

Domain Name: *alu-cab.com.au*

Name of Complainant: *Alu-Cab Holdings Pty Ltd*

Name of Respondent: *Jacobus Johannes Joubert*

Provider: *Resolution Institute*

Single Member Panellist: *Dennis Liner*

1. The Parties

- 1.1 The Complainant in this proceeding is Alu-Cab Holdings Pty Ltd (“the Complainant”).
- 1.2 The Respondent in this proceeding is Jacobus Johannes Joubert (“the Respondent”).

2. The Domain Name, Registrar and Provider

- 2.1 The Domain Name subject to this proceeding is *“alu-cab.com.au”* (the Domain Name”).
- 2.2 The Registrar of the Domain Name is Web Address Registration Pty Ltd (“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 4 December 2019. The email with such Complaint attached supporting documentation 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 him and advised that a Response to the Complaint would be due Tuesday 31 December 2019.

(iii) The Provider received an email on Tuesday 14 January 2020 from Lawyers acting on behalf of the Respondent advising as to the reasons for the delay in filing a response within the appropriate time and that a Response would be filed on 20 January 2020.

(iv) The Provider received an email on Wednesday 15 January 2020 from the Lawyers acting for the Complainant objecting to the Respondent being permitted to file a Response outside the permitted time for this, inter alia, that "the Respondent has been on Notice of our client's intention to commence auDRP proceedings since our letter of 26 April 2019 and we provided further notice of our intention to commence proceedings in an additional letter of 9 September 2019".

(v) The Provider was supplied with a Response of the Respondent lodged by way of an email Tuesday 21 January 2020. The email with such Response attached supporting documentation referred to below.

(vi) The Respondent is in South Africa and there are various end of year holidays which all contribute to causing problems in complying with the proscribed times for the various steps to be taken pursuant to the Policy and the Rules. Furthermore, the Applicant itself took more than three months to lodge its Application. In the interest of procedural fairness, I accordingly find that I will take into account the Response lodged, notwithstanding that it was not served within the relevant time.

(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. I have perused the documents and I am satisfied that the service of the documents and the time for service of the documents (as accepted herein) 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 4 December 2019.
- ii) Complaint .
- iii) Schedule of Annexures.
- iv) Annexure A: Trade Mark No. 1782295 ALU-CAB extract ("the Trade Mark").
- v) Annexure B: WHOIS search of alu-cab.com and confirmation of domain name ownership.
- vi) Annexure C: WHOIS search of alu-cam.com.au
- vii) Annexure D: ASIC business name extracts for "Quick Pitch Campers" and "Quick Pitch".

- viii) Annexure E: auDA confirmation of creation date for alu-cabs.com.au
- ix) Annexure F: Extracts of website availability of the Domain Name at various dates.
- x) Annexure G: ASIC business name extracts for "Alucab" and "ALU-CAB".
- xi) Annexure H: Letter sent by the Complainant's lawyers (Gadens) to the Respondent dated 26 April 2019.
- xii) Annexure I: Extract of the available at alu-cab.cvom.au dated 15 October 2016.
- xiii) Annexure J: The Policy and The Rules

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) Agreement "between the parties" dated 7 November 2016
- (ii) Letter from Awie Moolman Attorneys (SA) dated 14 January 2020 with attachments, being copy of their letter dated 14 October 2019 and copy letter from BDP Attorneys (SA) acting on behalf of the Complainant

Factual background and submissions

FACTS ALLEGED BY THE CLAIMANT AND SUBMISSIONS

- 4.1 The Complainant is the owner of Trade Mark No. 1782295ALU-CAB which has priority from 9 July 2016 (Annexure A)
- 4.2 The Complainant is the registrant of domain name *alu-cab.com* which was first registered 18 December 2013.
- 4.3 The Respondent is the registrant of the Domain Name (Annexure C).
- 4.4 The Respondent does not carry out business in the name of the Domain Name, but carries on business Quick Pitch (formerly Quick Pitch Campers) ("QP") and is the holder of business names "Quick Pitch Campers" registered 9 November 2013 and "Quick Pitch" registered 23 February 2018 (Annexure D)
- 4.5 The Respondent sells QP branded camping and outdoor living products and also distributes similar products manufactured by third party brands under the QP business
- 4.6 The Domain Name was created 12 March 2015 (Annexure E).
- 4.7 The Domain Name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights:
 - (i) the Complainant is the registered owner of the Trade Mark;
 - (ii) the Domain Name entirely comprises the Trade Mark suffixed by the generic 2LD signifier ".com" and the ccTLD signifier ".au" and is therefore identical to or confusingly similar to the Trade Mark.

- 4.8 At the time of registering the Domain Name on 12 March 2015 the Respondent had no right to register and was ineligible to register the Domain Name as he did not own a Trade Mark, business name or company in the names of ALUCAB or ALU_CAB, but registered "Alucab" on 16 April 2015 and "ALU-CAB" on 9 August 2016 (Annexure G)("the business names")
- 4.9 On or about 3 February 2015 the Complainant and the Respondent entered into an arrangement whereby the Complainant supplied the Respondent with its products for sale in Australia. On 7 November the parties entered into the Distribution Agreement (3.4(i) ("the Agreement") with the exclusive right to use the Trade Mark in Australia. The Agreement did not authorise the registration of the Domain Name or the business names
- 4.10 The Respondent notified the Complainant after he had registered the Domain Name that he was not eligible to do so, but agreed that the Respondent may utilise the Domain Name during the period that the Respondent remained an authorised distributor of the Complainant.
- 4.11 On 5 December 2018 the Complainant terminated the Agreement and on 11 April 2019 announced that it had entered into a new distribution agreement with a third party for the sale and distribution of its products in Australia.
- 4.12 On 26 April 2019 the Complainant's lawyers requested the Respondent to cease using the Trade Mark in any form, including business names, the Domain Name and social media, in accordance with the termination provisions of the Agreement.
- 4.13 The Respondent has continued to use the Domain Name and has refused to transfer it to the Complainant, notwithstanding that the Respondent has no legitimate interest in the Domain Name.
- 4.14 Between 5 December 2018 until at least May 2019 the Domain Name resolved to the Respondent's QP website www.quickpitch.com.au (the QP website). This re-direct resulted in indicating to consumers a connection between the Respondent and the goods and services offered in connection with the Domain Name which did not exist. It was apt to lead consumers to believe that there was some relationship, association or sponsorship between the Complainant and the Respondent when no such relationship existed.
- 4.15 Accordingly, the Respondent has no legitimate interest in the Domain Name and/or the Respondent has not made bona fide use of the Domain Name since the termination of the Agreement.
- 4.16 The Respondent is known by the reference to QP and not the Domain Name, and at most as the distributor of the Complainant.
- 4.17 The registration of the business names (registered after the registration of the Domain Name) does not establish that the Respondent is known by that name or that it has rights or legitimate interests in the Domain Name. The Respondent has traded by

reference to QP. The Respondent has not developed any reputation in the Domain Name.

4.18 The website hosted by the Domain Name is inactive and accordingly the Respondent is not making a legitimate non-commercial or fair use of the Domain Name.

4.19 The Respondent registered the Domain Name in bad faith on 25 March 2015, prior to having any legitimate basis upon which to register it (4.8). The ongoing registration is in breach of the agreement (4.10) and is accordingly is bad faith.

4.20 The Respondent is subsequently using the Domain Name as it was used to resolve to the Respondent's QP website (4.14), the Respondent is no longer authorised to promote or sell the Claimant's products, is in breach of the terms of the Agreement and interferes with the intellectual property rights of the Complainant as provided in the Agreement.

4.21 Further bad faith is evidenced by:

(i) the Respondent used the Domain Name for commercial gain after termination of the Agreement;

(ii) the Respondent has refused to transfer the Domain Name to the Complainant in breach of the Agreement;

(iii) the Complainant is prevented from reflecting the Trade Mark in the Domain;

(iv) the Respondent primarily refused to transfer the Domain Name for the purpose of disrupting the ongoing business or activities in Australia;

(v) by currently using the Domain Name in an inactive website, the Respondent has intentionally attempted to leave the impression that the Complainant is no longer distributing product in Australia.

FACTS ALLEGED BY THE RESPONDENT AND SUBMISSIONS

5.1 The Respondent denies that he has no rights or legitimate interests in respect of the Domain Name, such interests follow from the terms of the Agreement, Clause 21 thereof provides that the Complainant grants the Respondent exclusive licence to use the Trade Mark of the Complainant.

5.2 The parties are in dispute as to the termination of the Agreement and the Respondent has declared a dispute under the provisions of Clause 30.1.1 of the Agreement.

5.3 The termination and post termination entitlements of the parties under the Agreement (including the use of the Domain Name) are therefore in dispute and the subject of a dispute resolution and arbitration process instituted by the Respondent (3.4(ii)).

- 5.4 Clause 30 of the Agreement provides that the Agreement will be determined by South African Law and consented to the non-exclusive jurisdiction of the Western Cape High Court, South Africa.
- 5.5 Under the Agreement the parties agreed that any dispute in connection with the Agreement will be determined by a dispute resolution and arbitration process in South Africa under South African Law.
- 5.6 Clause 30.3.2 of the Agreement provides that the dispute resolution clause is “severable from the rest of the Agreement and shall remain in effect despite the termination or invalidity of the Agreement for any reason”.
- 5.7 Accordingly the Complaint can therefore not be dealt with contrary to the terms of the Agreement under Australian Laws in Australia, alternatively not until the dispute resolution in South Africa between the parties has been finalized.

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.
- 6.4 Clause 18 of the Rules provide that in the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain name dispute that is subject of a complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.

In the event that paragraphs 5.2 and 5.3 evidence a “legal proceeding”, then the Panel exercises its discretion to proceed to a decision.

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.

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

The Complainant contends that the Domain Name is identical to the Trade Mark of the Complainant (3.3(iv)).

The Domain Name is identical to the Trade Mark. 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 as set out in paragraph 4.8 to 4.13 inclusive. The Respondent contends that it has a right and legitimate interest pursuant to Clause 21 of the Agreement.

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.*

The Respondent contends the Domain Name was registered as a result of a distribution agreement with the Complainant and then pursuant to clause 21 of the Agreement. The Complainant states that it initially permitted the Respondent to utilise the Domain Name, but the Agreement has been terminated, the Respondent used it for commercial gain and to mislead consumers and the Respondent no longer uses it.

Upon evaluating all the evidence provided to me I find that the Respondent does not offer goods or services in connection with the Domain Name, is not commonly known by the Domain Name or making a legitimate use of the Domain Name. Accordingly I find that paragraph 4(a)(ii) is satisfied.

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

The Complainant contends that the Domain Name was registered in bad faith, not being eligible for registration, and subsequently used it in bad faith (Paragraphs 4.15 to 4.21 inclusive). The Respondent denies bad faith upon the basis that it was registered as a result of a distribution agreement with the Complainant and then pursuant to the Agreement (Paragraphs 5.1 and 5.2)

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 find that that the Domain Name was registered or subsequently used in bad faith in accordance with Schedule A (i), namely sub-clauses (ii), (iii) and (iv) are satisfied

In accordance with the above findings, I find that Paragraph 4(a)(i), (ii) and (iii) are satisfied.

10. Decision.

10.1 As I have found that as each element of Paragraph 4(a) has been proven, the Complainant is upheld.

10.2 Accordingly, for the above reasons, I direct that the Domain Name be transferred to the Complainant.

Dated 24 January 2019

Dennis Liner

Panellist