



ADMINISTRATIVE PANEL DECISION

City of Parramatta Council

v

Publishing Australia Pty Ltd

auDRP_21_05

<parramatta.com.au>

1 The Parties

The Complainant is the City of Parramatta Council of Parramatta, NSW. It is represented in the proceedings by Ms Despina Lyons of Anisimoff Legal in Melbourne, Victoria.

The Respondent is Publishing Australia Pty Ltd of Chatswood, NSW. It is represented by Mr David Lye, a director.

2 The Disputed Domain Name and Registrar

The Disputed Domain Name is <parramatta.com.au>. The registrar of the Disputed Domain Name is NetAlliance Pty Ltd trading as Netfleet.com.au.

3 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 17 March 2021. This was forwarded to the Registrar the same day with a request that the registration particulars be confirmed, and the Disputed Domain Name be locked. On 18 March 2021 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 Lye were notified of the Complaint on the same day, in the latter case using the email address <postmaster@parramatta.com.au>, which was the

contact email given when the Disputed Domain Name was registered and when most recently renewed.

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, 18 March 2021. Although Mr Lye complained that his receipt of the Complaint had been delayed by RI’s use of the registrant contact address, and RI extended the time within which to file a Response to 12 April 2021, in fact the Response was filed on the original deadline date of 7 April 2021.

Following receipt of the 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 later that day.

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

4 Factual Background

The Complainant is the City of Parramatta Council, the local government body for the City of Parramatta in New South Wales. It is constituted pursuant to the *Local Government Act 1993* (NSW) and the *Local Government (City of Parramatta and Cumberland) Proclamation 2016*.

Parramatta was founded in November 1788, only 10 months after the First Fleet landed at Sydney Cove. The Complainant was first incorporated in 1861 as the “Municipality of Parramatta” pursuant to the *Municipalities Act 1858*, but the town was later proclaimed as the “City of Parramatta” in 1938 by the passing of the *Local Government (City of Parramatta) Act*. The area of Parramatta has had a local municipal institution in one form or another since 1861.

The Disputed Domain Name was first registered by the Respondent on 21 October 2007. As at that date the only registered trade mark held by the Complainant was the following device mark registered in February 1983:



This mark has a narrow specification in addition to an explicit disclaimer, as follows:

Goods & Services

Class 42: Services in this class rendered by local council including services to council rate payers; tourist promotional services in this class

Endorsements Registration of this trade mark shall give no right to the exclusive use of the geographical name PARRAMATTA NSW.

On 25 June 2018 the Complainant applied to register four further trademarks which include the word <PARRAMATTA> and, on 12 March 2020 another 3 such marks. However, only one of the March 2020 applications has proceeded to registration:



That mark is registered in three classes with the following specification:

Goods & Services

Class 35: Local government council management and administration; marketing, promotional and advertising services, including promotion of businesses, trade and tourism; advocacy (promoting, publicising or otherwise representing the interests or concerns of others); association services (being the promotion of the interests of members of the association); business services being business management, administration and data analysis; conducting and provision of market surveys, research and studies; opinion polling

Class 39: Tourism services; transportation services including the transport of passengers; arrangement of tours; tour reservations; organisation of tourism facilities including sightseeing tours, tour arrangements, tourist transportation; transportation information; travel arrangements; vehicle rental booking services; vehicular transportations; refuse collection services

Class 41: Arranging, organisation and provision of cultural, ceremonial, entertainment, recreational, art, musical and sporting events and festivals; provision of education, training, entertainment, sporting and cultural activities; library services; providing non-downloadable electronic publication of information on a wide range of topics; organisation of entertainment competitions; publishing of newsletters

5 Parties' Contentions

Complainant

In summary, the Complainant asserts that:

- a) the Disputed Domain Name is identical or confusingly similar to its <PARRAMATTA> name, trademark or service mark;

- b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- c) the Disputed Domain Name was registered or has subsequently been used in bad faith.

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

1. it is known by the name “City of Parramatta Council”;
2. it owns the “registered trademarks” referred to in the Factual Background above;
3. There is no other entity or person that has the right to call or refer to themselves as PARRAMATTA on its own, and the Parramatta region was incorporated in 1861 as the Municipality of Parramatta and proclaimed to be the City of Parramatta from 1938. The Complainant is the Council operating under the name PARRAMATTA and is authorised and has the sole right, as result of being the government entity “in this area” to use and be known by the word “PARRAMATTA”;
4. No other entity has the right to be known by the name PARRAMATTA on its own;
5. the Disputed Domain Name is clearly identical or confusingly similar to the Complainant’s name; and
6. the “.com.au” second level domain does not affect the Disputed Domain Name being identical or confusingly similar to the Complainant’s name PARRAMATTA or its PARRAMATTA trademarks.

In support of the second ground on which it brings the Complaint the Complainant submits that:

7. the Respondent has not used or undertaken demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services;
8. the Disputed Domain Name resolves to a webpage which includes a number of links accompanied by a notice stating that sponsored listings displayed on the webpage are served automatically by a third party;
9. the Disputed Domain Name is clearly parked and the Respondent, by using the services of the third party sponsored links generator, is not exercising any level of control of the links that appear on the webpage. In support of this contention the Complainant attaches the following screenshot:



and submits, citing the *auDA Overview of Panel Views on Selected auDRP Questions*¹, that use of a domain name to resolve to parking or landing pages, or to generate revenue through pay-per-click links advertising, is generally not considered a *bona fide* offering of goods or services under the auDRP;

10. The website has in the past included information about the City of Parramatta. The Complainant submits that this use is not *bona fide*, and that the Respondent has registered the Disputed Domain Name due to the reputation and popularity of the Complainant’s trademark and name PARRAMATTA “as a pretext for commercial gain”;
11. At best, the Respondent has registered the Disputed Domain Name and has included links and information about Parramatta on the webpage as a “thin pretext” to claim *bona fide* use, when the actual intention behind securing the registration was to re-sell the Disputed Domain Name for a profit;
12. the Disputed Domain Name does not satisfy the “close and substantial connection” test set out in auDA’s “*Domain Name Eligibility and Allocation Policy Rules for Open 2LDs*”. Whilst acknowledging the monetisation exception to the “close and substantial connection” requirement, the Complainant notes that it is subject to the condition: “domain name must not be, or incorporate, an entity name, personal name or brand name in existence at the time the domain was registered”. The Complainant asserts that at the time the Disputed Domain Name was first registered the entity name PARRAMATTA did already exist (namely, the Complainant’s name) so that the Disputed Domain Name cannot obtain the benefit of the monetisation exception;
13. the Complainant’s representatives have not been able to locate any use of the word PARRAMATTA in connection with the Respondent. There were no trademark registrations or applications for the word PARRAMATTA in the name of the Respondent and the Respondent is not commonly known by the Disputed Domain Name or the word PARRAMATTA;
14. the Respondent’s name is not similar to and does not appear to be in any way connected to the Disputed Domain Name;

¹ 1st Edition at 2.6

15. the Respondent does not appear to be making a legitimate non-commercial or fair use of the Disputed Domain Name without intent for commercial gain misleadingly to divert consumers. The “Parramatta Eels” link that appears in the above screenshot appears to be false because it does not take the user to a page about the Australian professional rugby league football club based in Parramatta but rather takes the visitor to further random links including streaming links. The Complainant refers to this screenshot of the target of the “Parramatta Eels” link in support of its contention that the Complainant has used the words “Parramatta Eels” as “click bait and nothing more”:

[NRL 2020 LIVE STREAM - SEARCH](#)
[ON OUR WEBSITE - SEARCH](#)
[INFORMATION HERE](#)

16. The locality of Parramatta is a very well-known region of Australia. The City of Parramatta has a significant reputation in Australia and is widely recognised as a region in New South Wales, Australia. The Respondent was undoubtedly aware of the City of Parramatta when the disputed domain name was registered. As a result of this knowledge and the fact the Respondent has no legitimate connection with the disputed domain name, the Respondent has taken advantage of the legitimate need of others, such as the Complainant to register and use the disputed domain name and has registered the disputed domain name for the purpose of re-selling the domain name at a profit due to the Complainant’s reputation in the Disputed Domain Name.

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

17. the Respondent has registered the Disputed Domain Name in bad faith and for the deliberate purpose of re-selling the Disputed Domain Name at an inflated price. The Complainant states that “the Disputed Domain Name is for sale on the Netfleet website for a buy-it-now price of \$61,000”. [Panel note: The screenshot in support of that contention is the Netfleet bidding page for domain names which are available for sale. It makes no reference to a price of \$61,000 but does include archived bid history from 14 July 2008 to 21 September 2014. Over that period bids for the Disputed Domain Name have ranged from \$25 on the first mentioned to date to \$5,500 on 23 January 2011. The most recent bid appears to be \$1,000 on 21 September 2014. No bids are displayed subsequent to that date on the screenshot included in the Complainant’s evidence].
18. The Complainant “understands that the Respondent operates the Netfleet website which is a platform for selling domain names as an inflated price”. In support of that contention it attaches a screenshot of the landing page at www.netfleet.com.au. [Panel note: The screenshot in support of that contention contains no reference to the Respondent or to Mr Lye. Nor does the evidence include any other material by which the Panel could rule on the veracity of that allegation].
19. The fact that the Disputed Domain Name has been registered to the Respondent since 2007 and that there has been no legitimate use of the Disputed Domain Name in this time is corroborative of the submission that the Respondent has no intention to use the Disputed Domain Name in good faith but registered it for the purpose of re-selling it at a price in excess of the costs associated with registering it.

20. The fact that between October 2009 and March 2020 the webpage to which the Disputed Domain Name resolves included information about the City of Parramatta, and some pay-per-click links with headings related to Parramatta, proves that the Respondent is sophisticated. This can also be inferred from the Respondent's background operating the Netfleet domain name re-sale website; it has included this information on the website in order to establish that it does have some legitimate use and substantial connection to the Disputed Domain Name. The Complainant does not consider that this is *bona fide* use.
21. The fact that the Respondent has no legitimate connection to the Disputed Domain Name and the significant reputation of the City of Parramatta further supports the Complainant's submission that the Disputed Domain Name was registered for the purpose of re-selling it as a profit.

Respondent's Response

Given the Panel's findings below it will suffice to summarise the Respondent's submissions and supporting annexures as follows:

- a) The Complainant is not known as PARRAMATTA – its name is “City of Parramatta Council” and there is no evidence that it is referred to by any name that does not include the word “Council”;
- b) the Complainant does not have any trademarks confusingly similar to the Disputed Domain Name. There are approximately 81 trademarks and applications on the Australian trademark register which contain the word PARRAMATTA;
- c) the Complainant has been unable to overcome adverse Examiner's reports issued in response to its applications to register PARRAMATTA as a stand-alone word mark on the grounds that “other traders should be able to use PARRAMATTA in connection with goods or services similar to yours to indicate where their goods are located, originate from or are available from”;
- d) in the analogous case of *Tourism Tasmania v. Gordon James Craven* (DAU2003-0001) the panel held that the word TASMANIA cannot function as a trademark unless its geographical significance is shown to have been displaced by long and extensive use as a brand by a single trader in such a manner as to distinguish that trader's goods and services from those of competitors. The Respondent urges the Panel to adopt the same principle in this proceeding in relation to the word PARRAMATTA;
- e) Parramatta is an Aboriginal word that comes from Burrumatta. The Burrumatta people belonged to the Darug people of the Sydney area and in that Aboriginal language “burra” means “eel” and “matta” means place;
- f) there is a clear distinction between how “Parramatta” is used as a geographical term and the Complainant's name “City of Parramatta Council”. No one could believe these terms are interchangeable or confusingly similar;
- g) The Disputed Domain Name has resolved to webpages over the last 16 [sic] years that have had many iterations ranging from full websites to parking pages and default hosting pages, suspended hosting pages and unresolved sites (as it is today);

- h) The Respondent has rights and legitimate interests in respect of the Disputed Domain Name as a geographic indicator;
- i) the Disputed Domain Name was not registered for the purpose of reselling at a profit – at the time of registration it was not even possible to sell a domain name in Australia;
- j) the Disputed Domain Name was registered for the opportunity to develop a useful geographic site relating to a suburb/area the director of the Respondent knows well and worked in for several years at the same time as he developed newport.net.au relating to his home suburb of Newport;
- k) the Respondent used the Disputed Domain Name for more than 10 years for a website that contains information on a variety of topics relating to Parramatta including the Westfield Parramatta shopping centre, the Parramatta Leagues Club and other geographically located services. This is corroborated by the following screenshot:



- l) The Respondent has never solicited a sale of the Disputed Domain Name to anyone including the Complainant, and the Complainant has not led any evidence to this effect;
- m) the Disputed Domain Name is indeed listed for sale on Netfleet. Contrary to the Complainant's assertion, the Respondent denies any involvement with the Netfleet business;
- n) All of the Respondent's domain names are listed for sale on the Netfleet domain name marketplace;
- o) At the time of registration of the Disputed Domain Name, Netfleet (or any other such marketplace) did not exist; nor was it possible to sell domain names.

6 Reverse Domain Name Hijacking

It is the Respondent's submission that the Panel should make a finding of reverse domain name hijacking against the Complainant, for the following reasons:

- p) The Complainant has at no time served the Respondent with a letter of demand, outlining the subject matter of its dispute.

- q) The word PARRAMATTA is a descriptive and generic place name;
- r) The Complainant has failed to satisfy any of the grounds of the auDRP;
- s) The Complainant is legally represented by experienced counsel, and ought to have known that there was no proper basis to bring this proceeding; and
- t) The Complainant knows and admits that it doesn't trade as "Parramatta" and is not known as "Parramatta".

7 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 evidence before it, and the Complainant must prove all of the elements of the Policy at least on the balance of probabilities.

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

The uncontested evidence shows that the Complainant is the registered owner of multiple trademarks that include the word PARRAMATTA. However, it has no registered or common law trademark for the word PARRAMATTA by itself and nor is that word by itself the name of the Complainant. It follows that the Disputed Domain Name is not identical to any name or trademark in which the Complainant has rights.

Alternatively, the Complainant needs to show that the Disputed Domain Name is similar to one of its registered trademarks and confusingly so. The only similarity between the Disputed Domain Name and the Complainant's name or trademark is the word PARRAMATTA. As the Complainant itself noted, Parramatta is the second oldest city in Australia and plainly well-known as a geographic location. As noted in the Factual Background above the Complainant's very first trademark was registered with an endorsement to the effect that simply because the trademark included the word PARRAMATTA did not give the Complainant exclusive right to use that word.

Assuming for the sake of argument, but certainly not as a finding to that effect, that the Disputed Domain Name is similar to some registered or unregistered trademark in which the Complainant has rights, for it to be *confusingly* so Internet users will have to understand the word as having a secondary meaning other than its conventional geographic indication. There is simply no evidence to that effect. Indeed there is no evidence that any Internet user upon seeing the Disputed Domain Name would think of anything other than the geographic place known as Parramatta, or something associated with that geographical region.

The finding of the Panel is that the Disputed Domain Name is neither identical nor confusingly similar to any name or trademark in which the Complainant has rights.

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

The word PARRAMATTA is derived from an Aboriginal word meaning eel place. Whilst to some that might be most closely associated with the Parramatta Eels Rugby League Club, there is no evidence that the general public or Internet users in particular would be aware of its etymology.

Like most geographical designators, there are likely to be a large number of traders who might seek to use the word PARRAMATTA descriptively to convey some aspect about the location of their business or some connection with their services. Indeed there are hundreds of businesses in the Yellow Pages which include Parramatta in their business name.

Whilst monetisation is ordinarily not a good faith use of a domain name in connection with an offering of goods and services, here the evidence is unequivocal that the Respondent did for some 10 years subsequent to registration of the Disputed Domain Name use it in good faith in connection with an offering of goods or services related to the geographic region of Parramatta. That usage attracts the benefit of paragraph 4(c)(i) of the Policy which deems it sufficient to demonstrate the requisite rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy.

As an aside, and not as evidence on which the Panel has relied in reaching its findings, the Panel is aware that between 1965 and 2008 Qantas has had a jet aircraft named “City of Parramatta”, commencing with its first-delivered Boeing 707 on 10 February 1965. This use continued with successive models of aircraft including a Boeing 747-238, a Boeing 747 Special Performance, and culminated with this Boeing 767 which was in service from 1990 to 2008:



Photo credit: Bernie Proctor

The Panel is not aware of the Complainant having raised any concern about Qantas' use of the name of the City of Parramatta on an aircraft.

Here the Panel is unable to conclude that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name given the strident assertions in its Response and the fact that the Disputed Domain Name has been registered to the Respondent for nearly 14 years.

Registered or subsequently used in bad faith

Paragraph 4(a)(iii) of the Policy requires the Complainant to demonstrate that the Disputed Domain Name was registered *or* subsequently used in bad faith.

Despite an oblique reference to paragraph 4(b) of the Policy the Complainant has provided no evidence to support submissions which appear to be intended to invoke that provision. In fact the evidence demonstrates that the provision is not applicable to the Respondent, who it is to be remembered has been registrant of the Disputed Domain Name since 2007 and has used it in conjunction with a website relevant to the geographic location of Parramatta. The Panel would be slow to conclude in those circumstances that good faith registration and use has become bad faith use solely because the Disputed Domain Name is currently being monetised or offered for sale.

If the Complainant is concerned that the Respondent is no longer making use of the Disputed Domain Name to promote products of or from Parramatta, but instead has parked it for monetisation purposes with a service whose underlying algorithm only serendipitously generates links which have that purpose, bringing this proceeding is not the appropriate remedy. Indeed on the next occasion that the Disputed Domain Name is due for renewal the Respondent will need to demonstrate that it complies with the new licensing rules that apply to all domain names under the .au country code Top Level Domain. The Complainant would be better advised to consider lodging a complaint with auDA under the new regime which took effect on 12 April 2021 in respect of domain names registered or renewed after that date.

None of the Complainant's submissions on this limb of the Policy are persuasive. Many of them are not supported by the evidence and amount to baseless allegations. This applies in particular to the allegation that the Disputed Domain Name was registered for the purposes of resale and the allegation that the Respondent was the operator of the Netfleet domain name marketplace. The objective evidence points categorically in the opposite direction in relation to both allegations. In other cases the Complaint puts a complexion on the evidence which it does not fairly bear.

The Panel declines to make any finding of bad faith registration or subsequent use on the part of the Respondent.

8 Reverse Domain Name Hijacking

The Panel is ordinarily loathe to make findings of Reverse Domain Name Hijacking where a complaint is brought in good faith based on a reasonably arguable view of how the Policy applies to the relevant facts. However, as noted above, the Complaint includes baseless allegations and submissions not grounded in the evidence put before the Panel. The Complainant also did not draw to the Panel's attention that its applications for trademarks comprising the single word PARRAMATTA are the subject of adverse Examiner's reports that it has so far been unable to overcome.

Furthermore, there are numerous decisions both under the auDRP and the UDRP which have uniformly upheld the principle that the threshold for demonstrating rights or legitimate interests, in respect of a domain name which comprises a geographical indicator, is very low. Here that threshold was easily satisfied by evidence (including evidence filed by the Complainant) showing that the Disputed Domain Name was registered and subsequently used for some 10 years in its role as a geographical indicator for the second oldest city in Australia.

It is the Panel's considered view that the Complaint was brought in bad faith and constitutes Reverse Domain Name Hijacking within the meaning of paragraphs 1 and 15(e) of the Rules.

9 Order

The Complainant has failed to make good any of the grounds upon which it brought the Complaint. Accordingly the Panel orders, pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, that the Complaint be dismissed and that the Registry lock on the Disputed Domain Name be removed.

Dated this 23rd day of April 2021

A stylized blue signature of Philip N Argy, featuring a large, decorative initial 'P' followed by the name 'Argy' in a cursive script.

Philip N Argy
Panellist