

RAY WHITE (REAL ESTATE) PTY LTD and BUCKINGHAM and COMPANY PTY LTD atf THE BUCKINGHAM TRUST

**Determination re: raywhiteeltham.com.au**

1. I received the complaint and procedural history on 19 September 2022. The complaint was filed on 25 July 2022. Additional information to make the complaint compliance was filed on 17 August 2022. The relevant domain name registrar confirmed lock on the challenged domain name on 22 August 2022. AuDA notified the respondent of the complaint on 24 August 2022. The response was due 13 September 2022 but no material has been received from the respondent.

**Outline of complainant's contentions and respondent's non-response**

2. The complainant's material states the following matters (summarised) in support of its application to have the challenged domain name transferred to it:

2.1 The complainant owns and licenses to franchisees and others multiple registered trademarks, domain, company and business names containing the words "Ray White" which has been extensively used by the complainant for many years as its primary brand, with the business being founded in 1902. Under that name, mark and brand the complainant has gained a strong presence and identity with substantial and valuable reputation and goodwill in the market in Australia, New Zealand and Asia in real estate and related activities in many locations, where the location will be used in conjunction with the brand and mark.

2.2 The disputed domain name does not reflect any trade name or corporate name of the respondent, the respondent does not use the disputed domain name in connection with the offering of any goods or services, and

has not made any legitimate non-commercial or fair use of the disputed domain name. The respondent is not a franchisee authorised to use the Ray White name or brand in any form including in conjunction with a locality, as the challenged domain name does. Since August 2021 there has been a franchised business authorised by the complainant to use the Ray White brand and trading as Ray White (Eltham), under the agreement between the complainant and an entity other than the respondent. Despite having no authorisation or connection as just indicated, the respondent on 30 August 2021 registered as a business name “Ray White (Eltham)”.

2.3 The registration of the disputed domain name is a misuse of the Ray White name, a breach of registered trademarks and amounts in the circumstances already described to misleading and deceptive conduct. It adversely impacts the complainant’s ability to run its business and license others to use the Ray White name and brand.

2.4 The foregoing circumstances infer that “the respondent has registered the domain name in bad faith for the purposes of disrupting the business or activities of another person – the current franchisee of the franchised business trading as Ray White (Eltham). The registration of the domain name prevents the complainant from reflecting its mark in the .com.au namespace. ... Internet users would likely mistake the domain name as being owned or affiliated with the complainant, regardless of whether or not the domain name currently resolves to an active website”. *Telstra Corporation Ltd v Nuclear Marshmallows* WIPO case no D2000-0003 is cited; there are similar statements in many other WIPO and auDRP cases.

2.5 Accordingly, all elements required to establish the relief sought are said to have been established.

3. As already said, the respondent has been given the opportunity but has not provided material in response to the complaint.

4. Although there is clear power to permit either or both parties to put further material before a determining panel, in writing or in a hearing (auDRP 2016-01 Sch B paras 10, 12, 13), the usual course is that the complaint is determined on the material provided in the first instance by each party: auDRP Sch B para 15. The policy of administrative determination within tight time parameters and minimal cost, with the parties left to their curial rights if dissatisfied, would not be served by too easy a dispensation from the usual course which is known to the parties when they file their material. In a situation where it is known to the parties that the usual position is that a party has one turn to put material forward on the determination, a complainant needs to put forward all relevant material on the central issues and anticipate what may reasonably be said by the respondent in a contest. In accord with auDRP 2016-01 Sch B para 5(e), in the absence of a response and unless there are exceptional circumstances, the dispute is determined on the complainant's material. I find no exceptional circumstances.

#### **The auDRP requirements to be proved by the complainant**

5. 5.1 The matters which the complainant is required to establish are set out in para 4a of Sch A to the auDRP 2016-01 (current to 29 September 2022):

- (i) the challenged domain name is identical or confusingly similar to a name (Note 1), trademark or service mark in which the complainant has rights;
- (ii) and the respondent has no rights or legitimate interests in respect of the challenged domain name (Note 2); and
- (iii) the challenged domain name has been registered or subsequently used in bad faith.

#### **Note 1**

For the purposes of this policy, auDA has determined that a "name ... in which the complainant has rights" refers to:

- (a) the complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority; or
- (b) the complainant's personal name.

**Note 2**

For the purposes of this policy, auDA has determined that "rights or legitimate interests in respect of the domain name" are not established merely by a registrar's determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration."

5.2 On each of the requirements, and overall, the complainant bears the onus.

5.3 Under para 4c of Sch A, any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate the respondent's rights or legitimate interests to the domain name for purposes of para 4a(ii):

- (i) 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 name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) 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
- (iii) 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.

5.4 Under para 4b of Sch A, for the purposes of para 4a(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) Circumstances indicating that the registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or

(ii) the registrant has registered 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) the registrant has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or

(iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to a web site 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 web site or location or of a product or service on that website or location; or

(v) if any of the registrant's representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

#### **Discussion and decision on each auDRP requirement**

6. As to the first auDRP requirement, the complainant has many registered trade

marks to which the disputed domain name is identical in text with the addition of a locality. Registration of the trademarks long pre-dates the registration of the disputed domain name and the recent registration of a business name with the locality by the respondent. There is no challenge by the respondent to the complainant's asserted long and extensive use in Australia and internationally of the registered marks and corporate and business names and reputation in those marks and names in various localities including the use of the locality with the marks and names.

7. Here there is a strong basis for an inference of association with the complainant's corporate name despite the additional locality element in the challenged domain name (and recently-registered business name). There is no evidence of actual confusion. These matters may be relevant to, but are not in themselves necessarily determinative of, aspects of trade mark registration and challenge, the general law and the domain name dispute resolution policy in its early versions or in its form in other jurisdictions. However, the test under auDRP 2016-01 Sch A para 4a is that one simply compares the substantive word(s), in this case in the registered trade marks and challenged domain name, ignoring the domain suffix unless that forms part of the mark or name with which the challenged domain name is compared: see, eg, [costumesdirect.com.au](http://costumesdirect.com.au) LEADR auDRP 02/11 (3 person panel) at [10]-[12]; cp [engineer.com.au](http://engineer.com.au) LEADR auDRP 03/09 at [6]: "auDRP proceedings are designed to deal with relatively straight forward cases of cybersquatting; that is conduct that *classically involves a respondent registering as a domain name another person's mark*" [emphasis added]; *Tigers Direct* WIPO DAU 2010-005 at [6A] (where the complainant, as here, had a registered trade mark).
8. Here, on the required comparison the substantive part of the disputed domain name is "letter-for-letter" identical with the complainant's registered trade marks with the addition of a locality. The same occurs when one compares the dominant words in the complainant's corporate name with the challenged

domain name. The addition of the locality in the domain name (even if coupled with belated registration of a business name with the same features) does not diminish the confusing similarity with the complainant's registered trade marks and corporate name. It simply gives a territorial element that without more does not differentiate from the complainant. Paragraph 4a(i) is satisfied.

9. Turning to the second auDRP requirement, a decision that the name meets the eligibility requirements for registration as a domain name does not of itself affect rights to challenge the use by that registrant (the respondent) of the domain name: Note 2 to auDRP 2016-01 Sch A para 4a.
10. The respondent has provided no evidence as to its use of the challenged domain name in connection with its activities (actual or projected) or any evidence of its activities (actual or projected), or that it is known commonly by the domain name. The only evidence, provided by the complainant, is the late registration by the respondent, six days after being notified of this complaint, of a business name which is the same as the challenged domain name. There is no evidence of the use of the business name in connection with the respondent's activities or projected activities. The applicant's evidence says that there is no connection of the respondent with the applicant's real estate and related activities in many localities, including a franchise in the locality which is within the challenged domain name.
11. The applicant's evidence with the absence of evidence from the respondent establishes the second requirement in para 4(a)(ii) with note 2 and para 4c.
12. Turning to the third auDRP requirement, there is no evidence, to counter the strong inference from the facts just described for the second requirement, that the respondent has no demonstrated commercial or other rationale for registration of the challenged domain name other than to make money from selling or granting rights to use the challenged domain name to someone

such as the complainant, who from its long-established activities has a clear commercial rationale for using such a name in many localities including new localities and would be disrupted in its commercial activities if it could not use its prime brand as part of activity in a particular locality even if that is a new locality. This is notwithstanding the absence of evidence that, for example, the respondent has to date sought to sell or license the challenged domain name to the complainant.

13. The Panel accordingly finds that the complainant has established the third requirement under auDRP 2016-01 paras 4a(iii) with para 4b.

14. In the result, the complaint is made out on the material before the Panel.

### **Remedy**

15. The complainant sought the transfer of the domain name to it pursuant to auDRP 2016-01 Sch A para 4i. It seems to the Panel that is the appropriate remedy in the present case rather than cancelling the domain name and leaving it open to other potential applications for registration, because of the distinctive connection of the name in many localities with the complainant. For the same reason the complainant is clearly eligible to be registered for the challenged domain name.

### **Determination**

**16. The complaint is determined in favour of the complainant. The remedy granted is to transfer the challenged domain name to the complainant.**

2 October 2022

Determining Panel

Gregory Burton SC

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addition to under the auDRP