



auDRP_16_07

Single Panellist Decision - Jennifer Scott

Domain Name: www.parkopedia.com.au

Complainant PARKOPEDIA LIMITED

Respondent PARKHOUND PTY LTD

1. THE PARTIES

- 1.1 The Complainant in this proceeding is Parkopedia Limited.
- 1.2 The Respondent to the proceeding is Parkhound Pty Ltd.

2. SUBJECT MATTER OF COMPLAINT

- 2.1 The domain name in dispute: "**www.parkopedia.com.au**" ("Domain Name").
- 2.2 Jurisdiction: auDRP Rules 3(a) and 3(b)(xv).
- 2.3 The registrar of the Domain Name is Crazy Domains ("Registrar").

3. BASIS OF DETERMINATION

3.1. The complaint was submitted for determination by a single panellist under:

- 3.1.1. The provisions of Schedule A of the .au Dispute Resolution Policy and Rules 2016-01 ("auDRP"). The Policy was approved by auDA in 2001, commenced

operation on 1 August 2002 and was most recently approved by the auDA Board and published as Policy 2016-01 on 15 April 2016.

3.1.2. The Policy includes the Rules for .auDRP (“the Rules”) and the LEADR (now RI) Supplementary Rules for .auDRP (“the Supplemental Rules”).

3.2 Section 4 of the auDRP covers Mandatory Administrative Proceedings.

4. Procedural History

4.1. The full complaint regarding the domain name www.parkopedia.com.au (the Domain Name) was submitted to Resolution Institute (RI) on 16 September 2016 for decision in accordance with the .au Domain Name Dispute Resolution Policy (“the auDRP” or “the Policy”).

4.2. On 16 September 2016, RI acknowledged receipt of the complaint.

4.3. On 20 September 2016, RI transmitted by email to Crazy Domains a request for registrar verification and to lock the domain name during proceedings. The registrar confirmed locking of the domain name on 23 September 2016.

4.4. On 26 September 2016 RI notified auDA of the complaint and also sent the respondent a copy of the complaint by email and post, confirming that the due date for response was 16 October 2016.

4.5. As no acknowledgement was received from the Respondent, RI sent an email reminder to the Respondent on 10 October 2016. The Respondent has not responded with any information in response to the complaint.

4.6. On 19 October 2016 procedures for nominating and appointing the panellist were commenced and completed on 20 October 2016.

4.7. On 20 October 2016 RI forwarded the case file to the panellist Jennifer Scott. The panel finds that it was properly constituted. The panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by RI to ensure compliance with the Rules, paragraph 7.

4.8. The decision is due on 2 November 2016.

5. Facts alleges by the Complainant

The Complainant relies upon the following matters (summarised) in support of its application to have the domain name transferred to it:

- 5.1. The Parkopedia business was established in 2007 by Eugene Tsyркlevich. In July 2007 Mr Tsyркlevich incorporated the business as Parkopedia Limited, a UK limited liability company. The company operates an online service for users to search for and locate and book car parking spaces throughout the world, including Australia, under the name PARKOPEDIA.
- 5.2. The Respondent was incorporated in Victoria in September 2014 with two directors, Michael Matthew Nuciforo and Robert Vincent Crocitti. It operates a car parking space leasing business known as 'Parkhound' and has a website www.parkhound.com.au. The Respondent also has online presence with the name 'Parkhound' on twitter, Facebook and instagram.
- 5.3. The Respondent was the registered owner of the Domain Name at least since April 2015. Currently there is no website located at the Domain Name.
- 5.4. According to the Complainant, on or around February 2015, the Complainant became aware that the Respondent's directors had applied for registration of the trademark PARKOPEDIA in Australia on 22 January 2015. On 9 February the Complainant wrote to Mr Nuciforo requesting the application be withdrawn. The Complainant's documents confirm that the Respondent's application was withdrawn on 16 February 2015.
- 5.5. On 24 June 2015 the Complainant began corresponding with the Respondent requesting the Domain Name be redirected from the 'Parkhound' website to the complainant's Australian website. On 18 July the Respondent responded with the reply *"Parkhound Pty Ltd is waiting for formal written offer for purchase of the domain"*.

6. Facts alleged by the Respondent

- 6.1. The Respondent has not lodged a response and therefore there are not submissions for the panel to consider.

7. DISCUSSION AND FINDINGS

Jurisdiction

7.1. Paragraph 2.1 of the auDRP states:

“All domain name licences issued in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP. At the time of publication, the open 2LDs are asn.au, com.au, id.au, net.au and org.au...”

7.1.1. The Domain Name is an open 2LD within the meaning of this provision. As the Domain Name was registered around 2014 it is subject to the mandatory administrative proceeding prescribed by the auDRP.

Basis of decision

7.2. Paragraph 15(a) of the auDRP Rules states:

“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy [the auDRP Policy], these Rules and any rules and principles of law that it deems applicable.”

Elements of a successful complaint

7.3. According to schedule A paragraph 4(a) of the auDRP Policy, a person is entitled to complain about the registration or use of a domain name where:

(i) The domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and

(ii) The respondent to the complaint has no rights or legitimate interests in respect of the domain name; and

(iii) the respondent’s domain name has been registered or subsequently used in bad faith.

7.3.1. It is to be noted that the three elements of a complaint under paragraph 4(a) of the auDRP Policy are cumulative; all of them must be proved if the complaint is to be upheld.

Is www.parkopedia.com.au identical or confusingly similar to a name, trademark or service mark in which the complainant has rights?

7.4. The Panel must determine whether, on the basis of the facts set out in section 4 above, the Complainant has rights in a relevant name, trademark or service mark.

7.4.1. The auDRP Policy states:

“For the purposes of this policy, auDA has determined that a “name...in which the complainant has rights” refers to

- (a) the complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority;*
- (b) the complainant’s personal name.”*

7.4.2. The Panel notes that the Complainant has an established right in the trademark since 18 March 2015 and is the owner of Australian Trade Mark Registration No. 1742089 filed on 5 August 2015.

7.4.3. The auDRP Policy does not provide guidance as to the intended meaning of “identical” or “confusingly similar”. Panelist N J Hickey in *Camper Trailers WA Pty Ltd v Off Road Equipment Pty Ltd* LEADR Case number 06/2004(12 November 2004) provided a summary of recent principles arising out of other domain name dispute decisions:

“(a) *“Identical”*

As was noted in BlueChip InfoTech Pty Limited v Roslyn Jan and Blue Chip Software Development Pty Ltd LEADR Case No. 06/03 (26 December 2003), “essential or virtual identity” is sufficient.

(b) “Confusingly Similar”

(i) The “level domain” components of domain names (that is, “.com”, “. net” and similar suffixes) are to be ignored when comparing domain names with other names or marks (see for example GlobalCenter Pty Ltd v Global Domain Hosting Pty Ltd, WIPO Case No DAU2002-0001(5 March 2003) referred to in Esat Communications Pty Ltd v Kingford Promotions Pty Ltd LEADR Case No. 03/2003 (11 July 2003)).

(ii) The test of “confusing similarity” is confined to a comparison between the disputed domain name and the name or trade mark alone, independent of other marketing and use factors usually considered in trade mark infringement or other competition cases (see for example The Crown in Right of the State of Tasmania trading as “Tourism Tasmania” v James Gordon Craven, WIPO Case No DAU2003-0001 (16 April 2003).

- 7.4.4. These principles do not clarify what “confusing similarity” means. In particular, it is not clear what is contemplated to be “confusing” in circumstances where similar domain names and other names are registered or used by different persons. As noted in *Camper Trailers WA Pty Ltd*, the test of “confusing similarity” could be applied in much the same way as the test of “deceptive similarity” in trade mark infringement cases, where the concept of “deception” contemplates consumers who may be deceived or “caused to wonder” about the source or origin of goods or services.”
- 7.4.5. It is clear in the present case that the only additional component between the Complainant’s company and domain name with the disputed Domain Name, concerns the “.au”. As stated in *GlobalCentre* one should ignore the “.com.au” component of the Disputed Domain Name in making the comparison.
- 7.4.6. The Complainant has, therefore, satisfied the requirement of “identical” in paragraph 4(a) (i) of the auDRP Policy.

Does the Respondent have any rights or legitimate interests in respect of www.parkopedia.com.au?

- 7.5. Paragraph 4(c) of the auDRP Policy sets out particular circumstances, which can demonstrate a Respondent’s “rights or legitimate interests to the domain name for purposes of Paragraph 4(a) (ii).”
- 7.5.1. The first issue to consider is whether the Respondent, prior to being notified of the subject matter of the present dispute, made “*bona fide use of or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with an offering of goods or services*” (paragraph 4(c) (i)).
- 7.5.2. Although both the Complainant and the Respondent provide similar services to the public, the Respondent trades using the name ‘Parkhound’ and has not been known as PARKOPEDIA. When contacted by the Complainant in February 2015 regarding its application to register the trademark PARKOPEDIA, the Respondent immediately withdrew the application and confirmed that it “*seems to have been an oversight*”. The Panel further notes the Respondent’s initial use of the PARKOPEDIA website as a means of diverting internet enquiries to the “Parkhound” website.

7.5.3. Based on its evaluation of all the evidence presented, the Panel is satisfied that the Respondent's use of the Domain Name was not bona fide.

7.5.4. Accordingly, the Panel finds that paragraph 4(a)(ii) of the auDRP Policy has been satisfied by the Complainant.

**Has www.parkopedia.com.au been registered or subsequently used in bad faith?
(Paragraph 4(a)(iii))**

7.6. Whether a domain name is registered and/or subsequently used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in the Policy:

i. Circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or

ii. The registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

iii. By using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location. Paragraph 4(b) of the Policy.

7.6.1. With respect to paragraph 4(b) (i) of the auDRP Policy, the Panel notes the Respondent's correspondence suggesting the Complainant make an offer made to purchase the Domain Name. Although a price was not mentioned, the Panel is satisfied that the Respondent registered or acquired or used the Domain Names primarily for the purpose of denying the Complainant the use of the Domain Name or transferring it for valuable consideration.

7.6.2. The Complaint submits that the Respondent registered the Domain Name primarily for the purpose of disrupting the Complainant's business. The Panel is satisfied that the Domain Name was used to divert PARKOPEDIA internet

enquiries to the Respondent's 'Parkhound' website, thereby disrupting the Complainant's business in Australia.

7.6.3. The evidence provided by the Complainant clearly demonstrates that the Complainant and Respondent companies are in a similar market. The Domain Name and the Complainant's name are identical. In the Panel's view, the Respondent has attempted to use the Domain Name to *"intentionally attempt to attract, for commercial gain, Internet users to a website or other online location by creating a likelihood of confusion."*

7.6.4. For the reasons outlined above, the Complainant has satisfied the requirements of paragraph 4(a) (iii) of the auDRP Policy.

8. RELIEF

Transfer of the Domain Name

- 8.1. The Complainant has sought that the Domain Name be transferred to the Complainant.
- 8.2. Eligibility for a domain name in the open 2LDs is governed by auDA's Domain Name Eligibility and Allocation Rules for the Open 2LDs (2002-07) ("**Eligibility Rules**").
- 8.3. The Complainant owns an Australian registered trademark and the Domain Name forms part of the Complainant's Company Name. The Complainant therefore satisfies the Eligibility Rules.
- 8.4. The Panel orders that the Domain Name www.parkopedia.com.au be transferred to the Complainant.

9. DECISION

- 9.1. The Complainant has satisfied the elements of paragraph 4(a) of the auDRP Policy.

Dated: 1 November 2016

JENNIFER A SCOTT
SOLE PANELLIST