

**RESOLUTION INSTITUTE DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL**

**Case No <auDRP\_16\_05>**

**Three Member Panel Decision**

Berkshire Hathaway Specialty Insurance Company (ABN 84 600 643 034)

v.

Sonarpia Pty Limited (ABN 84 104 232 082)

**<berkshirehathaway.com.au>**

**1. The Parties**

The Complainant is Berkshire Hathaway Specialty Insurance Company (ABN 84 600 643 034) Victoria, Australia, represented by Clyde & Co, of Sydney, Australia.

The Respondent Sonarpia Pty Limited (ABN 84 104 232 082) is apparently unrepresented and has communicated through a Mr Charles Pratten, its director, and by alleged employee of his, one Susan Stephenson.

**2. The Domain Name and Registrar**

The disputed domain name <berkshirehathaway.com.au> (the “Domain Name”) is registered with Enetica Pty Limited (the “Registrar”).

**3. Procedural History**

The Complaint was filed with Resolution Institute on June 1, 2016. It was reviewed for administrative compliance by Resolution Institute on June 2, 2016. A copy of the Complaint was emailed to the Registrar on June 2, 2016 with a request to clarify the Respondent’s details and lock the Domain Name during proceedings. On June 7, 2016 the Registrar confirmed via email that the Domain Name in dispute had been locked. Resolution Institute advised auDA of the Complaint on June 7, 2016 via e-mail.

Pursuant to Paragraph 4(a) of the Rules for the auDRP (the “auDRP Rules”), on June 7, 2016 Resolution Institute sent the Respondent an email and written notification of the Complaint and annexures lodged against it in the manner prescribed by Paragraph 2(a) of the auDRP Rules. This Complaint therefore commenced on that date in accordance with Paragraph 4(d) of the auDRP Rules.

The due date for the response to the Complaint was confirmed to be June 27, 2016.

On June 17, 2016, on the email account of Charles Pratten, one Susan Stephenson, claiming to work for Mr Pratten, acknowledged receipt of the Complaint and supporting documents 'at our Victoria Road address' and stated that 'Mr Pratten has asked that you send any forms required for him to hand over the domain name as per your client's request'.

The solicitors for the Complainant on June 21, 2016 confirmed that the Complainant wanted to continue with its application for dispute resolution under the auDRP for determination by a three member panel.

No response has been received by Resolution Institute in accordance with the requirements of Paragraph 5(a) of the auDRP Rules nor has any request been made by or on behalf the Respondent for any extension of the date for such response.

On June 29, 2016 Resolution Institute approached each of the proposed Panellists. The Panellists each confirmed his availability, informed Resolution Institute that he had no conflict issues with the named parties by signing a *Statement of Impartiality and Independence* and accepted the matter on June 29, 2016. The three member panel of David Levin Q.C. (chair), Anthony Alder and Dr Andrew F. Christie was duly appointed on June 30, 2016 and the case file and relevant correspondence was forwarded to them on that day. The parties to the dispute were notified of the case allocation to the Panel on June 30, 2016. The Panel is satisfied that it was properly constituted.

The Panel is satisfied that this Domain Name dispute is subject to the auDRP and falls within the requirements resolution in a mandatory administrative proceeding as prescribed in Paragraph 4(a) of the auDRP. This dispute is therefore conducted in accordance with the auDRP, the auDRP Rules and the Resolution Institute's Supplemental Rules (auDRP 2016-01) ("the Supplemental Rules").

#### **4. Factual Background**

The Complainant is incorporated in the United States of America and since August 12, 2014 it has been registered in Australia as a foreign company and carries on the business as an insurance company in Australia. According to the unchallenged contentions the Complainant's ultimate parent company is Berkshire Hathaway, Inc.

Since the registration date of May 6, 2015 the Complainant has been the owner of Australian Registered Trade Mark No. 1691091 BERKSHIRE HATHAWAY INSURANCE AUSTRALIA and LOGO ("the trade mark").

The Respondent is incorporated in Australia and its sole director and shareholder is Mr Timothy Charles Pratten of Unit 4A, 3 Victoria Road, Parramatta, NSW, 2150. A person identified as Mr Charles Timothy Pratten of the identical address, namely Unit 4A, 3 Victoria Road, Parramatta, NSW, 2150 is recorded on the ASIC Register as a sole director and shareholder of Rural & General Insurance Broking Pty Limited (“RGIB”). RGIB was incorporated in Australia and carries on the business of an insurance broker in Australia.

The Domain Name was registered with the Registrar on 10 November 2015 by the Respondent, and the Whois Lookup records the contact name for the registrant as Charles Pratten. On or about 10 March 2016 the Complainant discovered that the Respondent had registered the Domain Name and appeared to be permitting RGIB to use the said Domain Name.

By a letter from the Complainant's solicitors (Clyde & Co) to the Respondent dated 15 March 2016, (“the cease and desist letter”) the solicitors stated that the Respondent ‘appears to be permitting RGIB to use the Domain [Name]’. It referred to the substantial global goodwill and reputation of the Complainant and its ultimate holding company Berkshire Hathaway, Inc in the name and mark ‘Berkshire Hathaway’. It requested a written undertaking from the Respondent, on terms acceptable to the Complainant, to immediately transfer any and all rights in and to the Domain Name to the Complainant, and to cease and desist from all use of that Domain Name.

By an email sent by Charles Pratten (apparently written on behalf of the Respondent, the name of which appeared under his name) to Clyde & Co on 30 March 2016 in response to the cease and desist letter, Mr Pratten did not dispute any of the allegations. Indeed he conceded that the Domain Name had been redirected to RGIB but claimed that “...*the redirect of the subject domain name [to RGIB] was an error caused by a previous domain registration consultant we had; as soon as your letter was received the redirect was removed.*” Mr Pratten also made an offer on a ‘without prejudice’ basis to the Complainant.

## **5. Parties’ Contentions**

### **A. Complainant**

The Complainant makes the following contentions:

- (i) that the Domain Name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, contrary to Paragraph 4(a)(i) of the auDRP.

- (ii) that the Respondent has no rights or legitimate interests in respect of the Domain Name, contrary to Paragraph 4(a)(ii) of the auDRP;
- (iii) that the Domain Name has been registered and/or is subsequently being used in bad faith, contrary to Paragraph 4(a)(iii) of the auDRP; and
- (iv) it appears that the Respondent has registered the Domain Name for the sole purpose of resale or transfer to the Complainant in breach of the prohibition of such registration under paragraph 8 of Schedule A to the Domain Name Eligibility and Allocation Policy Rules for Open 2LDS, Policy No. 2012-04 (Eligibility Rules).

The Complainant maintains that it has substantial global goodwill and reputation in the name and service mark 'Berkshire Hathaway'. The Respondent has not sought to dispute this contention. The Complainant has produced evidence of the trade mark of which it is the owner which incorporates the words 'Berkshire Hathaway', words which, in an amalgamated form, comprise the Domain Name.

The Complainant contends that the Domain Name <berkshirehathaway.com.au> is confusingly similar to the Complainant's name and the trade mark.

The Claimant maintains that it has given no right or interest to the Respondent which authorises the Respondent's use of the words which, in the amalgamated form, comprise the Domain Name. The Respondent has not been licensed or authorised by the Complainant to register the Domain Name. The Respondent does not have any other apparent rights in the Domain Name, nor does it appear to be commonly known by the Domain Name.

## **B. Respondent**

The Respondent has neither responded to the Complaint nor challenged any of the Complainant's allegations and supporting evidence.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Panel accepts that the Complainant is registered as a foreign company with ASIC and is the owner of the trade mark. The auDRP has determined (as footnoted therein) that a 'name' in the context of Paragraph 4(a)(i) refers, inter alia, to a company name that is registered with the relevant Australian government authority. The Complainant's name is registered with ASIC and so falls within the description of a 'name' for the purposes of this Paragraph.

Both its name and the trade mark include the words “Berkshire Hathaway”, words which in an amalgamated form comprise the substance of the Domain Name (ignoring the suffix ‘.com.au’). The Panel is satisfied that the Domain Name is confusingly similar to the Complainant’s name, and trade mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

### **B. Rights or Legitimate Interests**

To succeed on this element, a Complainant may make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. If such a *prima facie* case is made out, then the evidentiary burden shifts to the Respondent to demonstrate any such claimed rights or legitimate interests. On the evidence a *prima facie* case has been established that the Respondent lacks rights or legitimate interests in the Domain Name.

No attempt was made by the Respondent in its response to the cease and desist letter or in response to the Complaint to contend for or provide evidence in support of activities which might come within Paragraph 4(a)(ii) of the auDRP and demonstrate rights or legitimate interests in the Domain Name.

The Panel is satisfied that the Respondent is not affiliated with the Complainant in any way. It has not been authorised by the Complainant to register or use the Domain Name nor to seek the registration of any domain name incorporating the trade mark or any amalgamation of words derived therefrom. There is no evidence that the Respondent is commonly known by the Domain Name or by any similar name. There is no evidence that the Respondent has used the Domain Name in connection with a legitimate non-commercial use.

The Panel determines that the Respondent has no rights or legitimate interests in the Domain Name

### **C. Registered or Subsequently Used in Bad Faith**

For the purposes of paragraph 4(a)(iii) of the auDRP, if the Panel finds that

“by using the domain name, [the Respondent] intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location ”

shall be evidence of the registration and use of a domain name in bad faith: see Paragraph 4(b)(iv) of the auDRP.

It is admitted by the Respondent that the Domain Name was used to redirect web traffic to RGIB, a company established by the Complainant to be associated with Mr Pratten and the Respondent. RGIB is an insurance broker. It is a company trading in the same industry as the Complainant. No Response has been filed by the Respondent seeking to explain or justify the redirecting of such traffic. The Panel is in the circumstances satisfied that the Respondent was seeking to trade on the reputation of the Complainant in the insurance industry by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the RGIB website or service on that website.

Having come to the above conclusions, and resolving the contentions under Paragraph 4(a) of the auDRP in favour of the Complainant, the Panel does not address the issue raised by the Complainant in its fourth contention, namely the registration of the Domain Name for the sole purpose of resale or transfer to the Complainant in breach of the prohibition of such registration under paragraph 8 of Schedule A to the Domain Name Eligibility and Allocation Policy Rules for Open 2LDS. The evidence relied upon by the Complainant in relation to this issue is grounded upon an offer made on a 'without prejudice' basis to the Complainant in the Respondent's email reply to the cease and desist letter. Given the Panel's conclusion, that the Complainant has established its Complaint regardless of a determination of this issue, the Panel does not need to embark on any analysis of the somewhat contentious area of the effectiveness or otherwise of 'without prejudice' offers in the context of administrative proceedings.

## **7. Decision**

For all the foregoing reasons, the Complaint is upheld and in accordance with the Complaint the licence to the Domain Name is to be transferred to the Complainant.



**David Levin Q.C.**

Chair



**Anthony Alder**

Panelist



**Dr Andrew F. Christie**

Panelist

**Date:** July 12, 2016