



ADMINISTRATIVE PANEL DECISION

Varinder Singh Toor trading as Vicky Driving School Melbourne v Vikas Sharma

auDRP_22_3

<vickydrivingschool.net.au>

1. The Parties

The Complainant is Varinder Singh Toor, Victoria, represented by Andrew Petale of Y Intellectual Property, Victoria.

The Respondent is Vikas Sharma, Victoria, represented by Norman Morcom of Morcom Pernat, Victoria.

2. The Disputed Domain Name and Registrar

The disputed domain name is <vickydrivingschool.net.au> ("the Domain Name"). The Registrar of the Domain Name is Go Daddy.com LLC trading as GoDaddy.com.

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 Monday 2 May, 2022 and acknowledged on Thursday 5 May, 2022. On Sunday 8 May, 2022 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 Friday 13 May, 2022, the Registrar confirmed via email the Respondent's contact details and that the Domain Name has been locked. That day RI advised auDA of the Complaint via e-mail and, by email, notified the Respondent of the Complaint lodged against him. These notifications were copied to the Complainant and his representative. The proceeding therefore commenced on Friday 13 May, 2022 and the due date for a Response was Thursday 2 June, 2022. That day, the Respondent submitted a Response. On Friday 3 June, 2022, 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. That day the case file and relevant correspondence were forwarded to the Panellist and the parties were so informed. On Monday 6 June, 2022 the Respondent submitted, as an additional Annexure to the Response, a notification issued that day by IP Australia, which the Panellist has taken into account.

4. Factual Background

Both parties are in the car driving instruction business in Melbourne.

5. Parties' Contentions

Complainant

The Complainant submits that the Domain Name is identical or confusingly similar to the VICKY DRIVING SCHOOL name and trademark in which the Complainant has rights and that the Respondent has no rights or legitimate interests in respect of the Domain Name, which has been registered or subsequently used in bad faith.

The Complainant is the owner and operator of Vicky Driving School, a driving academy operating in and around the North-Western suburbs of Melbourne, Victoria. The Complainant has operated this business since around 2012. Since November 2015, the Complainant has promoted his business through his Facebook page appearing at www.facebook.com/vickydrivingschool and since 26 October 2016 through his website appearing at <https://vickydrivingschool.com.au>.

On 28 June 2018 the Complainant registered the business name Vicky Driving School Melbourne.

On 27 July 2020 the Complainant registered Australian Trademark No. 2057692



in Class 41 in relation to driving schools, upon application filed on December 19, 2019.

On 11 August 2020 the Complainant registered Australian Trademark No. 2059418 VICKY DRIVING SCHOOL in Class 41 in relation to driving schools, upon application filed on 3 January 2020.

By virtue of its extensive and expanding use of the VICKY DRIVING SCHOOL trademark since 2012 (as well as by virtue of the registration of the VICKY DRIVING SCHOOL trademarks) in relation to the provision of driving school services by the Complainant, the VICKY DRIVING SCHOOL trademark has become exclusively associated with the Complainant and the provision of any services bearing the same or similar trademark will appear to the public as having emanated from the Complainant. This reputation has the

effect that the Complainant enjoys common law rights in the VICKY DRIVING SCHOOL trademark in Australia, in addition to its registered trademark rights.

The Complainant submits that the Domain Name is identical to the VICKY DRIVING SCHOOL name and contains the VICKY DRIVING SCHOOL trademark in which the Complainant has rights.

As to legitimacy, the Complainant says that the Respondent by his own admission adopted use of the name Vicky Driving School in March 2018. At that point, the Complainant had been promoting his driving school under the name Vicky Driving School since 2015 through both the Complainant's Website and Facebook page. A simple search engine search by the Respondent for the phrase "Vicky Driving School" would have identified to the Respondent the fact that there was another business operating under this name in the same geographic area where the Respondent was planning to offer his services.

Since 2018, the Respondent has operated his driving school business in the same suburbs as the Complainant, which include Coolaroo, Broadmeadows, Craigieburn, Bundoora and surrounding suburbs. The Respondent has also promoted his business under a range of variant business names including VDS Driving School and Vikas Driving School. He has also set up Google My Business pages under the name Vicky Driving School and VDS Driving School although the photographs appearing on these pages show that his driving instruction vehicles are alternatively branded with the names Vikas Driving School or Vicky Driving School.

The Respondent's use and registration of the Domain Name is likely to confuse the public as to the source of the Respondent's services and at the very least, suggest a relationship with, approval by, or affiliation with, the Complainant, which the Respondent does not have. The use of the Domain Name appears to be deceptively to route Internet users who are searching for the Complainant's Vicky Driving School business to the Respondent's website, where the Respondent is using the mark VDS Driving School in connection with the provision of his driving school services.

Based on the Complainant's long standing continuous use of his registered and incontestable VICKY DRIVING SCHOOL trademarks and his irrefutable use of the VICKY DRIVING SCHOOL name, coupled with the Respondent's knowledge of the Complainant's rights, the Respondent cannot be said to have legitimately chosen or have any continuing need to use the Domain Name for use in connection with the promotion of his services under the VICKY DRIVING SCHOOL trademark. See *Telstra Corp Ltd. v Nuclear Marshmallows* (WIPO Case No. D2000-003).

The Complainant submits that it is the Complainant and not the Respondent that has come to be known by the VICKY DRIVING SCHOOL name.

The Respondent is currently using the Domain Name to direct traffic to the Respondent's Website which promotes his business under the name VDS Driving School, not Vicky

Driving School. This is not a legitimate use of the Domain Name. The Respondent is not the owner of the VICKY DRIVING SCHOOL trademark, and the use of that trademark directly infringes the Complainant's registered trademark rights and is not a legitimate use of the Domain Name.

The Respondent cannot be deemed to be utilising the Domain Name for any legitimate business purpose, including the creation and maintenance of a website in connection with a *bona fide* offering of goods or services. The Respondent had prior knowledge of the Complainant's identical VICKY DRIVING SCHOOL trademark used in connection with the operation of the Complainant's driving school and nevertheless has used the Domain Name in order to trade off the Complainant's trademark and goodwill.

The Respondent has therefore never legitimately been known by the Domain Name or the mark VICKY DRIVING SCHOOL or any close variation thereof, and certainly not at the time that it registered the Domain Name.

Furthermore, due to the significant reputation of the Complainant's VICKY DRIVING SCHOOL trademark, in particular in the North-Western suburbs of Melbourne, the Complainant submits that the Respondent is intentionally trading on the Complainant's reputation, and that at the time the Respondent registered the Domain Name, the Respondent had actual or constructive knowledge of the Complainant's rights and reputation in the VICKY DRIVING SCHOOL trademark such that the Respondent is making illegitimate, commercial and unfair use of the Domain Name.

In the administrative panel decision, *Fendi Adel SrL v Mitchell Kass Designs* (WIPO Case No. D2000-1742), the Panel stated that the use of a domain name that is contrary to law cannot be legitimate use or give rise to a legitimate interest. As in the UK Court of Appeal decision of *British Telecommunications Plc & Ors v One In A Million Ltd & Ors* (1998) 42 IPR 189, any realistic use of the Domain Name would result in passing off and would likely be use for a fraudulent purpose and to prevent the Domain Name from being transferred to the Complainant.

The Complainant is the owner of the rights in the VICKY DRIVING SCHOOL trademark and has not licensed or otherwise permitted the Respondent to use its trademarks or any variation thereof, or to register or use any domain name incorporating the mark or any variations thereof. The Respondent is in no way connected with the Complainant and its use of the trademark without the Complainant's authorisation results in a high likelihood of consumer confusion – and this prevents the Respondent from demonstrating a legitimate interest in the Domain Name.

None of the circumstances in paragraph 4(c) of the Policy possibly demonstrating rights or legitimate interests appear to arise in the present case. The Respondent is not authorised or related to the Complainant in any way. The Respondent is not commonly known by the Domain Name. The Respondent has previously made illegitimate use of the Domain Name with the intent to misleadingly divert internet users to the Respondent's website.

As to bad faith, the Complainant submits that the Respondent has registered the Domain Name primarily for the purpose of disrupting the Complainant's business activities.

The Complainant further submits that the matters discussed above mean that the test for bad faith posited by paragraph 4(b)(iv) of the Policy is satisfied by this Complainant. Specifically:

- (a) Given the well-known reputation of the Complainant in and around the North Western suburbs of Melbourne, the Respondent has attempted to attract users to the Respondent's website and has accordingly used the Domain Name for his own commercial gain;
- (b) The Domain Name is identical or substantially identical to the VICKY DRIVING SCHOOL trademark in which the Complainant has extensive rights and reputation. Given the VICKY DRIVING SCHOOL name and Domain Name are identical, consumer confusion is likely. Specifically, consumers are likely to be confused as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

On 18 August 2020, the Complainant's lawyers sent a letter of demand to the Respondent, asserting trademark infringement and that the Respondent was using pictures from the Complainant's website to advertise his business. The letter requested the Respondent immediately to cease use of the name Vicky Driving School in his business. The Respondent failed to comply with the letter of demand. The Complainant subsequently complained to GoDaddy that the Respondent was using the Domain Name in violation of the Complainant's rights. On November 16, 2021 GoDaddy notified the Complainant that the Respondent's website had been suspended but could be reinstated if the Respondent agreed to remove the infringing material. The Respondent subsequently amended the references on his website from Vicky Driving School to VDS Driving School, including on the logo for the website and the Respondent's website was reinstated.

In response to a further letter dated March 16, 2022, demanding that the Respondent cease use of the trademark VICKY DRIVING SCHOOL and deregister his website, the Respondent sought proof of the Complainant's use of the business name Vicky Driving School prior to March 24, 2018. The information was provided on March 25, 2022, namely screenshots of the Complainant's Facebook page in November 2015 and his <vickydrivingschool.com.au> website on October 26, 2016. To date the Respondent has not agreed to cease use of the Vicky Driving School business name nor to deregister his website.

The remedy the Complainant is seeking is transfer of the Domain Name <**vickydrivingschool.net.au**> to the Complainant.

Respondent

The Respondent Vikas Sharma adopted the trademark VICKY DRIVING SCHOOL in early 2018. On March 24, 2018, as an individual (sole trader), he registered the business name Vicky Driving School for one year. He chose the name "Vicky" solely because it is the Australianized name by which he is commonly known. At the time he was unaware of any other business that was using that trademark or a similar business name.

In 2019 the Respondent commenced a separate business and registered its business name, Vikas Driving School, on January 4, 2019. He has controlled both Vicky Driving School and Vikas Driving School businesses continuously since then.

He renewed his Vicky Driving School business name registration for three years on March 10, 2019.

In 2020 the Respondent decided to restructure his businesses and registered the company VDS Melbourne Pty Ltd on September 18, 2020 to operate both businesses. In December 2020 he transferred ownership of the business names Vikas Driving School and Vicky Driving School to VDS Melbourne Pty Ltd while retaining ownership personally of the trademark VICKY DRIVING SCHOOL. He retained and continues to exert full control over the use by VDS Melbourne Pty Ltd of the VICKY DRIVING SCHOOL mark.

So, the Respondent has had control of and actively used the business name Vicky Driving School since first registering it in March 2018.

No evidence has been submitted that the Complainant has been operating the business Vicky Driving School since around 2012. If such early use in fact happened, the business appears to have maintained a low profile for a long time and would have been operating for many years in the absence of the legally required registration of the business name. The Complainant hardly comes with clean hands.

Accordingly, the Respondent strenuously disputes the assertions that "the Complainant is the owner and operator of Vicky Driving School". It is the Respondent who operates Vicky Driving School and it is his company VDS Melbourne Pty Ltd which owns the business name Vicky Driving School. The Complainant's assertions to the contrary are dishonest.

As admitted in the Complaint, the Complainant registered the business name Vicky Driving School Melbourne on June 28, 2018, over three months after the Respondent registered the business name Vicky Driving School.

On 29 November 2021 the Respondent registered the business name VDS Driving School and, through VDS Melbourne Pty Ltd, has operated all three businesses Vicky Driving School, Vikas Driving School and VDS Driving School continuously since then. The businesses operate separately although with some limited co-operation. For example, there are occasions when a vehicle branded with one business name may be used by another business.

On May 9, 2018, about 6 weeks after first registering the business name Vicky Driving School, the Respondent registered the <vickydrivingschool.net.au> Domain Name. On February 12, 2019 the Domain Name resolved to a website promoting a driving school business and displaying the name Vicky Driving School and the statement:

“INSTRUCTOR NAME: - VIKAS SHARMA (VICKY)”

The website also displayed three testimonials referring to the Respondent as “Vicky”.

On March 30, 2022 the Respondent applied in Australia to register the trademark VICKY DRIVING SCHOOL in Class 41 (Application No. 2259509). On June 6, 2022 the Respondent was notified by IP Australia that the application has been examined early and accepted and that it will be advertised as accepted after 30 August 2022, when the opposition period will begin.

For the purpose of this domain name dispute, until any opposition by the Complainant to the Respondent’s trademark application is settled, consideration of existing trademark registrations should be made with caution. Accordingly, the Complaint should be dismissed so that the domain names <vickydrivingschool.com.au> and <vickydrivingschool.net.au> be allowed to co-exist with different owners. Otherwise, the adverse effect on the Respondent’s business would be much more severe than the beneficial effect on the Complainant’s business.

6. Discussion and Findings

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), trademark 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.

Rights

The Complainant has shown that it has rights in Australian Registered Trademark No. 2059418, VICKY DRIVING SCHOOL, registered on 11 August 2020 in Class 41 in relation to driving schools, with a priority date of 3 January 2020.

Identity or confusing similarity

The Panel finds the <**vickydrivingschool.net.au**> Domain Name to be identical to the Complainant’s registered VICKY DRIVING SCHOOL trademark, since it comprises the entirety of the mark and adds the inconsequential “.net.au” suffixes which may be disregarded.

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.

Under the auDA auDRP Overview 1.0, paragraph 2.1:

“A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. The complainant will usually make out a prima

facie case by establishing that none of the paragraph 4(c) circumstances are present. Once such a prima facie case is made, the burden of production shifts to the respondent, requiring it to provide evidence or plausible assertions demonstrating rights or legitimate interests in the domain name. If the respondent fails to provide such evidence or assertions, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy ... If the respondent does provide some evidence or plausible assertions of rights or legitimate interests in the domain name, the panel then weighs all the evidence – with the burden of proof always remaining on the complainant”.

There is no evidence before the Panel of use by the Complainant of the name or mark Vicky Driving School between 2012 and 2015. Given the descriptiveness of the expression “driving school” and that “Vicky” is a common personal name, the Panellist considers the screenshots of the Complainant’s Facebook page in November 2015 and its <vickydrivingschool.com.au> website on October 26, 2016 to be insufficient to support a finding that the Complainant had established common law rights in the VICKY DRIVING SCHOOL mark prior to the registration of the Domain Name. Accordingly, the Panellist is not satisfied that the Respondent was aware of the Complainant’s mark prior to registering the Domain Name on May 9, 2018.

The Respondent registered the <vickydrivingschool.net.au> Domain Name some two months after he registered his Vicky Driving School business name and some six weeks before the Complainant registered his Vicky Driving School Melbourne business name. The Respondent used the Domain Name from April, 2019 for his driving school website, displaying his name as “Vicky” and showing testimonials referring to him as “Vicky”.

The Complainant’s first letter of demand was dated 18 August 2020. Assuming that this constituted notice to the Respondent of the subject matter of the present dispute, the Panellist finds that the Respondent has shown that, prior to such notice, he used the Domain Name bona fide in connection with an offering of driver training services. Further, the Respondent has shown that, prior to such notice, his business, Vicky Driving School, was commonly known by the Domain Name. Each of these circumstances demonstrates the Respondent’s rights or legitimate interests to the Domain Name for purposes of Paragraph 4(a)(ii).

The Complainant has failed to establish this element.

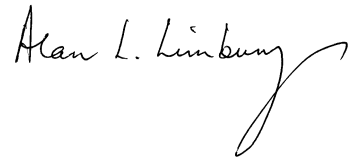
Bad faith

In light of the finding in relation to the previous element and having regard to the possibility that issues of trademark priority and infringement as between the parties may be contested in other fora, it is inappropriate for the Panellist to address this element.

7. Decision

The Complainant having failed to establish all three elements required to entitle it to relief, the Panellist orders that the Domain Name <vickydrivingschool.net.au> remain with the Respondent.

Dated this 7th day of June, 2022

A handwritten signature in black ink that reads "Alan L. Limbury". The signature is written in a cursive style with a long, sweeping tail on the letter "y".

Alan L. Limbury, Panellist