

**Domain Names:** *thepiercingplaces.com.au.*

**Name of Complainant:** *The Piercing Place's Pty Ltd* ACN 087341642

**Name of Respondent:** *Strone Heart Body Art Pty Ltd* ABN 609868813

**Provider:** *Resolution Institute*

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

### **1. The Parties**

- 1.1 The Complainant in this proceeding is The Piercing Place's Pty Ltd ACN 087341642 ("the Complainant").
- 1.2 The Respondent in this proceeding is Stone Heart Body Art Pty Ltd ABN 609868813 ("the Respondent").

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

- 2.1 The Domain Name subject to this proceeding is **thepiercingplaces.com.au** ("the Domain Name").
- 2.2 The Registrar of the Domain Name is Yexa.com.au Pty Ltd ("the Registrar").
- 2.3 The provider in this Proceeding is Resolution Institute of Suite 602, Level 6, Tower B, Zenith Centre, 821-843 Pacific Highway, Chatswood, NSW 2067 ("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 Thursday 12 May 2022 (the Complaint). The email with the Complaint attached supporting documentation is referred to below.
- (ii) On Monday 16 May 2022 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 6 June 2022.
- (iii) The Provider received an email on Tuesday 24 May 2022 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 Complainant were as follows: -

Domain Name Dispute Complainant by way of email to which the documents set out below were attached:

- i) Resolution Institute Domain Name Dispute Complaint Application Form dated 12 May 2022.
- ii) Submissions
- iii) Annexure A: Copy ASIC search of the Complainant.
- iv) Annexure B: Copy ASIC record of Business Name Holder "The Piercing Places".
- v) Annexure C: Whois search in respect to the Domain Name.
- vi) Annexure D: Copy IP Australia Trade Mark registration 1503842 of "THE PERCING PLACES A CLASS ABOVE THE REST".
- vii) Annexure E: Copy IP Australia Trade Mark registration 797113 of "The Piercing Place".
- viii) Annexure F: Copy letter from the Complainant's Lawyer to the Respondent dated 16 September 2021.
- ix) Annexures G to I: Various correspondence, emails and attachments between the Lawyer, the Complainant, the Respondent, the Registrar, etc.
- x) Annexure J: Copies of photos of trademark currently used by Complainant in advertising and marketing.
- xi) Annexure K: Whois search of antometal.com.au and promotional material for antometal and store finder search.
- xii) Annexure L: Copy ASIC search of the Respondent.
- xiii) Annexure M: Copies of examples of use of Domain Name and Trade Mark/s by Complainant.
- xiv) Annexure N: Copy screenshot of Opal Heart website.

3.4 The documents supplied by the Respondent were as follows: -

Resolution Institute Domain Name Dispute Complainant Response to which the document set out below were attached:

(i) Annexure: Copy Google Trends search for “piercing places”

***Factual background and submissions***

**FACTS ALLEGED BY THE CLAIMANT AND SUBMISSIONS**

- 4.1 The Complainant is one of Western Australia’s leading body piercers and sellers of body piercing products and jewellery.
- 4.2 The Complainant has been the registered owner of the name “The Piercing Place’s” since May 1999 – Annexures A and B.
- 4.3 The Complainant is the owner of the registered Trade Mark “The Piercing Place” with a priority date of 14 June 1999 – Annexure E.
- 4.4 The Complainant is the owner of the registered Trade Mark “The Piercing Place’s” with a priority date of 23 July 2012 – Annexure D.
- 4.5 As a result of the Complainant’s use of the Piercing Place’s Trade Marks, it has acquired a valuable reputation in such Trade Marks – Annexures D and E.
- 4.6 The Complainant actively uses the registered Trade Marks in the operation in its business advertising and marketing – Annexure J.
- 4.7 The Respondent is a competitor of the Complainant and is also involved in the business of body piercing and selling body piercing products and jewellery – Annexures K,L,N.
- 4.8 The Complainant is the owner of Trade Marks described in Annexures D and E under Class 44 using the name “The Piercing Place’s” for, inter alia, tattoo parlour services, body piercing services, etc.
- 4.9 The Complainant owned and operated the Domain Name until approximately April 2021 (see Annexure M) when it was cancelled because of unpaid domain name fees with the Registrar. The Complainant inadvertently failed to renew the Domain Name registration due to the fact that it did not see the renewal notices.
- 4.10 The Respondent purchased the Domain Name, and any search now is directed to a related domain name of [www.anatometal.com.au](http://www.anatometal.com.au) – Annexure K.

- 4.11 The Respondent is a competitor of the Claimant and is the owner of a rival body piercing business and owner of a related domain name of [www.anatometal.com.au](http://www.anatometal.com.au) of which the Respondent is also a beneficial owner as admitted in Annexure G Annexure N confirms that the Respondent operates a rival business in Perth..
- 4.12 The Complainant's Lawyer wrote to the Respondent 16 September 2021 that it was in breach of the Complainant's intellectual property, that the Complainant was entitled to the Domain Name and offering to pay the Respondent's costs to transfer the Domain Name to the Complainant.
- 4.13 The Respondent responded by denying that the Complainant was entitled to the Domain Name.

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

- 5.1 The terms "piercing place" and "piercing places" are common use colloquial terms to represent a body piercing studio or group of studios, thus the Domain Name is desirable not only for other businesses in the same industry as the Complainant, but also for anyone wanting to represent a group of body piercing establishments.
- 5.2 Google trends show the term "piercing places" is synonymous with "best piercing places near me" and "piercing places near me that are open". The term's use is also predominantly international and thus not isolated to the Complainant's locality, nor as a term exclusively used for their business entity.
- 5.3 The Complainant has admitted (4.9 above) that they neglected to renew the Domain Name and failed to renew its Domain Name registration due to the fact that they did not see the renewal notices. The Domain Name would have entered an "Expired Hold" status after multiple notifications of its pending expiry would have been issued to the Complainant. After this, the Domain Name's DNS information would be removed and the domain would no longer be pointing to anywhere and the Complainant's website would no longer be visible or functional for an additional 30 days.
- 5.4 Not only did the Complainant fail to see the renewal notices, they also failed to notice their own website was not functioning for an entire month before the the Domain Name entered a "Server Renew Prohibited" (expired) state and became publicly listed on the drop list of abandoned sites for purchase.
- 5.5. It was at that time the Respondent became aware of the abandoned domain on the Official Name Drop List and decided to purchase the domain to create a website showing enthusiasts their closest registered piercing place based on their geographical location within Australia.

## **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 panel 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, 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.*

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 Trade Marks in which the Complainant has rights.**

The Complainant contends that the Domain Name is identical to the business name and Trade Marks registered in the name of the Complainant.

The Respondent contends that Sub-paragraph 2.4.4(2) of the auDomain Administration Rules states that “it does not apply where a person has established an Australian presence by relying on an Australian Trade Mark, the domain name must be the exact match to the words which are the subject matter of the Australian Trade Mark.”

The Respondent’s use of the Domain Name is not a breach of the auFDA Rules as it is not an exact match to the Complainant’s name “The Piercing Place’s **Pty Ltd**” nor an exact match to the Complainant’s Trade Marks “The Piercing **Place**” and “The Piercing Places **A Class Above the Rest**”.

*The Panel notes that there have been various Panel decisions whereby the addition of “Pty Ltd” does not show that a Domain Name is not identical as a result of using Pty Ltd. Similarly, the use of singular instead or plural (place v places), and also the addition of a description (“A class above the Rest”) do not detract from being at least confusingly similar to the Domain Name . Accordingly, I find that the Domain Name is identical and confusingly similar to Trade Marks in which the Complaint has rights that accordingly that Paragraph 4(a) (i) is satisfied.*

- **Respondent has no rights or legitimate interests in respect of the Domain Name**

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent owns no goodwill in the Complainant’s name and has no registered rights in the Complainant’s Trade Marks. The Complainant’s Company name and Trade Marks are identical to the Domain Name, whereas the Respondent’s name, Stone Heart Body Pty Ltd is radically different from the Complainant’s company name. There is no corresponding Trade Mark similar to the Complainant’s Trade Mark owned by the Respondent.

The Respondent submits that Section 2.4.4 of the auDomain Administration Rules states that a person applying for a licence in the com.au and net.au namespace must be a commercial entity and the domain name applied for must be a match or synonym of the name of a service that the Person provides.

Merriam-webster defines body art as “art that uses the human body as a medium”, “specifically: decorative tattoos or **piercings**, therefore the Respondent fulfills the requirement of this section for the commercial entity “Stone Heart **Body Art** Pty Ltd.

*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 Complainant submits that the Respondent cannot demonstrate its rights or legitimate interests by any of the above.*

*The Respondent submits that the website of the Domain Name directs to a page that allows enthusiasts of body art to locate their closest registered piercing place based on their geographical location within Australia. During the development of this site, the domain in question was temporarily directed to another site on the same server, Anatometal Australia which shows a list of piercing g places that carry the Anatometal brand of body jewellery in Australia .The website [www.safepiercing.org.au](http://www.safepiercing.org.au) was completed and the domain “the piercing places.com.au” has since directed to the listing of registered professional piercing places in Australia.*

***Upon evaluating all the evidence provided and considering the facts and submissions as set out above ,I find that the Respondent has not substantiated any compliance with any of the elements of Schedule A and has not demonstrated the relevant use the Domain Name for services in connection with the Domain Name, is not yet commonly known by the Domain Name and is not 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**

*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 submits that the registration by the Respondent as a commercial competitor is a violation of all three factors and shows that the Domain Name was registered and subsequently used in bad faith, namely:*

- a) *the current registered Domain Name is redirected to [www.anatometal.com.au](http://www.anatometal.com.au) which is a related entity of the Respondent which is used to generate revenue for profit,*
- b) *the current registration of the Domain Name prevents the owner of the Trade Marks reflecting the name of the business and Trade Mark by registration of the Domain Name*
- c) *the Respondent has no interest in the current registered Domain Name other than to disrupt the business activities of the Complainant, and*
- d) *As a result of the Respondent owning the current registered Domain Name ,other than to attract business for their website [www.anatometal.com.au](http://www.anatometal.com.au) which generates profit and leads to the Respondent's business and causes confusion in the marketplace as to the Trade Mark at its source, sponsorship, affiliation or endorsement of the website*

*The Respondent submits;*

- a) *anatometal.com.au does not offer the same services as the Complainant as it does not offer body piercing services nor sell body jewellery to the public, instead it is a website for wholesale body jewellery and has a directory for the general public to use to locate their nearest retailer*
- b) *the Domain Name does not prevent the owner of the Trade Mark reflecting the name of the by registration of the Domain Name, as there is no exact match to the words which are the subject of the Australian Trade Mark.*
- c) *The Respondent did not register the Domain Name to disrupt the business activities of the Complainant, as the Domain Name was purchased for use as and continues to be used as a directory for piercing enthusiasts to locate their closest registered piercing place on their geographical location within Australia.*

***Upon the submissions, documents and evidence supplied I accept the submissions of the Complainant and accordin 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 upheld.



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

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Dated 9 June 2022

***Dennis Liner.*** Panellist