

ADMINISTRATIVE PANEL DECISION

Trova Pty Ltd
v
David Andrew Priest

auDRP_23_1

<portstephensaccommodation.com.au>

1 Executive Summary

For the reasons set out below the Complaint is dismissed and the Panel makes a finding of Reverse Domain Name Hijacking.

2 The Parties

The Complainant is Trova Pty Ltd of Newcastle, NSW. It is represented in the proceedings by Ms Aimee Travis of Travis Partners, a law firm in Newcastle, NSW.

The Respondent is Mr David Andrew Priest of Lota, QLD. He is self-represented.

3 The Disputed Domain Name and Registrar

The Disputed Domain Name is <portstephensaccommodation.com.au>. The registrar of the Disputed Domain Name is DROPP.com.au Pty Ltd.

4 Procedural History

This is an administrative proceeding pursuant to the .au Dispute Resolution Policy originally adopted by auDA on 13 August 2001, and subsequently amended on 1 March 2008 and re-issued on 15 April 2016 (“auDRP” or “Policy”); 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 Form was filed with Resolution Institute (**RI**) on 24 January 2023. This was forwarded to the Registrar on 31 January with a request that the registration particulars be confirmed, and the Disputed Domain Name be locked. On

13 February 2023 RI received an email from the Registrar confirming the accuracy of the named registrant and contact particulars and advising that the Disputed Domain Name had been server locked. auDA and Mr Priest were also notified of the Complaint on the same day.

Under Rule 5(a) a Response was due 20 calendar days after the proceeding commenced. The Rules make no allowance for weekends or public holidays. Under Rule 4(c) the proceeding is taken to have commenced on the date on which RI completed its responsibilities under Rule 2(a) in forwarding the Complaint to the Respondent. Under Rule 2(g) times are calculated from the date a communication was first made under Rule 2(f) – in this case, 13 February 2023. Accordingly, the last date for filing a Response was Sunday 5 March 2023. In fact a Response was submitted on Friday 3 March 2023.

Following receipt of a formal Response, RI approached the Panel and, following the Panel's Declaration of Independence and Statement of Impartiality, the parties were notified of the Panel's appointment on 9 March 2023 and RI transmitted the case file to the Panel on 10 March 2023.

All other procedural requirements in relation to the proceedings appear to have been satisfied.

5 Factual Background

The Disputed Domain Name was first registered on 4 December 2011.

The Complainant is the trustee of the Trova Unit Trust and in that capacity became the registered proprietor of the business name "*Port Stephens Accommodation*" (the **Business Name**) on 10 November 2017.

It lodged an application for the trademark PORT STEPHENS ACCOMMODATION (the **Trademark**) on 23 November 2022.

The Complainant also registered the business names "*Find Port Stephens Accommodation*" (27 October 2022) and "*Accommodation*" (28 October 2022).

6 Parties' Contentions

Complainant

The Complainant asserts that:

- a) the Disputed Domain Name is identical or confusingly similar to the Business Name and the Trademark in both of which the Complainant has rights;
- b) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- c) the Disputed Domain Name has been registered or subsequently used in bad faith.

In support of the first of those grounds the Complainant submits that:

1. the Disputed Domain Name wholly reproduces the Business Name and the Trademark if the second level domain (**2LD**) .com and the country code top level domain (**ccTLD**) .au are ignored;

2. the 2LD and ccTLD are to be disregarded when comparing a domain name to a trademark, for which proposition it cites the recent decision *Government Employees Insurance Company v Andrew Grover, A22 Pty Ltd*, case no. DAU2022-022 which it says confirms the long standing approach of panels under both auDRP and UDRP; and.
3. The Complainant has rights in the Business Name (as proprietor) and in the Trademark (as applicant for registration and as user of a logo in which the words are prominent).

In support of the second ground the Complainant submits that:

1. the Disputed Domain Name resolves to a web page associated with HotelsCombined which is said to be a competitor of the Complainant;
2. prior to 10 November 2017 the Respondent had only registered the business names “Northern Rivers” and “Northern Rivers Website”. He had not otherwise registered any business names that related to Port Stephens accommodation. The Complainant asserts that it has not been able to find any trademark or corporate name linking the respondent to the Disputed Domain Name;
3. the Disputed Domain Name was registered “years after the Business Name was first registered and used”;
4. the Respondent’s use of the Disputed Domain Name does not represent a bona fide offering given that it diverts Internet users to a webpage associated with HotelsCombined and thus capitalises on the reputation and goodwill of the Business Name built over a period exceeding 25 years and thereby misleads Internet users for commercial gain by HotelsCombined;
5. there is no evidence that the Respondent has been commonly known by the Disputed Domain Name;
6. the Respondent has not been making a legitimate non-commercial or fair use of the Disputed Domain Name without intent for commercial gain to misleadingly divert consumers to tarnish the Business Name and Trademark; and
7. the Complainant has not given any authorisation to the Respondent to the use of the Business Name in any form.

In support of the third ground of the Policy the Complainant submits that:

1. the use of the Disputed Domain Name by the Respondent is a misuse of the Complainant’s long-standing Business Name and, in addition to capitalising on the reputation and goodwill of the Business Name, the Respondent’s use of the Disputed Domain Name prevents the Complainant from reflecting its name in the .com.au namespace;
2. the diversion of Internet users to a webpage associated with HotelsCombined creates a likelihood of confusion and Internet users are likely to mistake the Complainant’s Business Name and Trademark as being owned by, or affiliated with, HotelsCombined. The effect (and likely intent) of the diversion is for Internet users who intend to book accommodation through the Complainant’s Port Stephens

Accommodation platform to be presented with, and book through, the HotelsCombined platform being used by the Respondent;

3. the Respondent has registered or acquired the Disputed Domain Name primarily for the purpose of selling, renting or otherwise transferring the Disputed Domain Name registration to another person for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the Disputed Domain Name;
4. the Disputed Domain Name was registered by the Respondent primarily for the purpose of disrupting the business activities of the Complainant; and/or
5. the Respondent 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 and mark as to the source, sponsorship, affiliation or endorsement of that website or location or of a product or service on that website or location.

The Complainant seeks transfer of the Disputed Domain Name to itself.

7 Respondent's Response

The Respondent submits that:

- a) the Complainant is a subsidiary of Alloggio, a recently listed ASX company whose CEO William Creedon purchased the domain names <portstephensaccommodation.com> and <accomnelsonbay.com> and business from Accom Nelson Bay Pty Ltd in 2017;
- b) the Complainant is not the registrant of <portstephensaccommodation.com> - the domain name it operates on is still owned by Mr Creedon;
- c) all parties involved in the 2017 sale or purchase of Accom Nelson Bay Pty Ltd's business would have known of the existence of the Disputed Domain Name and of the website to which it resolved but knowingly chose to build a business on "the.com version of the name" for over five years prior to lodgement of the Complaint;
- d) the Complainant does not own a trademark for "Port Stephens Accommodation". Despite having recently applied to register the same the application is unlikely to be accepted given that it is a geographic location with a descriptive word similar to the Leeton Wine example given by IP Australia as the kind of expression that is not sufficiently distinctive to become a trademark;
- e) the Complainant does not have an unregistered trade mark matching the Trademark and provides no evidence to support that assertion;
- f) the Complainant itself was only incorporated in 2017;
- g) the Business Name was only registered in 2017 nearly 6 years after the Respondent registered the Disputed Domain Name;
- h) the Complainant seems to claim or imply equity in a continuous presence and reputation in the Business Name since 1995;

- i) the Business Name was first registered by Accom Nelson Bay Pty Ltd in 2009 which is significantly less than the claimed 25 years;
- j) the Complainant's own evidence demonstrates that the website to which the Disputed Domain Name resolves provides a service exactly matching the words in the Disputed Domain Name;
- k) the Respondent uses a widget provided by HotelsCombined that provides a service for visitors to find accommodation in Port Stephens, being a service that exactly matches the Disputed Domain Name and is absolutely a bona fide use thereof;
- l) the Complainant does not have exclusive rights to the area of commerce that involves Port Stephens accommodation;
- m) although the Complainant claims that HotelsCombined is a competitor, its parent company's website claims them to be a partner – HotelsCombined is in fact owned by Booking.com;
- n) the Respondent is a sole trader with an Australian Business Number and is not required to have a business name to support his registration of the Disputed Domain Name;
- o) Accom Nelson Bay Pty Ltd made an offer to purchase the Disputed Domain Name in 2014 - which the Respondent rejected;
- p) prior to becoming aware of this dispute the Respondent created a website to which the Disputed Domain Name resolves and which provides a service that exactly matches the Disputed Domain Name, namely, to find and book accommodation in the Port Stephens area of New South Wales;
- q) the Respondent has purchased and developed over 20 other domain names in a similar fashion for the last decade which he says shows that he did not primarily or otherwise target the Complainant.

The Respondent explains his business model as being the purchase of domain names on public drop auction sites because they have high keyword search numbers and are type-in domains, are geographic place names plus a dictionary/service/generic word and because they are highly descriptive and generally not able to be trademarked nor likely to have common law rights associated with them. He says he then builds simple websites that satisfy the intent of those type-in visitors.

The Respondent includes evidence of some of his portfolio of websites which he says shows that he did not primarily target the Complainant or any other entity and that he has made considerable effort with his business model prior to the Complaint not only in respect of the Disputed Domain Name but for many others.

The Respondent re-emphasises his choice of geographic names plus a service word because they are highly descriptive and lack distinctiveness which makes them unlikely to be able to be trademarked or claimed to be an unregistered trademark, noting that the onus is on any claimant to prove they have rights in such expressions as a trademark. The Respondent in particular submits that the Complainant has completely failed to provide evidence in support of its submissions to the contrary.

The Respondent states that he rejected the offer by Accom Nelson Bay Pty Ltd to purchase the Disputed Domain Name in 2014 because he wanted to build a website and says that that intention negates any inference that he registered it merely to sell it for commercial gain.

The Respondent then goes on to assert that he has received “harassing and intimidating letters via email from the Complainant’s lawyers” which he submits were an attempt “to intimidate me into surrendering a valuable asset, created fear through the use of legal jargon and superior legal knowledge, and threatened to seek costs from me”.

The Respondent says that he declined to respond to emails from the Complainant’s lawyers because he perceived their client to be “bullies trying to steal my domain”.

The Respondent concludes by submitting that the Complaint does not provide a skerrick of evidence that he acted in bad faith at any point.

The Respondent also requests a finding of attempted Reverse Domain Name Hijacking against the Complainant on the following grounds:

1. it knew or should have known that the Complaint provided no evidence to support any of its claims of bad faith behaviour;
2. it is represented by legal practitioners who know or should know that the Complaint was without merit;
3. no attempt was made prior to filing the Complaint to settle the dispute with a commercial offer;
4. it has attempted to harass him with threatening legal letters from its lawyers.

8 Discussion and Findings

Paragraph 4(a) of the auDRP requires the Complainant to prove that:

- (i) the Disputed Domain Name is identical or confusingly similar to a name, trade mark or service mark in which it has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and
- (iii) the Disputed Domain has been registered *or* subsequently used in bad faith.

The Panel has to decide the case based on the available evidence, and the Complainant must prove that all of the elements of the Policy are satisfied, at least on the balance of probabilities.

Identical or confusingly similar to a name or trademark in which the Complainant has rights

On the day that the Complaint was lodged the Complainant was both the registered owner of the Business Name and the applicant for the Trademark.

Under this limb of the Policy the exercise is essentially one of comparing character strings and no account is taken of the content of any website nor of the dates on which the rights

relied upon by the Complainant accrued. Also, the “.com.au” is ignored for the purposes of this comparison unless they are demonstrably relevant.

Under Australian law, a person doing business under a name other than their actual name is required to register the business name so that those with whom it engages in trade are able to identify the person or entity with whom they are dealing. A business name registration does not confer any rights to the use of the name even though its presence on the register precludes others from registering an identical name as a business or company name. Therefore although the auDRP, unlike the UDRP, permits a complaint to be brought on the basis of either a name or a trademark, the requirement for a name to be one in which the complainant has rights is not satisfied simply by owning and using a registered business name.

The Panel observes that the Disputed Domain Name is comprised of the words *Port Stephens Accommodation* being both the Business Name and the Trademark, followed by “.com.au”. Although the circumstances of the Complainant’s very recent filing of its application for the Trademark are questionable, and ignoring the 2LD and the ccTLD as is long-standing practice, the Panel has no option but to find that the Disputed Domain Name is identical to the Trademark in which the Complainant has the barest of rights as the applicant for registration, thus technically satisfying the first limb of the Policy.

In the highly unlikely event that the Complainant’s application for the Trademark is accepted by IP Australia in respect of accommodation services, the Respondent would have sound grounds to oppose the registration of the Trademark for the reasons that he propounds. However, the Panel cannot take this factor into consideration under the first limb of the Policy because the application has neither been rejected nor lapsed. The circumstances are relevant under the second and third limbs of the Policy as well as in the consideration of whether to make a finding of Reverse Domain Name Hijacking.

No Right or Legitimate Interests in respect of the Disputed Domain Name

As the Respondent has submitted, the Disputed Domain Name comprises the geographic name *Port Stephens* together with the ordinary English word *accommodation*. The Disputed Domain Name resolves to a website which enables Internet visitors to find and book accommodation in Port Stephens.

Furthermore the Disputed Domain Name was registered in 2011 – some six years before the Complainant registered the Business Name and 11 years before it applied for the Trademark. Not only that, the Respondent is in fact using the Disputed Domain Name for a website which enables Internet visitors to find and book accommodation in Port Stephens. That seems to the Panel to be a perfectly legitimate use of the Disputed Domain Name and one which gives the Respondent a legitimate interest in respect of the Disputed Domain Name.

Those circumstances alone are sufficient for the Panel to find that the second limb of the Policy has not been made out by the Complainant. Other provisions of the Policy can also be relied upon by the Respondent to negate the Complainant’s submissions in relation to this limb of the Policy.

Registered or subsequently used in bad faith

Given the Panel’s finding in relation to the second limb of the Policy and the chronology referred to in both the Factual Background and the above discussion, it is impossible for

the Panel to find that the Disputed Domain Name was registered in bad faith in 2011. Furthermore, as the Complainant's own evidence shows, the Respondent is making use of the Disputed Domain Name to offer finding and booking services in respect of accommodation in Port Stephens. Those circumstances make it similarly impossible for the Panel to find that the Respondent is using the Disputed Domain Name in bad faith.

In relation to the Complainant's allegation that the Disputed Domain Name was registered for the purpose of selling it at an inflated price rather than using it in connection with a bona fide offering of goods or services, the Panel accepts the Respondent's explanation for his rejection of the 2014 offer from the Complainant's predecessor in business to purchase the Disputed Domain Name, namely, that he intended to use it in the manner in which it is now being used.

The Panel finds that there is no evidence to support any finding of bad faith registration or subsequent use of the Disputed Domain Name on the part of the Respondent and declines to do so.

9 Order

The Complainant has failed to prove two out of the three elements 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 forthwith.

10 Reverse Domain Name Hijacking

Given the above findings and order it is apparent that the Panel is of the view that the Complaint was without merit and should never have been lodged. It is obvious from the language used in the Complaint that the Policy and its associated jurisprudence is well-known to the Complainant's lawyers. It should have been abundantly clear to them that the background facts and the evidence they filed was hopelessly incapable of supporting the Complaint. In particular, the evidence did not even come close to supporting many of the submissions made. Complainants and their legal representatives must take care not to construct complaints by a ritualistic recitation of matters which have historically been found to make good the three grounds of the Policy. Submissions must be tailored to the facts of each case and, in particular, supported by the evidence filed.

The Panel has formed the view that the Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking and primarily to harass the Respondent. Accordingly, the Panel formally declares pursuant to paragraph 15(e) of the Rules that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

Dated this 18th day of March 2023

The signature is written in a blue, cursive font.

Philip N Argy
Panellist