

Domain Names: *wormaldsecurity.com.au*

Name of Complainant: *Wormald Australia Pty Ltd* ACN 80 008 399 004

Name of Respondent: *Norman Corp*

Provider: *Resolution Institute*

Single Member Panellist: *Dennis Liner*

1. The Parties

- 1.1 The Complainant in this proceeding is Wormald Australia Pty Ltd ACN 80 008 399 004 ("the Complainant") (Wormald).
- 1.2 The Respondent in this proceeding is Norman Corp ("the Respondent").

2. The Domain Name, Registrar and Provider

- 2.1 The Domain Name subject to this proceeding is **wormaldsecurity.com.au** ("the Domain Name").
- 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 Friday 12 June 2020. A rectified Application Form dated Tuesday 16 June 2020 was received by the Provider by email on Wednesday 17 June 2020 (the Complaint). The email with the Complaint attached supporting documentation is referred to below.

(ii) On Monday 22 June 2020 the Provider emailed 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 12 July 2020.

(iii) As at the date hereof no Response has been received either by the Provider or the Panellist.

(iv) I find that the making of the Complaint 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 16 June 2020.
- ii) Copy letter dated 10 March 2020 from Colin Biggers & Paisley, Lawyers acting on behalf of the Complainant to Brett Norman, to which there were various Annexures including:
 - Annexure A Whois search of the Domain Name;
 - Annexure C copies of email messages between the Complainant and the Respondent
- iii) Copy letter dated 27 April 2017 from the Complainant to Australian Securities and Investments Commission.
- iv) Copy Australian Trade Mark Search incorporating a symbol and the word "Wormald".
- v) Email from the Complainant to the Provider.

3.4 The documents supplied by the Respondent were as follows:-
None

Factual background and submissions

FACTS ALLEGED BY THE CLAIMANT AND SUBMISSIONS

4.1 The Complainant is the registered owner of the Trademark incorporating the word "Wormald" (3.3(iv)).

- 4.2 The Complainant is registered as the owner of Business Names "Wormald Security", "Wormald Security Group" and "Wormald Security Australia" and Wormald has been trading since the 1970s (under various guises).
- 4.3 Although the Respondent had previously been registered as the owner of the Business Name "Wormald Security", the Respondent did not carry on business under such name, as is confirmed in the email (3.3(ii)) wherein the Respondent advised that although it presently was the owner of such name, the business had not yet been commenced.
- 4.4 The Complainant maintains that in accordance with paragraph 4 of the Policy:
- i. the Domain Name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
 - ii. the Respondent has no rights or legitimate interests in respect of the Domain Name; and
 - iii. the Domain Name has been registered, or subsequently used in bad faith.
- 4.5 The Domain Name should be transferred to the Complainant.

FACTS ALLEGED BY THE RESPONDENT AND SUBMISSIONS

- 5.1
- (i). The Respondent provided no Response or submissions.

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.

- **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 name of the Complainant and the registered Business Name of the Complainant and, further, incorporates the name “Wormald” in the Trade Mark.

The Panel finds that the Domain Name is 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 4.1 to 4.3 inclusive. The Respondent has not contested these.

Pursuant to Schedule A 4(a)(ii) 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 has not demonstrated 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 or is making a legitimate use of the Domain Name

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

The Complainant alleges that the Respondent was previously employed in the security business and is attempting to take advantage of the Complainant's name and otherwise using the Domain Name in accordance with Schedule A of auDRP..

Pursuant to Schedule A of auDRP 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, in the absence of any arguments to the contrary, I find that the Respondent has registered or used the Domain Name in all the above circumstances, paragraphs (i) to (iv) inclusive.

In accordance with the above findings, accordingly I find that each element of paragraph 4(a) of the Schedule are satisfied.

10. Decision.

- 10.1 As I have found that all elements of Paragraph 4(a) have been proven, the Complainant is upheld.
- 10.2 Accordingly, for the above reasons, I direct the Domain Name be transferred to the Complainant.

Dated 20 July 2020

Dennis Liner

Panellist