



ADMINISTRATIVE PANEL DECISION

auDRP_23_04

Complainant: Sanyo Electric Co. Ltd

Respondent: P & I M Pty Ltd

Domain Name: < sanyo.com.au >

The Parties

The Complainant is Sanyo Electric Co. Ltd, represented by Mr Peter Thrush of McCabe & Company, Level 5, 38 Waving Taylor Street, Wellington, New Zealand [E: mail@mccabes.co.nz].

The Respondent is P & I M Pty Ltd (ACN 121840364) which is not represented.

The disputed Domain Name and Registrar

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

The Registrar of the Disputed Domain Name is DROP.com.au Pty Ltd.

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 (undated) was lodged by the Complainant with Resolution Institute via email on 7 March 2023. An Acknowledgement of Receipt of the Complaint was emailed to the Complainant on 9 March 2023. The Complaint consisted of:

- (a) A complaint document (unsigned and undated);
- (b) Schedule One, titled 'SANYO ELECTRIC CO – Sanyo Australian Trade Marks'; and
- (c) Schedule Two (listing further "Sanyo" Trade Marks).

A copy of the Complaint was emailed to the Registrar by the Resolution Institute (RI) on 10 March 2023 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 14 March 2023 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 March 2023 via email.

On 17 March 2023, 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 April 2023.

The Respondent has not filed any response.

On 13 April 2023, the Provider, RI, approached me to seek my availability to act as a single member panellist. The next day I confirmed my availability and that I had no conflict issues with the Parties. The parties were notified of my acceptance of nomination as Panellist on 14 April 2023.

The Case file and relevant correspondence were delivered by email to me on 14 April 2023.

Background

Who is the Complainant?

No company search of the Complainant, Sanyo Electric Co Ltd, has been produced. It is not clear to me where the Complainant is incorporated (if at all), the nature of the Complainant's business and the geographical area in which that business is carried on.

The Complainant asserts that it is a wholly owned subsidiary of Panasonic Holdings Corporation ("Panasonic") and that there are various subsidiary companies bearing the Sanyo name that are "owned" by the Complainant.

The Complainant has produced an extract from Wikipedia which in part asserts that SANYO was a global brand acquired by Panasonic when it acquired the Sanyo Corporation in 2009. The same Wikipedia extract states that Sanyo Electric Co Ltd was a Japanese electronics company incorporated in 1949, headquartered in Osaka, Japan. Whether or not the Complainant is the same company is not clear to me.

The Complaint therefore suffers from a fundamental defect at the outset.

Who is the Respondent?

No company search of the Respondent, P&I M Pty Ltd, has been produced. Again, I have little understanding of its activities.

Sanyo Mark

I am prepared to accept that "SANYO" is a famous mark.

The Complainant points to the fact that the Sanyo brand remains registered as a trademark in 156 countries around the world, including Australia. Schedule 1 to the Complaint is a listing of registered Sanyo trademarks in Australia. It asserts that there are two registrations of the Sanyo mark currently in force:

- (a) registration no. 456905 (in respect of goods and services in classes 7 and 9 and expiring on 9 December 2027); and
- (b) registration no. 1415913 (in respect of goods and services in classes 7, 9 and 10 and expiring on 10 September 2030).

The Sanyo mark the subject of the respective registrations is as follows:



The classes of goods of the Complainant's trademark registrations cover a range of goods, including a wide range of automotive parts.

The Complainant asserts (infelicitously) that "These registrations were made by the subsidiary company Sanyo Electric Co". I presume it means that it is the registered owner of the Australian trademarks, and accordingly that it has rights in those trademarks (although it is not entirely clear why it refers to Sanyo Electric Co in the third person).

None of the trademark registrations have been produced. Accordingly, I'm not satisfied that the Complainant is the registered owner of the Australian trademarks, or has any rights in them.

Complainant trading activities

As previously stated, it is not at all clear what activities (if any) the Complainant carries on in Australia (or elsewhere). The Complainant's submission refers to sales by Sanyo Oceania Pty Ltd (originally called Sanyo Australia Pty Ltd) between 2008 and 2011. The relationship between the Complainant and Sanyo Oceania Pty Ltd is not made clear. The Complainant does not refer to any of its own activities. It asserts that Sanyo is the Complainant's trading name around the world in relation to a wide range of goods and services. No proof is advanced in support of this assertion.

Original registration of the Sanyo domain name

The Complainant says that the domain name sanyo.com.au was registered in the name of Sanyo Australia Pty Ltd since at least 2007. The relationship between Sanyo Australia Pty Ltd and the Complainant is not explained but one may infer that both companies are (or were) part of the Sanyo group of companies.

Circumstances surrounding failure to renew the Sanyo domain name

The Complainant says that between 2011 and 2016 Sanyo recalled about 10,000 Sanyo - branded microwaves

The Complainant says that the domain name was controlled by a local contractor, C&CMS, and was used to display information about potential recalls and warranty. It asserts that when the contract between it and C&CMS came to an end, the Complainant made efforts to have the domain name transferred back “to their own control”, but these efforts were unsuccessful. Why the Complainant, and not Sanyo Australia Pty Ltd, contracted with C&CMS and sought re-transfer of the domain name, is not explained. Nor is any evidence produced of its attempts to wrest back control of the domain name.

The Complainant concludes that it “had no solution other than to wait for the domain registration to lapse, and to try to recover it using some online domain name drop-catching services”, which “attempt was unsuccessful, leading to the domain name being ‘drop caught’ by the Respondent.

To explain, for particularly popular domain names, there are often multiple parties anticipating their expiration. Competition for expiring domain names has since become the purview of drop-catching services, which operate to secure a domain name upon its availability, usually at an auction price.

It is incumbent on registrants to be proactive in managing their domain name registrations. To state the obvious, Sanyo Australia Pty Ltd failed to do so in allowing the registration of the domain name to lapse.

Respondent’s use and registration of the domain name

It appears that the Respondent became the registered owner of the domain name, sanyo.com.au, on about 2 December 2021, following the expiration of the earlier registration by of Sanyo Australia Pty Ltd.

The domain name currently diverts to “carexpert.com.au”, a professional website specialising in car reviews. The carexpert.com.au and sanyo.com.au registrants do not seem to be linked. The relationship between them is unclear. Similarly, the reason for the diversion of the domain traffic to carexpert.com.au is unclear.

Findings

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. I will consider each of these elements in turn.

First Element: confusing similarity

The Complainant submits that the domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights. As previously stated, I am not satisfied on the evidence that the Complainant is the registered proprietor of the current Australian trademarks, or has rights in those trademarks. Whether or not the domain name is identical or confusingly similar to those registered trademarks is therefore beside the point.

Separately, the Complainant submits that the domain name, sanyo.com.au, is identical or confusingly similar to the Complainant's company name, Sanyo Electric Co. The only real difference is the descriptive word "electric". The word "Sanyo" is the most dominant and distinctive element of the company name. However, I'm not satisfied on the evidence that Sanyo Electric Co Ltd is a currently incorporated company.

Therefore, the first element is not satisfied and accordingly the Complaint must be dismissed. It is not strictly necessary for me to consider the second and third elements, but I will briefly do so regardless.

Second element: right or legitimate interest

The Complainant submits that the Respondent has no rights or legitimate interest in respect of the domain name.

As it points out, there is no evidence of bona fide use of, or demonstrable preparations to use, the domain name (or corresponding name) in connection with an offering of goods or services, by the Respondent. I infer that the only use being made by the Respondent of the domain name is to attract traffic through the power of the well-known Sanyo brand, and then to divert that traffic to an automobile-related website which has no connection with any aspect of the Sanyo business.

I accept the Complainant's submission that neither the car expert business, nor any parties associated with it, are known by or associated with the Sanyo mark in any way, and never have been.

Nor is there any reason to believe that the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Although it is not necessary for me to decide, and I do not do so, it is arguable that the Respondent was in breach of the AUDA eligibility rules for domain names in registering the domain name.

Third element: bad faith

Finally, the Complainant submits that the domain name has been registered, or subsequently used, in bad faith. In particular, it submits that:

- (a) the Respondent has registered the domain name in order to prevent the Complainant from registering its trademark as a domain name;
- (b) the Respondent picked up the domain name via "drop catching" with the intention primarily to disrupt the Complainant's business;
- (c) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to a website, 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 of a product or service on that website.

I am not prepared to accept the Complainant's first two submissions as there is no evidence that the Respondent targeted the Complainant. However, I am prepared to accept the third submission. The reasonable inference is that the Respondent has opportunistically registered the lapsed domain name in order to exploit the famous Sanyo name to further its unrelated business interests.

Relief sought

The Complainant seeks an order transferring the domain name from the Respondent to it. This is notwithstanding that it never owned the domain name. Rather, Sanyo Australia Pty Ltd previously owned the domain name. Why that company has not brought the complaint is not explained.

Conclusion

Given the unsatisfactory nature of the evidence produced by the Complainant, the relief sought in the Complaint is refused. This of course is without prejudice to the rights of Sanyo Australia Pty Ltd to bring a separate complaint seeking the transfer of the domain name, sanyo.com.au.

Order

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

Decision

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



Albert Monichino KC

Panellist

Date: 21 April 2023