question 4.16(ii) below on the issue of when a single consolidated complaint can be brought against multiple respondents.]

Relevant decisions:

- [Jacuzzi, Inc. v. Wangra Pty Ltd](#), WIPO Case No. DAU2005-0001 (2005), <jacuzzispas.com.au>, Denial
- [Smart Voucher Ltd T/A Ukash v. Chowdhury, MD Abu Russel and Sydney Business & Technology Group Pty Ltd](#), WIPO Case No. DAU2013-0006 (2013), <ukash.com.au> *inter alia*, Transfer

4.9 Who is the proper respondent in a case involving a privacy or proxy registration service?

The position is *unknown*.

It appears that no auDRP case has yet addressed the situation where the named registrant of the domain name is a privacy or proxy registration service. Thus, it is not clear whether – and, if so, in what circumstances – the proper respondent can or should be a privacy or proxy registration service.

The reason for this is auDA's policy prohibiting the use of privacy or proxy registration services (currently '2010-07 – Registrant Contact Information Policy'). Under paragraph 2.4(b) of that policy, a registrant must not “do anything which may have the effect of concealing the true identity of the registrant or the registrant contact (e.g. by using a private or proxy registration service), unless specifically permitted otherwise by another auDA published policy”. [See also question 3.9 above.]

4.9A Who is the proper respondent generally?

The general position is **somewhat different** from that under the UDRP.

Paragraph 1 of the auDRP Rules defines the “respondent” to be “the holder of a domain name registration against which a complaint is initiated”. Consistent with this, paragraph 3(b) (v) of the auDRP Rules requires that “the name of the Respondent (domain name holder)” be provided in the complaint.

It is clear that the entity listed in the relevant WHOIS record as being the registrant of the domain name is a “holder” of the domain name. What is not clear, however, is when other entities can also be treated as a “holder” of the domain name. At least one auDRP panel has held that a complaint filed against an individual who was most likely related to the company identified as the registrant of the domain name – in the capacity of being either a Director or Company Secretary of the company – was not brought against the proper respondent; and, for this reason, the complaint was denied.

Relevant decisions:

- [Bikram Yoga Australia Pty Ltd v. Mark Reinierse](#), LEADR Case No. auDRP17/10 (2010), <bikramyoga.com.au>, Denial
- [Clark Equipment Company v. AllJap Machinery Pty Ltd](#), WIPO Case No. DAU2011-0042 (2012), <usedbobcats.com.au>, Transfer

4.10 Does delay in bringing a complaint prevent a complainant from filing under the auDRP?

The general position is the **same** as that under the UDRP.

auDRP panels have recognised that the doctrine or defence of laches does not generally apply under the auDRP. Thus, delay in bringing a complaint (judged by reference to the time since registration of the disputed domain name) does not, of itself, prevent a complainant from filing under the auDRP or from succeeding under the auDRP.

However, panels have also noted that a delay in bringing a complaint may make it more difficult for a complainant to establish its case on the merits, especially in relation to the second and third elements of the Policy. In particular, delay in bringing a complaint in the situation where the respondent is using the domain name in connection with relevant goods or services may result in the respondent acquiring a right or legitimate interest in the domain name, when it previously had none, that is sufficient to defeat a claim under the Policy – even where the initial registration of the domain name was in bad faith.

Relevant decisions:

- [Jacuzzi, Inc. v. Wangra Pty Ltd](#), WIPO Case No. DAU2005-0001 (2005), <jacuzzispas.com.au>, Denial
- [Colmar Brunton Pty Ltd v. Alta Computer Systems Pty Ltd](#), LEADR Case No. auDRP18/10 (2010), <opinionspaid.com.au>, Denial
- [Clinic Care Pty Limited v. Emma Redgate Payne \(also known as Emma Johnson\)](#), WIPO Case No. DAU2011-0027 (2011), <dermaroller.com.au>, Denial

- [Victoria's Secret Stores Brand Management, Inc. v. Linda Cameron Pickard](#), WIPO Case No. DAU2012-0015 (2012), <victoriassecrets.com.au>, Denial

4.11 Can a registrar be liable as a registrant under the auDRP?

The position is *unknown*.

It appears that no auDRP case has yet addressed the situation where the named registrant of the domain name is a registrar. Thus, it is not clear whether – and, if so, in what circumstances – the proper respondent can or should be a registrar. However, given the approach of auDRP panels to the issue of who is the proper respondent [see question 4.9A above], there appears to be no reason why a registrar could not be subject to an auDRP complaint in the event that it is the named registrant of a domain name.

4.12 Can auDRP proceedings be suspended for purposes of settlement?

The position is *unknown*.

Paragraph 17(a) of the auDRP Rules states that if, before the panel's decision, the parties agree on a settlement, the panel shall terminate the administrative proceeding. However, the Rules and the Policy are silent on whether a panel can and should suspend proceedings during, or to permit, settlement discussions.

It appears that no auDRP case has yet addressed the issue of suspending a complaint for the purposes of settlement. Thus, it is not clear whether – and, if so, in what circumstances – a complaint should be suspended during, or to permit, settlement discussions.

4.13 Can a panel decide a case under the auDRP based on a respondent's consent to transfer?

The general position is the *same* as that under the UDRP.

Where a respondent has stated, either in its response or some other communication to the panel, that it consents to a transfer of a domain name, auDRP panels have given effect to this by ordering transfer without consideration of whether the paragraph 4(a) requirements of the Policy are satisfied. For this to occur, the respondent's consent to transfer must be genuine, unconditional and unilateral. Where the consent to transfer is conditional – e.g., in return for payment of a fee – panels generally proceed to consider the merits of the complaint.

Relevant decisions:

- [People Telecom Limited v. A Marshall Computer Services Pty Ltd](#), LEADR Case No. auDRP03/04 (2004), <people.net.au>
- [ABC Learning Centres Limited v. MJ Central Pty Ltd](#), LEADR Case No. auDRP04/04 (2004), <abclearningcentres.com.au> *inter alia*, Transfer
- [PARROT v. Binh An Nguyen](#), WIPO Case No. DAU2011-0016 (2011), <ardrone.com.au>, Transfer
- [Marvel Characters, Inc. Pixar and Disney Enterprises Inc v. Jason Carmody, James Kite](#), WIPO Case No. DAU2013-0036 (2013), <avengers.com.au> *inter alia*, Transfer

4.14 What is the relationship between auDRP proceedings and court proceedings?

The general position is the *same* as that under the UDRP.

Paragraph 4(k) of the auDRP states that neither the complainant nor the respondent is prevented from submitting the dispute to a court of competent jurisdiction for independent resolution, either before an administrative proceeding under the Policy has commenced or after it has concluded. Where either party initiates legal proceedings in relation to a domain name the subject of a complaint, either prior to or during the administrative proceeding,

paragraph 18(a) of the auDRP Rules provides that the panel has the discretion to decide whether to suspend, to terminate or to continue with the proceeding.

Although at least one auDRP panel has considered a request under paragraph 18(a) of the auDRP Rules to suspend or terminate a complaint due to a pending court proceeding, it appears that no auDRP panel has yet exercised its discretion to do so. In considering whether to exercise this discretion (which it declined), one panel took account of the following factors: (i) paragraph 4(k) contemplates the parallel operation of both auDRP and court proceedings; (ii) even where both sets of proceedings deal with the same issues and offer similar relief, court proceedings are determined using very different rules of evidence and procedure; and (iii) a decision to terminate or suspend proceedings requires strong justifying circumstances, to ensure the result is not at odds with the purpose of the Policy, described in paragraph 1.2 of the 'Background' to the Policy as being "to provide a cheaper, speedier alternative to litigation for the resolution of disputes between the registrant of a .au domain name and a party with competing rights in the domain name".

Relevant decisions:

- [Jacuzzi, Inc. v. Wangra Pty Ltd](#), WIPO Case No. DAU2005-0001 (2005), <jacuzzispas.com.au>, Denial

4.15 To what extent is national law relevant to a panel assessment of rights and legitimate interests and/or bad faith?

The general position is the **same** as that under the UDRP.

Paragraph 15 (a) of the auDRP Rules provides that a panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable. Like the UDRP from which it is adapted, the auDRP is rooted in generally-recognised principles of trademark law and is designed to operate in the context of the Internet – and, for this reason, generally does not require resort to concepts or jurisprudence specific to national law. In the few cases where a panel has referred to Australian legal principles or case law, it has been to trademark law, either for the purpose of assessing whether the complainant has rights in a trademark or for determining whether the respondent has rights or legitimate interests in a domain name.

Relevant decisions:

- [The Crown in Right of the State of Tasmania trading as "Tourism Tasmania" v. Gordon James Craven](#), WIPO Case No. DAU2003-0001 (2003), <discover-tasmania.com.au>, Denial
- [Emirates, Emirates Group v. Bluecom Consulting Group Pty Ltd](#), WIPO Case No. DAU2008-0004 (2008), <emirates.com.au>, Denial

4.16(i) Can multiple complainants bring a single consolidated complaint against a respondent?

The general position is the **same** as that under the UDRP.

While the Policy and the Rules neither expressly permit nor expressly prohibit a consolidation of multiple complainants in a single complaint against a respondent, such consolidation will be permitted where the multiple complainants have a "common grievance" against the respondent, subject to the general requirement that it is equitable and procedurally efficient to have consolidation.

The most obvious case of multiple complainants having a common grievance against a single respondent is where the complainants have a *common legal interest* in the rights on which the complaint is based. Examples of such a common legal interest include: (i) where the multiple complainants have a shared interest in a trademark, such as may exist between a licensor and a licensee; (ii) where the multiple complainants form part of a single entity, such as being individual companies that are part of a larger corporate group or a joint venture; and (iii) where the multiple complainants are members of an association or league – such as an

authors' guild, an artists' collecting society or a sporting association – which is authorised to enforce the members' rights.

Where the multiple complainants do not have a common legal interest in the rights on which the complaint is based, the complainants would need to make a compelling case that the respondent has engaged in *common conduct* that has affected their individual rights in like fashion. Examples of conduct affecting individual rights in like fashion include: (i) where the respondent has clearly targeted multiple rights holders; (ii) where the rights relied on and all of the domain names complained about involve certain obvious and specific commonalities; and (iii) where there appears to be a clear pattern to the registration and use of all disputed domain names.

Factors that are relevant to determining whether or not a consolidation would be equitable and procedurally efficient include the number of complainants and the strength of the contest between the complainants and the respondent over the substantive aspects of the complaint. Multiple complainants to a complaint should decide between themselves, and state in the complaint, which complainant is to receive transfer of which domain name(s) in the event the complaint is successful [see also question 4.16A below].

Relevant decisions:

- [*National Dial A Word Registry Pty Ltd and others v. 1300 Directory Pty Ltd*](#), WIPO Case No. DAU2008-0021 (2008), <13cars.com.au> *inter alia*, Denial
- [*HCOA Pty Ltd, Molescan Australia Pty Ltd v. The Trustee for the Terantica Trust / Terry Lockitch*](#), WIPO Case No. DAU2013-0003 (2013), <molescan.com.au>, Transfer

4.16(ii) Can a single consolidated complaint be brought against multiple respondents?

The position is *uncertain*.

Paragraph 3(c) of the auDRP Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain holder.

auDRP panels have come to different views on whether the proviso in paragraph 3(c) has the effect of prohibiting consolidation of a single complaint against multiple respondents that are not the one and the same entity as the registrant of the domain names. Whereas one panel refused to permit consolidation even though the complainant contended that the registrants "had a unity of interest under related control", another panel permitted a single complaint to be brought in relation to multiple registrants where they were sufficiently closely associated or related to mean that the domain names were subject to common control. [See also question 4.8A above.]

Relevant decisions:

- [*Jacuzzi, Inc. v. Wangra Pty Ltd*](#), WIPO Case No. DAU2005-0001 (2005), <jacuzzispas.com.au>, Denial
- [*Smart Voucher Ltd T/A Ukash v. Chowdhury, MD Abu Russel and Sydney Business & Technology Group Pty Ltd*](#), WIPO Case No. DAU2013-0006 (2013), <ukash.com.au> *inter alia*, Transfer

4.16A To whom should a domain name be transferred in the event a complaint brought by multiple complainants succeeds?

The general position is *similar* to that under the UDRP.

The practice of domain name registration is generally that only one entity is listed as the registrant of a domain name. For this reason, where a complaint is successfully brought under the Policy by multiple complainants and the remedy sought by the complainants is transfer of the disputed domain name, the issue arises as to which of the complainants the panel should order the transfer of the domain name.

As a matter of principle, a panel should only order transfer of a domain name to a complainant that, in its individual capacity, has an entitlement to the trademark(s) on which the complaint is based. In a case brought by multiple complainants where more than one of the complainants has entitlement to the trademark(s) on which the complaint is based, the decision about to which of the complainants the domain name should be transferred preferably should be decided by the complainants, not the panel.

Where the complainants have the same interest in the domain name and the remedy requested is transfer to all complainants, it is permissible for the panel to choose to which of the complainants to transfer the domain name. Where, however, the complainants' interests in the domain name are divergent, the complainants request an ambiguous remedy by not stating to which of the complainants the contested domain name should be transferred, or the complainants have avoided the identification of each party's stake in the remedy, it is generally considered impermissible for the panel to choose one of the complainants to which to transfer the domain name; in that situation, an order of cancellation has been made instead.

Relevant decisions:

- [Jupitermedia Corporation and Australia.Internet.com Pty Ltd v. Spotpress Pty Ltd. trading as Internet Printing](#), WIPO Case No. DAU2003-0005 (2003), <internet.com.au>, Denial
- [Premier Fire Protection Services \(NSW\) Pty Ltd and Premier Fire Services \(NSW\) Pty Ltd v. Nixon Safety Pty Ltd](#), LEADR Case No. auDRP07/05 (2005), <premierfire.com.au> *inter alia*, Cancellation
- [The Calvin Klein Trademark Trust and Calvin Klein, Inc v. Yangjae Kim \(t/a Primary Blue\)](#), LEADR Case No. auDRP08/08 (2008), <calvinklein.com.au>, Cancellation
- [HCOA Pty Ltd, Molescan Australia Pty Ltd v. The Trustee for the Terantica Trust / Terry Lockitch](#), WIPO Case No. DAU2013-0003 (2013), <molescan.com.au>, Transfer

4.17 In what circumstances should a finding of Reverse Domain Name Hijacking or abuse of process be made?

The general position is the **same** as that under the UDRP.

Paragraph 15(e) of the auDRP Rules provides that, if the panel finds that the complaint “was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder”, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. Paragraph 1 of the auDRP Rules defines “Reverse Domain Name Hijacking” to be “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name”.

Circumstances that panels have considered to be indicative of a complaint having been brought in bad faith include: (i) the complainant knew it had no rights in the trademark or name upon which it relied and nevertheless brought the complaint; (ii) the complainant had, by the time the complaint was filed, been informed of and had otherwise ascertained all the facts necessary, to establish that the respondent had legitimate interests in the disputed domain name; (iii) the complainant had, in communications with the respondent, expressly acknowledged that the respondent had rights to the domain name; (iv) the complainant had knowledge of the respondent's rights or legitimate interests in the domain name and engaged in harassment or similar conduct in the face of such knowledge (such as repeated cease-and-desist communications, or prolonging the dispute in order to exploit superior financial resources); (v) the complainant had known from the beginning that its rights in the domain name were not exclusive, that the domain name was generic, and that the domain name described the activities for which the respondent used it; (vi) the complainant knew that its trademark was limited to a narrow field, and that the respondent's registration and use of the domain name could not, under any fair interpretation of the facts, constitute bad faith; and (vii) the complainant intentionally attempted to mislead the panel by omitting relevant evidence.

A finding of Reverse Domain Name Hijacking will rarely be made where there is a genuine dispute. Where a complainant has an arguable case that is merely weak on the evidence, a panel is unlikely to find the complaint to have been brought in bad faith.

Relevant decisions:

- [*The Crown in Right of the State of Tasmania trading as "Tourism Tasmania" v. Gordon James Craven*](#), WIPO Case No. DAU2003-0001 (2003), <discover-tasmania.com.au>, Denial
- [*WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd*](#), WIPO Case No. DAU2007-0003 (2007), <wow.com.au>, Denial
- [*Blurb Inc. v. Rethink IT PTY Ltd.*](#), WIPO Case No. DAU2009-0008 (2009), <blurb.com.au>, Denial
- [*United Parcel Service of America, Inc. v. Wesley Bryant*](#), WIPO Case No. DAU2009-0012 (2010), <pickupsonline.com.au>, Denial
- [*Environics Pty Ltd v. Connectus Pty Ltd*](#), LEADR Case No. auDRP03/09 (2009), <engineer.com.au>, Denial
- [*Adjudicate Today Pty Limited v. The Institute of Arbitrators and Mediators*](#), WIPO Case No. DAU2012-0033, (2013) <adjudicate.org.au>, Denial
- [*Cairns Airport Pty Ltd. v. Chris Ford \(Christopher William Ford\) / C and C Family Discretionary Trust*](#), WIPO Case No. DAU2013-0023 (2013), <cairnsairportparking.com.au> *inter alia*, Denial
- [*Stephens Valuation and Consultancy Pty Ltd v. SLR Consulting Australia Pty Ltd*](#), WIPO Case No. DAU2013-0026 (2013), <quarryvaluations.com.au> *inter alia*, Denial