



DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

auDRP_20_9

Single Panellist Decision

Make an Offer IP Pty Ltd ACN 642 933 051

v.

David Eckersley

1. The Parties

1.1 The Complainant is Make an Offer IP Pty Ltd ACN 642 933 051 of c/- Level 19, 480 Queen Street, Brisbane, Queensland, Australia 4000 ("the Complainant").

1.2 The Respondent is David Eckersley ("the Respondent").

2. Domain Name, Registrar and Provider

2.1 The domain name upon which complaint is based is makeanoffer.com.au (the Domain Name).

2.2 The Registrar of the Domain Name is Rebel (formerly Namescout) ("the Registrar").

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

3. Procedural History

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 (Policy) and Schedule B (Rules); and

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

3.2 The Complainant initially lodged a complaint with the Resolution Institute ("the Provider") on 27-08-2020 together with a schedule of attachments relating to the Complaint. A notification of non-compliance was issued to the Complainant by the Provider on 28-08-2020. A rectified complaint was lodged on 31-08-2020.

3.3 The documents supplied by the Complainant comprise the rectified complaint and schedule of attachments relating to the Complaint, namely:

- (1) ASIC Search MAKE AN OFFER IP PTY LTD
- (2) Who is Lookup Search of MAKE ME AN OFFER.COM.AU
- (3) ASIC Search (business name) MAKE ME AN OFFER@ANOTHER GALAXY
- (4) Pages of Google searches (69 pages) conducted on 10.08.2020 for the words “make an offer” site.au; “make an offer@another galaxy” site.au; “make an offer” site.au; a web.archive.org (Wayback Machine) search of <http://www.makeanoffer@anothergalaxy.com.au> for 2018 conducted on 10.08.2020
- (5) Emails sent from the Complainant’s solicitor to the Respondent’s email address david.eckersley.ws on 10.08.2020 and 17.08.2020; and
- (6) copy of a notice “504 Gateway Timeout: remote server did not respond to the proxy” for www.makeanoffer.com.au of 10.08.2020

3.4 On 31-08-20 a copy of the rectified complaint was submitted by the Provider to Rebel (formerly Namescout) (“the Registrar”) with a request to clarify Respondent details and lock the Domain Name during proceedings.

3.5 On 2-09-2020 the Registrar confirmed that the Domain Name in dispute had been locked.

3.6 On 02.09.2020 the Provider notified auDA of the Domain Name complaint.

3.7 On 02.09.2020 the Respondent was Notified by the Provider of the Domain Name Dispute Complaint, with a copy of that Notification also sent to the Complainant and the Registrar.

3.8 Pursuant to 5(a) of Schedule B of the auDRP Rules, the Respondent was required to submit a response to the Provider no later than 22.09.2020, this being twenty (20) days after the date of commencement of the administrative proceeding.

3.9 No response has been received from the Respondent to the Provider.

3.10 The Resolution Institute appointed Rowena McNally as the sole panellist in the matter on 28-08-2020. The Panellist has confirmed that she has no conflict of interest in relation to the matter. All procedural requirements appear to have been satisfied.

4. Background

4.1 The Complainant, Make an Offer IP Pty Ltd ACN 642 933 051 is a company which was registered on 24 July 2020. It has its registered office in East Brisbane.

4.2 Other than that the Complainant was registered with ASIC on 24.07.2020, the Complainant does not assert to carrying on any business enterprise or undertaking any business or other activity that might flavour its application beyond the fact of its registration.

4.3 The Complainant says that the Domain Name is either identical or confusingly similar to the Complainant’s Company Name.

4.4 The material filed on behalf of the Complainant includes:

- i. a copy of a Whois Lookup search of 10.08.2020 which indicates that the domain name “Makeanoffer.com.au” is registered to Mr David Eckersley (Registrant); Eligibility Type: “registered business”; Eligibility Name: “Make me an offer@ Another Galaxy” Eligibility ID: “WA BN 09566077”

- ii. a copy of an ASIC business names search which records that the Business Name Make Me an Offer@Another Galaxy, Registration number BN 09566077, was registered in Western Australia on 9.08.2002, but was cancelled (*date of cancellation unspecified*).
- iii. printouts of Google searches conducted on 10.08.2020 for “make an offer” site:au; “make an offer@another galaxy” site:au; “make an offer” site:au; and a copy of a web.archive.org (Wayback Machine) search conducted on 10.08.2020
- iv. and a copy of a timeout notice of 10.08.20 “504 Gateway Timeout: remote server did not respond to the proxy”.

4.5 The Complainant submits, on the basis of this, that there is no record that the Respondent (as an individual, business, business or other organisation) has commonly been known by the Domain Name and says that the Respondent’s business name is now cancelled.

4.6 The Complainant says the Respondent has not responded to numerous attempts to contact the Respondent about the use and possible transfer of the Domain Name. These attempts comprise:

- (i) one email of 10.08.2020 to the Respondent’s email address:

“Dear Mr Eckersley
Our firm represents a client who may be interested in acquiring the domain name www.makeanoffer.com.au. We note that you are listed as the registrant for this domain name through a ‘whois’ search. Would you kindly contact the undersigned or indicate via return email if you would be interested in discussing this matter further?”

and

- (ii) one email of 17.08.2020 to the Respondent’s email address:

“Dear Mr Eckersley
We are just following up from our email of 10 August (attached below). Our client has indicated that should you provide no response to this email, they will file a domain dispute under the auDRP process. However, our client is willing to discuss use of the domain should you agree, without the need to go through the dispute process. Please contact the asap to progress this matter further.”

5. Jurisdiction

5.1 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.”

5.2 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. Response

6.1. The Respondent has not responded to the Complaint.

6.2 Pursuant to 5.3 of the auDRP Policy, a respondent is not obliged to file a Response however if no Response is received, unless there are exceptional circumstances, the Panel shall decide the dispute based on the information provided in the Complaint.

7. Complaint Elements and the Onus of Proof

7.1 Schedule A of the auDRP applies to disputes which meet the requirements set out in paragraph 4(a) of Schedule A of the auDRP. Subparagraph 4(a) requires that any party holding a domain name licence issued in the 2LDs "...submit to a mandatory administrative proceeding in the event that a third party (complainant) asserts to the applicable Provider, in compliance with the Rules of Procedure that:

- (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] have 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.
- In an administrative proceeding, the complainant bears the onus of proof."*

8. Is the Domain name identical to or confusingly similar to a name, trade name or service mark in which the Complainant has rights?

8.1 The Complainant's name was registered with ASIC on 24.07.2020.

8.2 The Complainant says that its registration on 24.07.2020 satisfies 4(a)(i) on the basis that that the Domain Name is now identical to, or confusingly similar to the Complainant's Company Name.

8.3 Sub-paragraph 4(a)(i) contains a number of elements and requires that the Domain Name is identical to or confusingly similar to a name, trade name or service mark in which the Complainant has rights.

8.4 While the Domain name and the Complainant's name, "Make an Offer IP Pty Ltd" both include the word "make an offer", the Complainant's name also includes "IP Pty Ltd" and I find the two names, while similar, are not identical.

8.5 I turn next to consider whether the Domain name is "confusingly similar" to the Complainant's name. I have had regard to the Google searches provided by the Complainant, which evidence multiple uses of the generic phrase "make an offer" in relation to numerous products differentiated by the particular offering, such as real estate, business. In considering this issue I have also had regard to the following:

- (i) that the term, "make an offer" is a well-understood generic term used in unnumerable contexts, including in common banter, in trade and commerce, over the internet and in the Google searches provided by the Complainant;
- (ii) that the Domain Name contains only part of the complainant's name,
- (iii) that the words in common comprise a generic term used commonly and in many and varied contexts;

and I find that it is unlikely that the Domain Name would be confused for or is confusingly similar for the Complainant's name.

8.6 A further element of sub-paragraph 4(a)(i) is Complainant has rights in the name that is being infringed or impacted upon by the Domain Name.

8.7 The Complainant says that it was registered as a company with ASIC on 24.07.2020.

8.8 The Complainant has referred me to the auDRP Overview¹ on the point and submits, and I accept, that registration of a domain name before a complainant acquires rights in a name does not necessarily prevent the Panel finding that the names are identical or confusingly similar.

8.9 I find however that the fact that a party has registered a company name does not, of itself, establish that party has rights or a legitimate interest in the domain name that corresponds to the company name. This is because although registration with ASIC is a legislative requirement, that registration does not confer proprietary rights in the name.

8.10 Other than that the Complainant was registered with ASIC on 24.07.2020, and had thereby been in existence for 32 days before lodgement of the current auDRP complaint, the Complainant does not assert to carrying on any business enterprise or undertaking any business or other activity that might demonstrate that it has a right to the name, or which might in any way flavour its application beyond the fact of its registration.

8.11 I find that beyond the mere fact of registration of the company name with ASIC the Complainant does not demonstrate that it has rights in the name “make an offer” or “Make an offer IP Pty Ltd”.

9. Does the Respondent have a right or legitimate interest in the Domain name (4(a)(ii))?

9.1 The Complainant says the respondent has no rights or legitimate interests in the domain name.

9.2 The Complainant says its submission is supported by the cancelled business name and the searches conducted on 10.08.2020 and says there is no record of the Respondent ever having made “demonstrable preparations” or “bona fide use” of the Domain Name.

9.3 In the absence of a response from the Respondent, I am entitled to rely upon the information contained in the Complaint, however the Complainant still bears the onus of satisfying the Panel that the Respondent does not a right or legitimate use in the Domain Name.

9.4 In relation to the Complainant’s submission that the Respondent made no “demonstrable preparations” or “bona fide use” of the Domain name, the Complainant’s own material indicates that as at 9.08.2002 the Respondent apparently had a registered business called “Make an Offer@ Another Galaxy”. This business appears to have been in existence when the Domain name was registered, as it was referenced by the Respondent, and recorded by the Registrar at the time the Doman Name was registered. The Domain name “Make me an Offer.com.au” is still registered to the Respondent.

9.5 The searches provided by the Complainant do not disclose when Domain Name was registered with the Registry (although it must have been after 9.08.2002 when the business name was registered) and nor do they disclose when the business name was de-registered.

9.6 Included in the Complainant’s material referenced in support of its submission around the lack of bona fide use of the Domain Name is a wayback archive search, which is a digital archive of the World wide Web and which reveals that there was no archive for that URL. However, this search

¹ The auDRP Overview is a compendium of consensus views of panels on key legal and procedural issues under the auDRP. It has been produced for auDA by [Dr Andrew F Christie](#), Foundation Professor of Intellectual Property at Melbourne Law School. The format is based on the [UDRP Overview](#) produced by WIPO and covers approximately 330 auDRP decisions from 1 August 2002 to 15 July 2014.

related to a world wide web search of the Respondent's business name ("Make me an Offer@Another Galaxy") not the Domain Name. The Complainant did not include "wayback archive" search results for the Domain Name the subject of the Complaint.

9.7 The Complainant also refers to what it describes as "numerous attempts to contact Respondent about the use and possible transfer" of the Domain Name in support of its assertion that the Respondent has no right or legitimate interest in the Domain Name. I note these are the initial email sent on 10.08.20 and a follow-up email sent on 17.08.20.

9.8 Complaints under auDRP have the potential to seriously impact on the rights and interests of respondents and while the rules provide that in the absence of a response from a respondent the Panel is entitled to rely upon the information contained in the Complaint, it is necessary for the Complainant to satisfy the Panel that the Respondent does not have a right or legitimate interest in the Domain Name.

9.9 I cannot be satisfied on the basis of the material provided by the Complainant that the Respondent has no right or legitimate interest in the Domain Name.

10. Has the Domain Name has been registered or subsequently used by the Respondent in bad faith: (4(a)(iii)?

10.1 The third limb of sub-paragraph 4(a) is whether the Domain Name has been registered or subsequently used by the Respondent in bad faith (4(a)(iii).

10.2 The Complainant relies on the material submitted with the Complaint (outlined in (4) and (9) above) and submits that that the Panel should find that the Domain Name was registered or has been subsequently used by the Respondent in bad faith because:

- (a) a passive holding of the Domain name does not prevent a finding of bad faith even without any active attempt to sell or contact the Complainant about the Domain name;
- (b) The Respondent has not responded to the Complainant's emails of 10.08.20 and 17.08.20;
- (c) There "appears to be no contact details available" (*presumably other than the email address used by the Complainant*)
- (d) the Domain Name was registered before the Complainant was registered on 24.07.2020, but the passive holding of the Domain name is now preventing the Complainant from reflecting its name in a corresponding domain name.

10.3 The evidence gleaned from the Complaint indicates that the Respondent had a registered business name from 2002, and that the Domain name was registered subsequently.

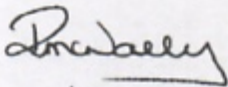
10.4 The Panellist notes that even where a domain name has initially been registered in good faith, that domain name may subsequently be used in bad faith. I note that it is possible that the Respondent is now passively holding the Domain Name, however I cannot be satisfied on the basis of the material provided by the Complainant that this is so, or that the Respondent is doing so in bad faith.

10.5 All three components of paragraph 4(a) are required to be satisfied for any Complaint to be upheld. As I have found that the Complainant has failed to discharge its onus of proof in relation to each element of paragraph 4(a) it follows that I find the Complainant's Complaint should be dismissed.

11. Decision

The Panellist finds that the Complainant's application and requested transfer of the Domain Name to the Complainant should be refused.

DATE: 10 October 2020

A handwritten signature in black ink, appearing to read 'Rowena McNally', with a horizontal line underneath the name.

**Rowena McNally
Panellist**