

PANEL DECISION

Case number:	auDRP_23_08
Domain:	tjm4x4.au, tjmalicesprings.au, tjmbendigo.au, tjmbundaberg.au, tjmcanberra.au, tjmcoopersplains.au, tjmgeebung.au, tjmgeelong.au, tjmherveybay.au, tjmhobart.au, tjmkewdale.au, tjmlismore.au, tjmmaryborough.au, tjmnorthernbeaches.au, tjmorange.au, tjmportmacquarie.au, tjmshepparton.au, tjmtweedheads.au, tjmunderwood.au, tjmwagga.au, tjmwollongong.au
Panel:	Andrew Robertson
Complainant:	Aeroklas Asia Pacific Group Pty Ltd
Contact person:	Daniel Gill
Respondent:	More 4x4 Pty Ltd
Contact person:	Aaron Mitchell
Date of decision:	3 October 2023

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1. PROCEDURAL HISTORY

1.1 On 20 September 2023 I was appointed by the Resolution Institute as sole panellist for this domain name dispute, following the provision by me to the Resolution Institute of my Statement of Impartiality and Independence.

1.2 The panel also received, that same day, a copy of the Resolution Institute's case file consisting of:

- (a) the Procedural Case History prepared by the Resolution Institute;
- (b) a print out copy of the online application;
- (c) letter of 9 August 2023 from Daniel Gill of the complainant (Aeroklas Asia Pacific Group Pty Ltd, "Aeroklas") to the Resolution Institute and copied to the registrar and the respondent including annexures:

- (1) list of disputed 21 domain names
- (2) details of trade marks registered by Aeroklas;
- (3) .au Domain Administration Rules: Licensing;
- (4) The fourth annexure (annexure D) is described as "Email evidence" and consists of an email chain in these terms (as a chain the earliest email is displayed last):

- (A) An email dated 6 August 2023 at 5:52pm from Aaron Mitchell apparently on behalf of the respondent (More 4x4 Pty Ltd, "More 4x4") to Daniel Glass of Aeroklas identifying the "*domain names legitimately registered below*", which is followed by a listing of the 21 disputed domain names, and then continues:

"Given the size of some of the stores, the value of each domain name varies and some are worth more than others.

Some domain names have been offered to store owners but before we conduct any individual transaction, is Aeroklas interested in purchasing all domain names in one transaction?"

- (B) An email dated 5 December 2022 at 4:33 pm from Daniel Glass of Aeroklas apparently to Aaron Mitchell of More 4x4 which includes:

"I refer to your email below.

Aeroklas is willing to accept your offer. Could you please send us an invoice for \$880 issued to 'Aeroklas Asia Pacific Group Pty Ltd' and sign and return the attached Change of Legal Owner form.

Our agent, DDNS, will handle the transfer of domain name at our cost".

- (C) An email dated 30 November 2022 at 4:13pm from Aaron Mitchell apparently on behalf of More 4x4 to Daniel Glass of Aeroklas which includes:

"Thanks for the brief telephone conversation today.

MORE 4x4 is not using any of the TJM names or trademarks and we have no intention of using the domain name or TJM's Trademark to aid our sales or promotional purposes.

The domain name was unused and available for purchase on the open market.

Entering into litigation seems a useless waste of resources especially when the going rate for auDRP filing fees are right around \$2k or more for multi member panel plus legal fees which are not recoverable from other parties.

It's a simple transaction scenario and we'd be happy to transfer the domain name into any of your preferred entity names. If you arrange a bank transfer of \$880 inc GST, we'll transfer the domain name within 7 days of receiving clearer funds"

- (D) An email dated 30 November 2022 at 2:37pm from Daniel Glass of Aeroklas apparently to Aaron Mitchell of More 4x4 which includes:

"It has come to TJM's attention that you have registered the domain names tjmnorthernbeaches.au, and records pm the WHOIS Auda database show that your company is listed as the registered owner. As you are not authorised by TJM to do so, we attach our letter in response to your conduct that is infringing TJM's rights.

Please note that, if you fail to take any action to address further damage caused to TJM from your ownership of the domain name, we will instruct our solicitors to issue proceedings against you and your company in the Federal Court of Australia."

Although there is a reference to a letter attached I do not appear to have been provided with a copy.

- 1.3 By reference to the procedural case history provided to me it appears that on 7 August 2023 Aeroklas lodged an online application with the Resolution Institute seeking a determination in accordance with auDRP Policy, Rules and Supplemental Rules regarding the domain names:

- (a) tjm4x4.au;
- (b) tjmalicesprings.au;
- (c) tjmbendigo.au;
- (d) tjmbundaberg.au;
- (e) tjmcanberra.au;
- (f) tjmcoopersplains.au;
- (g) tjmgeebung.au;
- (h) tjmgeelong.au;
- (i) tjmherveybay.au;
- (j) tjmhobart.au;
- (k) tjmkewdale.au;
- (l) tjmlismore.au;
- (m) tjmmaryborough.au;
- (n) tjmnorthernbeaches.au;
- (o) tjmorange.au;
- (p) tjmportmacquarie.au;
- (q) tjmshepparton.au;
- (r) tjmtweedheads.au;
- (s) tjmunderwood.au;
- (t) tjmwagga.au; and
- (u) tjmwollongong.au

- 1.4 Subsequent to the online application the Resolution Institute received detailed submissions via email on 9 August 2023. Both those submissions and the original on-line form elected to have the dispute resolved by a single member panel.
- 1.5 An acknowledgement of receipt of a complete complaint was provided to Aeroklas on 21 August 2023.
- 1.6 The registrar was informed of the complaint on 22 August 2023 and provided confirmation that the domain was locked that same day.
- 1.7 More 4x4 was notified of the complaint, by way of communication copied to Aeroklas, the registrar and auDA, on Thursday 23 August 2023.

- 1.8 A response was due by Wednesday 13 September but no response was received that that date.
- 1.9 I am advised that confirmation that no response had been received was sent to More 4x4, and copied to Aeroklas and auDA, on Wednesday 20 September 2023.
- 1.10 Notification of my appointment as sole panellist was sent to both Aeroklas and More 4x4, copied to auDA and the registrar, also on Wednesday 20 September 2023. As noted at the outset, that day the panel also received the case file.
- 1.11 The panel finds that it was properly constituted for this complaint.

2. PARTIES

- 2.1 The complainant, Aeroklas is a corporation (ABN 56 009 887 325).
- 2.2 The respondent, More 4x4 is also a corporation (ABN 17 627 789 208).
- 2.3 The multiple disputed domain names are set out in paragraphs 1.3(a) through to 1.3(u) of this determination.
- 2.4 The complainant is represented by its Group Legal Counsel, Daniel Gill and its solicitor Katrina Chambers of Thomson Geer.
- 2.5 The registrar identified in the complaint is Synergy Wholesale Accreditations Pty Ltd.

3. BACKGROUND AND SUBMISSIONS

The Complainant's submissions

- 3.1 I take the letter of 9 August 2023 to the Resolution Institute as setting out Aeroklas' submissions in this dispute.
- 3.2 Aeroklas advances its submissions on three grounds:
- (a) The domain names are identical or confusingly similar to a name, trademark or service mark in which Aeroklas has rights; and
 - (b) More 4x4 has no rights or legitimate interest in respect of the domain names; and
 - (c) The domain names have been registered or subsequently used in bad faith.
- 3.3 The submissions then go on to develop each of these propositions.

Identical or confusingly similar to a trademark

- 3.4 Annexure B to the letter of 9 August 2023 identifies the trademarks relied upon by Aeroklas.
- 3.5 Annexure B consists of 68 pages setting the trademarks in the word TJM, by itself or in combination with orders or in combination with images, in the name of Aeroklas.
- 3.6 The written submissions note Aeroklas has been the registered owner of the trademark in the word TJM since 17 July 1991.

The Respondent has no rights or legitimate interest in respect of the domain names

- 3.7 Aeroklas direct attention to the email of 30 November 2022 contained in Annexure D from More 4x4. I have extracted portion of that email above.
- 3.8 Aeroklas notes that More 4x4 apparently claimed in that email that it was not using any of the TJM names or trademarks and it has no intention of using the domain name or trade marks of Aeroklas to aid its sales or promotional materials.
- 3.9 Aeroklas alleges that More 4x4 is not licensed by Aeroklas to use the name of TJM or any of Aeroklas' trademarks.
- 3.10 Aeroklas asserts that use of the domain names by More 4x4 would be in breach of a range of Australian laws including:
- (a) Misleading and deceptive conduct laws under the Australian Consumer Law;
 - (b) Trademark infringement laws; and
 - (c) The common law offence of "passing off".

The domain names have been registered in bad faith

- 3.11 Aeroklas refer to the email exchange of 30 November and More 4x4's offer to transfer the domain tjmnorthernbeaches.au in exchange for \$880, being an amount less than the fees required to file a complaint pursuant to the auDRP.
- 3.12 The submissions indicate that Aeroklas paid that sum and the domain name was subsequently transferred to Aeroklas. However, the relevant domain is still listed in the More 4x4 email of 6 August 2023 and in the on-line complaint. As such it remains one of the disputed domain names for the purposes of this process.
- 3.13 Subsequently Aeroklas submits that the correspondence establishes that all of the disputed domain names were offered for sale to Aeroklas, and some to the relevant store owners.
- 3.14 The submissions proceed to then assert that:
- (a) The evidence shows that More 4x4 have registered the domain names primarily for the purpose of selling or otherwise transferring the disputed domain names to another person for valuable consideration in excess of out-of-pocket costs directly related to the domain names; and
 - (b) More 4x4 has registered the domain names for the sole purpose of cybersquatting and domain name monetization.
- 3.15 The differing formulation of the motivation is not explained on the evidence.
- 3.16 It is alleged by Aeroklas that the asserted cybersquatting by More 4x4 is a breach of the warranties contained in rule 2.10 of the .au Domain Administration Rules. This asserted breach of warranty is said to be further evidence of bad faith.

Remedy sought by the complainant

- 3.17 In its submissions Aeroklas seeks the transfer of the disputed domain names to it or, failing that being an accepted remedy, cancellation of the disputed domain names.

The Respondent's submissions

- 3.18 As noted, no response was received from More 4x4.

4. RELEVANT PRINCIPLES

- 4.1 This complaint is to be resolved in accordance with the auDRP Policy, Rules and Supplemental Rules.
- 4.2 That material identifies the matters which the panel is to determine and the range of outcomes available in this process.
- 4.3 The determination of a panel are limited to three specific outcomes: There are two remedies available to a complainant to seek:
- (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.
- 4.4 These remedies are the sole remedies available to a complainant in this process. There is a third alternative outcome to a dispute under the auDRP policy and that is a dismissal of the complaint.
- 4.5 Those three alternative outcomes represent the outcomes available to parties utilising the auDRP.
- 4.6 The auDRP sets out the mechanism by which the panel is to conduct the proceedings, especially in Schedules A and B of the auDRP.
- 4.7 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.
- 4.8 I note that these reflect these are the matters to which Aeroklas has directed its submissions.

- 4.9 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.
- 4.10 Although More 4x4 has not provided a response the panel cannot make orders unless Aeroklas have provided evidence to the panel to discharge Aeroklas' onus. The requirements of 4(a) are cumulative in that each of 4(a)(i), (ii) and (iii) must be satisfied if a complainant is to be successful in proceedings pursuant to the auDRP.
- 4.11 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 in Schedule A paragraph 4(b) but it is noted they include 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.
- 4.12 I now consider each of paragraphs 4(a)(i), (ii) and (iii) of Schedule A of the auDRP Policy in turn.

Identical or confusingly similar

- 4.13 I have set out the evidence and submissions of Aeroklas above.
- 4.14 There are multiple disputed domain names.
- 4.15 I do not understand Aeroklas to be asserting that the disputed domain names are identical to the trademarks alleged. For the complainant to discharge its onus it is sufficient if the dispute domain names are confusingly similar.
- 4.16 Each of the domain names commence with TJM.
- 4.17 Each of the domain names further contains the letters TJM together with either a geographical indicator (for all but one) or the addition 4x4.
- 4.18 In the absence of any material from More 4x4 I find the disputed domain names in each of their formulations are deceptively similar to the trademark in TJM which Aeroklas has established it holds.
- 4.19 Accordingly, I find that Aeroklas has established the matters it is required to establish for the purposes of 4(a)(i).

No rights or legitimate interests

- 4.20 The material set out in annexure D and the submissions relating thereto have been set out above.
- 4.21 I note the email chain in annexure D and relied upon by Aeroklas. This is to be contrasted with the absence of any explanation of that chain by More 4x4.

4.22 That chain contains this statement apparently on behalf of More 4x4:

“MORE 4x4 is not using any of the TJM names or trademarks and we have no intention of using the domain name or TJM’s Trademark to aid our sales or promotional purposes.”

4.23 No right or legitimate interest is positively asserted by More 4x4.

4.24 I note the assertion by Aeroklas that More 4x4 is not licensed by Aeroklas to use the name of TJM or any of Aeroklas’ trademarks.

4.25 None of this material assists me to identify More 4x4 as having a relevant right or legitimate interest.

4.26 I am satisfied that Aeroklas has established the matters it must establish for the purposes of 4(a)(ii) of the Policy.

Registered or Subsequently used in Bad faith

4.27 In considering the requirement of bad faith I have had regard to 4(b) of the Policy and the non-exclusive circumstances set out in 4(b)(i) through to 4(b)(v).

4.28 In particular I note 4(b)(i) which provides (the language is directed to the position of the respondent):

“(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name”

4.29 In my view I only need to be satisfied of the primary purpose.

4.30 There is evidence that:

- (a) More 4x4 has no intention of using the domain name or TJM’s Trademark to aid More 4x4’s sales or promotional purposes;
- (b) More 4x4 has apparently offered the domain names to Aeroklas, and others, seeking a sum of money for the transfer;
- (c) The amount sought by More 4x4 appears to be determined as being competitive with *“the going rate for auDRP filing fees are right around \$2k or more for multi member panel plus legal fees which are not recoverable from other parties”*, no reference is made to the costs related to obtaining registration of the domain names.


4.31 More 4x4 has not provided its own evidence of its purpose in registering the disputed domain names.

4.32 The policy directs my attention to what the circumstances indicate.

4.33 I am satisfied that the evidence establishes that Aeroklas has established the requirements of 4(a)(iii).

5. CONCLUSION AND DECISION

- 5.1 Accordingly, I am of the view that Aeroklas has established the matters it is required to establish for the purposes of this dispute and is entitled to the remedy it seeks in accordance with paragraph 4(i) of Schedule A of the auDRP Policy.
- 5.2 Pursuant to paragraphs 4(a) of Schedule A of the auDRP Policy and paragraph 15 of the auDRP Rules, I direct that all of the disputed domain name registrations be transferred to the complainant consistent with paragraph 4(i) of Schedule A of the auDRP Policy.



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Andrew Robertson

Dated: 3 October 2023