



**Domain Names:** *stayatmtgambier.com.au*

**Name of Complainants:** *Kerry Anne Guerin and Peter Desmond Guerin*

**Name of Respondent:** *Carol Lee Downing*

**Provider:** *Resolution Institute*

**Single Member Panellist:** *Dennis Liner*

**1. The Parties**

- 1.1 The Complainant in this proceeding are Kerry Anne Guerin and Peter Desmond Guerin (“the Complainants”).
- 1.2 The Respondent in this proceeding is Carol Lee Downing (“the Respondent”).

**2. The Domain Name, Registrar and Provider**

- 2.1 The Domain Name subject to this proceeding is **stayatmtgambier.com.au** (“the Domain Name”).
- 2.2 The Registrar of the Domain Name is Netregistry (“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 Complainants 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 and Complaint dated Monday 7 September 2020 by way of an email and received by the Provider on Tuesday 8 September Thursday 2020 (the Complaint). The email with the Complaint attached supporting documentation is referred to below.

(ii) On Monday 14 September 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 Sunday 4 October 2020.

(iii) The Provider received an email on Sunday 4 October 2020 with the Response and attached supporting documentation as referred to below.

(iv) 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 Complainants 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 7 September 2020.
- ii) Complaint.
- iii) Annexure A: Record of Registration of Business Name "stayatmtgambier".
- iv) Annexure B: Record of Registration of Business Name "stay@mtgambier".
- v) Annexure C: Example page of Complainants' website at <http://mountgambier-accomodation.com.au>
- vi) Annexure D: Example page of Complainants' website at <http://mountgambieraccommodation.com.au>
- vii) Annexure E: Photograph of Complainants' office frontage showing logo.
- viii) Annexure F: Photograph of Complainants' office building showing logo.
- ix) Annexure G: Copy homepage of Complainants' website.
- x) Annexure H: ASIC extract of the Respondent's business name "Mount Gambier Apartments".
- xi) Annexure I: Screen shot from Respondent's website.

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 TradeMark search showing no TradeMark registered in name of “stay@mtgambier” (the first Business Name).
- (ii) Annexure B: TradeMark search showing no TradeMark in name of “stayatmtgambier” (the Second Business Name).
- (iii) Annexure C: List of Domain Names owned by the Respondent.
- (iv) Annexure D: List of Domain Names owned by the Complainants.
- (v) Annexure E: Screen shots from web page of mountgambieraccomodation.com.au (Complainants’)
- (vi) Annexure F: Screen shot from web page of mtgambieraccomodation.com.au (Complainants’)
- (vii) Annexure G: Screen shot from web page of mountgambierapartments.com.au belonging to the Respondent (30 August 2020).
- (viii) Annexure H: Netregistry records showing date that the Respondent acquired the Domain Name.
- (ix) Annexure I: ASIC extract showing registration date of Business Name “stayatmtgambier”.
- (x) Annexure J: Screen shot from web page of mtgambierapartments.com.au (Complainants’)

***Factual background and submissions***

**FACTS ALLEGED BY THE CLAIMANT AND SUBMISSIONS**

- 4.1 The Complainants are the owners of the Business Names as described in Annexures A and B (the Business Names), have the rights in respect thereto, and the Complainants use the Business Names in relation to the Complainants’ business of providing accommodation, letting of services apartments and related services including tourist services.
- 4.2 The logo comprising the Second Business Name (the logo) is used extensively on current websites of the Complainants (Annexures C and D) and on the Complainants’ office frontage and building (Annexures E and F).
- 4.3. The Complainants have the rights in the logo as authors and first users of the logo
- 4.4 The Top Level Domain (TLD) of “.com.au” as a standard registration requirement, is properly to be disregarded in determining whether the Domain Name is identical or confusingly similar to the Business Names and logo. The Second Business Name is identical to the Domain Name when disregarding the TLD (stayatmtgambier).
- 4.5 The first Business Name and the logo are aurally identical and almost visually identical, such that it is confusingly similar to the Domain Name:
  - (a) on a side by side comparison to the Domain Name, stayatmtgambier, very closely resembles the Second Business Name: stay@mtgambier;

(b) the @symbol is pronounced “at” and is commonly used to represent this word in writing;

(c) the meaning and the impressions evoked from the Domain Name and the Business Names are the same in that they are indicating staying or vacationing at a town known as Mt Gambier;

(d) a consumer is likely to think that when typing “stayatmtgambier” into their browser or search engine that this is the same phrase as the Second Business Name.

4.6 The Domain Name is currently being redirected to the Respondent’s website at <https://mountgambierapartments.com.au> (3.4(vii)). Such website promotes and offers accommodation services in Mt Gambier, South Australia

4.7 The Respondent is not known by the Domain Name and commonly uses “Mount Gambier Apartments in the conduct of its business, not “Stay At Mt Gambier”:

(a) the Respondent’s only registered business name is “Mount Gambier Apartments”, as set out in paragraph 3.3(x), Annexure H;

(b) Each page of the Doman Name website prominently displays “Mount Gambier Apartments” prominent. See examples in Annexures 3.3 G and I and the Annexure does not display “Stay at Mt Gambier.

(c) The Respondent does not own any Australian TradeMarks.

4.8 The Respondent:

(a) is not affiliated with the Complainants and has not been authorised to use the Business Names;

(b) uses the Domain Name for commercial gain by directing consumers to the Respondent’s website;

(c) must have registered the Domain Name and uses it to trade on the goodwill and reputation of the Complainants through the creation of internet used confusion;

(d) appears to offer legitimate offering of accommodation services, the use of the Domain Name is merely to redirect consumers to an alternative website, which is not a legitimate use;

4.9 The unauthorised use of the Domain Name by the Respondent in circumstances where it is identical or confusingly similar to the Complainant’s Business Name and logo raises the presumption that it is being used in bad faith.

4.10 In using the Domain Name solely to redirect consumers to the Respondent’s website the Respondent is attempting to attract internet users to its website for commercial gain, such redirection being barely noticeable to internet users

- 4.11 The Respondent is seeking to take advantage of the Complainants' Business Names, reputation and logo in using the Domain Name "as a hook" to redirect consumers to the Respondent's website. .
- 4.12. As the Domain Name is identical or confusingly similar to the Complainants' Business Names and logo, the Respondent's use of it is likely to mislead and deceive consumers into believing sponsorship, affiliation with or approval of the Complainants.
- 4.13. The Respondent must have knowledge of the Complainants' business and their Business Names because both the Complainants and the Respondent operate in the same industry in the same town with a small population and the Complainants are well-known in the industry and the town.
- 4.14. The Respondent must have registered and continued using the Domain Name primarily for the purpose of disrupting the business of the Complainants as the Complainants' potential customers who type "stayatmtgambier" into a browser will not be directed to the Complainant but rather will be directed to the Respondent.

#### **FACTS ALLEGED BY THE RESPONDENT AND SUBMISSIONS**

- 5.1 The Domain Name was acquired because it contained a key generic term in the accommodation industry, in which he operates.
- 5.2 In the accommodation industry there are similar domain names, website names and business names registered by various businesses competing in the same market, using generic key terms, phrases, business names and domain names that relate directly to such industry, such as "stay at Mount Gambier", "stay at Mt Gambier", "Mount Gambier Accommodation", "Mt Gambier Accommodation", "Mount Gambier Apartments", Mount Gambier Bed and Breakfast", "Limestone Coast Apartments", "Limestone Coast Accommodation".
- 5.3 The words "Mt Gambier Apartments" are all generic words and common phrases and are specific to the accommodation industry, not specific to an individual nor are they Trade Marked ((3.4 (i) and (ii)).
- 5.4 The Respondent has a legitimate right to the Domain Name in similar manner as the Complainants having domain names "mtgambierapartments", "limestonecoast accommodation" and "limestonecoaastalapartments" when they market under the banner "stay@mtgambier". This is so, as the words in the Domain Name are generic terms.
- 5.5. It could be argued that the Complainants are trying to gain by obtaining the Domain Name so it could be mistaken for the Respondent's business.
- 5.6. The Respondent obtained the Domain Name 2.5 years before the Complainants registered the Business Names ((3.4 (viii) and (ix)).

- 5.7 The Respondent has never sought to hold out that in redirecting the Domain Name website that it had any connection with the Business Names of the Complainant. Also, in redirecting it or parking it, there is no bad faith.
- 5.8 The Complainants do not extensively use the “stay@mtgambier” in their advertising (Annexure J, 3.4(x)) and various websites of the Complainants have similar listings.

## **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, it has agreed to be so bound. Accordingly the finds that pursuant to the Policy and the Rules it has jurisdiction to determine the Complaint in respect to the Domain Name.

## **7 Basis of Decision**

- 7.1 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.”*

- 7.2 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, Trad 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.*

It is noted 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 TradeMarks in which the Complainant has rights.**

The Complainant contends that the Domain Name is identical to the Second Business Name of the Complainant when disregarding the TLD.

The Respondent contends that the Complainant does not have a Trade Mark of that name, but does not otherwise contest this.

***The Panel finds that the contention of the Respondent is not relevant to this aspect and that the Domain Name is identical or confusingly similar to the business name in which the Complainant has rights. 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 Paragraphs 4.6, 4.7 and 4.8. These include the contention that the Respondent has not made bona fide use of the Domain Name in connection with offering goods or services as the website directs to another webpage of the Respondent, the Respondent is not known by the Domain Name the Respondent, and is not making a legitimate non-commercial or fair use of the Domain Name as the website displays no content.

The Respondent contends that the words used in the Domain Name are generic (Paragraphs 5.2 and 5.3), the Respondent registered the Domain Name 2.5 years before the Complainants registered their Business Names.

*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 and considering the facts and submissions as set out above, I find that the Respondent has not demonstrated any of these matters. Accordingly, I find that paragraph 4(a)(ii) is satisfied.***

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

The Complainant and the Respondent both made detailed 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.*

***The Complainant relies only upon the contention that paragraphs (i), (iii) and (iv) apply. The Respondent contends that the Domain Name was acquired before the Business Names of the Complainant were registered and the Domain Name is a composite of generic names. The Respondent also evidenced that it was common practice for the parties (and others) to register numerous Domain Names to try to attract business to themselves and, accordingly, there was much cross over between websites, business names, etc., this being common in the industry and practice in this area and accordingly there was no evidence of bad faith. Upon the submissions, documents and evidence supplied I find that paragraph 4 (a)(iii) is not satisfied.***



**8. Decision.**

8.1 As I have found that not all elements of 4(a) have been proven, the Complainant is dismissed.

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

Dated 17 October 2020

***Dennis Liner.*** Panellist