



## ADMINISTRATIVE PANEL DECISION

auDRP\_22\_10

**Complainant: Metro Finance Pty Ltd**

**Respondent: RO Computer Services Pty Limited atf  
RO Family Trust t/as Netro**

**Domain Name: < metro.com.au >**

### 1. The Parties

The Complainant is Metro Finance Pty Ltd, represented by Kate Green, Norton Rose Fulbright Australia, level 5 60 Martin Place, Sydney, NSW 2000.

The Respondent is RO Computer Services Pty Limited atf RO Family Trust t/as Netro, represented by Ray Overdijk, of PO Box 47, Lane Cove NSW 1595

### 2. The disputed Domain Name and Registrar

The Disputed Domain Name is < metro.com.au >

The Registrar of the Disputed Domain Name is Synergy Wholesale Pty Ltd.

### 3. Procedural History

This is an administrative proceeding pursuant to the .au Dispute Resolution Policy ("Policy") originally adopted by auDA on 13 August 2001, the auDA Rules for .au Dispute Resolution Policy ("Rules"), and the Resolution Institute Supplemental Rules for .au Domain Name Dispute Resolution Policy ("RI Supplemental Rules").

A Domain Name Dispute Complaint dated 29 July 2022 was lodged by the Complainant with Resolution Institute via email on 4 August 2022. An Acknowledgement of Receipt of the Complaint was emailed to the Complainant on 8 August 2022. The Complaint consisted of:

- a. Complaint document dated 29 July 2022 signed by David Albest, the Chief Operating Officer of Metro Finance Pty Ltd;
- b. ASIC Company extract of the Complainant;
- c. AU trademark No 1963581 Metro Finance (figurative) class 36 29 October 2018;

The logo for Metro Finance, featuring the word "METRO" in a bold, sans-serif font inside a rectangular box.

- d. AU trademark No 1963582 Metro Green (figurative) class 36 29 October 2018;  

- e. AU trademark No 2232961 M Metro (figurative) 
- f. AU trademark No 2233300 Metro Finance (words);
- g. AU trademark No 2233303 My Metro (words);
- h. Redirect landing page extract accessed on 19 May 2022;
- i. Webpage extract of [netro.com.au/support/metro/](http://netro.com.au/support/metro/) accessed on 19 May 2022;
- j. Webpage extract of [netro.com.au/](http://netro.com.au/) accessed on 19 May 2022;
- k. Webpage extract of [netro.com.au/services/page.htm/](http://netro.com.au/services/page.htm/) accessed on 19 May 2022;
- l. Webpage extract of [netro.com.au/services/profile/page.htm/](http://netro.com.au/services/profile/page.htm/) accessed on 19 May 2022;
- m. Screenshot of Domain Name as at 25 January 2004 from Wayback Machine;
- n. Screenshot of Domain Name as at 6 January 2006 from Wayback Machine;
- o. Screenshot of Domain Name as at 2 January 2015 from Wayback Machine;
- p. Screenshot of Domain Name as at 27 December 2015 from Wayback Machine;
- q. Screenshot of Domain Name as at 17 December 2021 from Wayback Machine;
- r. Screenshot of [metrofin.com.au](http://metrofin.com.au) as at 2711 October 2011 from Wayback Machine;
- s. Letter from Norton Rose Fulbright Australia to the Respondent dated 22 February 2022;
- t. Email from the Respondent to Norton Rose Fulbright Australia dated 4 March 2022;
- u. Letter from Norton Rose Fulbright Australia to the Respondent dated 17 March 2022 (screen shots 1 & 2);
- v. Letter from Norton Rose Fulbright Australia to the Respondent dated 25 March 2022;
- w. Company extract of Metro CF Pty Ltd from ASIC database.

A copy of the Complaint was emailed to the Registrar by Resolution Institute (RI) on 11 August 2022 with a request to confirm the Respondent Registrant's details and lock the domain name pending the final decision of the domain name dispute proceedings.

On 12 August 2022 the Registrar confirmed via email details of the Respondent and confirmed that the Disputed Domain Names had been locked.

RI advised auDA of the Complaint on 17 August 2022 via email.

On 17 August, RI emailed the Respondent with the Notification of the Complaint lodged in respect of the Disputed Domain Name. The Complainant, the Registrar and auDA were copied in on the notification. The due date for the Response was noted to be 6 September 2022.

On 2 September a request for extension was submitted. RI provided a 5-calendar day extension, with a revised due date of 11 September 2022.

On 11 September 2022, the Respondent elected to have a three-member panel and provided its Response, consisting of:

- a. submission in response dated 11 September 2022;
- b. ASIC record of registration of Business Name Metro registered on 22 March 1995;
- c. email from auDA Compliance Team to Ray Overdijk advising date of creation of domain name metro.com of 12 December 2003;
- d. email from auDA Compliance Team to Ray Overdijk advising date of creation of domain name metrofin.com of 11 March 2011;
- e. Search results from IP Australia class of services;
- f. Search results from IP Australia registration search of the word phrase 'metro' as at 12 December 2003;
- g. Search results from IP Australia registration search of the image word phrase 'metro finance Pty Ltd';
- h. Web archive of Metro Finance from Wayback Machine;
- i. Email from Michael Kloak from Cisco to Ray Overdijk dated 9 October 1995;
- j. Email from Allan Woods from Australia Tourist Commission to Ray Overdijk dated 13 March 2002;
- k. Message from SANS Institute to Security Professional dated 26 May 2004;
- l. Email correspondence between Ray Overdijk John Gao of Global Dial Pty Ltd dated 1 June 2005;
- m. Email correspondence between Ray Overdijk and John Gao, Network Manager dated 31 May 2005;
- n. Email from Cisco Systems to Ray Overdijk dated 26 July 2006;

- o. Netware Certificate dated 16-20 September 1991 [AAM: is this date correct?]; [JAS: yes, this is the correct date]
- p. Microsoft Certificate of Excellence and certified transcript as Systems Engineer.

On 13 September 2022, the Provider, RI, approached the three Panellists. The Panellists formally confirmed their availability and that they had no conflict issues with the Parties. The Panellists accepted the matter on 15 September 2022.

The Case file and relevant correspondence were delivered by email to the panellists on Tuesday 16 September 2022.

The Parties to the dispute were notified by email of the constitution of the Panel on 16 September 2022.

On 27 September 2022, the Respondent filed an unsolicited revised Response, which appeared to differ from the originally filed Response in cosmetic details only and did not address any issue that was not already addressed in the original Response. The revised Response is therefore rejected on the grounds that the Respondent has not established exceptional circumstances for admission.

#### **4. Background**

The Complainant is a private company providing commercial and equipment finance.

The domain name metrofin.com was registered by the Complainant on 11 March 2011. The Complainant has five registered trademarks:

- a. METRO FINANCE (figurative) and METRO GREEN (figurative), both registered from 29 October 2018 for class 36 (provision of equipment finance);
- b. M METRO (figurative), METRO FINANCE (words only), and MY METRO (words only), all registered from 7 December 2021 for class 36 (provision of commercial finance; provision of equipment finance; provision of finance; and advisory services relating to finance);

The Respondent is a family trust providing a range of Internet Services.

The Respondent's homepage for Netro's website is at "www.netro.com.au".

The Respondent registered the disputed Domain Name on 12 December 2003.

From 19 May 2022, the Domain Name was redirected to "netro.com.au/services/metro/", and lands on a webpage titled "Netro Services: Metro Ethernet".

The Complainant seeks the transfer to it of the licence to use the disputed domain name or in the alternative a decision to cancel the licence of the disputed domain name.

In order to be entitled to the relief sought, the Complainant must establish as per paragraph 4(a) of the Policy three cumulative matters:

- a. first, the Respondent's Domain Name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- b. secondly, the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- c. thirdly, the Respondent's Domain Name has been registered or subsequently used in bad faith.

The Complainant must establish each of the elements identified in paragraph 4(a) of the Policy. One or two is not enough to succeed. The standard of proof is the balance of probabilities. The Panel will consider each of these elements in turn.

## **5. The Parties' Contentions**

### **(a) Element 4(a)(i): Confusing similarity**

The Complaint submits:

- a. the Domain Name, "metro", is similar to the Complainant's entity name, Metro Finance Pty Limited, registered with the Australian Securities & Investments Commission (ASIC). The Domain Name and Complainant's entity name both contain the word "metro". The Complainant also relies on the fact that it is a wholly owned subsidiary of Metro CF Pty Ltd, a group of companies it claims is known widely as "Metro";
- b. the Domain Name is also similar to five trademarks registered by the Complainant: METRO FINANCE (figurative) and METRO GREEN (figurative), both registered from 29 October 2018 for class 36 (provision of equipment finance); M METRO (figurative), METRO FINANCE (words only) and MY METRO (words only), all registered from 7 December 2021 in class 36;
- c. the similarities between the Domain Name and the Complainant's entity name and trademarks are confusing and deceptively similar, and the word "metro" is the common word associated with all aspects of the Complainant's branding and business and is the most dominant and distinctive element of its registered trademarks.;
- d. there is one letter difference between "Netro" and "metro", and the Domain Name redirects Internet users to "netro.com.au/services/metro" in the event they misspell "Netro" which suggests the Domain Name is confusingly similar to the Complainant's entity name and trademarks.

The Respondent submits:

- a. the Domain Name was registered as an abbreviation for its Metro Ethernet service, which is classified as class 38 (Telecommunications services), as distinct from the Complainant's services in Class 36 (Financial services) and therefore are quite distinctly different services;

- b. although the Complainant's entity name and trademarks contain the word "metro", they are not confusingly similar as the name "Metro Ethernet" is distinct, when compared to:
  - i Metro Finance
  - ii Metro Green
  - iii M Real People, Reliable Finance
  - iv M Metro
  - v My Metro;
- c. according to the Metro Financial home page at "metrofin.com.au", the Complainant is shown as "Metro Finance", which is not confusingly similar to "metro";
- d. the Respondent was not aware of the Complainant or its entities prior to being contacted on 22 February 2022;
- e. the Complainant has only a few months ago undertaken a rebrand to make the word "Metro" more prominent;
- f. A keyword search highlights that "metro" is a common keyword used within domain names by other registrants and that the Complainant's domain name "metrofin.com.au" does not show up on the list.

**(b) Element 4(a)(ii): Right or legitimate interest**

The Claimant submits:

- a. the Respondent did not satisfy the applicable eligibility criteria:
  - i. at the time of registration of the Domain Name and at the time of any subsequent renewal of it prior to 12 April 2021, because it was and is not an exact match, abbreviation or acronym of the Respondent's name or trademark, and was not and is not otherwise closely or substantially connected to the Respondent;
  - ii. at the time of any subsequent renewal of the Domain Name on or after 12 April 2021, because it was not and is not a match to or acronym of the Respondent's name or trademark, and was not and is not a match to or synonym of the name of a service or goods that the Respondent provides or sells.
- b. the Respondent has not made bona fide use or engaged in demonstrable preparations to use the Domain Name or a name corresponding to the Domain Name in connection with an offering of goods or services because:
  - i. Metro Ethernet appears to be the name of the metropolitan-area network based on Ethernet standards rather than the name of the service that the Respondent allegedly provides as part of its proprietary brand;
  - ii. the Domain Name is not being used in connection with the services connected or ancillary to Metro Ethernet because, when the Domain Name is entered in a search engine, Internet users are redirected to the

netro.com.au domain name suggesting that it is netro.com.au and not the Domain Name that is actually being used in connection with the services being allegedly provided in connection or ancillary to Metro Ethernet;

- iii. the Respondent neither trades as “Metro”, nor does it own, based on the Complainant’s searches, any trademarks which may suggest it has rights in respect of the Domain Name;
- iv. the Domain Name is a shell used to redirect Internet users to the Respondent’s services where Internet users misspell ‘Netro’.

The Respondent submits:

- a. the Domain Name was registered as an abbreviation for the Respondent’s Metro Ethernet service;
- b. the Respondent has a long history with Metro Ethernet, and the Respondent’s director was trained in the network whilst employed by Microsoft;
- c. Metro Ethernet, an Ethernet-based computer network that covers a metropolitan area, was one of the Respondent’s core services as an ISP, and the Respondent still provides this service to small to medium sized businesses;
- d. the Metro Ethernet page is active and was last updated on 1 June 2021 and more recently redirected to the Respondent’s main webpage, netro.com.au;
- e. Metro Ethernet is mainly part of the Respondent’s NBN Enterprise Ethernet offering via various wholesalers.

**(c) Bad Faith 4 (a) (iii)**

The Claimant submits:

- a. the Respondent has registered the Domain Name primarily for the purpose of selling or otherwise transferring the Domain Name registration to another person for valuable consideration;
- b. the Respondent has intentionally attempted to attract, for commercial gain, Internet users to a website by creating a likelihood of confusion with search results for names and marks containing “metro” as to the source of, or service on, that website;
- c. the Respondent’s representations or warranties as to eligibility or third-party rights given on an application or renewal are, or subsequently became, false or misleading;
- d. the Respondent has used the Domain Name in bad faith by squatting on the Domain Name for almost two decades.

The Respondent submits:

- a. some sections of its website are out of date and do not provide an exhaustive list of all the products and services it currently offers; however, it still provides Metro

- Ethernet services, especially for SME (Small and Medium Enterprise) clients. These services fall under the general “Permanent Access/ Dedicated Internet” category;
- b. since 17 November 1997, Netro has been an active ISP (Internet Service Provider) member of the TIO (Telecommunications Industry Ombudsman), which is a requirement when offering Metro Ethernet services;
  - c. as the Complainant and the Respondent are in separate business categories and offer different types of services, there is no confusion in the Respondent’s use of the Domain Name and no intent by the Respondent to make commercial gain from any such confusion.

## **6. Discussion and Findings**

### **(a) Element 4(a)(i): Confusing similarity**

The first element, under paragraph 4(a)(i) of the Policy, has two components. First, the Domain Name must be identical or confusingly similar to a name, trademark or service mark. Second, the Complainant must have rights in respect of that name, trademark or service mark.

In this case, the Domain Name consists of one word, “metro”, once the second-level and top-level domain identifiers “.com.au” are disregarded (which is appropriate in this case).

The Complainant made the bare assertion that the group of companies headed up by its parent company, Metro CF Pty Ltd, is known as “Metro”. However, it did not provide any evidence to support this claim. For the Complaint to have rights in the name “Metro” for the purpose of founding a complaint under the Policy, it would need to establish that “Metro” has acquired secondary meaning and become a distinctive identifier associated with it or its goods or services – *i.e.*, that it is a common law or unregistered trademark. Evidence relevant to establishing such secondary meaning includes the length and amount of sales under the name, the nature and extent of advertising using the name, surveys of consumer recognition of the name, and media references to the name. The Complaint provide no such evidence. In the absence of any evidence to support the assertion, the Panel does not accept that the Complainant has a common law trademark in the word “metro”.

The Complainant’s company name, and each of its trademarks, do contain the word “metro”. However, they do so in combination with other terms, and all but two of its trademarks contain figurative elements.

The test for identity is whether there is essential or virtual identity between the domain name and the trademark or name in which the Complainant has rights. It is evident that the Domain Name, “metro”, is not identical to the Complainant’s company names or any of its trademarks, because all of them include words or images in addition to the word “metro”.

As to confusing similarity, this part of the element involves a comparison between the Complainant’s entity name or trademark (on the one hand) and the Domain Name (on the



other hand). The application of the test for confusing similarity typically involves a straightforward visual or aural comparison of the alpha numeric string of the disputed domain name with the entity name or trademark, to determine the likelihood of Internet user confusion. Where, as is the situation in this case, the domain name contains only part of the complainant's entity name or trademark and that part is highly descriptive or is generic, the domain name is unlikely to be confusingly similar: auDA Overview of Panel Views on Selected auDRP Questions First Edition ("auDA auDRP Overview 1.0"), section 1.2.

In respect of the trademarks that contain figurative elements, it is the figurative elements which provide the distinctiveness of the trademark. Because those elements are absent from the Domain Name, the Domain Name is not confusingly similar to those trademarks.

In respect of the Complainant's company name, Metro Finance Pty Limited, and its word trademark METRO FINANCE, the Panel considers that the term "finance" is dominant, as it is the substantive element, both visually and conceptually. Because that term is absent from the Domain Name, the Domain Name is not confusingly similar to that name or trademark.

The Domain Name is clearly similar to the Complainant's word trademark MY METRO, with the only difference being the absence of the word "my". The Panel acknowledges that the Domain Name has a greater degree of similarity with this trademark than with the other trademarks, as the word "my" appears subservient to the word "metro". Whether the Domain Name is confusingly similar to the trademark is finely balanced. Of significance to the Panel is the descriptive and non-distinctive nature of the word "metro". On balance, the Panel is of the view that the Domain Name "metro.com.au" is not confusingly similar to the word trademark MY METRO.

Therefore, the Panel finds that the Complainant has failed to satisfy the first element of the Policy, and the complaint fails. Accordingly, it is unnecessary for the Panel to address the second and third elements.

**(b) Element 4(a)(ii): Right or legitimate interest**

Unnecessary to consider.

**(c) Bad Faith 4 (a) (iii)**

Unnecessary to consider.

**7. Order**

The Complainant has failed to prove the first element of the Policy which it is required to prove under paragraph 4(a) of the Policy. Accordingly, the Panel orders, pursuant to paragraphs 4(i) of the Policy and 15(a) of the Rules, that the Complaint be dismissed and that the Registry lock on the Disputed Domain Name be removed.

**8. Decision**

For the foregoing reasons, in accordance with paragraph 4(a) of the Policy and paragraph 15 of the Rules, the Complaint is dismissed.



Jennifer Scott

Panel Chair

Date: 3 October 2022



Albert Monichino KC

Panellist



Andrew F. Christie

Panellist