

Domain Names: *surfboardwarehouse.com.au*

Name of Complainants: *TSBW Pty Ltd + Coastlines International Ltd*

Name of Respondent: *Kahlia Sulendra*

Provider: *Resolution Institute*

Single Member Panellist: *Dennis Liner*

1. The Parties

- 1.1 The Complainant in this proceeding are TSBW Pty Ltd + Coastlines International Ltd (“the Complainants”).
- 1.2 The Respondent in this proceeding is Kahlia Sulendra (“the Respondent”).

2. The Domain Name, Registrar and Provider

- 2.1 The Domain Name subject to this proceeding is **surfboardwarehouse.com.au** (“the Domain Name”).
- 2.2 The Registrar of the Domain Name is Synergy Wholesale 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 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 21 September 2020 by way of an email and received by the Provider on that day received a rectified Complaint dated Tuesday 22 September on that day (the Complaint). The email of 22 September with the Complaint attached supporting documentation is referred to below.
- (ii) On Tuesday 22 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 Monday 12 October 2020.
- (iii) The Provider has not received a Response.
- (iv) On Monday 19 October 2020, pursuant to the auDPR Rules the Panellist forwarded to the Applicant an email requesting the relationship of the Registrant and the Complainant, both having different names, viz the Registrant shown as Fiona Ellen and the Respondent being named Kahlia Sulendra.
- (v) Copies of correspondence and emails from Lawyers have been supplied to the Panel advising that the Registrant is the mother of the Respondent. Such correspondence also evidenced that the Respondent was the beneficial owner of the Domain Name and had the ability to deal with it (Annexures F,G,H). Further, service of documents was made to the email of the Registrant to which the Respondent replied. The Panel received an email from a Lawyer acting for the Registrant advising that the Registrant held the Domain Name in trust for the Respondent. Accordingly, the Panel finds that the Registrant is holding the Domain Name for the Respondent or that there was an arrangement whereby the Respondent was to be able to deal with it. I find that the Respondent is properly a party in this Application.
- (vi) 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 Complainants were as follow:

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 21 September 2020.
- ii) Complaint.
- iii) Annexure A: Copy TradeMark search for "The Surfboard Warehouse"
- iv)** Annexure B: Screen shot of the Complainants' web page www.thesurfboardwarehouse.com.au.
- v) Annexure C: Copy Whois lookup of the Domain Name.

- vi) Annexure D: Copy Whois lookup of the Domain Name thesurfboardwarehouse.com.au
- vii) Annexure E: Demonstration of the Domain Name web page directing consumers to sideways.com.au., a competitor.
- viii) Annexure F: Copy letter from QBM Lawyers (acting for the Complainants) to Bolt Findlay Lawyers (acting for the Respondent) dated 8 September 2020).
- ix) Annexure G: Copy letter from QBM to Bolt Findlay dated 8 September 2020.
- x) Annexures H and I: Copies of further correspondence between the lawyers.

3.4 The Respondent has not filed any Response or reply nor provided any documents

Factual background and submissions

FACTS ALLEGED BY THE CLAIMANT AND SUBMISSIONS

- 4.1 The Complainants are the owners of the TradeMark in the name of “the surfboardwarehouse” (Annexure 3.3(iii)). The Domain Name is identical, except the word “The” has been omitted. and the Complainants use the name in relation to the Complainants’ business.
- 4.2 The firstnamed Complainant is the registrant of the domain name surfboardwarehouse.com.au
- 4.3. The Respondent is not known by the Domain Name, has no connection with the Complainants or any legitimate business in the industry
- 4.6 The Domain Name is currently being redirected to a competitor’s website sideways.com (Annexure E)
- 4.7. The Respondent has agreed to transfer the Domain Name to the Complainants

FACTS ALLEGED BY THE RESPONDENT AND SUBMISSIONS

- 5.1 The Respondent has not alleged any facts or submissions in response to the Application.

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, TradeMark 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 word “the”.

The Respondent does not contest this.

The Panel finds 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 Respondent takes no issue or contests the contents of paragraph 4.

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 as contained in paragraph 4 and the Respondent does not take issue or contests the contents thereof.

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), (ii), (iii) and (iv) apply. The Respondent does not contest the paragraph. I find that the contents thereof illustrate and evidence bad faith. faith. Upon the submissions, documents and evidence supplied I find that paragraph 4 (a)(iii) is satisfied.

8. Decision.

- 8.1 As I have found that as all elements of 4(a) have been proven, the Complainant is substantiated.
- 8.2 Accordingly, for the above reasons, I direct that the Domain Name be transferred to the Complainants.

Dated 20 October 2020

Dennis Liner. Panellist