

Domain Names: *Transportallianceaustralia.com.au*

Transportalliance.com.au

Transportallianceaustralia.org.au

Transportalliance.org.au

Name of Complainant: *Transport Alliance Australia Ltd* ACN 633 784 460

Name of Respondent: *The Australian Taxi Industry Association Limited* ACN 008 664 980

Provider: *Resolution Institute*

Single Member Panellist: *Dennis Liner*

1. The Parties

1.1 The Complainant in this proceeding is Transport Alliance Australia Ltd ACN 633 784 460 (incorrectly referred to as Transport Alliance Australia **Pty.** Ltd in the Complaint) (“the Complainant”)(TAA).

1.2 The Respondent in this proceeding is The Australian Taxi Industry Association Limited ACN 008 664 980 (“the Respondent”) (ATIA).

2. The Domain Name, Registrar and Provider

2.1 The Domain Names subject to this proceeding are *Transportallianceaustralia.com.au* (DN1), *Transportalliance.com.au* (DN2), *Transportallianceaustralia.org.au* (DN3), *Transportalliance.org.au* (DN4), collectively referred to as “the Domain Names”.

2.2 The Registrar of the Domain Name is GoDaddy.com LLC trading as GoDaddy.com (“the Registrar”).

2.3 The provider in this Proceeding is Resolution Institute of Level 2, 13-15 Bridge Street, Sydney, NSW 2000 (“the Provider”)

3 Procedural Matters

3.1 This proceeding relates to the complaint submitted by the Complainant in accordance with:-

(i) the .au Dispute Resolution Policy no.2016-01 published 15 April 2016 (“auDRP”) which includes Schedule A (the Policy) and Schedule B (the Rules);

and

(ii) the Provider’s supplemental rules for the au Domain Name Dispute Policy.

3.2 (i) The Provider was supplied with an ADR Domain Name Dispute Complaint Application Form by way of an email and received by the Provider on Wednesday 27 November 2019. An amended Application Form by way of an email and received by the Provider on Monday 9 December (the Complaint). The email with the Complaint attached supporting documentation is referred to below.

(ii) The Provider emailed and express posted the Respondent a copy of the Complaint and written notification of the Complaint lodged against it and advised that a Response to the Complaint would be due Tuesday 2 January 2020.

(iii) After the Respondent had agreed to extend the time for the Response to Wednesday 8 January, the Provider received an email on Tuesday 7 the Provider was supplied by way of an email the Response with attached supporting documentation as referred to below.

(iv) The Provider received by way of email on Wednesday 15 January 2020 “Complainant’s Reply to Response” and forwarded copies to the Respondent and the Panellist. On Thursday 16 January 2020 the Respondent forwarded an email to the Provider objecting to the filing of such reply and gave reasons for such objection. Subsequently, the Respondent requested permission to respond to such reply and requested that it be provided by 16 February 2020.

(v) The Panel has a discretion to accept any further statements and documents. The Panel has decided to not accept the Complainant’s Reply to Response nor any reply thereto from the Respondent.

(vii) I find that the making of the Complaint and the Response, together with the supporting documentation referred to below comprise all the relevant matters submitted to the Panellist which the Panellist takes into consideration in making this Determination. I have perused the documents and I am satisfied that the service of the documents and the time for service of the documents complies with the Rules.

3.3 The documents supplied by the Complainant were as follows:-

Domain Dispute Name Complainant by way of email to which the documents set out below were attached:

- i) Resolution Institute Domain Name Dispute Complaint Application Form dated 9 December 2019.
- ii) Complaint (as amended).
- iii) Annexure A: Company search of TAA.
- iv) Annexure B: Company search of AITA.
- v) Annexure C: Domain Names registration details.
- vi) Annexure D: Copy Drive A2B magazine article.
- vii) Annexure E: Copy Drive A2B system extract
- viii) Annexure F: Copies of correspondence between lawyers acting for the Parties.

3.4 The documents supplied by the Respondent were as follows:-

Response by way of email to which the documents set out below were attached:

- (i) Annexure A: ASIC result list search.
- (ii) Annexure B: Google search results.
- (iii) Annexure C: Home page of The Transport Alliance, USA.
- (iv) Annexure D: History of The Transport Alliance, USA.
- (v) Annexure E: Press release of TAA in USA .
- (vi) Annexure F: Copy of the Respondent's Constitution.
- (vii) Annexure G: Agenda, etc of the Respondent's conference on 26-30 May 2019.
- (viii) Annexure H: Records of Registration of Business Names.
- (ix) Annexure I: copies of various records of the Respondent.
- (x) Annexure J: Booking records for Andre Baruch and Toni Peters for May international Conference.

Factual background and submissions

FACTS ALLEGED BY THE CLAIMANT AND SUBMISSIONS

- 4.1 The Complainant was incorporated 18 July 2019 and its objects include "the representation of the transport industry across Australia, representations to government and policy research". Constituent members and affiliates include transportation associations in various states and has an affiliate in Queensland.
- 4.2 According to its website, the stated activities of the Respondent are related to advocating on behalf of the taxi industry.
- 4.3 The Respondent is the registrant of the Domain Names (Annexure C).
- 4.4 The Respondent was not eligible for registration of the Domain Names pursuant to Schedules C and E of the Policy for the following reasons:
 - (i) ATIA has no legal association with the terms "Transport", "alliance" or "Transport Alliance", and otherwise did not hold or was otherwise associated with any match, abbreviation or acronym of the domain names;

(ii) ATIA was not otherwise associated with the words comprising the Domain Names any did not have any close or substantial connection to the terms used in the Domain Names;

(iii) ATIA did not register the Domain Names for the purpose of monetization, and was not entitled to do so in any event;

(iv) The Complainant has a legitimate interest in the Domain Names, being the holder of a name which substantially comprises two of the Domain Names, and in the case of the other two, represent a shortening of its name.

4.5 On or about 18 July 2019 TAA and state chapters, including Queensland were incorporated. Membership of TAA “and its support” include taxi or hire car associations, including the then Commercial Passenger Vehicle Association of Australia.

4.6 On 6 August, Blair Davies, a Director and CEO of the Respondent, accessed the article in DriveA2B magazine which advised of the Complainant’s proposal to become a national organisation under the name of Transport Alliance Australia, with the intention that the various States will be part of the organisation and become members (Annexure E).

4.7 At 10:50pm on that day Mr Davies registered each of the Domain Names.

4.8 On 25 November 2019 ATIA registered two further business names, “Transportation alliance” and “The Transportation Alliance – Australia”.

4.9 Based on its name, the Complainant would be eligible to be registered with the Domain Names if they were not registered to the Respondent. The names of two of the Domain Names are identical with the Complainant’s name and the other two are similar with the omission of “Australia”, which would have little impact. TAA has a direct, material association with the Domain Names and satisfies the criteria in the Policy, AITA does not satisfy any of the criteria.

4.10 Membership of an international association, of itself, does not an accepted category with the Guidelines on the Interpretation of Policy Riles for Open 2LDs and therefore has no basis for the Respondent’s registration.

4.11 The Respondent registered the Domain Names in bad faith, to stifle the potential for competing activity or appeals for membership by the Complainant.

4.12 The conduct and timing of the actions taken by AITA carry the presumption of bad faith, specifically:

(i) ATIA has made no use of the Domain Names;

(ii) AITA registered the Domain Names within hours of learning of potential “competition”;

(iii) AITA has not sought to take any of the steps to make use of the name that it purports to be associated with;

(iv) AITA is not making any use of the Domain Names

4.13 Each of the Domain Names should be transferred to the Complainant.

FACTS ALLEGED BY THE RESPONDENT AND SUBMISSIONS

- 5.1 The Complainant is described in a letter from its Lawyers and in the Complaint as "Transport Alliance Australia Pty Ltd", which is not registered (Annexure A) and accordingly is not an entity that exists or recognised by law. It does not have any capacity or standing to bring the Complaint and therefore the Respondent has no case to answer and the Complaint should be dismissed as nonjusticiable.
- 5.2 The Respondent does not contest that DN1 and DN3 are identical or confusingly similar to the Complainant's name.
- 5.3 The Respondent denies that DN2 and DN4 are identical or confusingly similar to the Complainant's name.
- 5.4 The term "Transportalliance" is a commonly used generic word. A Google search shows at least 40 references to the term identical or similar within the first 4 pages of search results, out of which 17 returns refer to businesses that contain such name or similar term as part of their business names (Annexure B).
- 5.5 An organisation in USA called "The Transportation Alliance" is the largest trade-based organisation in the transportation industry in USA, and represents interests of members in 250 cities on four continents covering a wide range of transportation services. It holds the domain name www.thetransportationalliance.org.
- 5.6 Under the Respondent's objectives under its constitution (Annexure F), it represents or engages in the broad transport industry focussing on provision of passenger transport services, not limited to taxis.
- 5.6 Although the Complainant's company name corresponds to the Domain Name "Transportalliance", it is a commonly used generic business name that closely corresponds to the services that the Respondent provides. Accordingly, those two Domain Names are neither identical nor confusingly similar to the Complainant.
- 5.7 Even if there is any confusion, the Respondent should not be precluded from using those Domain Names, as it should not be deterred from pursuing the objectives and services that the Respondent is bound to provide under its constitution. The term is not only commonly used in business in Australia and USA, but it accurately describes the Respondent's objectives as representative body in a large and broad alliance of transport industry participants Australia wide.
- 5.8 The Respondent has rights or legitimate interests in respect of the Domain Names for the following reasons:

- (i) the term “transport alliance” accurately describes the Respondent’s role;
- (ii) the Respondent has a broad alliance of members in the transport industry (being allied or connected and/or joining of efforts or interests by persons or organisations)
- (iii) the term “transport alliance” or “transport alliance australia” conforms precisely to the objectives of the Respondent and describes what it intends to deliver. The Domain Names therefore closely correspond to the Respondent’s objectives and services;
- (iv) the Domain Names comply with eligibility requirements of the Rules, satisfying the “otherwise closely and substantially connected” requirement.

5.9 Each of the Domain Names has close and substantial connection with the Respondent for the following reasons:

- (i) the term “transport alliance” describes the services and activities that the Respondent engages in for its members and the broader community under its constitution;
- (ii) the Respondent holds events to bring people and organisations in the light transport industry together, forming an alliance of people to further their interests in passenger transport services;
- (iii) the Respondent has along standing relationship with USA counterpart and the Domain Names were registered to provide USA equivalent names in Australia;
- (iv) during the Respondent’s conference in May 2019 the USA name of The Transportation Alliance was revealed and proposals for the Respondent were discussed (Annexure G);
- (v) the Respondent registered the Business Names, which have close connection with the Domain Names;
- (vi) before the Respondent had notice of the subject of the dispute, it had made bona fide preparations to use the names “transport alliance” for its activities and events and secured the names by registration. The Respondent did not register the Domain Names for the purpose of selling, renting or otherwise transferring to another person.

5.10 The Domain Names were not registered or being used in bad faith because;

- (i) As Domain Names are registered on “first come, first served” basis, the Respondent was the first to register them;
- (ii) the Respondent registered them in accordance with the plan it had in place since the May 2019 conference wherein it was advised to the attendees the new name of the USA company was changed to Transportation Alliance;

- (iii) the Respondent had plans to rebrand and change its name as far back as December 2018 (Annexure I);
- (iv) the Respondent intended to register domain names that conformed with its USA counterpart;
- (v) the Complainant has not established that the Domain Names have been registered of subsequently used in bad faith in accordance with any of the examples at Schedule A, paragraph 4(b) of the Policy.

6 Jurisdiction

6.1 Paragraph 2.1 of the auDRP states:

“All Domain Name licences issued or renewed in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP.”

6.2 The Domain Name, being “com.au”, is an open 2LD within the scope of the aforementioned paragraph. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP

6.3 In registering the Domain Name the Respondent became subject to the Policy and the Rules in respect to any dispute in regard to the Domain Name, and in registering the Domain Name under the .au process, he has agreed to be so bound. Accordingly the Panel rejects the submission of the Respondent in paragraphs 5.3 to 5.7 inclusive and finds that pursuant to the Policy and the Rules it has jurisdiction to determine the Complaint in respect to the Domain Name.

9 Basis of Decision

9.1 Paragraph 15(a) of the Rules state:

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

9.2 Paragraph 4(a) of the Policy provides that 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, Trade Mark or service mark in which the complainant has rights; and

ii) the respondent to the complaint has no rights or legitimate interests in respect of the Domain Name; and

(iii) the respondent’s Domain Name has been registered or subsequently used in bad faith.

I note that **all three** components of Paragraph 4(a) are required to be proven for any Complaint to be upheld.

Upon a preliminary basis, it is noted that the Respondent complains that Transport Alliance Pty Ltd does not exist, and therefore it has no standing and the Complaint should be dismissed as nonjusticiable. The Panel notes that although the Complaint has been described in this manner, paragraph 4 of the Complaint correctly identifies the Complainant as Transport Alliance Ltd. Also the correct ABN is referred to. Furthermore, Annexure A sets out correct name of the Complainant. Accordingly I direct that all references to the Complainant be amended to the correct name.

- **Domain Name is identical and confusingly similar to names or Trade Marks in which the Complainant has rights.**

The Complainant contends that the Domain Names are identical to the name of the Complainant .

The Respondent concedes that DN1 and DN3 are identical or confusingly similar, but disputes that DN2 and DN4 are identical or confusingly similar.

The Panel finds that each of the Domain Names are identical or confusingly similar to the name of the Complainant. Accordingly, I find that Paragraph 4(a) (i) is satisfied.

- **Respondent has no rights or legitimate interests in respect of the Domain Name**

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name upon the basis of the facts and submissions as set out in paragraph 4.4 to 4.10 inclusive. The Respondent contends that it has a right and legitimate interest upon the basis of the facts and submissions as set out in paragraphs 5.1 to 5.9 inclusive.

Pursuant to Schedule A of auDRP the Respondent is required to demonstrate its rights or legitimate interests in respect to the Domain Name by inter alia, any of the following:

- *before any notice to the respondent of the subject matter of the dispute, the respondent's bona fide use of, or demonstrable preparations to use, the domain name or a domain name corresponding to the domain name in connection with an offering of goods or services(not being the offering of domain names that it has acquired for the purpose of selling, renting or otherwise transferring); or*
- *the respondent (as an individual, business, or other organisation) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or*

- *the respondent 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 name, trademark or service mark at issue.*

Upon evaluating all the evidence provided to me I find that the Respondent demonstrates that it is preparing to use the Domain Name for services in connection with the Domain Name, is not yet commonly known by the Domain Name and is making a legitimate use of the Domain Name. Accordingly I find that paragraph 4(a)(ii) is not satisfied.

- **The Domain Name was registered or was subsequently used in bad faith**

The Complainant and the Respondent both made details submissions in respect to this matter.

Pursuant to Schedule A of auDPR the following circumstances, inter alia, shall be evidence of the registration and use of a domain name in bad faith:

- (i) *circumstances indicating that the domain name has been registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for a profit; or*
- (ii) *the registration of the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or*
- (iii) *registering the domain name primarily for the purpose of disrupting the business activities of another person; or*
- (iv) *using the domain name to intentionally attempt 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.*

Upon the submissions, documents and evidence supplied, I am not required to make a finding in respect to this matter, as one of the three components has not been satisfied.

In accordance with the above findings, I find that Paragraph 4(a)(i) is satisfied, (ii) not satisfied and no finding is required in respect to(iii).

10. Decision.

- 10.1 As I have found that at least one element of Paragraph 4(a) has not been proven, the Complainant is dismissed.

10.2 Accordingly, for the above reasons, I direct that no action be taken in respect of the Domain Names.

Dated 30 January 2020

Dennis Liner

Panellist