



Resolution Institute **auDRP_18_08**

Domain Name Administrative Panel

Andre Geske

Complainant

and

Adultshop.com Pty Ltd as The Trustee for The Adultshop Trust

Respondent

Three member panel

Determination re: satisfyer.com.au & satisfier.com.au

Procedural History and summary of outcome

- 1.1 The complaint was submitted to Resolution Institute (RI) on 12 September 2018 for decision in accordance with the .au Domain Name Dispute Resolution Policy (“the auDRP” or “the Policy”). The Policy was approved by auDA in 2001, commenced operation on 1 August 2002 and was most recently approved by the auDA Board and published as Policy 2016-01 on 15 April 2016. The Policy includes the Rules for .auDRP (“the Rules”) and the Resolution Institute (RI) Supplementary Rules for .auDRP (“the Supplemental Rules”). The Complainant requested determination of the complaint by a three-member panel.
- 1.2 On 17 September 2018, RI acknowledged receipt of the complaint.
- 1.3 On 17 September 2018, RI transmitted by email to TPP Wholesale Pty Ltd a request for registrar verification and to lock the Disputed Domain Names during proceedings. The registrar confirmed locking of the Disputed Domain Names on 19 September 2018.

- 1.4 On 20 September 2018 RI notified auDA of the complaint and also sent the Respondent a copy of the complaint by email and post, confirming that the due date for response was 10 October 2018.
- 1.5 On 9 October 2018 RI received the response from the Respondent. Procedures for nominating and appointing a three-member panel were completed on 15 October 2018.
- 1.6 On 15 October 2018 the parties were notified of the panel allocation. RI forwarded the case file to the appointed panel comprising Jennifer Scott (Chair), Gregory Burton SC and Andrew Robertson. The Panel finds that it was properly constituted. All members of the panel have submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by RI to ensure compliance with the Rules, paragraph 7.

Outline of parties' contentions

The Complainant's contentions

2. The Complainant resides in Lubbecke, Germany and is represented by Keypoint Law, Melbourne. The Complainant relies upon the following matters (summarised) in support of its application to have the domain names transferred to him:
 - 2.1. The Complainant, in conjunction with his companies including EIS GmbH (**EIS**), Triple A Marketing GmbH and Domainhandel Bielefeld GmbH (collectively the Complainant), registered the brand and trademark and domain name 'Satisfyer.com' on 29 November 2015, with its website live from that domain name since approximately 1 April 2016. It launched the SATISFYER brand (connected with adult toys and accessories) in Germany in March 2016 with sales scheduled to commence on 16 April 2016. The Complainant also began to market the brand globally. In June 2016, the Complainant commenced selling and marketing products in Australia. Initially, sales into Australia were made by EIS GmbH, switching to Triple A Marketing GmbH in January 2018 following an internal restructure. Three Australian distributors have been authorised to distribute the products in Australia. Australia is a significant market for the Complainant.
 - 2.2 The Complainant has provided details of 26 registered trademarks for the SATISFYER brand dating back to March 2016 and claims the brand is recognised globally, including Australia. In addition to the registered trademarks, the Complainant provided supporting documents showing it owns

the following domain names which incorporate the trade mark: Satisfyer.com – registered in November 2015; Satisfyer-men.com; Satisfyerman.com; and Satisfyer-man.com. Each of these are redirected to the website found at satisfyer.com. The Complainant also claims unregistered rights through its websites, social media, commercial success, marketing, industry recognition, sponsorship, search engines, and its customers.

- 2.3 On 9 May 2018 the Complainant contacted the Respondent regarding the use of the domain name satisfyer.com.au. The Respondent replied on 28 May and 7 June asserting it was entitled to continue to use the domain name.
- 2.4 The Complainant relies on the following grounds for both satisfyer.com.au and satisfier.com.au that:
 - 2.41 As the trademark and the Satisfyer domain are identical, the Complainant contends that there is a real risk that internet users will be confused into thinking there is a connection between the Satisfyer Domain and the Complainant and/or the Complainant's products. The trademark and the Satisfier domain are also phonetically identical and confusingly similar.
 - 2.42 The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. The Complainant asserts that the Respondent has no registered trademark rights or other registered or unregistered rights and has not been commonly known by the disputed domain names. Further, the Claimant relies on the evidence provided that it has an established reputation and protectable goodwill, as well as registered rights, in and to the Trade Mark.
 - 2.43 The Respondent's Disputed Domain Names have been registered or subsequently used in bad faith. The Complainant asserts that the Respondent only registered the Disputed Domain Names after the launch of the SATISFYER products in March 2016 to take financial benefit from capturing potential customers and that the Respondent used the website to redirect potential customers to the Respondent's website adultshop.com.au. The Complainant relies on *Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-090* which sets out the criteria for bona fide use.

The Respondent's contentions

3. The respondent provides the following answers:

- 3.1 The Complainant did not commence selling or marketing the Satisfyer brand in Australia until June 2016, two months after the Respondent registered the

domain satisfyer.com.au on 16 April 2016.

- 3.2 The Respondent had developed a webpage for the purposes of selling only the Satisfyer products and intended to launch the webpage using the domain satisfyer.com.au.
- 3.3. The satisfyer.com.au website would note that Adultshop.com Pty Ltd is not the owner of the Satisfyer trademark.
- 3.4 When the Satisfyer brand launched in Australia, the Respondent decided simply to point the domains to the Adultshop.com page that sold the Satisfyer branded products as an interim strategy until such time as it could develop a web page.

Basis of decision

- 4 Paragraph 15(a) of the auDRP Rules states:
“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy [the auDRP Policy], these Rules and any rules and principles of law that it deems applicable.”

Elements of a successful complaint

- 5 According to paragraph 4(a) of the auDRP Policy, a person is entitled to complain about the registration or use of a domain name where:
 - (i) The domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and*
 - (ii) The respondent to the complaint has no rights or legitimate interests in respect of the domain name; and*
 - (iii) the respondent’s domain name has been registered or subsequently used in bad faith.*
- 5.1 It is to be noted that the three elements of a complaint under paragraph 4(a) of the auDRP Policy are cumulative; all of them must be proved if the complaint is to be upheld.

Are the Disputed Domain Names identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights?

- 5.2 The Panel must determine whether, on the basis of the facts set out in section 4 above, the Complainant has rights in a relevant name, trademark or service mark.
- 5.3 The auDRP Policy states:
“For the purposes of this policy, auDA has determined that a “name...in which the complainant has rights” refers to
(a) the complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority;
(b) the complainant’s personal name.”
- 5.4 The Complainant has provided supporting evidence that it had registered brand, trade mark and domain name ‘Satisfyer.com’ on 29 November 2015 and it has used the name ‘satisfyer’ since March 2016 and began a significant marketing launch on 16 April 2016.
- 5.5 The auDRP Policy does not provide guidance as to the intended meaning of “identical” or “confusingly similar”, however clarity has been provided by previous cases. It was noted in *BlueChip InfoTech Pty Limited v Roslyn Jan and Blue Chip Software Development Pty Ltd* LEADR Case No. 06/03 (26 December 2003), that “essential or virtual identity” is sufficient.
- 5.6 The Complainant refers to the recent case of *Seatgeek, Inc. v. Lokesh Kumar, WIPO Case No. DAU2018-0019*, where the panel stated that the test for identity or confusing similarity requires ‘a visual, phonetic and conceptual comparison of both the trade mark and the Disputed Domain Name’.
- 5.7 The Disputed Domain Name ‘satisfyer’ is clearly identical in all respects to the Complainant’s brand, trade mark and domain name ‘Satisfyer.com’, with its website live from that domain name since approximately 1 April 2016. The domain name ‘satisfier’ is phonetically identical and confusingly similar to the Disputed Domain Name.
- 5.8 The Complainant has satisfied the requirement in paragraph 4(a) (i) of the auDRP Policy.

Does the Respondent have any rights or legitimate interests in respect of the Disputed Domain Names?

- 5.9 Paragraph 4(c) of the auDRP Policy sets out particular circumstances, which can demonstrate a Respondent's *"rights or legitimate interests to the domain name for purposes of Paragraph 4(a) (ii)."*
- 5.10 Paragraph 4(c)(i) provides the Respondent may establish rights or legitimate interest by evidencing, prior to being notified of the subject matter of the present dispute, that the Respondent made *"bona fide use of or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with an offering of goods or services"* (paragraph 4(c) (i)).
- 5.11 The Respondent provided no evidence of bona fide use of the Disputed Domain Names, except stating that it intended to develop the webpage. The Complainant, on the other hand, has provided supporting evidence of a global use of the brand and trade mark.
- 5.12 Based on its evaluation of all the evidence presented, the Panel is not satisfied that the Respondent's use of the Disputed Domain Name was "bona fide". The Respondent's evidence on this aspect is unsatisfactory providing no reasonable explanation suggestive of bona fide use or preparation to use the domain name.
- 5.13 With respect to paragraphs 4(c) (ii) and 4(c) (iii) of the auDRP Policy, the Panel is satisfied that the Respondent has neither been commonly known by the Disputed Domain Names, nor is the Respondent making legitimate non-commercial or fair use of them. The Panel considers the Respondent's website to be *"likely to misleadingly divert customers"* from the Complainant.
- 5.14 Paragraph 4(c) of the auDRP Policy is not exhaustive of the manner in which the Respondent may demonstrate rights to and legitimate interest in the domain name. The Panel is not satisfied that the evidence establishes any other basis by which the Respondent demonstrated rights to or legitimate interests in the domain name. Accordingly, the Panel finds that the Respondent has no right or legitimate interest in the Disputed Domain Names, and so paragraph 4(a)(ii) of the auDRP Policy has been satisfied by the Complainant.

Have the Disputed Domain Names been registered or subsequently used in bad faith?

- 5.16 Paragraph 4(b) of the auDRP Policy sets out circumstances that provide *"evidence of the registration and use of a domain name in bad faith"*.

- 5.17 Paragraph 4(b) (iv) provides that bad faith may be established if the Respondent “*by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location*”. The Panel considers there is sufficient evidence for a finding with respect to paragraph 4(b) (iv) of the auDRP Policy. The clear inference is that the Respondent was hoping to capture the custom of consumers who were seeking to purchase the Complainant's products. In the Panel's view, the likelihood is that the Respondent registered the Disputed Domain Names “*intentionally attempting to attract, for commercial gain, Internet users to a website or other online location by creating a likelihood of confusion.*”
- 5.18 The finding with respect to Paragraph 4(b) (iv) is sufficient. Nevertheless the Panel considers there is also sufficient evidence for a finding with respect to paragraph 4(b) (ii) of the auDRP Policy, namely that the Respondent has registered the Disputed Domain Names in order to prevent another person, namely the Complainant, from reflecting its brand in a corresponding domain names, namely the Disputed Domain Names. The date of the launch of the brand in Germany in March 2016 and USA in April 2016, coinciding with the registration of the domain in Australia on 13 April 2016 and the nature of its subsequent use, provides evidence from which the necessary inferences can be drawn.
- 5.19 For the reasons outlined above, the Complainant has satisfied the requirements of paragraph 4(a) (iii) of the auDRP Policy.

Relief

Transfer of the Disputed Domain Name

6. The Complainant has sought that the Disputed Domain Names be transferred to the Complainant.

Determination

7. The Panel orders that the Domain Names **satisfyer.com.au & satisfier.com.au** be transferred to the Complainant.

26 October 2018

Determining Panel

Jennifer Scott (Chair) Gregory Burton SC, Andrew Robertson

Liability limited for each panel member (where relevant) by schemes approved under Professional Standards Legislation in addition to under the auDRP.