

PANEL DECISION

Case number:	auDRP_22_9
Domain:	digitalx.net.au
Panel:	Andrew Robertson
Complainant:	DigitalX Limited
Contact person:	Frances Cranston
Respondent:	DigitalX Technology Group Pty Ltd
Contact person:	Hanh Do (David) Nguyen
Date of decision:	6 October 2022

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1. Procedural history

- 1.1 The disputed domain name is <digitalx.net.au>.
- 1.2 The material provided to me by the Resolution Institute indicates that material was provided to the Resolution Institute with respect to the complaint on 11 August 2022. Further material was received from the Complainant by the Resolution Institute on 18 August 2022 to complete the complaint.
- 1.3 That additional material indicates that the complaint is lodged by DigitalX Limited. That material further confirmed the identity of the domain name in dispute as <digitalx.net.au>.
- 1.4 The Resolution Institute advised the Registrar of the complaint on 25 August 2022. The Registrar responded with registration details and confirmation of a lock on the domain name on 26 August 2022.
- 1.5 I am informed that the Resolution Institute notified .au Domain Administration Limited (auDA) of the complaint on 31 August 2022.
- 1.6 Notification was provided to the Respondent of the complaint by way of an email from the Resolution Institute to DigitalX Technology Group Pty Ltd (ABN 64 656 442 769), by way of email dated 31 August 2022.
- 1.7 The panel provided a Statement of Impartiality and Dependence on 21 September 2022.
- 1.8 Notice of nomination of the Panellist was provided to the parties on Friday, 23 September 2022 and the panel was provided with a case file thereafter, although there was some difficulty in receiving the material such that it was received over several days.
- 1.9 The panel received the following material from the Resolution Institute:
 - (a) draft Statement of Impartiality and Dependence;
 - (b) Domain Name Dispute Complaint – Procedural case history auDRP_22_12 (a listing of documents);
 - (c) a copy of the Complaint Application Form;
 - (d) email from the Resolution Institute dated 17 August 2022 to the Complainant;
 - (e) a document marked to the attention of the Resolution Institute dated 18 August 2012 and signed by the Chief Risk Officer for the Complainant, together with attachments to that document being the DigitalX Limited ABN lookup, Trademark Registration, DigitalX Technology Group Pty Ltd ABN lookup and DigitalX Technology Group Pty Ltd company extract;
 - (f) email from the Resolution Institute dated 25 August 2022 to the Complainant acknowledging the complaint;
 - (g) email from the Resolution Institute dated 31 August 2022 to auDA advising of the complaint;

- (h) email chain between the Resolution Institute and the Respondent commencing from 31 August 2022 and concluding with an email of 21 September 2022 which final email appears to be copied to others including to the Complainant;
 - (i) email between the Resolution Institute to the Registrar advising of the complaint and confirming the domain is locked pending determination of this case.
- 1.10 The Complainant in their material indicated a preference for a single member panel to determine the dispute. The Respondent in their email of 20 September 2022 indicated a preference for a three member panel. However, that position was overtaken by the position adopted in the Respondent's email of 21 September 2022 which indicated that a single member panellist should be appointed by the Resolution Institute.
- 1.11 Accordingly, I was appointed as a sole panellist on 23 September 2022.
- 1.12 The panel finds that it was properly constituted for this complaint.

2. Parties

- 2.1 The Complainant is a corporation: DigitalX Limited (ABN 59 009 575 035).
- 2.2 The Respondent is also a corporation: DigitalX Technology Group Pty Ltd (ABN 64 656 442 769).
- 2.3 The disputed domain name is <digitalx.net.au>.
- 2.4 The Complainant has been represented in the material by way of person identified as the Chief Risk Officer for the Complainant, Frances Cranston.
- 2.5 The Respondent has been represented in the correspondence by a person identifying himself as the Chief Executive Officer for the Respondent. In his signature clause in his email, he has identified himself as David Nguyen. I note that in the correspondence the Resolution Institute identified him by the name Hanh Do (David) Nguyen. The ASIC search provided by the Complainant identified the director of the Respondent as Hanh Do Nguyen. David Nguyen is the identified contact for the domain. By reference to the correspondence it appears that Mr Hanh Do Nguyen and Mr David Nguyen are the same person.
- 2.6 The Registrar is identified in the complaint as GoDaddy.Co.

3. Background and Submissions

The Complainant's submissions

- 3.1 As noted above the Complainant has provided both a Complaint Application Form and supplementary material by way of a document dated 18 August 2022. The Complainant identifies in that in that material that the Complainant "*holds an ABN name of DigitalX as well as a trademark name of DigitalX*". I understand this to mean that the Complainant is indicating that is a company registered pursuant to the Australian Corporations Act with the registered name of DigitalX Limited which corporation has as its ABN 64 656 442 769.

- 3.2 The Complainant indicates that it is an ASX listed company.
- 3.3 Further there is material relating to a registered trademark of DigitalX supplied by the Complainant. The material which has been provided to me indicates that that trademark is registered with IP Australia. The material that has been provided describes trademark 1663519 encompassing the words DIGITALX.
- 3.4 That document indicates that the trademark has been registered since 10 December 2014. The submission from the Complainant says that DigitalX is the owner of the trademark. The material appears to indicate that Digital CCIP Pty Ltd is the owner of the trademark. I infer that the Complainant is submitting that there is a commercial relationship between Digital CCIP Pty Ltd and DigitalX Limited. The details of that relationship are not immediately clear on the material.
- 3.5 The Complainant's submissions also identified the Respondent as Mr Hanh Do Nguyen who holds an ABN. Again, I understand this submission to be that the Respondent is a corporation established under the Australian Corporations Act and accordingly has an ABN. The material provided to me identifies the Respondent as DigitalX Technology Pty Ltd's and the material from the Respondent identifies its ABN. The director of the Respondent identified in that material is Hanh Do Nguyen.
- 3.6 The submissions of the Complainant go on to discuss the nature of the business conducted by the Complainant. The submissions indicate that the Complainant provides services which include blockchain consulting and AI (Artificial Intelligence) development as well as asset management services. The submissions identified that the Complainant presently use a top-level domain address of <digitalx.com>.
- 3.7 The Complainant's submissions identify that DigitalX Technology, by which I understand the Complainant to be referring to the Respondent, has been active since January 2022 and identifies that it provides smart AI technology. The submissions of the Complainant identify that the Respondent uses in its business a second level domain address which is the domain the subject of this dispute.
- 3.8 The Complainant submits that "*the use of an identical company name as the web name is confusing and misleading*". The Complainant submits that a person searching for the Complainant would not be expected to know that a different domain extension belonged to a different company, and it would be reasonable for such a person undertaking such a search for them to think it was the same company.
- 3.9 The Complainant submits that when searching for DigitalX in a search engine the first result returned is <digitalx.com> (the domain utilised by the Complainant) however it is submitted that there have been instances where the search engine result has displayed <digitalx.net.au> (the domain in dispute in this arbitration). It is asserted that sometimes a search result displaying the disputed domain is the first result, further it is asserted that sometimes the search engine has only displayed the disputed domain.
- 3.10 I have not been provided with details of the words utilised in the searches undertaken or upon which search engines they were undertaken. The only evidence I have in relation to this purported conclusion are the statements by the Complainant in the Complainant's submissions.
- 3.11 The Complainant says that it is concerned that existing or potential shareholders or investors could be confused about the two domain addresses with what is said to be

the exact same site name but different domain extensions and if they click on the disputed name thinking it is the domain belonging to the Complainant they are not knowingly seeing information about the Complainant and could make an investment decision or purchase a service they would not have made if they had known it was not the Complainant they were dealing with.

- 3.12 The Complainant seeks an opportunity to purchase the disputed domain and indicates that in doing so it will then make it dormant so that it can maintain its current domain of <digitalx.com>.

The Respondent's submissions

- 3.13 The material provided to me suggests the Respondent has not made formal submissions, as such, however I have been provided with copies of the email chain between the Resolution Institute and the Respondent in which the Respondent has indicated that the domain that has been registered, that is I understand to be a reference to the disputed domain, is the property of the Respondent. It describes the Respondent as a Sydney based business.
- 3.14 The Respondent indicates that they received legal advice that registration of domain names is on a "*first come first serve service*" and the Respondent therefore submits they have full rights to register the domain name and use it for their business.
- 3.15 In a further email of 21 September, the Respondent repeated its submission of its understanding that the domain name system "*is working on first come first serve basis*" and that accordingly it is submitted by the Respondent that it had full right to register the domain when it was available.
- 3.16 The Respondent also notes that the Complainant has not registered the domain name <digitalx.com.au> and that the Complainant is currently operating with the <digitalx.com> domain.
- 3.17 This second email is outside of the time established by the auDRP Rules in which the Respondent us to provide a response. I therefore do not accept it as forming part of the response.

4. Relevant principles

- 4.1 The panel has been appointed to determine this dispute in accordance with the .au Dispute Resolution Policy (auDRP) established by .auDA. A copy of the auDRP is available on .auDA's website <www.auda.org.au>.
- 4.2 The relevant policy and the dispute resolution principles which apply are set out in the auDRP. The auDRP states the purpose of the policy is to provide a cheaper, speedier alternative to litigation for the resolution of disputes between the registrant of a .au domain name and a party with competing rights in the domain name. The policy sets out the process for the filing of a complaint and the process by which a complaint is to be determined.
- 4.3 The policy identifies that a party making a complaint should ensure that they have read the entire auDRP including Schedules A and B (the auDRP Rules) of the auDRP policy.

- 4.4 The policy identifies the remedies that are available to a Complainant. The remedies as identified in the policies are limited to those in paragraphs 6.1 of the auDRP, namely:
- (a) a Complainant may seek to have the domain name licence cancelled, in which case the domain name will become available for registration in the normal way; or
 - (b) a Complainant may seek to have the domain name licence transferred to themselves, but only if the Registrar determines that they are eligible to hold the domain name under the relevant policy rules.
- 4.5 These remedies are the sole remedies available to a Complainant in the arbitral process.
- 4.6 There is a third alternative outcome that can occur in relation to a complaint raised under the auDRP policy and that is a dismissal of the complaint.
- 4.7 Those three alternative outcomes represent the outcomes available to parties utilising the auDRP.
- 4.8 The auDRP sets out the mechanism by which the panel is to conduct the proceedings, especially in Schedules A and B of the auDRP.
- 4.9 Schedule A paragraph 4 (a) identifies applicable disputes. Applicable disputes pursuant to the auDRP are those that give rise to a complaint by the Complainant that the Respondent is alleged to have:
- (a) a domain name which is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
 - (b) the Respondent has no rights or legitimate interests in the domain name; and
 - (c) the disputed domain name has been registered or subsequently used in bad faith.
- 4.10 The auDRP in Schedule A paragraph 4(a) sets out these criteria in paragraphs 4(a)(i), (ii) and (iii) and further identifies that in any proceedings the Complainant bears the onus of proof.
- 4.11 The requirements of 4(a) are cumulative in that each of 4(a)(i) and (ii) and (iii) must be satisfied if a Complainant is to be successful in proceedings pursuant to the auDRP.
- 4.12 Schedule A paragraph 4(b) provides examples of circumstances which, though they are expressed to be without limitation, if found by a panel to be present shall be evidence of registration and use of a domain name in bad faith. The language is directed towards the conduct of the Respondent. Reference should be had to the description of these five in Schedule A paragraph 4(b) but in summary they are:
- (a) circumstances where the Respondent has registered or acquired the domain name primarily for the purposes of selling, renting or otherwise transferring the domain name registration to another person for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;

- (b) the Respondent 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.
- (c) the Respondent has registered the domain name primarily for the purposes of disrupting the business or activities of another person;
- (d) the Respondent by using the domain name has intentionally attempted 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 a service of that website or location;
- (e) the Respondent's representations or warranties as to eligibility or third-party rights given on the application or renewal for the domain are subsequently identified as false or misleading in any manner.

4.13 I note in my view the Complainant has not directed attention to material in support of these matters in its submissions. Therefore I must review the material provided to consider how the material is relevant to each of the three criteria.

Identical or confusingly similar

4.14 Both the Complainant and the Respondent have as part of their name the expression DigitalX. In the case of the Complainant the totality of the name is DigitalX Limited. In the case of the Respondent the name is DigitalX Technology Group Pty Ltd but nevertheless still contains the relevant component DigitalX.

4.15 The material in relation to the trademark of DigitalX is in my view unsatisfactory. I can determine the matter based upon the other material presented to me.

4.16 Nevertheless, in my view the material presented to me demonstrates that the Complainant has a relevant right in the name of DigitalX through it forming the substantial portion of its corporate name DigitalX Limited.

4.17 Further in my view the Claimant has demonstrated that the domain name is identical or confusingly similar to the name in which the Complainant has rights.

4.18 Accordingly in my view the Complainant has satisfied the requirements of 4(a)(i) of Schedule A namely that the domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights.

No rights or legitimate interests

4.19 The Complainant must satisfy the panel that the Respondent has no rights or legitimate interests in respect of the domain name.

4.20 In my view the Complainant has not satisfied that the Respondent has no rights or legitimate interests in respect of the domain name.

4.21 Although the evidence is imperfect even the submissions of the Complainant appear to proceed on the basis that the Respondent is and has been trading, apparently since at least January 2022, under the name of DigitalX Technology Pty Ltd. In my view it is not fatal that the corporate name of the Respondent is DigitalX Technology

Pty Ltd whereas the domain is truncated to DigitalX.net.au, that is excluding the technology component of the Complainant's name.

- 4.22 In my view that a person seeking to register a domain name truncates the domain name to a material portion of their name does not necessarily in and of itself result in them having no right or legitimate interest in the domain name.
- 4.23 There is no evidence of any assertion by the Complainant of a lack of right or a legitimate interest in respect to the domain name on the part of the Respondent. The submissions of the Complainant indicate that it has not been in communication with the Respondent.
- 4.24 The Complainant's central thesis is that persons may be confused between <digitalx.net.au> and <digitalx.com>. The asserted potential confusion does not mean that the Respondent has no rights or legitimate interests in respect of the domain name.
- 4.25 Accordingly in my view the Complainant has failed to discharge the onus it bears in relation to establishing this element of the complaint and accordingly the complaint must be denied.

Bad faith

- 4.26 By reason of the conclusions identified above I do not need to consider this aspect of the dispute. Nevertheless, I note that in my view for similar reasons as set out above with respect to the second element there is a lack of satisfactory evidence of bad faith use of the domain name by the Respondent. The types of matters identified in paragraph 4(b) of Schedule A of the auDRP policy have not been identified to me in the evidence.
- 4.27 The asserted confusion relied upon by the Complainant is not said by the Complaint to have been deliberate on the Respondent's part.
- 4.28 Accordingly, therefore if I needed to determine the matter it would be my view that the Complainant has also failed to establish the element of bad faith.

5. Conclusion and decision

- 5.1 For the reasons set out in this determination the panel orders that the complaint be denied.



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Andrew Robertson

Dated: 6 October 2022