

RESOLUTION INSTITUTE DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

Case No <auDRP_24_05>

Single Panelist Decision

BMD Constructions Pty Ltd
(ABN 59 010 126 100)

Claimant

-and-

Construction, Forestry and Maritime
Employees Union

Respondent

<bmdtherealstory.com.au>

1. The Parties

The Complainant is BMD Constructions Pty Ltd of 1 Sandpiper Avenue, Port of Brisbane, QLD 4178. Mr Tuttiett, General Counsel of BMD Group, is named as its authorised representative.

The Respondent is the Construction, Forestry and Maritime Employees Union (**CFMEU**) which claims to be registered and incorporated under the Fair Work (Registered Organisations) Act 2009 (Cth) and is represented by Josh Liley, the CFMEU National Legal Officer, whose address is Level 6, 540 Elizabeth St., Melbourne VIC 3000.

2. The Domain Name and Registrar

The Complaint was attached to an email dated April 30, 2024 from Mr Christopher Tuttiett, to Resolution Victoria (RI) (**the initiating email**) in which Mr Tuttiett stated that the Complainant was BMD Constructions Pty Ltd and that the annexed Complaint Application Form entitled *Resolution Institute Domain Name Dispute Application Form* (**the Application**) constituted its application. In the initiating email Mr Tuttiett wrote:

"The [Application] relates to the domain www.bmdtherealstory.com.au which BMD asserts infringes the trademarks held by BMD and is easily confused with www.BMD.com.au which is owned by BMD.

The infringing website is also being used to bully and harass workers which presents an unacceptable psychosocial risk.

In the Application the domain name in dispute was entered, once again, as the domain 'www.bmdtherealstory.com.au'. The Respondent has taken no issue with identification of the domain name in dispute and so the Panel will treat <bmdtherealstory.com.au> as the disputed domain name in the Application (**Domain Name**). The Application Form set out the designated numbers of two alleged trademarks on which the Complainant was apparently relying for the claim of trademark

infringement, although the jurisdiction of registration of these marks was not stated.

3. Procedural History

Following the receipt of the Application RI emailed the Complainant on May 1, 2024, (**the RI Request**) stating:

"To progress your complaint, could you please also forward further information, including evidence, trademarks and summary notes etc, to complete your complaint." [emphasis added]

RI set out sections of the Application which required such further information, quoting from the auDRP Policy (**Policy**) and Rules (**Rules**) which applied to it¹. Inter alia, RI requested that the Complainant:

- (v) Specify the domain name(s) that is/are the subject of the complaint;
- (vi) Identify the Registrar(s) with whom the domain name(s) is/are registered at the time the complaint is filed;
- (vii) Specify the name(s), trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used (Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.);

Later that day Mr Tuttiett responded by a further email (**the BMD Particulars**), purporting to provide the requested information, submitting particulars of the Complaint in accordance with the auDRP 'Policy and Rules'. To (v) above, he stated "*As per the Complaint Application Form (attached)*"; in response to (vi) he stated '*Digital Pacific*'; in response to (vii) he set out transcriptions of what was claimed to be 'published trade mark details' for trademarks 1996319 and 1996321, preceded by the following statement:

"BMD Holdings Pty Ltd (Parent Company of BMD Constructions Pty Ltd) holds the following trademarks which are infringed by the disputed domain name and the content of the site"

He annexed to the email a photograph of a flyer or poster (**poster**) (attached to this determination). RI has treated the Application together with the BMD Particulars as the Complaint. The Panel concurs with this approach.

Communication with the Registrar

A copy of the Complaint was emailed to Digital Pacific Pty Ltd on May 6, 2024 with a request for it to clarify the Respondent's details and lock the Domain Name pending determination of the dispute. Follow up emails were sent by RI on May 8 and May 14, 2024]

¹ The .auDispute Resolution Policy (**auDRP**) No 2016-01 published on September 29, 2022

On May 15, 2024, Pty Ltd confirmed via email to RI that it was the registrar of the domain name <bmdtherealstory.com.au> and that the name had been locked.

Notification to Respondent

The Respondent was notified of the Complaint by RI by email on May 16, 2024. The date of commencement of the administrative proceeding determined pursuant to Paragraph 4(c) of the auDRP Rules is therefore that day, May 16, 2024. The due date for the response to the Complaint was June 5, 2024.

Response of the Respondent

On June 4, 2024, the Respondent, by email from its authorised representative, emailed to RI and to Mr Tottieth, acknowledged receipt of the Complaint and supporting document and filed its Response.

Appointment of the Panel

David Levin K.C. was approached by RI to accept an appointment to act as the panelist. He confirmed his availability and informed RI that he had no conflict issues with the named parties (subject to a matter which he detailed) by signing a Statement of Impartiality and Independence, and accepted the matter on June 11, 2024. On June 11, 2024 RI allocated the dispute to a single member panel constituted by David Levin K.C. (**the Panel**). The case file and relevant correspondence was forwarded to the Panel on that day and the parties to the dispute were notified of the case allocation to the Panel, although without being informed of the matter noted by David Levin K.C. in the Statement of Impartiality and Independence. Upon becoming aware of this situation, the Panel requested that the complete text noted in the Statement of Impartiality and Independence be expressly brought to the attention of the parties, which was done by email from RI on June 14, 2024.

The Panel is satisfied that it is properly constituted.

4. Factual Background

Incorporation

No proof of the incorporation of the Complainant has been set out. No documents have been filed evidencing (or even making submissions as to) the incorporation of the Complainant nor of BMD Holdings Pty Ltd nor any dates of incorporation of either, nor any evidence of any connection between these entities.

5. Parties' Contentions

A. Complainant

The Complainant makes the following allegations in the Complaint:

BMD Holdings Pty Ltd (Parent Company of BMD Constructions Pty Ltd) holds the following trademarks which are infringed by the disputed domain name and the content of the site.

It includes what are claimed to be 'the published trade mark details' for the two numbered trademarks, each of which contains an unexplained reference to '(730) B.M.D. Holdings Pty. Limited

It then sets out its contentions in relation to the issues in auDRP Schedule A paragraph 4(a) which it is required to establish:

***Eligibility Criteria (Paragraph 4(a))**:* BMD has demonstrated its rights to both the name and mark which is identical or confusingly similar to the disputed domain name. BMD has provided evidence above proving ownership of a registered trademark in Australia that predates the registration of the domain name.

***Identity or Confusing Similarity (Paragraph 4(a)(i))**:* It is clear that the disputed domain name is identical or confusingly similar to BMD's trademark and the logo. The domain name contains a protected word (BMD).

***Rights or Legitimate Interests (Paragraph 4(a)(ii))**:* BMD has proven that the respondent has no rights or legitimate interests in respect of the domain name. This is a clear trademark breach, the respondent lacks such rights or interests, which are not commonly known by the domain name.

***Registration and Use in Bad Faith (Paragraph 4(a)(iii))**:* It is clear from the content within the site that the domain name was registered and is being used in bad faith. It is clear that the respondent registered the domain name primarily to disrupt the business of BMD which is demonstrated by the flyer attached which includes the disputed domain and a QR Code linked to the site. The Respondent is also clearly attempting to attract Internet users for commercial gain by creating confusion with the complainant's trademark.

In response to the RI request to specify the remedies sought, the Complainant stated:

***Remedies (Paragraph 4(i))**:* BMD seeks the transfer of the domain name to BMD in circumstances where the complainant has registered the following domains:

bmdtherealstory.com
bmdtherealstory.au
bmdtherealstory.net.au
bmdtherealstory.net

In the alternative, BMD seeks that the domain be cancelled.

No evidence has been provided of the registration by the Complainant of any of the four domain names listed. It is unclear how the fact that the Complainant may have registered these names, with no dates as to when such registrations have taken place, might be claimed to support the Complaint.

B. Respondent

The Respondent makes the following contentions in response:

- (a) it is a trade union registered and incorporated under the Fair Work (Registered Organisations) Act 2009 (Cth) attempting, inter alia, to regulate and protect the working conditions of workers who are eligible to be its members, including and especially with respect to

workplace health and safety. The Panel observes that no formal evidence has been produced of its registration, incorporation or objectives.

(b) the Complainant has failed to establish any of the matters set out in Schedule B, paragraph 4(a) of the auDRP Rules in that:

1) as to paragraph 4(a)(i)

- i. it has not proved that either of the trademarks are marks of the Complainant or marks to which the Complainant has enforcement rights;
- ii. it has alleged, to the contrary, that it is not the owner of the trademarks;
- iii. it claimed in the initial email that [the Domain Name] 'is easily confused with www.BMD.com.au which is owned by BMD' whereas the Respondent maintains that the domain www.BMD.com.au was not and is not owned by BMD;
- iv. there is no evidence of a likelihood of confusion with the alleged trademarks;

2) as to paragraph 4(a)(ii) the Respondent has established that:

- i. it has "rights or legitimate interests" in the Domain Name;
- ii. it is 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' which is to be taken to demonstrate its rights or legitimate interests to the Domain Name" as set out in auDRP para 4(c)(iii);
- iii. it has not caused any breach of trademark;
- iv. in its conduct it is making a 'non-commercial' use of the Domain Name in like manner to the use analysed by Griffiths J in NRMA where similar conduct was held to be other than 'in trade or commerce';²
- v. in its conduct is making 'fair use' of the Domain Name similar to the allowable use in copyright law for the purpose of criticism, satire or parody;³

3) as to paragraph 4(a)(iii)

- i. the Complainant has failed to establish registration or subsequent use of the Domain Name in bad faith;

² National Roads and Motorists' Association Limited v Construction, Forestry, Maritime, Mining and Energy Union [2019] FCA 1491 (NRMA) per Griffiths J

³ Copyright Act 1968 (Cth ss 103A and 103AA)

- ii. the Respondent's conduct is to promote legitimate criticism of the Complainant in the interests of the workplace health and safety of its members;
- iii. is acting "without intent ... to tarnish the name, trademark or service mark at issue" but rather to promote its fundamental raison d'être, by publishing legitimate criticism of the Complainant in the interests of the workplace health and safety of its members;
- iv. by its conduct is not encouraging or discouraging anyone from investing in the Complainant's business or providing patronage to it but rather to garnering support for its industrial campaign for better working conditions for employees of the Complainant.

The Panel notes that the Complainant has not sought to challenge any of the Respondent's contentions by seeking to file any further evidence or statement pursuant to Para 12 of Schedule A to the auDRP.

The Respondent by its Response seeks dismissal of the Complaint.

Does the auDRP apply to this administrative proceeding?

The Panel is satisfied that the dispute is one which meets the requirements set out in Schedule A Paragraph 4(a) of the auDRP.

4. Under paragraph 4(a) of the Rules a respondent is obliged to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable provider (in this case, RI), in compliance with the Rules that:
 - (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 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.

In an administrative proceeding, the complainant bears the onus of proof.

Discussion and Findings

The Claimant in this proceedings makes a series of allegations (some of which are inconsistent or contradictory) which it claims establish its entitlement to a determination in its favour but in no case produces evidence to support its allegations. It makes claims of bullying and harassment in the initiating email which are then not mentioned further and not supported with any evidence. It claims a breach of a mark in relation to a logo without explaining in what manner the Domain Name is alleged to include any logo and the manner of

the infringement. It claims infringement of trademark rights by the registration of the Domain Name 'and the content of the site' although it nowhere explains or provides evidence of those site contents. The Rules⁴ draw to the attention of a claimant that it bears the onus of proof and it is invited to annex any documentary or other evidence to its complaint. Save for the photograph of the Respondent's poster it produced no evidence.

Under the auDRP Rule 2(b)(xv) a claimant is instructed to

(xv) Annex any documentary or other evidence ... and any name, trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.

This paragraph was included in the RI Request, to which the Claimant responded in the BMD Particulars by attaching, without comment, the poster.

The Complainant claims to have established the three requirements under paragraph 4 of the auDRP Rules.

It contends that '*BMD has demonstrated its rights to both the name and mark*'. Presumably this is a reference to the word 'BMD'. The Panel will first consider the proof of either of the trademarks.

Trademarks

In the Application the Complainant refers to two trademarks by number: 1996319 and 1996321

No evidence of either of the trademarks has been provided by the Complainant. Neither of the purported registrations is certified by the Registrar of Trade Marks and therefore there is no evidence of any entry in the Trade Marks Register in Australia in compliance with s.211(2) of the Trade Marks Act 1955 (Cth).

No evidence has been given of the ownership of the trademarks, other than the slight inference which might be drawn from the inclusion of the two trademarks in the Application that the Complainant is the owner or licensee of them. However this inference is directly contradicted by the statement in the BMD Particulars that

"BMD Holdings Pty Ltd (Parent Company of BMD Constructions Pty Ltd) holds the following trademarks which are infringed by the disputed domain name and the content of the site".

Any inference that the Complainant is the owner of the trademark is also contradicted by the apparent transcription of sections from the trademarks set out in the Response email which states in relation to each of the two trademarks that the owner is B.M.D. Holdings Pty Ltd. Whether *B.M.D. Holdings Pty. Limited* is the same company as *BMD Holdings Pty Ltd* is not explained. Assuming that the ownership of the trademarks is in fact that of BMD Holdings Pty Ltd, there is no evidence of any agreement with or licence granted to the Complainant of any rights in relation to either of the trademarks. The bald phrase 'BMD Holdings Pty Ltd (Parent Company of

⁴ Schedule A Paragraph 4(a)

BMD Constructions Pty Ltd)' does not evidence the corporate existence of or relationship between these two entities.

The Panel concludes that the Claimant has failed to prove that it is the owner of any name or trademark consisting of or incorporating the word 'BMD'

The Complainant has not alleged its incorporation and has provided no certificate of incorporation, nor evidence of its share register nor the incorporation of any alleged holding company and any control by ownership of any shareholding in the Complainant. Further, it has produced no evidence of any agreement giving rights to it to enforce the trademark 'BMD', if such rights exist. Objectively it would appear that the Complainant is contending that the correct complainant in this proceeding should be BMD Holdings Pty Ltd.

Notwithstanding the allegation that '*BMD has provided evidence above proving ownership of a registered trademark in Australia that predates the registration of the domain name*' the Panel finds no proof of the date of the Complainant's ownership of the trademarks or the date of any agreement between it and any company owning the trademark giving it a licence to the marks and any right to enforce them.

After referring to the trademark numbers in the Application the Complainant stated:

"Further BMD Constructions owns www.BMD.com.au"

This contention is apparently set out in the Application to reinforce the claim of its ownership of the trademarks. However the Panel is satisfied from the WHOIS search result of March 6, 2024 of the domain name <bmd.com.au>⁵ that the registrant of that name is BMD Holdings Pty Ltd and this supports the Panel's conclusion that the Claimant is not the owner of either of the trademarks and has established no rights derived from them. The Panel concludes from this erroneous contention that it must look carefully for evidence supporting any allegation made by the Claimant.

Identical or Confusingly Similar: auDRP paragraph 4(a)(i)

Plainly, and the Panel concludes, the Domain Name is not identical to the name 'BMD'. In relation to the proposition that the disputed domain is confusingly similar to 'BMD' there is no evidence of anyone being confused and the proposition is not established merely by stating the allegation.

Further, the Complainant's contention that '*[i]t is clear that the disputed domain name is identical or confusingly similar to BMD's trademark and the logo*' fails, ab initio, as a proposition in the absence of a finding that the Complainant is the owner of any relevant trademark. Further, it raises, for the first time, an issue in relation to a logo. What this logo is claimed to be, the manner in which any enforceable rights in the logo are held by the Claimant and the alleged breach by the registration or use of the Domain Name is not established on the evidence.

⁵ Produced as Annexure 1 to the Response

The Complainant states, as though it is self-evident, that BMD has provided evidence proving ownership of a registered trademark in Australia that predates the registration of the domain name. The Panel has not been provided with such evidence and does not so conclude.

In any event, had all of the other elements required been established by the Complainant, the Panel would not have been satisfied that the Domain Name is confusingly similar to the name 'BMD'. Any person reading the Domain Name would be aware that the site could be criticising the company BMD⁶, a conclusion made manifest if the reader became aware of the site after reading the poster on which the Claimant apparently relies. The Panel refers to the determination in *Wal-Mart Stores*⁷ and may have relied on it, had the other necessary elements been established (noting that for other reasons the Panel in *Wal-Mart Stores* ordered the transfer of the domain name to Wal-Mart):

'But the fame of a mark does not always mean that consumers will associate all use of the mark with the mark's owner. No reasonable speaker of modern English would find it likely that Wal-Mart would identify itself using wal-martsucks.com. Complainant has no evidence of any potential confusion. The Panel specifically rejects Complainant's argument that consumers are likely to be confused as to the sponsorship or association of a domain name that combines a famous mark with a term casting opprobrium on the mark'

Rights or Legitimate Interests: auDRP paragraph 4(a)(ii)

The date when the Domain Name was registered is not established from the Complainant's evidence and the Claimant has established no trademark or other intellectual property rights in the name 'BMD'. It could be that the Domain Name was registered prior to the incorporation of the Complainant. The Panel has no evidence to determine this issue. In the circumstances the Panel does not find, on the Claimant's case, that the Respondent had no rights or legitimate interests in the Domain Name when it was registered.

The Respondent has in its Response raised various arguments supporting its submission that it has rights or legitimate interests in the Domain Name.

The Panel determines that the Respondent has rights and legitimate interests in the Domain Name and is entitled to make legitimate, non-commercial and/or fair use of it. It accepts the analysis applied by Griffiths J in *NRMA* insofar as it is applicable to the issues before the Panel.⁸ It determines that the Respondent was not acting for commercial gain, nor seeking to misleadingly divert the Complainant's customers away. It may be seeking to cause customers or potential customers to question the Complainant as to certain industrial issues which it is highlighting, but it was doing so to garner support for its campaign in the same way that the MUA was found to be

⁶ Red Bull GmbH v. Russell Snyder, [WIPO Case No. D2007-0915](#); Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale, WIPO Case No.D2000-0662

⁷ Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale, WIPO Case No.D2000-0662

⁸ NRMA per Griffiths J

seeking to enlist support from NRMA members in *NRMA*.⁹ Although it might be argued that its campaign was indirectly part of its activities to widen its membership and so was 'commercial' the Panel finds the activities were not shown to have been for commercial purposes¹⁰ but were rather for 'educational and political purposes'¹¹. In the absence of a finding in favour of the Complainant as to its ownership of any trademark or logo the question of any intent to tarnish does not arise.

The Complainant has failed to establish a breach of paragraph 4(a)(ii).

Registration or Subsequent Use in Bad Faith: auDRP paragraph 4(a)(iii)

The Complainant avers that:

'It is clear from the content within the site that the domain name was registered and is being used in bad faith. It is clear that the respondent registered the domain name primarily to disrupt the business of BMD which is demonstrated by the flyer attached which includes the disputed domain and a QR Code linked to the site. The Respondent is also clearly attempting to attract Internet users for commercial gain by creating confusion with the complainant's trademark'

The Panel determines that the Complainant has failed to establish registration or subsequent use of the Domain Name in bad faith. The conduct of the Respondent is to promote legitimate criticism of the Complainant in the interests of the workplace health and safety of its members. It is neither encouraging nor discouraging anyone from doing business with the Complainant or investing in the Complainant's business, but merely intending to highlight shortcomings which it claims to have identified in that business.

The Panel concludes that the Domain Name was not registered and is not being used for commercial gain but for advancing the union's arguments of improper conduct by the Complainant as part of its industrial campaign for better working conditions for its members. On the authorities, this is a reasonable conduct and publicising such action by using a domain name does not, without more, show registration or subsequent use of that name in bad faith.

In the circumstances the Panel will not address the remedies sought.

7. Decision

For all the foregoing reasons, the Complaint is dismissed.

⁹ NRMA per Griffiths J at [150(d)]

¹⁰ NRMA per Griffiths J at [135]

¹¹ Orion Pet Products Pty Ltd v Royal Society for the Prevention of Cruelty to Animals (Vic) Inc [2002] FCA 860; 120 FCR 191 per Weinberg J at [193]

A handwritten signature in black ink that reads "D.S. Levin". The signature is written in a cursive style with a long, sweeping underline that extends to the right.

David Levin K.C.
Panelist

Date: June 19, 2024
Annexure

CON
BMD

JOBSITES ARE DEADLY

BMD sells itself as a family-friendly Queensland company and a good corporate citizen. But to construction workers, BMD is known as BAD MAD DANGEROUS.

Bad Mad Dangerous is a billion-dollar behemoth, with interests in everything from small residential jobs to big taxpayer-funded civil projects. Despite posting enormous profits, they pay substandard wages and their jobsites are notoriously unsafe for workers.

BMD is a dodgy construction company that puts profits ahead of workers lives. Don't trust Bad Mad Dangerous.

**SEE FOR
YOURSELF**



WWW.BMDTHEREALSTORY.COM.AU

CFMEU

Authorised by Z Spithy Construction, Forestry and Maritime Products Pty Ltd, 201 Elizabeth St Melbourne, V.I.C.