



## **ADMINISTRATIVE PANEL DECISION**

**Conveyancing Canberra Pty. Ltd.**

**v.**

**The Trustee for QC Unit Trust**

**auDRP\_18\_03**

**<conveyancingcanberra.net.au>**

### **1. The Parties**

The Complainant is Conveyancing Canberra Pty. Ltd., of Canberra, ACT 2601, represented by Maxwell & Co, Solicitors and Barristers, of Canberra, ACT 2601.

The Respondent is The Trustee for QC Unit Trust, of Canberra, ACT 2601, represented by Legalx Group of Canberra ACT 2601.

### **2. The Disputed Domain Name and Registrar**

The disputed domain name is <conveyancingcanberra.net.au> ("the Domain Name"). The Registrar of the Domain Name is Synergy Wholesale Pty Ltd.

### **3. Procedural History**

This is an administrative proceeding pursuant to the 2016-01.au Dispute Resolution Policy published by auDA on April 15, 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").

The Complaint was received by Resolution Institute ("RI") via email on Friday 4 May 2018 and acknowledged on Tuesday 8 May 2018. That day a copy of the Complaint was emailed to the Registrar with a request to clarify the Respondent's details and to lock the Domain Name pending the final decision in this proceeding. On Thursday 10 May 2018 the Registrar confirmed via email that the Domain Name has been locked. On Friday 11 May 2018 RI advised auDA of the Complaint via e-mail and emailed the Respondent with written notification of the Complaint lodged against it. These notifications were copied to the Complainant. The due date for a Response was Thursday 31 May 2018. On that day the Respondent's representative submitted an email in Response to the Complainant and to RI. On Monday 4 June 2018, RI approached the Panellist, who that day confirmed his availability, informed RI that he has no conflict issues with the parties and accepted the matter. The case file and relevant correspondence was forwarded to the Panellist on Tuesday 5 June 2018.

#### **4. Factual Background**

Both parties provide conveyancing services in Canberra. The Complainant registered the business name Conveyancing Canberra with the Australian Securities & Investments Commission ("ASIC") on December 17, 2010. The Domain Name was registered in the name of the Respondent on July 12, 2016.

#### **5. Parties' Contentions**

##### **Complainant**

The Complainant says the Domain Name is identical to its registered business name Conveyancing Canberra, under which it has carried on business since it was registered on December 17, 2010. The Domain Name is also confusingly similar to the Complainant's domain name <conveyancingcanberra.com.au>.

The Respondent does not have a legitimate right to the Domain Name, as it is not and has not been known by the Domain Name. The Respondent's registration of the Domain Name does not establish entitlement to the name as shown in Note 2 to Paragraph 4(a)(ii) of the auDRP. The Complainant has legitimate rights to the Domain Name as it represents the Complainant's company name and business name as registered with ASIC.

The Respondent is using the Domain Name in bad faith as per Paragraph 4(b)(iii) of the auDRP. The Respondent is intentionally using the Domain Name as a portal to direct Internet users to its other website, which constitutes the use of the Domain Name in bad faith as described in Paragraph 4(b)(iv) of the auDRP.

##### **Respondent**

The email from the Respondent's representative reads as follows:

"We refer to the above complaint and respond as follows:

- We have been operating in Canberra providing conveyancing services since 1968.
- We are aware that IP Australia will not register a trademark based on a geographical location and generic service.
- The domain describes what we do and where and [sic] we do it.

You can contact us on [directors@legalx.com.au](mailto:directors@legalx.com.au) should you wish to proceed with this matter. This email in no way implies that we consent to you dealing with this dispute or that you have the jurisdiction to do so."

#### **6. Discussion and Findings**

The Panellist has jurisdiction to determine this dispute pursuant to Paragraph 2.1 of the auDRP:

"All domain name licences issued or renewed 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 as.au, com.au, id.au, net.au and org.au."

Further, RI is an approved Provider under Paragraph 3 of the auDRP and the Panellist has been duly appointed by RI.

Paragraph 15(a) of the Rules instructs the Panel as to the principles it is to use in determining this dispute:

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

Paragraph 4(a) of the auDRP requires the Complainant to prove each of the following three elements:

- (i) the Domain Name is identical or confusingly similar to a name (Note 1), trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name (Note 2); and
- (iii) the Domain Name has been registered *or* subsequently used in bad faith.

**Note 1**

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; or
- (b) the complainant’s personal name.

**Note 2**

For the purposes of this policy, auDA has determined that “rights or legitimate interests in respect of the domain name” are not established merely by a registrar’s determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration.

**Identity**

The Complainant relies on its registered business name as distinct from its company name. It has annexed a copy of the registration certificate showing that it registered the business name Canberra Conveyancing with ASIC on December 17, 2010. That certificate showed the next renewal date as December 17, 2016. Having visited the ASIC website the Panel is satisfied that the registration has been renewed until December 17, 2019. That visit was made in accordance with Paragraph 4.5 of the auDA Overview of Panel Views on Selected auDRP Questions First Edition, (“auDA auDRP Overview 1.0”) July 2014, which provides:

“4.5 May a panel perform independent research when reaching a decision?

The general position is the same as that under the UDRP.

Panels have undertaken limited factual research into matters of public record where it has considered this necessary to reach the right decision. This may include visiting the website

linked to the disputed domain name in order to obtain more information about the respondent and the use of the domain name...”

Accordingly the Panel finds that the Complainant has rights in the business name Conveyancing Canberra, pursuant to Paragraph 4(a)(i) and Note 1 of the auDRP. The Domain Name is identical to the Complainant’s business name, save for the inconsequential ccTLD “.net.au”, which may be ignored. The Complainant has established this element.

### **Legitimacy**

Paragraph 4c of the auDRP provides:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the subject matter of the dispute, your 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 (not being the offering of domain names that you have acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue.

There is no evidence to suggest that the Respondent has been commonly known by the Domain Name.

For the reasons set out below in relation to the element of bad faith, the Panel finds that the Respondent’s use of the Domain Name has not been bona fide and that the Respondent’s use is intended, for commercial gain, misleadingly to divert consumers. The Complainant has established this element.

### **Bad faith**

In order to appreciate the significance of the Complainant’s assertion as to the use to which the Domain Name is being put, the Panel visited [www.conveyancingcanberra.net.au](http://www.conveyancingcanberra.net.au) and found that this resolves to a website at [www.velocityconveyancing.com.au](http://www.velocityconveyancing.com.au), headed “Velocity Conveyancing Group” and promoting “Professional Solicitors focusing on Conveyancing”, established in 1968 and having offices in the ACT and elsewhere in Australia.

The Panel accepts that the Respondent has been operating in Canberra providing conveyancing services since 1968 and notes that the Domain Name was registered on July 12, 2016, some 5½ years after the Complainant registered its business name.

Since the Complainant relies on its registered business name and does not claim trademark rights, the Respondent's assertion that IP Australia will not register a trademark based on a geographical location and generic service, even if correct, is irrelevant.

As to the Respondent's assertion: "The domain describes what we do and where and [sic] we do it", the Panel accepts that 'conveyancing' is an ordinary descriptive word and 'Canberra' is a geographic word. In combination those words are descriptive of conveyancing services provided in Canberra.

The following well-known passages from the judgment of Stephen J in the High Court of Australia in *Hornsby Building Information Centre v. Sydney Building Information Centre Ltd* (1978) 140 CLR 216 at 229 are apposite:

"There is a price to be paid for the advantages flowing from the possession of an eloquently descriptive trade name. Because it is descriptive it is equally applicable to any business of a like kind, its very descriptiveness ensures that it is not distinctive of any particular business and hence its application to other like businesses will not ordinarily mislead the public. In cases of passing off, where it is the wrongful appropriation of the reputation of another or that of his goods that is in question, a plaintiff which uses descriptive words in its trade name will find that quite small differences in a competitor's trade name will render the latter immune from action (*Office Cleaning Services Ltd. v. Westminster Window and General Cleaners Ltd.* (1946) 63 RPC 39, at p 42, per Lord Simonds). As his Lordship said (1946) 63 RPC, at p 43, the possibility of blunders by members of the public will always be present when names consist of descriptive words – "So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some members of the public will be confused whatever the differentiating words may be". The risk of confusion must be accepted, to do otherwise is to give to one who appropriates to himself descriptive words an unfair monopoly in those words and might even deter others from pursuing the occupation which the words describe." (At p229).

"There was evidence before the Industrial Court about the antecedents and activities of the Hornsby Centre from which it could have concluded that those concerned with that Centre's activities were intent to benefit from the good repute which the Sydney Centre had, over the years, created for the particular kind of services, unique of their kind, which it had offered as the only building information centre in the Sydney area. However to say this is not to suggest any wrongdoing on their part. Neither the concept of such a centre nor its conduct is anything for which a monopoly can be claimed, any more than it could be claimed for, say, an art gallery. If the first commercial art gallery in a city meets with an enthusiastic response from the public, competitive galleries are likely to be attracted to the field. They will be free to enter it and to describe themselves as art galleries, that being the descriptive name appropriate to their business; and this despite the fact that the pioneer gallery might have chosen also to style itself "art gallery", prefixed by a regional name. **For competitors' conduct to be misleading and deceptive they would have to have adopted as their names the same or a similar regional prefix followed by "art gallery". A quite distinct regional prefix, followed by "art gallery" would neither mislead nor deceive.** The opposite view would involve treating this provision of the trade practices legislation as the source of a newly created monopoly heretofore unknown to the law and likely to deter new entrants into a field which ought to be open to legitimate competition. It is difficult to contemplate any less likely legislative source of such a

consequence. The present case of building information centres is, I think, no different in principle.” (at p231). [Emphasis added].

This administrative proceeding is not a passing off case nor, unlike *Hornsby Building Information Centre*, a case of alleged misleading or deceptive conduct in contravention of trade practices legislation. Nevertheless the Domain Name, being identical to the Complainant’s business name, maintaining the two words in the same order, is likely to render Internet users confused as to whether there is a connection between the two. The critical issue is the intent of the Respondent in registering or using the Domain Name.

The Complainant invokes Paragraph 4b(iv) of the auDRP which provides:

“...the following circumstances, in particular but without limitation...shall be evidence of the registration and [sic] use of a domain name in bad faith:

- (iv) by using the domain name, you have 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 service on that website or location.

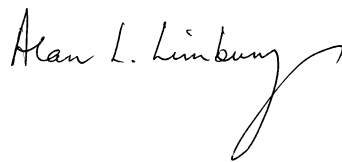
The Respondent has been providing conveyancing services in Canberra since 1968. The Complainant has been providing conveyancing services in Canberra under the registered business name Conveyancing Canberra since 2010. The parties had been competitors for at least 6 years when the Respondent registered the Domain Name.

Under these circumstances, the Panel finds, on the balance of probabilities, that the Respondent must have been aware of the Complainant and its business name when it registered the Domain Name in 2016 and that the Respondent is using the Domain Name to resolve to the website of Velocity Conveyancing Group in order intentionally to attract, for commercial gain, Internet users to that website by creating a likelihood of confusion with the Complainant’s name as to the source, sponsorship, affiliation, or endorsement of that website or of the services on that website. The Complainant has established this element.

## 7. Decision

The Complainant having established all three elements required to entitle it to relief and being eligible to register the Domain Name, the Panel orders that the Domain Name <conveyancingcanberra.net.au> be transferred to the Complainant.

Dated this 8th day of June, 2018



Alan L. Limbury, Panellist