

# Overview of Panel Views on Selected auDRP Questions, Second Edition ("auDRP Overview 2.0")

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## INTRODUCTION

The .au Dispute Resolution Policy (“auDRP”) is a policy of the .au Domain Administration Ltd (“auDA”), the authority to whom the Internet Corporation for Assigned Names and Numbers (“ICANN”) has delegated administration of the .au country-code Top Level Domain (“ccTLD”). The auDRP, which is Schedule A of auDA Policy No. 2016-01, establishes a mandatory administrative procedure for resolving entitlement claims brought by trademark or name holders against .au domain name registrants. It is an adaptation of the ICANN Uniform Domain Name Dispute Resolution Policy (“UDRP”). The auDRP commenced on 1 August 2002.

This second edition of the Overview of auDRP Decisions (“auDRP Overview 2.0”), like the first edition published in July 2014, provides a summary of the consensus view of auDRP panels on a range of common and important substantive and procedural issues under the Policy. It adopts the general format of the prevailing WIPO Overview of WIPO Panel Views on Selected UDRP Questions – which, in this case is the third edition (“WIPO Overview 3.0”). The auDRP Overview 2.0 poses and answers the same general questions posed and answered by the WIPO Overview 3.0, and does so using the same numbering of the questions (although the numbering of sub-questions and of paragraphs under each question is not followed). Adopting this approach enables those familiar with the WIPO Overview 3.0 to easily discern the position of auDRP panels on the key issues.

The answer to each question begins with a comparison of the auDRP position to that which applies under the UDRP. Then follows statements which capture the consensus view of auDRP panels on the issue, where there is a consensus view. Where a clear consensus has yet to emerge, disparate views are explained. Citations are provided to the most relevant decisions on each issue.

This edition of the Overview takes account of the more than 600 auDRP decisions that have been published from commencement of the auDRP up to 31 July 2022. The assistance of Liz Newton, the input of Warwick Rothnie and John Swinson, and the guidance of the WIPO Arbitration and Mediation Center (in particular, Brian Beckham, Michael Eylerts, and Francisco Rios) is gratefully acknowledged.



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## 1 FIRST AUDRP ELEMENT

### 1.1 What type of rights are encompassed by the expression “name, trademark or service mark in which the complainant has rights” in auDRP paragraph 4(a)(i)?

The general position is **somewhat different** from that under the UDRP. In particular:

- Unlike the UDRP, the auDRP requires that where the complaint is based on an unregistered trademark, those rights must exist in a particular jurisdiction – namely, Australia.
- Unlike the UDRP, the auDRP expressly recognises a “name” as being a right on which a complaint may be based.

1.1.1 The term “trademark or service mark” [*n.b.*, hereafter in this Overview the term “trademark” includes “service mark” unless otherwise indicated] as used in paragraph 4(a)(i) of the Policy encompasses both a registered trademark and an unregistered trademark (sometimes referred to as a “common law trademark”).

1.1.2 The auDRP does not restrict a complainant’s **registered trademark** rights to a trademark registered with the Australian trademark authority. Thus, a trademark registered *outside* of Australia satisfies the requirements of the Policy to the same extent that a trademark registered in Australia does. It must be noted, however, that a non-Australian trademark registration, of itself, does not satisfy the eligibility and allocation criteria for registration of a domain name at the third level (*i.e.*, at the level immediately preceding “.com.au”, “.net.au”, or “.org.au”) or at the second level (*i.e.*, at the level immediately preceding “.au”). [See section 5.2 on the relevance of a complainant’s failure to satisfy the eligibility and allocation criteria for the domain name.]

1.1.3 Where the complainant does not have a registered trademark, it must establish that it has **unregistered trademark** rights *in Australia*; evidence that it has unregistered trademark rights outside of Australia is insufficient. [See section 1.3 on the requirements for establishing rights in an unregistered trademark.]

1.1.4 The auDRP makes no specific reference to the date on which the owner of the trademark or name must have acquired rights so as to satisfy the requirements of paragraph 4(a)(i) of the Policy. Panels have found that the relevant time by which a complainant must establish its rights is at the time of the filing of the complaint. Rights that were acquired only on the day on which the complaint was filed will suffice. It follows that registration of a domain name *before* a complainant acquires rights in a trademark or name does not prevent a finding of identity or confusing similarity under the Policy, although this fact may be relevant to determining whether the second and third elements of the Policy are satisfied.

1.1.5 An **application** for trademark registration in Australia (even an accepted application, where it has not proceeded to grant) does not, of itself, satisfy the requirement of the complainant having rights for the purposes of paragraph 4(a)(i) of the auDRP. For the complainant to satisfy that requirement, the trademark that is the subject of the application must either: (i) satisfy the test for being a common law or unregistered trademark [see section 1.3]; or (ii) constitute a “name” within Note 1 of the Policy – *i.e.*, be the complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority, or be the complainant’s personal name [see section 1.1.6 *et. seq.*].

1.1.6 The auDRP expressly recognises that a complaint may be based on a “**name** ... in which the complainant has rights”. Note 1 of the Policy explains that this is: (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.

- 1.1.7 A **name** is a series of words of legal significance used to identify a thing, such as a natural person, a legal entity, a product or a place. At least one panel has interpreted Note 1 as non-prescriptive in character, such that it does not operate to restrict the relevant names on which a complaint may be based. However, the reference in Note 1 to a company, business or the other legal or trading name being “registered with the relevant Australian government authority” has been interpreted as prescriptive – with the result that a complaint could not be based on the name of a foreign company that was not registered in Australia. Although registered with the relevant Australian government authority – in this case, the National Health and Medical Research Council (NHMRC) – the title under which a hospital was authorised to conduct a clinical trial was found not to be a “name” for the purposes of the auDRP.
- 1.1.8 The majority of panelists to have addressed the issue consider that a “**smart number**” or “**phone word**” (*i.e.*, a telephone number some or all of the digits of which correspond to a word – *e.g.*, 1300lawyer) is not a “name” for the purposes of paragraph 4(a)(i) of the Policy – and, hence, cannot be the basis for a complaint under the auDRP applies. The reasons for this include: (i) the licence granted by the Australian Communications and Media Authority (ACMA) is to the number only (it does not refer explicitly to any word); and (ii) there may be no word that corresponds to the number (*e.g.*, 131111) or there may be many words that correspond to the number (*e.g.*, 13aircraft, 13aircon, 13circle and 13circus for the number 132472). According to these panels, for a smart number or phone word to provide auDRP-relevant rights, it must satisfy the test for being a common law or unregistered trademark [see section 1.3]. One panel has come to the contrary view, for the reasons that: (i) the auDRP Note 1 requirement for a “name” is satisfied by the correspondence of the phone number’s digits with the particular letters allocated to that digit on a keypad; and (ii) the auDRP Note 1 requirement for the name to be “registered with the relevant Australian government authority” is satisfied by the role played by the ACMA in granting the licence to use the phone word.
- 1.1.9 It would seem that a **domain name** could only constitute a “name” for the purposes of the auDRP if it had been used by the complainant either as a “trading name” within Note 1 of the Policy or as an unregistered trademark (on the requirements for which, see section 1.3).
- 1.1.10 As is the case with trademark rights, the relevant time at which the complainant must establish rights in a name is at the time of the filing of the complaint. For the purposes of paragraph 4(a)(i) of the Policy, it does not matter that rights to the name were not acquired prior to registration of the domain name.
- 1.1.11 A complainant cannot succeed in a complaint under the auDRP where it does not exist as a legal entity under the name in which it filed the complaint.

Relevant decisions – 1.1.2

- [TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Interactive Pty Limited](#), WIPO Case No. DAU2006-0003 (2006), <truelocal.com.au>, Denial
- [WebFarm Ltd v Fopoco Pty Ltd trading as “Free Parking”](#), WIPO Case No. DAU2006-0007 (2006), <freeparking.com.au>, Denial
- [Doteasy Technology, Inc. v. M Makras and E.A Nahed dba Dot Easy Australia](#), WIPO Case No. DAU2006-0011 (2007), <doteasy.com.au>, Denial
- [American Future Technology Corp. v. Rex Hall](#), WIPO Case No. DAU2009-0007 (2009), <ibuypower.com.au>, Denial
- [Marshmallow Skins, Inc. v. Piipiinoo Australia Pty Limited](#), Case No. WIPO DAU2013-0015

Relevant decisions – 1.1.3

- [Sitecore Australia Pty Ltd v. WB Solutions Pty Ltd](#), LEADR Case No. auDRP10/08 (2008), <sitecore.com.au> *et. al.*, Denial
- [We Buy Any Car Limited v. Highway Auto Mart and Jason Collings](#), WIPO Case No. DAU2012-0004 (2012), <webuyanycar.com.au> *inter alia*, Denial

- [\*The Lotter Enterprises Limited v. NG, Ying Fat\*](#), WIPO Case No. DAU2016-0047 (2017), <thelotter.com.au>, Cancellation

Relevant decisions – 1.1.4

- [\*WebFarm Ltd v Fopoco Pty Ltd. trading as "Free Parking"\*](#), WIPO Case No. DAU2006-0007 (2006), <freeparking.com.au>, Denial
- [\*Doteasy Technology, Inc. v. M Makras and E.A Nahed dba Dot Easy Australia\*](#), WIPO Case No. DAU2006-0011 (2007), <doteasy.com.au>, Denial
- [\*Lance John Picton v. KK Factory Seconds Online / Dean James Mackin\*](#), WIPO Case No. DAU2007-0005 (2007), <factoryseconds.com.au>, Denial
- [\*Yola, Inc. v. Aaron John Peter Johnson / Aaron Johnson\*](#), WIPO Case No. DAU2010-0017 (2010), <yola.com.au>, Transfer

Relevant decisions – 1.1.5

- [\*TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Interactive Pty Limited\*](#), WIPO Case No. DAU2006-0003 (2006), <truelocal.com.au>, Denial
- [\*Michael Arnold, Lorimax Pty Ltd v. Tolling Customer Ombudsmn Pty Ltd\*](#), WIPO Case No. DAU2016-0036 (2016), <tollingcustomerombudsman.com.au>, Denial
- [\*Unicareer \(Shanghai\) Education Technology Co., Ltd v. Navigation International Pty Ltd, Linghang Education\*](#), WIPO Case No. DAU2019-0001 (2019), <unicareer.com.au>, Transfer
- [\*Pinho Dental Pty Ltd as trustee for the Pinho Dental Trust v. Ace Digital Marketing Pty Ltd\*](#), WIPO Case No. DAU2021-0019 (2021), <toothimplantssydney.com.au>, Denial

Relevant decisions – 1.1.7

- [\*Brilliance Publishing, Inc. v. My Brilliance Pty Ltd / Ceinwen Schneider\*](#), WIPO Case No. DAU2013-0007 (2013), <brillianceaudiocollections.com.au> *et. al.*, Transfer
- [\*The Sydney Children's Hospitals Network \(Randwick and Westmead\) \(incorporating the Royal Alexandra Hospital for Children\) v. Louise Adams\*](#), WIPO Case No. DAU2019-0023 (2019), <fasttracktrial.com.au>, Denial
- [\*Signature Nail Systems, LLC v. Diamond Nails Supplies Pty Ltd as Trustee for the DT Pham & PTT Nguyen Family Trust\*](#), WIPO Case No. DAU2020-0010 (2020), <snsnail.com.au>, Transfer

Relevant decisions – 1.1.8

- [\*John Kolenda v. 1300 Phonewords Pty Ltd\*](#), WIPO Case No. DA2009-0001 (2009), <1300homeloan.com.au>, Transfer
- [\*Multi-National Concepts Pty Ltd v. 1300 Directory Pty Ltd\*](#), WIPO Case No. DAU2009-0002 (2009), <1300accountant.com.au> *inter alia*, Denial
- [\*Inbound Telecommunications Pty Ltd, Phonename Marketing Australia Pty Ltd v. 1300 Directory Pty Ltd, Demetrio Padilla\*](#), WIPO Case No. DAU2009-0018 (2010), <1300fitness.com.au> *et. al.*, Denial

Relevant decisions – 1.1.9

- [\*Signature Nail Systems, LLC v. Diamond Nails Supplies Pty Ltd as Trustee for the DT Pham & PTT Nguyen Family Trust\*](#), WIPO Case No. DAU2020-0010 (2020), <snsnails.com.au>, Transfer
- [\*Air Charter Service \(Aust\) Pty Ltd v. AVMIN Pty Ltd\*](#), WIPO Case No. DAU2021-0029 (2021), <aircharterservices.com.au>, Denial

Relevant decisions – 1.1.10

- [\*The Crown in Right of the State of Tasmania trading as "Tourism Tasmania" v. Gordon James Craven\*](#), WIPO Case No. DAU2003-0001 (2003), <discover-tasmania.com.au>, Denial
- [\*MW Toolbox Manufacturing \(Vic\) Pty Ltd v. Edward Enayah\*](#), RI Case No. auDRP\_21\_08 (2021), <toolboxcenter.com.au>, Denial

Relevant decisions – 1.1.11

- [\*So Random Pty Ltd v. The Trustee for Mandrake Trust\*](#), RI Case No. auDRP\_20\_16 (2021), <shoeboxtax.com.au>, Denial

## 1.2 Do registered trademarks automatically confer standing to file an auDRP case?

The general position is *similar* to that under the UDRP.

- 1.2.1 Ownership of a registered trademark, wheresoever it is registered, generally satisfies the auDRP paragraph 4(a)(i) threshold requirement of the complainant having rights in a trademark [see section 1.1.2].
- 1.2.2 It appears that no panel has yet had to consider the issue of whether a complainant relying on a trademark registration listed solely on the USPTO Supplemental Register is expected to show secondary meaning (on which, see section 1.3) in order to establish trademark rights under the Policy. (Under US law, a supplemental registration does not, by itself, provide evidence of distinctiveness to support trademark rights.)
- 1.2.3 Subject to considerations addressed in section 1.10, the fact that a trademark registration incorporates a design element or a disclaimed term typically does not preclude the complainant from satisfying the auDRP paragraph 4(a)(i) requirement of having rights in a trademark.

## 1.3 What does a complainant need to show to successfully assert unregistered or common law trademark rights?

The general position is *somewhat different* to that under the UDRP. In particular:

- Unlike the UDRP, the auDRP requires that where the complaint is based on an unregistered trademark, those rights must exist in a particular location – namely, Australia.
- 1.3.1 The requirement that the complainant has rights in a trademark is satisfied where the complainant can show that an unregistered mark has acquired "secondary meaning", such as to become a distinctive identifier associated with the complainant or its goods or services – i.e., that it is a common law trademark. Evidence relevant to establishing such secondary meaning includes: (i) the length and amount of sales under the mark; (ii) the nature and extent of advertising using the mark; (iii) surveys of consumer recognition of the mark; and (iv) media references to the mark.
  - 1.3.2 To constitute a common law trademark, an unregistered mark does not need to be famous or well known. The key requirement is that the mark has sufficient distinctiveness so as to be able to act as a badge of origin that distinguishes the goods or services of the complainant from those of other traders. Merely trading under a name does not, as such, make that name distinctive.
  - 1.3.3 Where the complainant's claimed unregistered mark consists of a generic or descriptive word, a strong case will be required to show that the word has acquired secondary meaning such as to become associated with the complainant and its goods or services. Operating a website which corresponds to an unregistered mark, and using that website in connection with business, will not necessarily give common law rights in that mark.
  - 1.3.4 Where the complainant's trading name has not acquired secondary meaning as an unregistered trademark, it will not provide auDRP-relevant rights unless it is registered with the relevant Australian government authority and thereby is a "name" within the Note 1 definition [see section 1.1.6 *et. seq.*].

### Relevant decisions – 1.3.1

- [University of Melbourne v. union melb](#), WIPO Case No. DAU2004-0004 (2004), <unimelb.com.au>, Transfer



- [Spanton Media Group Pty Limited v. Lion Global Pty Limited](#), WIPO Cases Nos. DAU2007-0007 and DAU2007-0008 (2007), <barawards.com.au> *inter alia*, Denial
- [WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd](#), WIPO Case No. DAU2007-0003 (2007), <wow.com.au>, Denial
- [Curtain Communications Pty Ltd. v. Leann Webb](#), WIPO Case No. DAU2008-0022 (2008), <alphakids.com.au>, Denial
- [Orient Express Travel Group Pty Ltd v. Mookstar Media Pty Ltd](#), WIPO Case No. DAU2015-0004 (2015), <etg.com.au>, Denial
- [Unicareer \(Shanghai\) Education Technology Co., Ltd v. Navigation International Pty Ltd. Linghang Education](#), WIPO Case No. DAU2019-0001 (2019), <unicareer.com.au>, Transfer

#### Relevant decisions – 1.3.2

- [WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd](#), WIPO Case No. DAU2007-0003 (2007), <wow.com.au>, Denial
- [Queensland Electricity Transmission Corporation Limited ACN 078 849 233 trading as Powerlink Queensland v. The Trustee for GAMM FAMILY TRUST](#), LEADR Case No. auDRP11/11 (2011), <pq.net.au>, Denial
- [Brilliance Publishing, Inc. v. My Brilliance Pty Ltd / Ceinwen Schneider](#), WIPO Case No. DAU2013-0007 (2013), <brillianceaudio.com.au> *inter alia*, Transfer

#### Relevant decisions – 1.3.3

- [Stephens Valuation and Consultancy Pty Ltd v. SLR Consulting Australia Pty Ltd](#), WIPO Case No. DAU2013-0026 (2013), <quarryvaluations.com.au> *inter alia*, Denial
- [Michael Arnold, Lorimax Pty Ltd v. Tolling Customer Ombudsmn Pty Ltd](#), WIPO Case No. DAU2016-0036 (2016), <tollingcustomerombudsman.com.au>, Denial
- [Australian Made Campaign Ltd v. Brett Watson, Australian Logo Pty Ltd](#), WIPO Case No. DAU2017-0016 (2017), <australianmadelogo.com.au>, Transfer
- [The Sydney Children’s Hospitals Network \(Randwick and Westmead\) \(incorporating the Royal Alexandra Hospital for Children\) v. Louise Adams](#), WIPO Case No. DAU2019-0023 (2019), <fasttracktrial.com.au>, Denial

### 1.4 Does a trademark owner’s affiliate or licensee have standing to file an auDRP complaint?

The general position is *similar* to that under the UDRP.

- 1.4.1 In most circumstances, an entity that is corporately related to the registered owner of a trademark – such as by being a subsidiary or the parent of the owner of the trademark – is considered to have rights in the trademark for the purposes of paragraph 4(a)(i) of the Policy. However, merely having a common director or a common shareholder does not, of itself, give one company a legal interest in a trademark to which another company has a right – at least where there is no parent company of which the two companies are subsidiaries and there is no evidence to show that both companies use the mark. Where the complainant asserts that the relevant trademark rights are held by another entity with whom it is in a joint venture, it would generally be necessary to provide evidence that establishes the existence of the joint venture. A mere assertion of the existence of a joint venture does not suffice to give the complainant standing to file an auDRP complaint in respect of a trademark the rights to which are held by another entity that is not listed as a co-complainant.

- 1.4.2 In most circumstances, an entity that is a licensee of the trademark owner is considered to have rights in a trademark for the purposes of paragraph 4(a)(i) of the Policy. Evidence establishing the existence of the trademark licence, and possibly the consent of the trademark holder to the bringing of the complaint, would generally be required. One panel has found that the appointment of the complainant as the “exclusive distributor” in Australia of the product that was sold under the registered trademark, together with an “authorisation” of the complainant to use the “trade name” in Australia, was insufficient to provide the complainant with rights in a name for the purposes of the Policy. The reasoning of the panel seems to be that the authorisation to use the “trade name” did not include an authorisation to use a trademark.

Relevant decisions – 1.4.1

- [Automatix Pty Limited trading as Popcake v. Todd Polke](#), IAMA Case No. 3710 (2013), <popcake.com.au>, Denial
- [Eva-Last Hong Kong Limited v. Ben Ranieri, The Trustee for B J Trust](#), WIPO Case No. DAU2019-0022 (2019), <eva-last.com.au>, Denial
- [Sportsbet Pty Ltd, The Sporting Exchange Ltd, and Flutter Entertainment Plc v. Gaming Investments Pty Ltd](#), WIPO Case No. DAU2019-0029 (2020), <flutter.com.au>, Denial

Relevant decisions – 1.4.2

- [Graphisoft Australia v. CAD Australia Pty Limited](#), CIARB Case No. 05/01 (2005), <archicad.com.au>, Denial

## 1.5 Can a complainant show auDRP-relevant rights in a personal name?

The general position is **somewhat different** from that under the UDRP. In particular:

- Unlike the UDRP, the auDRP expressly recognises a “personal name” as being a right on which a complaint may be based, even where the name does not function as an unregistered trademark.

Note 1 of the auDRP states that the complainant’s “personal name” is a “name” for the purposes of the Policy, and hence is a right on which a complaint may be based [see section 1.1.6 *et. seq.*]. Thus, a complainant has auDRP-relevant rights in a personal name, even where that name is neither a registered trademark nor an unregistered (common law) trademark. At least one panel has found that a well-known *nickname* of the complainant is sufficient to constitute a “name” for the purposes of the Policy.

Relevant decisions – 1.5

- [Tina Arena v. Enigmatic Minds Pty Ltd](#), Case No. LEADR Case No. auDRP01/07 (2007), <tinaarena.com.au>, Transfer
- [Shane Keith Warne v. Sure Thing Services Pty Ltd](#), LEADR Case No. auDRP08/10 (2010), <warnie.com.au> *inter alia*, Transfer

## 1.6 Can a complainant’s rights in a geographical term provide standing to file an auDRP complaint?

The general position is **somewhat different** from that under the UDRP. In particular:

- Unlike the UDRP, a geographical term that is also the complainant’s “name” is recognised by the auDRP as being a right on which a complaint may be based.

A geographical term cannot function as a *trademark* for the purposes of paragraph 4(a)(i) of the Policy unless its geographical significance has been displaced by long and extensive use as a brand by a trader in such a manner as to distinguish that trader’s goods and services from those of other traders. However, a complaint may be based on a geographical term if it is either the complainant’s company, business or other legal or trading name and is registered with the relevant Australian government authority, or the complainant’s personal name. This

is because Note 1 of the Policy states that each of those is a “name” for the purposes of the Policy, and hence is a right on which a complaint may be founded [see section 1.1.6 *et. seq.*].

#### Relevant decisions – 1.6

- [\*The Crown in Right of the State of Tasmania trading as "Tourism Tasmania" v. Gordon James Craven\*](#), WIPO Case No. DAU2003-0001 (2003), <discover-tasmania.com.au>, Denial
- [\*Dorset Council v Damian von Samorzewski\*](#), LEADR Case No. auDRP 15/04 (2015), <bluederby.com.au> *et. al.*, Denial
- [\*Phillip Island Nature Park Board of Management Inc. v. The Trustee for the Langford Family Trust No. 4, Technology Consulting and Solutions Pty Ltd\*](#), WIPO Case No. DAU2016-0014 (2016), <churchillislandcafe.com.au>, Denial
- [\*Adelaide Oval Hotel Pty Ltd, Adelaide Oval SMA Ltd v. Hines Property Asset Services Pty Ltd\*](#), WIPO Case No. DAU2020-0021 (2020), <adelaideovalhotel.com.au>, Transfer

### 1.7 What is the test for identity or confusing similarity under the first element?

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

- 1.7.1 The first element of the auDRP functions primarily as a standing requirement. The standing (or threshold) test for identity or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark or name, on the one hand, and the domain name, on the other hand. [On the issue of how the test for identity or confusing similarity is applied to a trademark with design elements (*i.e.*, to a trademark consisting of textual and visual elements), see section 1.10.]
- 1.7.2 The test is *not* about whether the domain name infringes the complainant’s trademark rights. Thus, the goods and/or services for which a registered trademark is registered or used, and for which an unregistered trademark (or a name) is used, is not considered to be relevant to the first element test. This is also the case for the filing date, the priority date, and the date of registration of a registered trademark (or a name), and for the date of claimed first use of a registered or unregistered trademark (or a name). However, these factors may be relevant to the issues that arise for consideration under the second and third elements of the Policy.
- 1.7.3 The test for *identity* is whether there is “essential or virtual identity” between the domain name and the trademark or name in which the complainant has rights.
- 1.7.4 Application of the test for *confusing similarity* typically involves a straightforward visual or aural comparison of the alphanumeric string of the domain name with the trademark/name, to determine the likelihood of Internet user confusion. In order to satisfy the test for confusing similarity, the relevant trademark/name generally needs to be recognisable as such within the domain name. The recognisability of the trademark/name may arise even where the domain name has a shortening, a misspelling, or a substitution, of a term in the trademark/name.
- 1.7.5 A reversal of the order of the terms of the complainant’s trademark or name may not avoid confusing similarity, at least where those terms are descriptive.
- 1.7.6 The inclusion in the domain name of additional terms that are common or descriptive typically is regarded as being insufficient to prevent threshold Internet user confusion. It may be different, however, where the additional terms have the effect of changing how a typical Internet user would read the domain name, such that the trademark/name is not recognizable within the domain name.
- 1.7.7 Where the domain name contains only part of the complainant’s trademark or name and that part is highly descriptive or is generic, the domain name is unlikely to be confusingly similar.

- 1.7.8 Where the domain name merely consists of the acronym or initialism of the complainant's trademark or name, it is unlikely to be considered confusingly similar to that trademark or name unless the complainant can establish a reputation in the acronym or initialism as an unregistered trademark. [But see section 1.15, on a panel taking into account the content of a website to which a domain name resolves to gain an indication of the intended meaning of the domain name.]

Relevant decisions – 1.7.1

- [\*The National Office for the Information Economy v. Verisign Australia Limited\*](#), LEADR Case No. auDRP02/03 (2003), <gatekeeper.com.au>, Transfer
- [\*1SaleADay L.L.C. and Benjamin Federman v. LivinWireless, Simon Mochkin and Eli Feiglin\*](#), WIPO Case No. DAU2010-0016 (2010), <onesaleaday.com.au> *inter alia*, Transfer

Relevant decisions – 1.7.2

- [\*GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd\*](#), WIPO Case No. DAU2002-0001 (2003), <globalcentre.com.au> *inter alia*, Transfer
- [\*Mass Nutrition, Inc. and Todd Rosenfeld v. Mass Nutrition Pty Ltd now known as Tweed Holdings, Luke McNally\*](#), WIPO Case No. DAU2010-0002 (2010), <massnutrition.com.au>, Denial
- [\*Allergan, Inc. and Allergan Australia Pty Ltd v. Denise Costa\*](#), WIPO Case No. DAU2021-0038 (2021), <hairbottox.com.au>, Transfer

Relevant decisions – 1.7.3

- [\*GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd\*](#), WIPO Case No. DAU2002-0001 (2003), <globalcentre.com.au> *inter alia*, Transfer
- [\*Immihelp, LLC v. Babak Shahafar\*](#), WIPO Case No. DAU2013-0041 (2014), <immihelp.com.au>, Denial

Relevant decisions – 1.7.4

- [\*Swinburne University of Technology v. Swinner a/k/a Benjamin Robert Goodfellow\*](#), WIPO Case No. DAU2004-0003 (2004), <swin.com.au>, Transfer
- [\*Silpro Pty Limited v. Corey De Silva t/a Silva Service Spit Roast Catering\*](#), WIPO Case No. DAU2008-0013 (2008), <silvasspitroastcatering.com.au>, Denial

Relevant decisions – 1.7.5

- [\*Tooling Australia Incorporated v. Austool Limited \(In Liquidation\)\*](#), IAMA Case No. 3045 (2007), <toolingaustralia.com.au> *inter alia*, Denial
- [\*Travel Insurance Direct Pty Limited v. Paul F. Quinn\*](#), WIPO Case No. DAU2014-0007 (2014), <directtravelinsurance.com.au>, Denial

Relevant decisions – 1.7.6

- [\*United Parcel Service of America, Inc. v. Wesley Bryant\*](#), WIPO Case No. DAU2009-0012 (2010), <pickupsonline.com.au>, Denial

Relevant decisions – 1.7.7

- [\*WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd\*](#), WIPO Case No. DAU2007-0003 (2007), <wow.com.au>, Denial
- [\*City of Parramatta Council v. Publishing Australia Pty Ltd\*](#), RI Case No. auDRP\_21\_05 (2021), <parramatta.com.au>, Denial

Relevant decisions – 1.7.8

- [\*Queensland Electricity Transmission Corporation Limited ACN 078 849 233 trading as Powerlink Queensland v. The Trustee for GAMM FAMILY TRUST\*](#), LEADR Case No. auDRP11/11 (2011), <pq.net.au>, Denial
- [\*Hall & Wilcox Lawyers v. Mookstar Media Pty Ltd\*](#), ACN 038 167 293, WIPO Case No. DAU2014-0040 (2015), <hw.com.au>, Denial

- [Power On Systems Pty Ltd v. Combined Battery Systems Pty Ltd formerly known as Ceil Motive Power Pty Ltd](#), WIPO Case No. DAU2018-0007 (2018), <cbsystems.com.au>, Denial
- [Keep Australia Beautiful Council \(Qld\) Inc. v. Keep Australia Beautiful National Association Ltd.](#), WIPO Case No. DAU2021-0004 (2021), <kabqld.org.au>, Denial

**1.8 Is a domain name consisting of a trademark or name and a descriptive or geographical term confusingly similar to a complainant's trademark or name?**

The general position is **similar** to that under the UDRP.

Where the incorporated trademark or name constitutes the dominant or principal component of the domain name, the addition of merely generic, descriptive or geographical wording will not, of itself, avoid a finding of confusing similarity between the domain name and the trademark/name under the first element of the auDRP. The position may be different, however, where the trademark or name (especially one that is of a descriptive nature) is incorporated or subsumed within other words or textual elements of the domain name such that the trademark/name is not recognizable within the domain name.

Relevant decisions – 1.8

- [Seek Limited v. Arazac Nominees Pty Ltd.](#), WIPO Case No. DAU2006-0010 (2007), <seekbusiness.com.au>, Denial
- [United Parcel Service of America, Inc. v. Wesley Bryant](#), WIPO Case No. DAU2009-0012 (2010), <pickupsonline.com.au>, Denial
- [My Brilliance Pty Ltd. v. Amazon Corporate Services Pty Ltd.](#), WIPO Case No. DAU2014-0018 (2014), <brilliancepublishing.com.au>, Transfer
- [Pivotel Group Pty Ltd v. Switch Telecom Pty Ltd](#), LEADR Case No. auDRP\_14\_12 (2014), <thinktelecom.com.au>, Denial
- [Yangzhou Okay Auto Accessories Co. Ltd. v. Mr. Ran Zheng, ZQ Pty Ltd.](#), WIPO Case No. DAU2017-0039 (2018), <zqracing.com.au>, Denial

**1.9 Is a domain name consisting of a misspelling of the complainant's trademark or name (i.e., typosquatting) confusingly similar to the complainant's mark or name?**

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

A domain name that contains a common or obvious misspelling of a trademark or name normally will be found to be confusingly similar to such trademark or name, where the misspelled trademark or name remains the dominant or principal component of the domain name. However, where the domain name's variation of the trademark/name fundamentally changes the meaning of the domain name – and, as such, is not in fact a misspelling – the domain name will not be confusingly similar to the trademark.

Relevant decisions – 1.9

- [Telstra Corporation Limited v. Mikhail Doubinski and Yury Sharafutdinov trading as AAA Marketing World](#), WIPO Case No. DAU2006-0008 (2006), <whitepage.com.au>, Transfer
- [United Parcel Service of America, Inc. v. Wesley Bryant](#), WIPO Case No. DAU2009-0012 (2010), <pickupsonline.com.au>, Denial

**1.10 How are trademark registrations with design elements or disclaimed text treated in assessing identity or confusing similarity?**

The general position is **similar** to that under the UDRP.

- 1.10.1 As figurative, stylized or design elements in a trademark are generally incapable of representation in a domain name, such elements are typically disregarded for the purpose of assessing the identity or confusing similarity of a domain name with a trademark. Accordingly, the assessment is generally made between the alpha-numeric components of the domain name and the dominant textual components of the relevant trademark. This is so even where the figurative, stylized or design element is a significant, or even the dominant, component of the trademark. Conversely, the more distinctive or particular are the textual elements of the trademark, the greater is the likelihood of the domain name being identical or confusingly similar to it.
- 1.10.2 Where the entire textual element of a figurative trademark is disclaimed, a panel may find that the complainant has no trademark rights in that element by virtue of its registration – with the result that the complainant does not have a trademark to which the Policy applies unless, through use, the disclaimed element has become distinctive of the complainant’s goods or services.

Relevant decisions – 1.10.1

- [Lance John Picton v. KK Factory Seconds Online / Dean James Mackin](#), WIPO Case No. DAU2007-0005 (2007), <factoryseconds.com.au>, Denial
- [Rainbow Sandals, Inc. v. Malua Point Holdings Pty Limited, Anthony Brown / Malua Point Holdings Pty Limited a/k/a Malua Point Merchants](#), WIPO Case No. DAU2013-0014 (2013), <rainbowsandals.com.au>, Transfer / Cancellation
- [Phillip Island Nature Park Board of Management Inc. v. The Trustee for the Langford Family Trust No. 4, Technology Consulting and Solutions Pty Ltd](#), WIPO Case No. DAU2016-0014 (2016), <churchillislandcafe.com.au>, Denial
- [Makegoods Pty Limited / Niche Group Holdings Pty Limited v. Zoran Petkovic, GMP Constructions Pty Ltd](#), WIPO Case No. DAU2019-0003 (2019), <makegood.com.au>, Denial
- [Television Food Network G.P. v. Lane Trewin-Hallett](#), WIPO Case No. DAU2019-0020 (2019), <foodnetwork.com.au>, Transfer

Relevant decisions – 1.10.2

- [Cambridge Nutritional Foods Limited and Cambridge Manufacturing Company Limited v. Cambridge Diet Pty Ltd](#), WIPO Case No. DAU2010-0021 (2011), <cambridge-diet.com.au>, Transfer

**1.11 Is the Top Level Domain relevant in determining identity or confusing similarity?**

The general position is **similar** to that under the UDRP.

- 1.11.1 Prior to introduction of “direct registration” (*i.e.*, registration at the second level – the level immediately preceding “.au”) in early 2022, open registration in the “.au” domain space was possible only at the third level (*e.g.*, at the level immediately preceding “.com.au”, “.net.au”, or “.org.au”). For a domain name registration at the third level, the applicable second level and first level suffixes in the domain name (*e.g.*, “.com.au”, “.net.au”) are generally disregarded when assessing identity or confusing similarity. The equivalent approach for a direct registration domain name is to disregard the first level suffix (*i.e.*, “.au”).
- 1.11.2 However, a panel will take account of the higher-level suffix(es) where the suffix(es) is/are relevant to determining how a typical Internet user would likely perceive the domain name. A typical .au ccTLD Internet user would likely consider the domain name as having an Australian connection, and hence would generally find it to be confusingly similar to a trademark or name that contained the word “Australia” or the like, even though that word was not present in the domain name.

Relevant Decisions – 1.11.1

- [The National Office for the Information Economy v. Verisign Australia Limited](#), LEADR Case No. auDRP02/03 (2003), <gatekeeper.com.au>, Transfer
- [1SaleADay L.L.C. and Benjamin Federman v. LivinWireless, Simon Mochkin and Eli Feiglin](#), WIPO Case No. DAU2010-0016 (2010), <onesaleaday.com.au> *inter alia*, Transfer

Relevant Decisions – 1.11.2

- [National Australia Bank Limited v. Joshua Hoa That Ton](#), WIPO Case No. DAU2020-0018 (2020), <bgfa.com.au> et. al, Transfer and Denial

**1.12 Is a domain name consisting of the complainant’s trademark or name plus a third-party trademark or name confusingly similar to the complainant’s trademark or name?**

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

It appears that no auDRP panel has yet addressed the situation of a domain name consisting of or containing more than one trademark or name where the complainant does not have rights in all of them. However, consistent with the approach taken by panels under the UDRP, where the complainant’s trademark/name is recognizable within a domain name (e.g., <[complainttrademark/name]+[thirdpartytrademark/name].2LD.au>), it is very likely that an auDRP panel would consider that the addition of a third-party’s trademark/name is insufficient in itself to avoid a finding of confusing similarity to the complainant’s trademark/name. [See also section 4.13.]

**1.13 Is a domain name consisting of a trademark or name and a negative term (“sucks cases”) confusingly similar to a complainant’s trademark or name?**

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

It appears that no auDRP panel has yet addressed the situation of a domain name consisting of or containing a trademark/name and a negative or pejorative term (e.g., <[trademark/name]sucks.2LD.au>. However, consistent with the approach taken by panels under the UDRP, where the complainant’s trademark/name is recognizable within the domain name it is very likely that an auDRP panel would consider that the addition of negative or pejorative term is insufficient in itself to avoid a finding of confusing similarity to the complainant’s trademark/name.

[On the issue of whether use of a domain name for criticism gives rise to rights or legitimate interests in the domain name, see section 2.6.]

**1.14 Is a domain name that consists or is comprised of a translation or transliteration of a trademark or name identical or confusingly similar to a complainant’s trademark or name?**

The position is **not yet established** (as it has not yet been considered by an auDRP Panel).

It appears that no auDRP panel has yet addressed the situation of a domain name consisting of or containing a translation or transliteration of a trademark or name (e.g., <livrouge.com.au> in relation to the trademark or name REDBOOK). However, consistent with the approach taken by panels under the UDRP, it is likely that a domain name consisting of or containing a translation or transliteration of a trademark/name would be found by an auDRP panel to be identical or confusingly similar to the trademark/name for the purposes of the first requirement of the Policy.

**1.15 Is the content of the website associated with a domain name relevant in determining identity or confusing similarity?**

The general position is ***not yet established*** under the auDRP (as it has not yet been considered by an auDRP Panel).

It appears that no auDRP panel has yet addressed the issue of whether the content of a website resolving from a domain name is relevant to determining the identity or confusing similarity of the domain name to the complainant's trademark/name. However, consistent with the approach taken by panels under the UDRP, it is expected that an auDRP panel would generally ignore the content of any website to which the domain name resolves – on the basis that identity or confusing similarity is determined simply by way of a string comparison (*i.e.*, by comparison of the domain name's text with the text of the complainant's trademark/name) [on which, see section 1.7] – unless it was necessary to do so to gain an indication of the intended meaning of the domain name.



## 2 SECOND AUDRP ELEMENT

### 2.1 How do panels assess whether a respondent lacks rights or legitimate interests in a domain name?

The general position is ***somewhat different*** from that under the UDRP. In particular:

- Unlike the position with respect to the open gTLDs (e.g., “.com”, “.net”, “.org”) to which the UDRP applies, there are eligibility and allocation requirements for registration of a domain name at the third level in the open 2LDs, and at the second level, of the .au ccTLD, and a failure to satisfy these requirements can mean that a respondent is unable to establish it has rights or legitimate interests in the domain name.
- 2.1.1 A complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. 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 evidence or plausible assertions demonstrating rights or legitimate interests in the domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy [see also section 4.3 in relation to respondent default]. If the respondent does provide some evidence or plausible assertions demonstrating 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.
  - 2.1.2 The mere fact that the respondent was able to register the domain name does not, of itself, establish that the respondent has rights or legitimate interests in the domain name. Note 2 of the Policy states that, for the purpose of paragraph 4(a)(ii), rights or legitimate interests in 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”. The fact that the .au ccTLD administrator, .au Domain Administration Ltd (auDA), has determined that the respondent satisfies the eligibility criteria (see section 2.1.6) does not, of itself, establish that it has rights or legitimate interests in the domain name.
  - 2.1.3 A respondent’s rights or legitimate interests in a domain name may be demonstrated by circumstances other than those specified in paragraph 4(c). However, it will generally be difficult for the respondent to show rights or legitimate interests in a domain name that has not been used in any way, particularly where the domain name has been registered for a significant period of time.
  - 2.1.4 The rights or legitimate interests in a domain name that the respondent must establish are the rights or legitimate interests of the respondent *itself*, as distinct from those of an associated entity. Evidence of the rights or legitimate interests in the domain name of some other entity, even an entity related to the respondent, is generally not sufficient. The position may be different, however, where the related entity previously held the domain name before transferring it to the respondent. [See also section 5.1.1.]
  - 2.1.5 A respondent who does not exist (*i.e.*, who is not a recognised legal entity) cannot have rights or legitimate interests in the domain name of which, according to the Whois information, it is the registrant.

- 2.1.6 auDA has promulgated eligibility and allocation requirements for the registration of domain names in the .au ccTLD. Prior to 12 April 2021, the eligibility and allocation requirements for registration of a domain name at the third level were set out in auDA Policy No. 2012-04 'Domain Name Eligibility and Allocation Policy Rules for Open 2LDs'. Since 12 April 2021, those requirements, and the requirements for registration of a domain name at the second level, are contained in auDA Policy 2019-01 '.au Domain Administration Rules: Licensing'.
- 2.1.7 A respondent who does not, and never did, satisfy the eligibility and allocation requirements for a domain name cannot have rights or legitimate interests in that domain name for the purposes of paragraph 4(a)(ii) of the Policy.
- 2.1.8 The position may be different, however, where the respondent did satisfy the eligibility and allocation requirements at the time of registration of the domain name, even though it subsequently failed to continue to satisfy them (e.g., because a pending Australian trademark application on which eligibility was founded failed to proceed to registration). Such a respondent can have rights or legitimate interests in the domain name for the purposes of paragraph 4(a)(ii) of the Policy, arising from use of the domain name at a time when the eligibility and allocation requirements were satisfied. [Importantly, however, paragraph 2.11.5 of the auDA Policy 2019-01 '.au Domain Administration Rules: Licensing' provides that a domain name licence "will be cancelled" by the Registrar or auDA where the registrant "no longer has an Australian presence". That paragraph contains a note which states "For example: A foreign natural person whose Australian Trade Mark registration has lapsed no longer has an Australian presence and the licence will be cancelled".]

Relevant decisions – 2.1.1

- [Jacuzzi, Inc. v. Wangra Pty Ltd](#), WIPO Case No. DAU2005-0001 (2005), <jacuzzispas.com.au>, Denial
- [ESPN Inc. v. IMCO Corporation Pty Ltd](#), WIPO Case No. DAU2005-0005 (2006), <espn.com.au>, Transfer
- [Telstra Corporation Limited v. Mikhail Doubinski and Yury Sharafutdinov trading as AAA Marketing World](#), WIPO Case No. DAU2006-0008 (2006), <whitepage.com.au>, Transfer
- [TeamViewer GmbH v. Nigel Burke](#), WIPO Case No. DAU2012-0027 (2012), <teamviewer.com.au>, Transfer
- [Pindan Pty Ltd v. Kre8 Brand Pty Ltd](#), WIPO Case No. DAU2013-0038 (2014), <switchfeelathome.com.au>, Transfer
- [Binance Holdings Limited v. Tell Media Pty Ltd](#), WIPO Case No. DAU2020-0009 (2020), <binance.com.au>, Denial

Relevant decisions – 2.1.2

- [Easy Living Home Elevators Pty Ltd v. Lift Shop Pty Ltd](#), LEADR Case No. auDRP09/08 (2009), <domuslift.com.au>, Transfer
- [Smart LLC v. Care Products Group Pty Ltd](#), RI Case No. auDRP\_21\_10 (2021), <chemicalguys.com.au>, Transfer
- [Carmen McNamara, The Skin Fairy Pty Ltd t/as Skin Fairy, Skin Fairy Group Pty Ltd v. Katine Elfis, James Buchanan, Skin Evolution, About Face Cosmetic Studio Pty Ltd](#), WIPO Case No. DAU2021-0001 (2021), <skinfairy.com.au> et. al., Transfer
- [Metro Baby Pty Ltd v. Swaddler Shop Pty Ltd](#), WIPO Case No. DAU2022-0012 (2022), <metrobaby.com.au>, Denial

Relevant decisions – 2.1.3

- [Baby Factory \(NZ\) Limited v. Sydney's Baby Kingdom Pty Ltd](#), WIPO Case No. DAU2020-0014 (2020), <babyfactory.com.au> et. al., Transfer

Relevant decisions – 2.1.4

- [My Brilliance Pty Ltd. v. Amazon Corporate Services Pty Ltd.](#), WIPO Case No. DAU2014-0018 (2014), <brilliancepublishing.com.au>, Transfer

- [Hydro Building Systems France \(formerly SAPA Building Systems France\) v. Nader Ragheb](#), WIPO Case No. DAU2018-0033 (2019), <technal.com.au>, Transfer

Relevant decisions – 2.1.5

- [BT Financial Group Pty Limited v. Basketball Times Pty Ltd](#), WIPO Case No. DAU2004-0001 (2004), <bt.com.au>, Transfer
- [Grayson's International Pty Ltd v. Leafscreeener \(NSW\) Pty Ltd](#), RI Case auDRP\_20\_04 (2020), <leafscreeener.com.au>, Transfer
- [Grayson's International Pty Ltd v. BW Harrison & FR Harrison](#), RI Case auDRP\_20\_06 (2020), <waleafscreeener.com.au>, Denial

Relevant decisions – 2.1.7

- [Jasham Pty Ltd \(ACN 065 058 988\) v. Perfume Empire Pty Ltd \(ACN 108 883 325\)](#), LEADR Case No. auDRP01/06 (2006), <jasham.com.au>, Transfer
- [HCOA Pty Ltd, Molescan Australia Pty Ltd v. The Trustee for the Terantica Trust / Terry Lockitch](#), WIPO Case No. DAU2013-0003 (2013), <molescan.com.au>, Transfer
- [My Brilliance Pty Ltd. v. Amazon Corporate Services Pty Ltd.](#), WIPO Case No. DAU2014-0018 (2014), <brilliancepublishing.com.au>, Transfer
- [Sydney Theatre Company Ltd v. Blogger Pty Ltd](#), WIPO Case No. DAU2014-0021 (2014), <sydneytheatrecompany.com.au>, Transfer
- [Dollar Rent A Car, Inc. v. Tom O'Donnell, Prudential Energy Pty Limited](#), WIPO Case No. DAU2016-0021 (2016), <dollarcar.com.au>, Transfer
- [Discovery Holiday Parks Pty Ltd. v. B2B Network Pty Ltd](#), WIPO Case No. DAU2021-0027 (2021), <gday.net.au>, Cancellation
- [Perspective Law Pty Ltd ACN 167 483 089 v. Usedcarnow Pty Ltd ACN 622 100 154](#), RI Case No. auDRP\_21\_17 (2021), <perspectivelaw.com.au>, Transfer

Relevant decisions – 2.1.8

- [Lance John Picton v. KK Factory Seconds Online / Dean James Mackin](#), WIPO Case No. DAU2007-0005 (2007), <factoryseconds.com.au>, Denial
- [Three Best Rated Pty Ltd v. Signature Profit LLC](#), WIPO Case No. DAU2020-0006 (2020), <threebestrated.com.au>, Denial
- [Myca Australia Pty Ltd v. Dr Peter H Cole Surgical Pty Ltd](#), Resolution Institute Case No. auDRP\_21\_03 (2021), <hellohealth.com.au>, Denial

**2.2 What qualifies as prior use of, or demonstrable preparations to use, the domain name in connection with a *bona fide* offering of goods or services?**

The general position is *similar* to that under the UDRP.

- 2.2.1 Paragraph 4(c)(i) of the auDRP states that a respondent will be taken to have demonstrated rights or legitimate interests in a domain name where, before any notice of the subject matter of the dispute, it has *bona fide* used, or prepared to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services. Unlike the equivalent provision in the UDRP, paragraph 4(c)(i) of the auDRP expressly states that “an offering of domain names that you have acquired for the purposes of selling, renting or otherwise transferring” is not a *bona fide* offering for this purpose.

- 2.2.2 The key issue is whether the respondent's prior use of, or preparations to use, the domain name is *bona fide* – *i.e.*, is in good faith. To determine whether a respondent's use of a domain name is in good faith requires a consideration of the respondent's motivation for undertaking that use – which, in turn, requires an evaluation of all the facts and evidence. Relevant facts include: the degree of similarity of the domain name to the complainant's trademark/name; the respondent's awareness of the complainant's business conducted under its trademark/name; the likelihood of customer confusion; and whether the domain name is genuinely being used for any descriptive meaning that it may have. Where there is evidence that the respondent registered the domain name to exploit the value of the complainant's trademark/name incorporated in it, a lack of good faith will be inferred in respect of the respondent's use of the domain name. [See also section 2.8.]
- 2.2.3 A respondent's use of a domain name under a trademark licence from the complainant does not give rise to respondent rights or legitimate interests in the domain name, unless (contrary to the usual position under a trademark licence) the complainant has consented to the respondent acquiring its own goodwill through use of the trademark. A respondent's use of a domain name after termination of a trademark licence from the complainant will not give rise to respondent rights or legitimate interests in the domain name.
- 2.2.4 It is not necessary for the respondent to do business under the exact term or phrase incorporated in the domain name – it is sufficient that there is a “connection” between the domain name's descriptive meaning and the respondent's offering of goods or services.
- 2.2.5 The Policy recognises that a respondent has no obligation to commence using a domain name immediately – or, indeed, within any specified time frame – after registration of it. However, where the domain name has been registered for many years and there is little or no evidence of any progress towards an alleged intended *bona fide* use of the domain name, panels are unwilling to conclude that the respondent has established rights or legitimate interests in it.
- 2.2.6 Preparations to use a domain name may be demonstrated by, among other things, the engagement of third parties (e.g., web designers, graphic designers, etc.) to assist with the launch of a proposed business using the domain name. The persuasiveness of a claim of preparations to use a domain name will be determined by the strength of the evidence provided by the respondent. Where the evidence is given in the form of a statutory declaration, a panel is unlikely to ignore it. .

Relevant decisions – 2.2.2

- [PA Consulting Services Pty Ltd v. Joseph Barrington-Lew](#), WIPO Case No. DAU2003-0002 (2003), <paconsulting.com.au>, Transfer
- [Budget Rent A Car v. Emma Faye Weekly](#), WIPO Case No. DAU2010-0020 (2011), <budgetcarhire.com.au>, Transfer
- [Confo Pty Ltd v. Meridian Project Consulting Pty Ltd](#), LEADR Case No. auDRP\_10\_20 (2011), <buildercpd.com.au>, Transfer
- [Cairns Airport Pty Ltd. v. Chris Ford \(Christopher William Ford\) / C and C Family Discretionary Trust](#), WIPO Case No. DAU2013-0023 (2013), <cairnsairportparking.com.au> *et. al.*, Denial
- [Tyre Depot Holdings Pty Ltd v. Tyre Kingdom Pty Ltd.](#), WIPO Case No. DAU2014-0016 (2014), <tyredepot.com.au>, Transfer
- [Australian Made Campaign Ltd v. Brett Watson, Australian Logo Pty Ltd](#), WIPO Case No. DAU2017-0016 (2017), <australianmadelogo.com.au>, Transfer
- [National Australia Bank Limited v. Joshua Hoa That Ton](#), WIPO Case No. DAU2020-0018 (2020), <bgfa.com.au> *et. al.*, Transfer and Denial
- [Varinder Singh Toor trading as Vicky Driving School Melbourne v. Vikas Sharma](#), RI Case No. auDRP\_22\_3 (2022), <vickydrivingschool.net.au>, Denial

- [Fritz Egger GmbH & Co. OG and Egger Australasia Pty Ltd v. Domain Admin, Proform Products Pty Ltd](#), WIPO Case No. DAU2022-0006 (2022), <egger.com.au>, Transfer

#### Relevant decisions – 2.2.3

- [Cobb International Limited v. Cobb Australia & New Zealand \(Pty\) Ltd.](#), WIPO Case No. DAU2013-0005 (2013), <cobb.com.au>, Transfer
- [Illycaffè S.p.A. v. John Frisco & Associates Pty Ltd trading as Illycafe / CEW Pty Ltd](#), WIPO Case No. DAU2015-0009 (2015), <illy.com.au>, Transfer
- [Tangle Teezer Limited, Shaun Pulfrey v. Betrina Hill, The trustee for Hill Family Trust](#), WIPO Case No. DAU2019-0006 (2019), <tangle-teezer.com.au>, Transfer
- [The Lovesac Company v. PLS Trading Pty Ltd](#), WIPO Case No. DAU2021-0025 (2021), <lovesac.com.au>, Transfer

#### Relevant decisions – 2.2.4

- [Lance John Picton v. KK Factory Seconds Online / Dean James Mackin](#), WIPO Case No. DAU2007-0005 (2007), <factoryseconds.com.au>, Denial
- [Biodiversity Australia Pty Ltd v. Rob Barnaby, Biodiversity Solutions Australia Pty Ltd](#), WIPO Case No. DAU2021-0008 (2021), <biodiversityaustralia.com.au>, Denial

#### Relevant decisions – 2.2.5

- [Natures Organics Pty Ltd v. Anstee Dalton Pty Limited](#), WIPO Case No. DAU2019-0026 (2019), <earthchoice.com.au>, Transfer

#### Relevant decisions – 2.2.6

- [Peachbulk Pty Ltd v. Domain Boutique Pty Ltd](#), WIPO Case No. DAU2020-0013 (2020), <bromance.com.au>, Cancellation
- [Discovery Holiday Parks Pty Ltd v. Ed Keay-Smith, The Short Course Company Pty Ltd](#), WIPO Case No. DAU2021-0026 (2021), <gday.com.au>, Denial

### 2.3 How would a respondent show that it is commonly known by the domain name or a name corresponding to the domain name?

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

For a respondent to demonstrate that it (as an individual, business, or other organization) has been commonly known by the domain name or a name corresponding to the domain name, it is not necessary for the respondent to have acquired corresponding trademark rights. However, the respondent must be “commonly known”, as opposed to merely incidentally being known, by the relevant moniker. Mere assertions by a respondent that it is commonly known by the domain name will not suffice; for such a finding to be made, a respondent is required to produce concrete and credible evidence.

#### Relevant decisions – 2.3

- [Google Inc. v. Dmitri Rytsk](#), WIPO Case No. DAU2007-0004 (2007), <googlebay.com.au>, Transfer
- [Bernard Janes v. L.J. Bubenicek & A. J. Main, A&L Technologies](#), WIPO Case No. DAU2010-0014 (2010), <goballistic.com.au>, Transfer
- [Geek Group Pty Ltd v. SG Corporate Services Pty Ltd](#), WIPO Case No. DAU2019-0009 (2019), <supergeek.com.au>, Transfer

### 2.4 How does the auDRP account for legitimate fair use of a domain name?

The general position is **similar** to that under the UDRP.

Paragraph 4(c)(iii) of the auDRP provides that a respondent may demonstrate rights or legitimate interests in a domain name by providing evidence of “legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to

tarnish the [complainant's] name, trademark or service mark at issue". The application of this provision is discussed in section 2.8.

## 2.5 What are some of the core factors auDRP panels look at in assessing fair use?

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

Fundamentally, a respondent's use of a domain name will not be considered "fair" if that use falsely suggests an affiliation with the complainant. Central to that inquiry is the correlation between the domain name and the complainant's trademark or name. Generally speaking, a domain name that is identical to the complainant's trademark/name carries a high risk of implied affiliation with the complainant.

Beyond looking at the domain name itself, panels assess whether the overall facts and circumstances of the case support a respondent's claim to fair use of the domain name. In undertaking that assessment, panels will take into account the following factors, among others: (i) whether the domain name has been registered and is being used for legitimate purposes, and not as a pretext for commercial gain or other such purposes inhering to the respondent's benefit; (ii) whether the respondent reasonably believes its use (whether referential, or for praise or criticism) to be truthful and well-founded; (iii) whether it is clear to Internet users visiting the respondent's website that it is not operated by the complainant; (iv) whether the respondent has refrained from registering a domain name that is identical to the trademark or name of the complainant; and (v) whether the domain name registration and use by the respondent is consistent with a pattern of *bona fide* activity (whether online or offline).

These core factors, and other relevant factors for assessing fair use, are discussed further in sections 2.6–2.10.

## 2.6 Does a criticism site support respondent rights or legitimate interests?

The general position is **similar** to that under the UDRP.

2.6.1 Panels recognise that use of a domain name by the respondent to engage in free speech can give rise to respondent rights or legitimate interests in the domain name, so long as that use is genuine and non-commercial.

2.6.2 However, the right to express one's views is not the same as the right to use another's name to identify oneself as the source of those views. Accordingly, use of a domain name that consists solely of the complainant's trademark/name (*i.e.*, <trademark/name.2LD.au> or <trademark/name.au>) for the purpose of engaging in criticism of the complainant does not, of itself, give rise to rights or legitimate interests in the domain name.

### Relevant decisions – 2.6.1

- [Google Inc. v. Dmitri Rytsk](#), WIPO Case No. DAU2007-0004 (2007), <googlebay.com.au>, Transfer
- [SKYCITY Adelaide Pty Limited \[ABN 72 082 362 061\] v. Trellian Pty Ltd \[ABN 55 098 223 048\]](#), IAMA Case No. 3353 (2009), <adelaidecasino.com.au>, Transfer
- [Miltenyi Biotec GmbH v. Rachel A. Liu-Williams](#), WIPO Case No. DAU2015-0033 (2015), <miltenyibiotec.net.au>, Transfer

### Relevant decisions – 2.6.2

- [Miltenyi Biotec GmbH v. Rachel A. Liu-Williams](#), WIPO Case No. DAU2015-0033 (2015), <miltenyibiotec.net.au>, Transfer
- [Mount Wellington Cableway Company Pty Limited v. The Trustee for the Dive Trust](#), RI Case No. auDRP\_18\_04 (2018), <mtwellingtoncablecar.com.au>, Transfer

## 2.7 Does a fan site support respondent rights or legitimate interests in a domain name?

The general position is *similar* to that under the UDRP.

For the purpose of constituting a fair use under paragraph 4(c)(iii) of the Policy, a respondent's website on which the owner of the corresponding trademark/name is celebrated or discussed ("fan site") must be active, genuinely non-commercial, and clearly distinct from the complainant's official website. A respondent will not have rights or legitimate interests in a fan site on which commercial activity occurs – even if this is only a part of the site's content – because of the requirement in paragraph 4(c)(iii) that the respondent's use was "without intent for commercial gain".

### Relevant decisions – 2.7

- [Arena Entertainment Pty Limited v. Alex Haddad](#), LEADR Case No. auDRP05/05 (2005), <rmbsuperclub.com.au>, Transfer
- [Tina Arena v. Enigmatic Minds Pty Ltd](#), Case No. LEADR Case No. auDRP01/07 (2007), <tinaarena.com.au>, Transfer
- [LEGO Juris A/S v. Brock Flanagan, BJB Web Design](#), WIPO Case No. DAU2016-0027 (2016), <legoman.com.au>, Transfer

## 2.8 How do panels assess claims of nominative (fair) use by resellers or distributors?

The general position is *similar to* that under the UDRP.

- 2.8.1 In determining whether a respondent's commercial use of a domain name is a "fair use" for the purposes of paragraph 4(c)(iii) of the Policy, auDRP panels have generally adopted the principles set out in the UDRP case [Okidata Americas, Inc. v. ASD, Inc.](#), WIPO Case No. D2001-0903 (the "Okidata principles"). Under the *Okidata* principles, a reseller or distributor can be making a *bona fide* offering of goods and services, and thus have a legitimate interest in the domain name, if its use meets these requirements: (i) the respondent must actually be offering goods or services related to the trademark/name in respect of which the domain name is confusingly similar; (ii) the respondent must offer only those goods or services in connection with the domain name; (iii) the respondent must have disclosed its true relationship with the owner of the trademark/name to which the domain name is identical or confusingly similar, prior to notice of the dispute; and (iv) the respondent must not have attempted to "corner the market" in domain names that reflect the complainant's trademark/name. Generally, a failure to satisfy one of these requirements results in a finding that the respondent has not established that it has rights or legitimate interests in the domain name.
- 2.8.2 The respondent can have rights or legitimate interests in a domain name on the basis of a *bona fide* offering of goods or services only where it is **actually offering the goods or services** related to the complainant's trademark/name. Simply linking to another website at which the goods or services are offered is not sufficient.
- 2.8.3 The respondent can have rights or legitimate interests in a domain name on the basis of a *bona fide* offering of goods or services only where it is **offering solely the goods or services** of the trademark/name owner. Where the website also offers the goods or services of another entity, the respondent will not be able to establish that it has rights or legitimate interests in the domain name, unless the other goods/services are of a minor and supplementary nature.

- 2.8.4 The respondent can have rights or legitimate interests in a domain name on the basis of a *bona fide* offering of goods or services only where it has **disclosed its true relationship** with the owner of the trademark/name. If the respondent is not authorized to deal in the complainant's goods/services, a failure to indicate this on the respondent's website will generally mean the respondent has not established rights or legitimate interests – at least where the website suggests that the respondent is either the complainant or has some form of accreditation from the complainant. Even where the respondent's website does disclaim association with the complainant, that disclaimer will not be considered as satisfying the requirement of disclosing the respondent's true relationship with the complainant if it is not sufficiently prominent or if there are other features of the website that convey a contrary impression.
- 2.8.5 The respondent can have rights or legitimate interests in a domain name on the basis of a *bona fide* offering of goods or services only if it has **not attempted to corner the market** in domain names that reflect the complainant's trademark/name. An attempt to corner the market is likely to be found where the respondent has registered multiple domain names containing the trademark/name. It is also likely to be found where only one domain name has been registered and that domain name consists wholly of the trademark/name (*i.e.*, is <trademark/name.2LD.au> or <trademark/name.au>).
- 2.8.6 The *Oki Data* principles have been applied by auDRP panels to a respondent reseller that is unauthorised, as well as to one that is expressly authorised, to use the trademark/name by the trademark/name owner. Thus, these principles have been applied to a reseller of the trademarked goods that are second-hand.
- 2.8.7 The *Oki Data* principles have also been applied to a respondent acting not as a reseller of the trademarked goods, but as an *agent for the purchaser* of such goods.
- 2.8.8 The *Oki Data* principles have further been applied to a respondent that uses the trademarked goods in the supply of its services.
- 2.8.9 Satisfying the *Oki Data* principles is not the only way in which a respondent can establish that its commercial use of a domain name is a "fair use" for the purposes of paragraph 4(c)(iii) of the Policy, and hence one which can give rise to rights or legitimate interests in it. It has been recognised that the respondent has a legitimate interest in describing itself and its goods or services accurately, and that this legitimate interest will extend to the use of a domain name that contains the complainant's trademark/name where that use is a "descriptive fair use". To determine whether a commercial use of a domain name is a descriptive fair use requires consideration of two issues: (i) whether the respondent's use of the domain name is "descriptive"; and (ii) if so, whether it is "fair".
- 2.8.10 The issue of whether the respondent's use of the domain name is descriptive requires careful articulation. The issue is not whether the domain name as a whole is being used descriptively, but whether the complainant's trademark/name within the domain name is being used descriptively. More specifically, the correct question is whether a respondent is using descriptively that part of the domain name that is identical with or confusingly similar to a complainant's trademark/name. To answer this question requires consideration of how the domain name would be read by Internet users; and the answer to this question will, inevitably, turn on the specific facts of the particular case – including where in the domain name appears the complainant's trademark/name, and what other words are contained in the domain name.



- 2.8.11 Even if a respondent's commercial use of the domain name is descriptive (in the sense explained above), that will not give rise to rights or legitimate interests in the domain name unless that use is also fair. One instance in which a respondent's descriptive use of the domain name will not be fair is where it is undertaken with "intent for commercial gain to misleadingly divert consumers or to tarnish" a complainant's trademark or name (this being a requirement of paragraph 4(c)(iii) of the Policy). There can be other instances in which a particular use, though descriptive, is nevertheless not a fair use, and so does not give rise to a respondent having a right or legitimate interest in the domain name. However, there may be nothing inherently unfair about providing, independently of a trademark owner, information about the products sold under the trademark, even if that information includes comparisons with rival products.

Relevant decisions – 2.8.1

- [Princess Yachts International plc v. Graham Stephens](#), LEADR Case No. auDA 08\_07 (2007), <princessyachts.com.au>, Transfer
- [Topfield Co. Ltd v. Jai Kemp and Digital Products Group Pty Ltd, t/a Topfield Australia, formerly Paige Communications Pty Ltd](#), WIPO Case No. DAU2008-0002 (2008), <topfield.net.au> et. al., Denial and Transfer
- [Pangaea Laboratories Ltd, Pacific Direct Intertrading Pty Ltd v. Astrix Pty Ltd](#), WIPO Case No. DAU2015-0013 (2015), <nanogen.com.au> et. al., Transfer

Relevant decisions – 2.8.2

- [GM Holden Ltd v. Blogger Pty Ltd](#), WIPO Case No. DAU2008-0016 (2008), <holdenastra.com.au>, Transfer
- [Terra Plana International Ltd. v. The Summer House Australia Pty Ltd / Tanya Greenwood](#), WIPO Case No. DAU2012-0025 (2012), <vivobarefoot.com.au> et. al., Transfer
- [FJ Westcott Company v. Samuel Leo Klein / Image Melbourne Pty Ltd](#), WIPO Case No. DAU2014-0037 (2015), <fjwestcott.com.au>, Transfer
- [Jaguar Land Rover Limited v. Downshire Motors \(Service\) Pty Ltd](#), WIPO Case No. DAU2015-0039 (2015), <jaguarservice.net.au>, Transfer

Relevant decisions – 2.8.3

- [Clark Equipment Company v. AllJap Machinery Pty Ltd](#), WIPO Case No. DAU2011-0042 (2012), <usedbobcats.com.au>, Transfer
- [GM Holden Ltd v. Publishing Australia Pty Ltd](#), WIPO Case No. DAU2011-0002 (2011), <holdendiscounts.com.au>, Denial
- [Link Engine Management Limited v. DDMF Pty Ltd](#), WIPO Case No. DAU2020-0023 (2020), <linkecu.com.au>, Transfer
- [KHN Solutions, Inc. v. Suzanne Barrett](#), WIPO Case No. DAU2020-0024 (2020), <bctrack.com.au>, Transfer
- [Jaguar Land Rover Limited v. F.W.D. Vehicles Pty. Ltd. and High Ground Vehicles Pty. Ltd.](#), WIPO Case No. DAU2016-0038 (2016), <landrovers.com.au>, Transfer
- [Fritz Egger GmbH & Co. OG and Egger Australasia Pty Ltd v. Domain Admin, Proform Products Pty Ltd](#), WIPO Case No. DAU2022-0006 (2022), <egger.com.au>, Transfer

Relevant decisions – 2.8.4

- [Topfield Co. Ltd v. Jai Kemp and Digital Products Group Pty Ltd, t/a Topfield Australia, formerly Paige Communications Pty Ltd](#), WIPO Case No. DAU2008-0002 (2008), <topfield.net.au> et. al., Denial and Transfer
- [GM Holden Ltd. v. Bradley John Lawless](#), WIPO Case No. DAU2010-0010 (2010), <holdenplatinumservice.com.au> et. al., Transfer
- [Terra Plana International Ltd. v. The Summer House Australia Pty Ltd / Tanya Greenwood](#), WIPO Case No. DAU2012-0025 (2012), <vivobarefoot.com.au> et. al., Transfer
- [GM Holden Ltd v. Publishing Australia Pty Ltd](#), WIPO Case No. DAU2011-0002 (2011), <holdendiscounts.com.au>, Denial

- [\*Illycaffè S.p.A. v. John Frisco & Associates Pty Ltd trading as Illycafe / CEW Pty Ltd\*](#), WIPO Case No. DAU2015-0009 (2015), <illy.com.au>, Transfer
- [\*United Breweries Limited v. Nadoli Pty Ltd, G.P. Singh\*](#), WIPO Case No. DAU2017-0022 (2017), <kingfisherbeer.com.au>, Transfer
- [\*Signature Nail Systems, LLC v. Diamond Nails Supplies Pty Ltd as Trustee for the DT Pham & PTT Nguyen Family Trust\*](#), WIPO Case No. DAU2020-0010 (2020), <snsnail.com.au>, Transfer
- [\*Link Engine Management Limited v. DDMF Pty Ltd\*](#), WIPO Case No. DAU2020-0023 (2020), <linkecu.com.au>, Transfer
- [\*Argyle Diamonds Limited v. Domain Manager / Argyle Diamond Investments Pty Ltd\*](#), WIPO Case No. DAU2021-0028 (2021), <argylediamondinvestments.com.au>, Transfer

#### Relevant decisions – 2.8.5

- [\*GM Holden Ltd. v. Bradley John Lawless\*](#), WIPO Case No. DAU2010-0010 (2010), <holdenplatinumservice.com.au> *et. al.*, Transfer
- [\*FJ Westcott Company v. Samuel Leo Klein / Image Melbourne Pty Ltd\*](#), WIPO Case No. DAU2014-0037 (2015), <fjwestcott.com.au>, Transfer
- [\*KHN Solutions, Inc. v. Suzanne Barrett\*](#), WIPO Case No. DAU2020-0024 (2020), <backtrack.com.au>, Transfer
- [\*BlueScope Steel Limited v. Jye Fulton\*](#), WIPO Case No. DAU-2016-0029 (2016), <colourbondfence.net.au> *et. al.*, Transfer
- [\*Jaguar Land Rover Limited v. The Trustee for the Trivett Family Trust\*](#), WIPO Case No. DAU2016-0033, <actrangerover.com.au> *et. al.*, Transfer and Cancellation

#### Relevant decisions – 2.8.6

- [\*GM Holden Ltd. v. Bradley John Lawless\*](#), WIPO Case No. DAU2010-0010 (2010), <holdenplatinumservice.com.au> *et. al.*, Transfer
- [\*Clark Equipment Company v. AllJap Machinery Pty Ltd\*](#), WIPO Case No. DAU2011-0042 (2012), <usedbobcats.com.au>, Transfer
- [\*Argyle Diamonds Limited v. Domain Manager / Argyle Diamond Investments Pty Ltd\*](#), WIPO Case No. DAU2021-0028 (2021), <argylediamondinvestments.com.au>, Transfer

#### Relevant decisions – 2.8.7

- [\*GM Holden Ltd v. Publishing Australia Pty Ltd\*](#), WIPO Case No. DAU2011-0002 (2011), <holdendiscounts.com.au>, Denial
- [\*Bayerische Motoren Werke Aktiengesellschaft v. Publishing Australia Pty Ltd, ACN 120 531 982, Mr. Nicholas Crawshay\*](#), WIPO Case No. DAU2011-0024 (2011), <bmwdiscounts.com.au>, Denial

#### Relevant decisions – 2.8.8

- [\*Christine Schrammek Kosmetik GmbH & Co. KG v. Advanced Laser Therapy Clinics Australia Pty Ltd\*](#), WIPO Case No. DAU2014-0034 (2014), <greenpeel.com.au>, Transfer
- [\*BlueScope Steel Limited v. Jye Fulton\*](#), WIPO Case No. DAU-2016-0029 (2016), <colourbondfence.net.au> *et. al.*, Transfer

#### Relevant decisions – 2.8.9

- [\*Google Inc. v. Q Interactive Pty Ltd / Mr. Victor Quinteros\*](#), WIPO Case No. DAU2012-0026 (2013), <androidappstore.com.au>, Transfer
- [\*KHN Solutions, Inc. v. Suzanne Barrett\*](#), WIPO Case No. DAU2020-0024 (2020), <bactrack.com.au>, Transfer
- [\*Argyle Diamonds Limited v. Domain Manager / Argyle Diamond Investments Pty Ltd\*](#), WIPO Case No. DAU2021-0028 (2021), <argylediamondinvestments.com.au>, Transfer

#### Relevant decisions – 2.8.10

- [\*Google Inc. v. Q Interactive Pty Ltd / Mr. Victor Quinteros\*](#), WIPO Case No. DAU2012-0026 (2013), <androidappstore.com.au>, Transfer
- [\*Jaguar Land Rover Limited v. Bauer Media Pty Ltd\*](#), WIPO Case No. DAU2017-0029 (2017), <whichjaguar.com.au>, *et. al.*, Denial

Relevant decisions – 2.8.11

- [Google Inc. v. Q Interactive Pty Ltd / Mr. Victor Quinteros](#), WIPO Case No. DAU2012-0026 (2012), <androidappstore.com.au>, Transfer
- [Jaguar Land Rover Limited v. Bauer Media Pty Ltd.](#), WIPO Case No. DAU2017-0029 (2017), <whichjaguar.com.au>, *et. al.*, Denial
- [Argyle Diamonds Limited v. Domain Manager / Argyle Diamond Investments Pty Ltd](#), WIPO Case No. DAU2021-0028 (2021), <argylediamondinvestments.com.au>, Transfer

**2.9 Do “parked” pages comprising pay-per-click links support respondent rights or legitimate interests?**

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

Use of a domain name to resolve to a parking or landing page, or to generate revenue through pay-per-click (PPC) links advertising, is generally not considered to be a *bona fide* offering of goods or services such as to give rise to rights or legitimate interests in a domain name. However, where the domain name consists of a dictionary word or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word or phrase, and not to trade off the complainant’s (or its competitor’s) trademark, respondent rights or legitimate interests can arise – especially where the domain name was registered before the complainant’s trademark/name rights arose.

Relevant decisions – 2.9

- [Insure & Go Insurance Services Limited v. CoverDirect Pty. Ltd.](#), WIPO Case No. DAU2008-0019 (2008), <insureandgo.com.au>, Transfer
- [Stardoll AB v. Domain Folio 1 Pty Ltd](#), WIPO Case No. DAU2011-0038 (2012), <stardoll.com.au>, Transfer
- [Freelife International Holdings, LLC and Freelife International Australia Pty Ltd. v. Nick Nastevski dba Health Doctor](#), WIPO Case No. DAU2012-0017 (2012), <chi3.com.au> *et. al.*, Transfer
- [CruiseMart Pty Ltd v. Debretts Travel Services](#), LEADR Case No. auDRP\_12\_06 (2012), <cruiseholidays.com.au>, Transfer
- [Arla Foods Amba v. Graytech Hosting Pty Ltd. ABN 49106229476, Elizabeth Rose](#), WIPO Case No. DAU2016-0001 (2016), <arlafoods.com.au>, Transfer
- [Mecu Limited v. OZ8 Pty Ltd](#), WIPO Case No. DAU2016-0003 (2016), <bankaus.com.au> *et. al.*, Denial
- [Hatchet Pty Ltd v. Internet Products Sales and Services Pty Ltd](#), RI Case No. auDRP\_18\_06 (2018), <hatchet.com.au>, Transfer
- [J & J Calder Company Pty v. Switch Nutrition Pty Ltd](#), WIPO Case No. DAU2020-0020 (2020), <ketolean.com.au>, Transfer
- [Glanbia Performance Nutrition Limited v. Web Media Pty Ltd](#), WIPO Case No. DAU2021-0021 (2021), <optimumnutrition.com.au>, Transfer

**2.10 Does a respondent have rights or legitimate interests in a domain name comprised of a dictionary word/phrase or acronym?**

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

- 2.10.1 A respondent cannot rely solely on the fact that a domain name is composed of ordinary language words to ground a claim to rights or legitimate interests in it. If the complainant makes a *prima facie* case that the respondent has no rights or legitimate interests in a domain name, and the respondent fails to show one of the three circumstances under paragraph 4(c) of the auDRP, or any other basis for rights or legitimate interests, then the respondent will lack rights or legitimate interests in the domain name even though it is comprised of a descriptive or dictionary word or phrase.

- 2.10.2 Where the complainant has a registered trademark to which the domain name is identical, the complainant is entitled to a rebuttable presumption that its trademark is distinctive rather than descriptive.
- 2.10.3 Where the domain name is highly descriptive, the complainant must make a strong case in order to establish, *prima facie*, that the respondent does not have rights or legitimate interests in it. As a general principle, the less distinctive is the complainant's trademark/name, the more likely it is the respondent will have rights or legitimate interests in a corresponding domain name.
- 2.10.4 Factors that are relevant to determining if the respondent has rights or legitimate interests in a descriptive domain name include: the distinctiveness, status and fame of the trademark/name in which the complainant has rights; the likelihood of customer confusion between the domain name and the complainant's trademark/name; and whether the respondent was aware of the likelihood of customer confusion between the domain name and the complainant's trademark/name prior to registering the domain name. Where the complainant's trademark/name has a very considerable reputation and there is a strong likelihood of confusion between it and the domain name, the descriptive nature of the words constituting the domain name will not give the respondent rights or legitimate interests in it. Where there is evidence of actual customer confusion between the domain name and the trademark/name, the descriptive nature of the words constituting the domain name will generally not give the respondent rights or legitimate interests in it [see also sections 2.2 and 2.8].
- 2.10.5 If a respondent is using a descriptive word to describe its goods or services without intending to take advantage of the complainant's rights in that word, then it has a right or legitimate interest in a domain name that contains that word. However, the respondent's use of the domain name must not be a "sham"; panels have been alert to disregard a respondent's use of a domain name to resolve to a website that is "spurious" or a "shell".
- 2.10.6 Where the respondent has not used a domain name, the fact that it is a descriptive or dictionary word does not, of itself, give rise to rights or legitimate interests in it.

Relevant decisions – 2.10.1

- [Telstra Corporation Limited v. Mikhail Doubinski and Yury Sharafutdinov trading as AAA Marketing World](#), WIPO Case No. DAU2006-0008 (2006), <whitepage.com.au>, Transfer
- [Environics Pty Ltd v. Connectus Pty Ltd](#), LEADR Case No. auDA 03\_09 (2009), <engineer.com.au>, Denial
- [Adultshop.com Pty Ltd v. Josh Marsden, Importa Pty Ltd](#), WIPO Case No. DAU2015-0002 (2015), <adultshopwarehouse.com.au>, Transfer

Relevant decision – 2.10.2

- [Cognito Software Limited v. Rethink IT Pty Ltd](#), WIPO Case No. DAU2009-0011 (2010), <moneyworks.com.au>, Transfer

Relevant decisions – 2.10.3

- [Jupitermedia Corporation and Australia.Internet.com Pty Ltd v. Spotpress Pty Ltd. trading as Internet Printing](#), WIPO Case No. DAU2003-0005 (2004), <internet.com.au>, Denial
- [TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Interactive Pty Limited](#), WIPO Case No. DAU2006-0003 (2006), <truelocal.com.au>, Denial
- [Makegoods Pty Limited / Niche Group Holdings Pty Limited v. Zoran Petkovic, GMP Constructions Pty Ltd](#), WIPO Case No. DAU2019-0003 (2019), <makegood.com.au>, Denial

Relevant decisions – 2.10.4

- [Telstra Corporation Limited v. Mikhail Doubinski and Yury Sharafutdinov trading as AAA Marketing World](#), WIPO Case No. DAU2006-0008 (2006), <whitepage.com.au>, Transfer

- [QSoft Consulting Limited v. B.S.P.](#), WIPO Case No. DAU2009-0003 (2009), <gaydar.net.au>, Transfer
- [Cognito Software Limited v. Rethink IT Pty Ltd](#), WIPO Case No. DAU2009-0011 (2010), <moneyworks.com.au>, Transfer
- [Smartmark Pty Ltd v. Dash Corp Pty Ltd, Robert Kaay, Registry Australia Pty Ltd](#), WIPO Case No. DAU2019-0031 (2020), <smartmark.com.au>, Denial
- [Air Charter Service \(Aust\) Pty Ltd v. AVMIN Pty Ltd](#), WIPO Case No. DAU2021-0029 (2021), <aircharterservices.com.au>, Denial

#### Relevant decisions – 2.10.5

- [Envionics Pty Ltd v. Connectus Pty Ltd](#), LEADR Case No. auDA 03\_09 (2009), <engineer.com.au>, Denial
- [Dorset Council v Damian von Samorzewski](#), LEADR Case No. auDRP 15/04 (2015), <bluederby.com.au> *et. al.*, Denial
- [Federation Tuck Pointing \(WA\) Pty Ltd v. Brick and Mortar Restorations Pty Ltd ACN 602 844 682](#), LEADR-IAMA Case No. auDRP\_15\_06 (2015), <federationtuckpointing.com.au>, Transfer
- [Kinderplay Designs Inc. v. Swanshore Pty Ltd](#), RI Case No. auDRP\_18\_02 (2018), <waterplay.com.au>, Denial
- [Sportsbet Pty Ltd, The Sporting Exchange Ltd, and Flutter Entertainment Plc v. Gaming Investments Pty Ltd](#), WIPO Case No. DAU2019-0029 (2020), <flutter.com.au>, Denial
- [Peachbulk Pty Ltd v. Domain Boutique Pty Ltd](#), WIPO Case No. DAU2020-0013 (2020), <bromance.com.au>, Cancellation
- [Air Charter Service \(Aust\) Pty Ltd. v. AVMIN Pty Ltd](#), WIPO Case No. DAU2021-0029 (2021), <aircharterservices.com.au>, Denial

#### Relevant decisions – 2.10.6

- [R S Capital Partners Pty Ltd t/a My SMSF v. Adviser IT Ltd](#), WIPO Case No. DAU2019-0007 (2019), <mysmsf.com.au>, Denial
- [Television Food Network G.P. v. Lane Trewin-Hallett](#), WIPO Case No. DAU2019-0020 (2019), <foodnetwork.com.au>, Transfer

### 2.11 At what point in time of respondent conduct do panels assess claimed rights or legitimate interests?

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

auDRP panels assess a respondent's claim to rights or legitimate interests in a domain name at the time when the respondent became aware of the dispute about the domain name – which will be no later than the date of the filing of the complaint, and may be earlier (e.g. upon receipt of a letter of demand from the complainant). Rights or legitimate interests acquired only after awareness of the dispute are not sufficient. A previous holding of rights or legitimate interests does not suffice where those rights/interests no longer exist at the time the respondent was made aware of the dispute.

#### Relevant decisions – 2.11

- [Princess Yachts International plc v. Graham Stephens](#), LEADR Case No. auDA 08\_07 (2007), <princessyachts.com.au>, Transfer
- [TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Interactive Pty Limited](#), WIPO Case No. DAU2006-0003 (2006), <truelocal.com.au>, Denial
- [Geek Group Pty Ltd v. SG Corporate Services Pty Ltd](#), WIPO Case No. DAU2019-0009 (2019), <supergeek.com.au>, Transfer
- [Ogio International Inc v. Ogio Pty Ltd](#), WIPO Case No. DAU2019-0011 (2019), <ogio.com.au>, Denial

## 2.12 Does a respondent trademark or name corresponding to a domain name automatically generate rights or legitimate interests?

The general position is *similar* to that under the UDRP.

- 2.12.1 auDRP panels have tended to recognise that a respondent's registration of a **trademark** corresponding to the disputed domain name will normally, but does not necessarily, establish that the respondent has rights or legitimate interests in that domain name. A key issue is whether the respondent's trademark registration is *bona fide*. Where the respondent has chosen its trademark without seeking to create confusion with the complainant's website, products or customers, the existence of its trademark will very likely mean the respondent has rights or legitimate interests in a domain name that corresponds to that trademark. However, where the overall circumstances indicate that the respondent's acquisition of a trademark was not *bona fide* – e.g., where it was obtained primarily to circumvent the application of the auDRP – panels have generally declined to find that the respondent has rights or legitimate interests in the corresponding domain name.
- 2.12.2 auDRP panels have found that a respondent's **application** to register a trademark does not, of itself, automatically generate rights or legitimate interests in a corresponding domain name. The reason is that, although the rights to a trademark registration, once granted, run from the date of the application, a pending application does not confer any enforceable legal rights. However, where the respondent has undertaken other relevant activities in relation to the applied-for trademark, the totality of the respondent's activities may be sufficient for a panel to find either that the respondent has, or that the complainant has failed to prove that the respondent does not have, rights or legitimate interests in the corresponding domain name.
- 2.12.3 While a **company name** or **business name** registration provides a basis on which a respondent can satisfy the eligibility and allocation requirements for registration of a .au domain name [see section 2.1.6], a company name or business name registration does not, of itself, establish that the respondent has rights or legitimate interests in a domain name corresponding to the company/business name. The reason for this is that the registration of a company/business name is a legislative requirement. The registration of a company name is a legislative requirement that needs to be satisfied where an entity is incorporated. The registration of a business name is a legislative requirement that needs to be satisfied where an entity trades under a name that is not its own personal name or company name. Satisfying a legislative requirement with respect to name does not, of itself, give rise to rights or legitimate interests in the name.
- 2.12.4 The critical issue is that the respondent is trading under the company name or business name, and is doing so in good faith. The respondent will generally be able to establish that it has rights or legitimate interests in a domain name that corresponds to its registered company name or business name where it has actually traded under that name. Where, however, there is no trading under the company name or business name, or there is trading under the name but it is not in connection with use of the domain name, or the name registration or the trading under the name is not *bona fide*, neither the fact of registration of the name nor the trade under it will be sufficient to establish that the respondent has rights or legitimate interests in the corresponding domain name.
- 2.12.5 Where a domain name contains the whole or a significant part of the respondent's **personal name**, the respondent is likely to have rights or legitimate interests in it, even if the respondent cannot establish that he or she has been "commonly known" by the domain name [see also section 2.3].

### Relevant decisions – 2.12.1

- [PayBurst Financial Technologies and Gregory Fx Iannacci v. Virgin Blue Airlines Pty Ltd](#), WIPO Case No. DAU2006-0001 (2006), <velocityrewards.com.au>, Denial

- [\*American Future Technology Corp. v. Rex Hall\*](#), WIPO Case No. DAU2009-0007 (2009), <ibuypower.com.au>, Denial
- [\*Linhope International Limited and Original Beauty Technology Company Limited v. Jianqing Ltd \(Company No. 12282015\)\*](#), WIPO Case No. DAU2021-0013 (2021), <cbdresses.com.au> *et. al.*, Transfer

#### Relevant decisions – 2.12.2

- [\*Zillow Inc. v. Felix-Hoffman Anne-Simone\*](#), WIPO Case No. DAU2006-0015 (2007), <zillow.com.au>, Transfer
- [\*Curtain Communications Pty Ltd. v. Leann Webb\*](#), WIPO Case No. DAU2008-0022 (2009), <alphakids.com.au>, Denial
- [\*Vitacost.com, Inc., v. Ronald Lee Bradley\*](#), WIPO Case No. DAU2012-0003 (2012), <vitacost.com.au>, Transfer

#### Relevant decisions – 2.12.3

- [\*Insure & Go Insurance Services Limited v. CoverDirect Pty. Ltd.\*](#), WIPO Case No. DAU2008-0019 (2008), <insureandgo.com.au>, Transfer
- [\*QSoft Consulting Limited v. B.S.P.\*](#), WIPO Case No. DAU2009-0003 (2009), <gaydar.net.au>, Transfer
- [\*Mass Nutrition, Inc. and Todd Rosenfeld v. Mass Nutrition Pty. Ltd. now known as Tweed Holdings Pty Ltd, Luke McNally\*](#), WIPO Case No. DAU2010-0002 (2010), <massnutrition.com.au>, Denial
- [\*Aloha Pools Pty Ltd. v. Palatial Pools & Spas Pty Ltd\*](#), WIPO Case No. DAU2014-0033 (2014), <alohapoolsandspas.com.au>, Transfer
- [\*Peachbulk Pty Ltd v. Domain Boutique Pty Ltd\*](#), WIPO Case No. DAU2020-0013 (2020), <bromance.com.au>, Cancellation

#### Relevant decisions – 2.12.4

- [\*Asset Housing Pty Ltd v. Kitome Pty Ltd\*](#), CIArb Case No. auDRP 06-01 (2006), <countrykithomes.com.au>, Denial
- [\*Just Magazines Pty Ltd v. Australian Just Bikes of the Northern Rivers\*](#), LEADR Case No. auDRP06/08 (2008), <justbikes.com.au>, Transfer
- [\*General Television Pty Limited v. Laszlo Till\*](#), LEADR Case No. auDRP08/09 (2009), <heyheyitssaturday.com.au> *et. al.*, Denial
- [\*Macquarie Group Limited v. McQuarie Group Pty Ltd / Roland Storti\*](#), WIPO Case No. DAU2012-0028 (2013), <mcquarie.com.au>, Cancellation
- [\*Nirvana LLC v. Darren Marc Wilcox\*](#), WIPO Case No. DAU2014-0031 (2014), <nirvanadrums.com.au> *et. al.*, Transfer
- [\*Aloha Pools Pty Ltd. v. Palatial Pools & Spas Pty Ltd\*](#), WIPO Case No. DAU2014-0033 (2014), <alohapoolsandspas.com.au>, Transfer
- [\*Peacock Media Group Pty Ltd v. Your Solar Quotes Pty Ltd\*](#), WIPO Case No. DAU2017-0005 (2017), <yoursolarquotes.com.au>, Denial
- [\*Geek Group Pty Ltd v. SG Corporate Services Pty Ltd\*](#), WIPO Case No. DAU2019-0009 (2019), <supergeek.com.au>, Transfer
- [\*General Motors LLC v. GMSV Pty Ltd\*](#), RI Case No. auDRP\_20\_14 (2020), <gmsvshop.com.au>, Transfer

### 2.13 How do panels treat complainant claims of illegal (e.g., counterfeit) activity in relation to potential respondent rights or legitimate interests?

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

- 2.13.1 It appears that no auDRP case has yet expressly addressed the issue of whether a respondent can have rights or legitimate interests in a domain name used for activities that are clearly illegal (e.g., the sale of counterfeit goods, phishing, distributing malware, unauthorized account access/hacking, impersonation, or other types of fraud). However, consistent with the approach taken by panels under the UDRP, it is very likely that an auDRP panel would find that a respondent does not have rights or legitimate interests in a domain name used in this way.
- 2.13.2 Where the claim of illegal conduct relates to a complicated relationship between the parties and is largely unsubstantiated, the complaint might be dismissed on the basis that the claim is not suitable for determination under the auDRP given the abbreviated nature of its procedure.

Relevant decisions – 2.13.2

- [Aquarian Foundation, Inc. v. Daryl Wardenaar, Church of Higher Spiritualism](#), WIPO Case No. DAU 2022-0003 (2022), <hispirit.org.au>, Denial

**2.14 Is the TLD under which a domain name is registered relevant in assessing respondent rights or legitimate interests?**

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

in all cases to which the Policy applies, the TLD of the domain name is “.au”. No auDRP case has yet expressly addressed the issue of the relevance of the TLD to a respondent’s entitlement to a domain name. However, consistent with the approach taken by panels under the UDRP, and with the approach of auDRP panels when considering whether a domain name is identical or confusingly similar to the complainant’s trademark/name [see section 1.11], it is very likely that an auDRP panel would take into account the TLD of the domain name when considering the respondent’s rights or legitimate interests in it, where that was relevant to the assessment.

**2.15 What is the relation between the 2nd and 3rd auDRP elements?**

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

To support a claim to rights or legitimate interests under the auDRP, the use of a domain name must not be abusive of the complainant’s rights in its trademark/name. In some cases therefore, panels assess the second and third elements of the Policy together – e.g., where clear indicia of bad faith suggest there cannot be any respondent rights or legitimate interests in the domain name. In such cases, panels have found that the facts and circumstances of the case would benefit from a joint discussion of the policy elements.

Relevant decisions – 2.15

- [Conveyancing Canberra Pty. Ltd. v. The Trustee for QC Unit Trust](#), RI Case No. auDRP\_18\_03 (2018), <conveyancingcanberra.net.au>, Transfer
- [Colbridge Pty Ltd v. Foxwell Magic Toys / Lyndon Wayne Sanders](#), RI Case No. auDRP\_19\_07 (2019), <foxwellmagic.com.au>, Transfer



### 3 THIRD AUDRP ELEMENT

#### 3.1 How does a complainant prove a respondent's bad faith?

The general position is *different* from that under the UDRP. In particular:

- Unlike paragraph 4(a)(iii) of the UDRP, which requires the complainant to establish that the domain name “has been registered *and* is being used in bad faith”, the equivalent provision in the auDRP requires that the domain name “has been registered *or* is being used in bad faith” (emphases added); thus, the third requirement of the auDRP will be satisfied if it is established that the respondent subsequently used the domain name in bad faith, even though the respondent’s registration of the domain name was in good faith.
- Unlike paragraph 4(b)(i) of the UDRP, which specifies it is bad faith for the respondent to register the domain name for the purpose of transferring it to “the complainant” or “a competitor of that complainant”, the equivalent paragraph of the auDRP merely requires that the purpose of registration was to transfer it to “another person”.
- While both the UDRP and the auDRP in paragraph 4(b)(ii) specify that it is bad faith for the respondent to register the domain name for the purpose of preventing the trademark owner from reflecting their trademark in a corresponding domain name, unlike the UDRP the auDRP does not require that the respondent has “engaged in a pattern of such conduct”.
- While both the UDRP and the auDRP in paragraph 4(b)(iii) specify that it is bad faith for the respondent to register the domain name primarily for the purpose of disrupting business, unlike the UDRP the auDRP does not require that it be the business of “a competitor”.
- While both the UDRP and the auDRP in paragraph 4(b)(iv) specify that it is bad faith for the respondent to use the domain name to intentionally attempt to attract, for commercial gain, Internet users to be a website or other online location by creating a likelihood of confusion with the complainant’s trademark or name, unlike the UDRP the auDRP does not require that it be to the respondent’s website or online location.
- The UDRP has no equivalent of paragraph 4(b)(v) of the auDRP, which provides that it is evidence of bad faith where any of the respondent’s representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

- 3.1.1 **Paragraph 4(b)(i)** of the auDRP states that evidence of the registration and use of a domain name in bad faith includes circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to another person for valuable consideration in excess of out-of-pocket expenses directly related to the domain name. Unlike the equivalent provision in the UDRP, paragraph 4(b)(i) of the auDRP does not require that the respondent’s offer of transfer be to “the complainant” or “a competitor of that complainant”; an offer of transfer to any person is sufficient.

Panels have drawn a distinction between an offer to transfer that is unsolicited and an offer to transfer that is solicited by the complainant. Where the complainant approached the respondent soliciting an offer to transfer a domain name, a consequential offer to transfer for a price is generally considered insufficient, of itself, to demonstrate bad faith on the part of the respondent. However, the presence of additional facts – such as a false statement by the respondent to the complainant about the registration and use of the domain name, “the tone of the correspondence” between the respondent and the complainant, and the amount of the offer – may support a finding that, even though the offer was solicited by the complainant, the respondent registered the domain name with the intention of selling it to the complainant.

Where the complainant approached the respondent proposing a particular price for transfer of a domain name, the failure to accept the proposed price does not, *of itself*, demonstrate bad faith – at least where the proposed price was not clearly “an adequate offer” in the circumstances of the respondent’s position.

Panels have reached different views on whether a distinction should be drawn between an “offer” and an “invitation to treat” (an agreement to respond to any further offer that might come from the complainant). One view is that an invitation to treat cannot constitute an offer to transfer a domain name for the purposes of paragraph 4(b)(i) of the Policy, because the law recognises that an invitation to treat is not an offer and this distinction has been recognised and implemented in domain name practice. The alternative view is that an invitation to treat can establish that the respondent registered the domain name primarily for the purpose of transferring it.

- 3.1.2 **Paragraph 4(b)(ii)** of the auDRP states that evidence of the registration and use of a domain name in bad faith includes the respondent registering the domain name in order to prevent the owner of a trademark or name from reflecting that mark or name in a corresponding domain name. Unlike the equivalent provision in the UDRP, paragraph 4(b)(ii) of the auDRP does not require that the respondent has “engaged in a pattern of such conduct”.

Panels generally have found that registration of a domain name that consists solely of the complainant’s trademark or name (once the second-level and/or the top-level domain extensions are ignored) has the effect of preventing the complainant from reflecting its trademark/name in a domain name – and hence is evidence of bad faith. However, it will generally not be possible to find that this was done “in order to” prevent the complainant from reflecting its trademark or name in a domain name where the domain name was registered long before the trademark/name was registered.

There is an obvious potential for a respondent’s conduct to fall simultaneously within both paragraph 4(b)(ii) and paragraph 4(b)(iii) of the Policy, since a domain name registration that prevents the complainant from reflecting its trademark or name in a domain name may well have been done to disrupt the business activities of the complainant [see section 3.1.3].

- 3.1.3 **Paragraph 4(b)(iii)** of the auDRP states that evidence of the registration and use of a domain name in bad faith includes the respondent registering the domain name primarily for the purpose of disrupting the business or activities of another person. Unlike the equivalent provision in the UDRP, paragraph 4(b)(iii) of the auDRP does not require that the respondent has disrupted the business of a “competitor”; it is sufficient that the business or activities of any other person are disrupted.

Panels have generally found that registration of a domain name that contains the complainant’s trademark or name has the effect of disrupting the business of the complainant, so long as the complainant is actively involved in business *in Australia*. In at least one case, the panel found there was disruption even though the complainant did not have a substantial business presence in Australia, in the special situation where: (i) the complainant was planning to expand its business to Australia, (ii) this fact was known to the respondent, (iii) the respondent registered the domain name in the same year as the planned expansion, and (iv) the respondent was a competitor of the complainant in the overseas jurisdiction where the complainant was based.

There is an obvious potential for a respondent’s conduct to fall simultaneously within both paragraph 4(b)(iii) and paragraph 4(b)(ii) of the Policy, since a domain name registration done to disrupt the business activities of the complainant could also be a registration which prevents the complainant from reflecting its mark in a domain name [see section 3.1.2]. There is also the obvious potential for a respondent’s conduct to fall simultaneously within both paragraph 4(b)(iii) and paragraph 4(b)(iv) of the Policy, since use of a domain name to resolve to a website of a competitor of the complainant (whether the respondent or a third party) could both disrupt the business of the complainant and constitute an intentional attempt to attract, for commercial

gain, Internet users to a website by creating a likelihood of confusion with the complainant's trademark/name [see section 3.1.4].

- 3.1.4 **Paragraph 4(b)(iv)** of the auDRP states that evidence of the registration and use of a domain name in bad faith includes the respondent using the domain name to intentionally attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's trademark or name as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service thereon. Unlike the equivalent provision in the UDRP, paragraph 4(b)(iv) of the auDRP does not require that the website or online location be the respondent's website or online location; the website or online location of anyone is sufficient.

Where a domain name is identical or confusingly similar to a trademark or name in which the complainant has rights, panels typically find that use of the domain name to resolve to the website of the respondent or a third party is use in bad faith pursuant to paragraph 4(b)(iv) of the Policy. It can also be bad faith for the respondent to use the domain name to resolve to the complainant's website, since doing so is likely to mislead consumers into thinking that the respondent either is the complainant or is endorsed by or associated with the complainant. In all situations, however, bad faith must be established. For bad faith to be shown, generally there must be some intent on the part of the registrant to take advantage of the complainant's trademark or name.

- 3.1.5 **Paragraph 4(b)(v)** of the auDRP states that evidence of the registration and use of a domain name in bad faith includes circumstances indicating that any of the respondent's representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner. There is no equivalent of this provision in the UDRP.

Paragraph 2 of the auDRP states that by applying to register the domain name, or by requesting maintenance or renewal of the domain name registration, the respondent warrants that: (a) statements it made in the domain name application are complete and accurate, including those as to eligibility for the domain name; (b) to its knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) it is not registering the domain name for an unlawful purpose; and (d) it will not knowingly use the domain name in violation of any applicable laws or regulations. Panels have found that providing a false registrant name and false registrant contact details in the application for registration or the renewal of a domain name constitutes bad faith pursuant to paragraph 4(b)(v) of the Policy. At least one panel has found a respondent's failure to conduct a trademark or other search to check whether the domain name would infringe another person's rights supports a finding of bad faith by virtue of this provision.

auDA has promulgated eligibility and allocation requirements for the registration of domain names in the .au ccTLD (see section 2.1.6). Panels have found that where the respondent does not meet the relevant eligibility requirements for the domain name, the respondent has breached the paragraph 2(a) warranty of having made complete and accurate statements on registration or renewal of the domain name. Applying paragraph 4(b)(v), panels have found that such a breach satisfies the paragraph 4(a)(iii) requirement that the domain name has been registered or subsequently used in bad faith.

- 3.1.6 The circumstances specified in paragraph 4(b) of the Policy are *not exhaustive* of what can be evidence of registration and use of a domain name in bad faith. Panels will consider all the relevant circumstances of the case, including circumstances not mentioned in paragraph 4(b), in determining the *bona fides* of the respondent. Thus, for example, bad faith registration has been found where the evidence indicated the respondent registered the domain name in anticipation of the complainant obtaining a trademark registration, to put himself in a position where he could exert leverage over the complainant should he lose control of the complainant at some time in the future.

Relevant decisions – 3.1.1

- [PA Consulting Services Pty Ltd v. Joseph Barrington-Lew](#), WIPO Case No. DAU2003-0002 (2003), <paconsulting.com.au>, Transfer
- [Gloria Jean's Coffees Holdings Pty Ltd v. Jeremy Paul Cleaver](#), WIPO Case No. DAU2007-0006 (2007), <gloriajeans.com.au>, Transfer
- [AW Faber-Castell \(Aust\) Pty Ltd. v. Pen City Pty Ltd. / Atf Diblasi Jones Unit Trust](#), WIPO Case No. DAU2013-0018 (2013), <fabercastell.com.au>, Transfer
- [Parkopedia Limited v. Parkhound Pty Ltd](#), RI Case No. auDRP\_16\_07 (2016), <parkopedia.com.au>, Transfer
- [Carestaff Nursing Services Pty Ltd v. Carers Link Pty Ltd trading as Care Staff](#), RI Case No. auDRP\_18\_11 (2018), <carestaff.com.au>, Denial
- [Ogio International Inc v. Ogio Pty Ltd](#), WIPO Case No. DAU2019-0011 (2019), <ogio.com.au>, Denial
- [Television Food Network G.P. v. Lane Trewin-Hallett](#), WIPO Case No. DAU2019-0020 (2019), <foodnetwork.com.au>, Transfer
- [National Australia Bank Limited v. Joshua Hoa That Ton](#), WIPO Case No. DAU2020-0018 (2020), <bgfa.com.au> *et. al.*, Transfer and Denial
- [Smart LLC v. Care Products Group Pty Ltd](#), Resolution Institute Case No. auDRP\_21\_10 (2021), <chemicalguys.com.au>, Transfer

Relevant decisions – 3.1.2

- [Arena Entertainment Pty Ltd v. Alex Haddad](#), LEADR Case No. 05/05 (2005), <rnbsuperclub.com.au>, Transfer
- [Tina Arena v. Enigmatic Minds Pty Ltd](#), Case No. LEADR Case No. auDRP01/07 (2007), <tinaarena.com.au>, Transfer
- [Bernard Janes v. L.J. Bubenicek & A. J. Main, A&L Technologies](#), WIPO Case No. DAU2010-0014 (2010), <goballistic.com.au>, Transfer
- [Statoil ASA v. Creative Domain Pty Ltd. / Christine K. Hoyer](#), WIPO Case No. DAU2013-0012 (2013), <statoil.com.au>, Transfer
- [Miltenyi Biotec GmbH v. Rachel A. Liu-Williams](#), WIPO Case No. DAU2015-0033 (2015), <miltenyibiotec.net.au>, Transfer
- [Adani Australia Company Pty Ltd, ABN 87 163 221 609 v. Callum Buckeridge ABN 83 545 893 542](#), RI Case No. auDRP\_17\_10 (2017), <adaniaustralia.com.au>, Transfer
- [Ogio International Inc v. Ogio Pty Ltd](#), WIPO Case No. DAU2019-0011 (2019), <ogio.com.au>, Denial
- [CAF Nominees Limited and The Charities Aid Foundation v. Adrian Conti, Australian Multi Cultural Charity](#), WIPO Case No. DAU2021-0024 (2021), <cafaustralia.org.au>, Cancellation
- [R S Capital Partners Pty Ltd t/a My SMSF v. Adviser IT Ltd](#), WIPO Case No. DAU2019-0007 (2019), <mysmsf.com.au>, Denial

Relevant decisions – 3.1.3

- [Arena Entertainment Pty Limited v. Alex Haddad](#), LEADR Case No. 05/05 (2005), <rnbsuperclub.com.au>, Transfer
- [The Calvin Klein Trademark Trust and Calvin Klein, Inc v. Yangjae Kim \(t/a Primary Blue\)](#), LEADR Case No. auDRP08/08 (2008), <calvinklein.com.au>, Cancellation
- [Bernard Janes v. L.J. Bubenicek & A. J. Main, A&L Technologies](#), WIPO Case No. DAU2010-0014 (2010), <goballistic.com.au>, Transfer

- [\*Federation Tuck Pointing \(WA\) Pty Ltd ACN 079 825 291 v. Brick and Mortar Restorations Pty Ltd ACN 602 844 682\*](#), LEADR-IAMA Case No. auDRP\_15\_06 (2015), <federationtuckpointing.com.au>, Transfer
- [\*Parkopedia Limited v. Parkhound Pty Ltd\*](#), RI Case No. auDRP\_16\_07 (2016), <parkopedia.com.au>, Transfer
- [\*Colbridge Pty Ltd v. Foxwell Magic Toys / Lyndon Wayne Sanders\*](#), RI Case No. auDRP\_19\_07 (2019), <foxwellmagic.com.au>, Transfer

#### Relevant decisions – 3.1.4

- [\*GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd\*](#), WIPO Case No. DAU2002-0001 (2003), <globalcentre.com.au> *inter alia*, Transfer
- [\*The National Office for the Information Economy v. Verisign Australia Limited\*](#), LEADR Case No. auDRP02/03 (2003), <gatekeeper.com.au>, Transfer
- [\*Arla Foods Amba v. William Wong\*](#), WIPO Case No. DAU2016-0007 (2016), <arlafood.com.au>, Transfer
- [\*Parkopedia Limited v. Parkhound Pty Ltd\*](#), RI Case No. auDRP\_16\_07 (2016), <parkopedia.com.au>, Transfer
- [\*Top Connect OU v. Karl Gye, Lawsearch Australia Pty Ltd\*](#), WIPO Case No. DAU2016-0044 (2016), <travelsim.com.au>, Transfer
- [\*Mount Wellington Cableway Company Pty Limited v. The Trustee for the Dive Trust\*](#), RI Case No. auDRP\_18\_04 (2018), <mtwellingtoncablecar.com.au>, Transfer
- [\*The Sydney Children's Hospitals Network \(Randwick and Westmead\) \(incorporating the Royal Alexandra Hospital for Children\) v. Louise Adams\*](#), WIPO Case No. DAU2019-0023 (2019), <fasttracktrial.com.au>, Denial
- [\*Entrust Corporation \(formerly Entrust Datacard Corporation\) v. Unicard Systems Pty Ltd\*](#), WIPO Case No. DAU2021-0003 (2021), <datacardaustralia.com.au>, Transfer

#### Relevant decisions – 3.1.5

- [\*E.F.G. Nominees Pty Limited \[ACN 092 156 717\] v. Lenland Property Development Pty Ltd. \[ACN 143 463 816\]\*](#), IAMA Case No. 3658 (2012), <thepointkirribilli.com.au>, Cancellation
- [\*Private Real Estate Pty Limited \[ACN 154 253 924\] v. Chris Papas\*](#), IAMA Case No. 3665 (2013), <privaterealestate.com.au>, Denial
- [\*Debbie Morgan Macao Commercial Offshore Limited, Missguided Limited v. Samir Vora\*](#), WIPO Case No. DAU2013-0024 (2013), <missguided.com.au> *et. al.*, Transfer
- [\*Hill & Smith Limited v. LB International Pty Ltd.\*](#), WIPO Case No. DAU2014-0008 (2014), <brifen.com.au>, Transfer
- [\*BGC Partners, Inc., BGC Partners, L.P., BGC Partners \(Australia\) Pty Limited v. Dean McCarthy, BGC Trading Pty Ltd\*](#), WIPO Case No. DAU2015-0012 (2015), <bgcpartners.com.au> *et. al.*, Transfer
- [\*New South Wales Federation of Community Language Schools Inc v. The Australian Psychological Society Ltd\*](#), RI Case No. auDRP\_16\_08 (2016), <nswfcls.org.au>, Transfer
- [\*Fintech Financial Services \(AFSL 408634\) v. David Butler\*](#), RI Case No. auDRP\_18\_09 (2018), <fintech.com.au>, Transfer
- [\*Smart LLC v. Care Products Group Pty Ltd\*](#), Resolution Institute Case No. auDRP\_21\_10 (2021), <chemicalguys.com.au>, Transfer

#### Relevant decisions – 3.1.6

- [\*OneCode IP Pty Ltd v. Dillon Firrell, Energy Information Technology Pty Ltd\*](#), WIPO Case No. DAU2022-0005 (2022), <onecode.com.au>, Transfer

### 3.2 What circumstances further inform panel consideration of registration in bad faith?

The general position is **similar** to that under the UDRP.

- 3.2.1 Having **actual knowledge** of the complainant's trademark or name to which the domain name is identical or confusingly similar is relevant to whether registration or use of the domain name is in bad faith. Actual knowledge can be obtained in various ways, including by the respondent having a trademark application rejected or opposed on the basis of the complainant's prior registered trademark, or by the respondent being a former licensee of the complainant's trademark. Having actual knowledge of the complainant's trademark or name does not, of itself, establish that the domain name was registered or used in bad faith, at least where the respondent's primary intent is to use the domain name for goods and services different to those of the complainant and use of the domain name is non-confusing, non-competitive and without intent to divert Internet users who are seeking out the complainant. However, it is evidence of bad faith to register a domain name with knowledge of the complainant's trademark where *any* use of the domain name would imply an affiliation with the complainant that does not exist.
- 3.2.2 Having **likely knowledge** of the complainant's trademark or name to which the domain name is identical or confusingly similar is relevant to whether registration or use of the domain name is in bad faith. Panels will review the evidence relevant to awareness of the complainant's trademark or name, and will draw conclusions about the respondent's likely knowledge from that evidence. Where the complainant's trademark or name is extremely well-known, or where there is evidence indicating that the respondent would reasonably have been aware of the trademark or name (e.g., where the complainant and respondent are competitors in the same industry, or where the respondent was previously a customer or business partner of the complainant), panels are likely to find that the respondent was in possession of the necessary knowledge.
- 3.2.3 An "opportunistic registration" of a domain name – that is, a registration of a domain name that was previously registered by the complainant, who inadvertently allowed the registration to lapse, by a respondent who is aware of the complainant and operates in the same field as the complainant – will typically establish that the registration and use of the domain name was in bad faith.
- 3.2.4 Failing to transfer a domain name to the complainant at the end of an agreement under which the domain name was previously used by the respondent generally amounts to a bad faith use of the domain name.
- 3.2.5 Using a domain name to resolve to a website at which the complainant's copyright is infringed is a bad faith use of the domain name.
- 3.2.6 Ignoring the complainant's pre-action cease and desist letter will reinforce a view that the respondent has acted in bad faith.

Relevant decisions – 3.2.1

- [Brilliance Publishing, Inc. v. My Brilliance Pty Ltd / Ceinwen Schneider](#), WIPO Case No. DAU2013-0007 (2013), <brillianceaudio.com.au> *et. al.*, Transfer
- [Lytro, Inc. v. Drift Alliance Pty Ltd](#), WIPO Case No. DAU2014-0019 (2014), <lytro.com.au>, Denial
- [Phillips 66 Company v. Phillip Priest Pty. Ltd.](#), WIPO Case No. DAU2022-0004 (2022), <phillips66lubricants.com.au>, Transfer

Relevant decisions – 3.2.2

- [Informa Australia Pty Limited v. Reed Business Information Pty Limited](#), LEADR Case No. auDA 02/09 (2009), <earthmove.com.au>, Transfer
- [Tekla Corporation v. Tekla Project Management / Trango Towers Pty Ltd](#), WIPO Case No. DAU2014-0009 (2014), <tekla.com.au> *et. al.*, Transfer
- [Perth GP Pty. Ltd. v. Beyond Community & Health Foundation, trading as Beyond the Bell Inc.](#), RI Case No. auDRP\_19\_03 (2019), <willageemedicalcentre.com.au>, Transfer

Relevant decisions – 3.2.3

- [Tigerturf Australia Pty Ltd. v. Mason Merion, Tigerturf \(Unregistered\)](#), WIPO Case No. DAU 2018-0021 (2018), <tigerturf.com.au>, Transfer
- [CAF Nominees Limited and The Charities Aid Foundation v. Adrian Conti, Australian Multi Cultural Charity](#), WIPO Case No. DAU2021-0024 (2021), <cafaustralia.org.au>, Cancellation

Relevant decisions – 3.2.4

- [FJ Westcott Company v. Samuel Leo Klein / Image Melbourne Pty Ltd](#), WIPO Case No. DAU2014-0037 (2015), <fjwestcott.com.au>, Transfer
- [Axios IT Pty. Ltd. v. Strata Voting Pty. Ltd.](#), RI Case No. auDRP\_16\_09 (2017), <stratavote.com.au> *et. al.*, Denial
- [Rejuvatek Medical, Inc. v. Biosoft \(Aust\) Pty Ltd](#), WIPO Case No. DAU2017-0014 (2017), <tatt2awayaustralia.com.au>, Transfer

Relevant decisions – 3.2.5

- [Into Blinds Pty Ltd and John and Mark McDonald v. Cost less Décor Blinds Pty Ltd \(as Trustee for Cost Less Décor Blinds ABN 87 670 942 726, a discretionary trading trust\)](#), RI Case No. auDRP\_17\_07 (2017), <intoblindsandplantationshuttersmelbourne.com.au>, *et. al.*, Transfer

Relevant decisions – 3.2.6

- [QSA Brands Pty Ltd. v. Domain Administrator, Internet Service Consultants Pty Ltd.](#), WIPO Case No. DAU2022-0008 (2022), <questeastmelbourne.com.au> *et. al.*, Transfer

### 3.3 Can the “passive holding” or non-use of a domain name support a finding of bad faith?

The position is *similar* to that under the UDRP.

- 3.3.1 auDRP panels have found that a passive holding of the domain name (*i.e.*, an apparent lack of active use of the domain name, such as for a website or email address) without any active attempt to sell or to contact the complainant about the domain name), does not, as such, prevent a finding of bad faith. The panel will examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances indicative of bad faith include: the complainant having a well-known trademark; the respondent providing no evidence of any actual or contemplated good faith active use of the domain name since registration of it; the respondent having engaged in a pattern of registering domain names that are not put to any active use; it not being possible to conceive of any plausible actual or contemplated active use of the domain name by the respondent that would not be illegitimate; no response to the complaint having been filed; and the registrant's concealment of its identity. Panels may draw inferences about whether the domain name was used in bad faith from the circumstances surrounding the domain name's registration, and *vice versa*.
- 3.3.2 Where the domain name is initially registered in good faith pursuant to an agreement (*e.g.*, a distributorship arrangement) between the complainant and respondent, and the respondent passively retains the domain name after the agreement concludes, this may constitute use in bad faith. This is particularly so if the domain name is seen as being retained by the respondent to assist in its negotiations over a dispute with the complainant. [See also section 3.2.4.]

Relevant decisions – 3.3.1

- [Produits Berger v. Lay Tee Ong](#), WIPO Case No. DAU2004-0008 (2005), <lampeberger.com.au>, Transfer
- [Lucas Film Entertainment Company Ltd. LLC v. Moxomo Pty Ltd](#), WIPO Case No. DAU2014-0012 (2014), <starwars.com.au>, Transfer

- [R S Capital Partners Pty Ltd t/a My SMSF v. Adviser IT Ltd](#), WIPO Case No. DAU2019-0007 (2019), <mysmsf.com.au>, Denial
- [Ulendo Roode, Curatura Pty Ltd v. Eco Care Services Pty Ltd](#), WIPO Case No. DAU2020-0001 (2020), <caretocare.com.au>, Denial
- [Quora, Inc. v. Matthew Pryse, Jola Pty Ltd](#), WIPO Case No. DAU2020-0005 (2020), <quora.com.au>, Transfer
- [Datasite LLC v. Preet Singh, AUD Stock Pty Ltd](#), WIPO Case No. DAU2021-0031 (2021), <datasite.com.au>, Denial
- [Twilio Inc. v. Timothy John Apps](#), WIPO Case No. DAU2022-0002 (2022), <twilio.com.au>, Transfer
- [Chegg, Inc. v. Knoxweil Pty Ltd.](#), WIPO Case No. DAU2022-0010 (2022), <chegg.com.au>, Transfer

#### Relevant decisions – 3.3.2

- [Cobb International Limited v. Cobb Australia & New Zealand \(Pty\) Ltd.](#), Case No. DAU2013-0005 (2013), <cobb.com.au>, Transfer
- [Hill & Smith Limited v. LB International Pty Ltd.](#), WIPO Case No. DAU2014-0008 (2014), <brifen.com.au>, Transfer

### **3.4 Can the use of a domain name for purposes other than hosting trademark-abusive content constitute bad faith?**

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

It appears that no auDRP decision has yet expressly addressed the issue of whether using a domain name for purposes such as phishing, identity theft, or malware distribution can constitute use in bad faith. However, consistent with the approach taken by panels under the UDRP, there should be no doubt that an auDRP panel would consider such an abusive use of a domain name to be bad faith use.

### **3.5 Can third-party generated material “automatically” appearing on the website associated with a domain name form a basis for finding of bad faith?**

The general position is **similar** to that under the UDRP.

A respondent cannot disclaim responsibility for content appearing on a website associated with its domain name. Neither the fact that such links are generated by a third party (such as a registrar or auction platform or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith.

#### Relevant decisions – 3.5

- [The Lotter Enterprises Limited v. NG, Ying Fat](#), WIPO Case No. DAU2016-0047 (2017), <thelotter.com.au>, Transfer or Cancellation

### **3.6 How does a registrant’s use of a privacy or proxy service impact a panel’s assessment of bad faith?**

This issue **does not arise** under the auDRP.

Rule 2.2.3 of the *.au Domain Administration Rules: Licensing* expressly prohibits the use of a proxy or privacy service to register a .au domain name. Thus, the situation in which the respondent has used a privacy or proxy service to register a domain name does not arise under the auDRP. In the rare situation in which the respondent *attempted* to use a privacy service, the Panel considered that this supported a finding that the respondent had either registered or used the domain name in bad faith. [See also 4.4.]



Relevant decisions – 3.6

- [Nirvana LLC v. Darren Marc Wilcox](#), WIPO Case No. DAU2014-0031 (2014), <nirvanadrums.com.au> *et. al.*, Transfer
- [Moffat Pty Ltd v. Sienna Coffee BN97979311](#), WIPO Case No. DAU2020-0017 (2020), <rancilio.com.au>, Transfer

**3.7 How does a disclaimer on the webpage to which a disputed domain name resolves impact a panel's assessment of bad faith?**

The general position is *similar* to that under the UDRP.

- 3.7.1 In cases where the respondent appears to have a right or legitimate interest in a disputed domain name, a clear and sufficiently prominent disclaimer would lend support to circumstances suggesting that its registration and use of the domain name is in good faith. For example, where a respondent is legitimately providing goods or services solely related to the complainant (see section 2.8), the presence of a clear and sufficiently prominent disclaimer can support a finding that the respondent has undertaken reasonable steps to avoid unfairly passing itself off as related to the complainant, or otherwise confusing users.
- 3.7.2 However, the existence of a disclaimer cannot, by itself, cure bad faith when bad faith has been established by other factors. A disclaimer may in fact show that the respondent had prior knowledge of the complainant's trademark or name. This, in turn, may support a finding that the respondent has acted in bad faith, as well as a finding that the respondent does not have rights or legitimate interests in the domain name.
- 3.7.3 The *lack* of a disclaimer on a website to which the domain name resolves may support a finding that the respondent's use of the domain name is deliberately misleading, and thus may provide evidence of bad faith use, as well as preclude a finding that the respondent has rights or legitimate interests in the domain name [see section 2.8].

Relevant decisions – 3.7.2

- [Australian Rugby Union v. Weeks](#), LEADR Case No. auDRP09/05 (2005), <aru.com.au>, Transfer
- [Advanced Medical Institute Pty Limited v. World Wide Internet Services \(Aust.\) Pty Limited](#), IAMA Case No. 3021 (2006), <australianmedicalinstitute.com.au> *et. al.*, Transfer and Denial
- [Google Inc. v. Ravi Singh](#), WIPO Case No. DAU2016-0039 (2016), <gmailsupportaustralia.com.au>, Transfer

Relevant decisions – 3.7.3

- [Perpetual Limited v. Perpetual Home Loans Pty Ltd \(ACN 120010657\)](#), WIPO Case No. DAU2009-0009 (2009), <perpetualhomeloans.com.au>, Transfer

**3.8 Can bad faith be found where a domain name was registered before the complainant acquired rights in its trademark or name?**

The general position is *different* from that under the UDRP. In particular:

- Bad faith can be found where there has been use of the domain name in bad faith, even though the respondent's registration of the domain name was in good faith; thus, the timing of the domain name's registration is of little consequence.

- 3.8.1 Where a domain name is registered prior to the acquisition of rights by the complainant, an auDRP panel would generally assess the timing issue under the second, rather than the third, element of the Policy. Specifically, an auDRP panel would take the fact of the respondent's prior registration of the domain name into account when considering whether the respondent has used, or has prepared to use, the domain name in connection with a *bona fide* offering of goods or services as specified in paragraph 4(c)(i) of the Policy [see section 2.2].
- 3.8.2 The fact that a respondent registered a domain name before the complainant acquired rights in the trademark or name on which the complaint is based is usually of limited significance to whether the third element of the auDRP is satisfied. This is because the auDRP requires that the domain name was *either* registered in bad faith or used in bad faith – unlike the UDRP, both registration and use in bad faith is not required. Accordingly, registration – even one that is demonstrably in good faith – of the domain name prior to the complainant acquiring rights in its trademark or name will not protect a respondent from a finding that the third requirement is satisfied where it is established that the respondent subsequently used the domain name in bad faith. Nevertheless, there will be situations in which the prior registration of the domain name is a relevant factor and is consistent with other factors which, together, support a finding that the respondent's use of the domain name has not been in bad faith.
- 3.8.3 Conversely there will be situations in which the registration of a domain name is found to be in bad faith, even though the registration occurred prior to the complainant obtaining rights in its trademark or name. A typical instance of this is when the respondent was aware of the complainant's intention to register the trademark or name, and registered the domain name in anticipation of that.
- 3.8.4 Where the respondent had allowed the registration of the domain name to lapse and then subsequently registered it again before the filing of the complaint, the relevant date for determining whether the respondent's registration was in bad faith is the date of the *later* registration.

Relevant decisions – 3.8.2

- [SKYCITY Adelaide Pty Limited \[ABN 72 082 362 061\] v. Trellian Pty Ltd \[ABN 55 098 223 048\]](#), IAMA Case No. 3353 (2009), <adelaidecasino.com.au>, Transfer
- [R S Capital Partners Pty Ltd t/a My SMSF v. Adviser IT Ltd](#), WIPO Case No. DAU2019-0007 (2019), <mysmsf.com.au>, Denial
- [Ulendo Roode, Curatura Pty Ltd v. Eco Care Services Pty Ltd](#), WIPO Case No. DAU2020-0001 (2020), <caretocare.com.au>, Denial

Relevant decisions – 3.8.3

- [OneCode IP Pty Ltd v. Dillon Firrell, Energy Information Technology Pty Ltd](#), WIPO Case No. DAU2022-0005 (2022), <onecode.com.au>, Transfer

Relevant decisions – 3.8.4

- [Fritz Egger GmbH & Co. OG and Egger Australasia Pty Ltd v. Domain Admin, Proform Products Pty Ltd](#), WIPO Case No. DAU2022-0006 (2022), <egger.com.au>, Transfer

**3.9 Can the respondent's renewal of its domain name registration support a finding of (registration in) bad faith?**

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

No auDRP decision has yet addressed the issue of whether a renewal of a domain name amounts to a "registration" for the purposes of the Policy. Thus, it is not clear whether – and, if so, in what circumstances – renewal of a domain name registration in bad faith will be treated as a registration of the domain name in bad faith.

However, the issue is of limited significance, because the auDRP merely requires that the domain name was *either* registered in bad faith *or* used in bad faith – unlike the UDRP, both registration and use in bad faith is not required. Accordingly, there may be use in bad faith of a domain name that was registered in good faith, independent of whether a subsequent renewal of it was in bad faith.

### 3.10 Will panels consider statements made in settlement discussions?

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

Evidence of an offer to sell the domain name is generally admissible in proceedings under the auDRP, and is often used to show bad faith [see section 3.1.1]. This is so whether the offer is made before or after the filing of the complaint, and whether or not the correspondence evidencing the offer is marked “Without Prejudice”. An offer to sell the domain name made in settlement discussions may be seen as a “use” of the domain name for the purposes of showing bad faith, even if it is the respondent’s only use of the domain name.

#### Relevant decisions – 3.10

- [Sterling Marine Pty Ltd ABN 13 008 025 223 v. Etolin Pty Ltd ABN 87 008 222 428](#), LEADR Case No. auDRP\_13\_03 (2013), <cameroskiboats.com.au>, Transfer
- [Tyre Depot Holdings Pty Ltd v. Tyre Kingdom Pty Ltd.](#), WIPO Case No. DAU2014-0016 (2014), <tyredepot.com.au>, Transfer
- [Ogio International Inc v. Ogio Pty Ltd](#), WIPO Case No. DAU2019-0011 (2019), <ogio.com.au>, Denial

### 3.11 Can the use of “robots.txt” or similar mechanisms to prevent website content being accessed in an online archive impact a panel’s assessment of bad faith?

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

No auDRP decision has yet addressed the issue of use of “robots.txt” or similar mechanisms to prevent website content from being accessed in an on-line archive. Thus, it is not clear whether – and, if so, in what circumstances – use of such mechanisms by the respondent will be found to be evidence of bad faith.

### 3.12 Can tarnishment form a basis for finding bad faith?

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

It appears that no auDRP decision has yet addressed the issue of “tarnishment” – *i.e.*, of using a domain name to resolve to a website containing wholly inappropriate content, such as pornography. However, consistent with the approach taken by panels under the UDRP, there should be no doubt that an auDRP panel would consider such a use of a domain name to be bad faith use.

## 4 PROCEDURAL QUESTIONS

### 4.1 What deference is owed to past auDRP decisions dealing with similar factual matters or legal issues?

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

4.1.1 Panels deciding cases under the auDRP consider it desirable that their decisions are consistent with prior auDRP panel decisions dealing with similar fact situations. Thus, although the auDRP does not have a formal doctrine of precedent (*stare decisis*), panels tend to follow the approach of prior panels to the same issue, at least where a number of such panels have come to the same conclusion. One panel has gone so far as to state that “in the interests of consistency it is loathe to depart from an interpretation that has been followed by a number of distinguished panels ... even if the result could theoretically result in a conflict with the position under Australian national law”.

4.1.2 Where the relevant provision of the auDRP is the same as its equivalent provision in the UDRP, auDRP panels will treat UDRP decisions on that provision as equally persuasive as auDRP decisions on the issue.

#### Relevant decisions – 4.1.1

- [American Future Technology Corp. v. Rex Hall](#), WIPO Case No. DAU2009-0007 (2009), <ibuypower.com.au>, Denial

#### Relevant decisions – 4.1.2

- [GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd](#), WIPO Case No. DAU2002-0001 (2003), <globalcentre.com.au> *et. al.*, Transfer
- [National Dial A Word Registry Pty Ltd and others v. 1300 Directory Pty Ltd](#), WIPO Case No. DAU2008-0021 (2009), <13cars.com.au> *et. al.*, Denial

### 4.2 What is the applicable standard of proof in auDRP cases?

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

The general standard of proof under the auDRP is “on balance” – often expressed as the “balance of probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party would typically need to establish that it is more likely than not that the claimed fact is true.

#### Relevant decisions – 4.2

- [GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd](#), WIPO Case No. DAU2002-0001 (2003), <globalcentre.com.au> *et. al.*, Transfer

### 4.3 Does a respondent's default/failure to respond to the complainant's contentions automatically result in the complaint succeeding?

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

A respondent's default does not automatically result in a decision in favor of the complainant. Subject to the principles described in section 2.1.1 with regard to the second element of the auDRP, the complainant must establish each of the three elements required by paragraph 4(a) of the Policy. However, panels may draw appropriate inferences from a respondent's default, including that the complainant's factual allegations that are not inherently implausible are true, and that any evidence the respondent might have given would not have been in its favour.

Relevant decisions – 4.3

- [\*MGM Home Entertainment, Metro-Goldwyn-Mayer Lion Corporation, Metro-Goldwyn-Mayer Studios Inc. v. McIlroy Group Management Pty Ltd.\*](#), WIPO Case No. DAU2003-0006 (2003), <mgm.com.au>, Denial
- [\*Supre Pty Ltd v. Paul King\*](#), WIPO Case No. DAU2004-0006 (2004), <supre.com.au>, Transfer
- [\*Harness Racing Australia v. Acronym Wiki Pty Ltd.\*](#), WIPO Case No. DAU2011-0007 (2011), <hra.com.au>, Transfer
- [\*QSA Brands Pty Ltd. v. Domain Administrator, Internet Service Consultants Pty Ltd.\*](#), WIPO Case No. DAU2022-0008 (2022), <questeastmelbourne.com.au> *et. al.*, Transfer

**4.4 How is respondent identity assessed in a case involving a privacy or proxy registration service?**

This issue **does not arise** under the auDRP.

Rule 2.2.3 of the *.au Domain Administration Rules: Licensing* expressly prohibits the use of a proxy or privacy service to register a .au domain name. Thus, the issue of how respondent identity is assessed where the domain name is registered using a privacy or proxy registration service does not arise under the auDRP. [See also section 3.6.]

**4.5 How is the (working) language of an auDRP proceeding determined?**

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

Paragraph 11 of the auDRP Rules provides that the language of the proceeding is the language of the registration agreement, unless either the registration agreement specifies otherwise, both parties agree otherwise, or the panel determines otherwise having regard to the circumstances of the proceeding.

It appears that no auDRP panel has yet addressed the issue of the working language of the proceedings. Thus, it is not yet established whether – and, if so, in what circumstances – the working language of the proceedings should be other than the language of the registration agreement, as specified in the registration agreement, or as agreed between the parties.

**4.6 In what circumstances would a panel accept a party’s unsolicited supplemental filing?**

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

Paragraph 10 of the auDRP Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and requires the panel to ensure that the proceeding takes place with due expedition. Paragraph 12 of the auDRP Rules provides that, in addition to the complaint and the response, the panel may request or permit, in its sole discretion, further statements or documents from either of the parties. It appears that the service provider will, as a matter of course, put unsolicited statements before the panel, on the basis that it is for the panel to decide whether to admit such statements into the case record.

In exercising its discretion whether to accept an unsolicited supplemental filing from either party, panels bear in mind the need for procedural efficiency, the obligation to ensure that each party has a fair opportunity to present its case, and the obligation to treat each party with equality. Generally, panels will only accept an unsolicited supplementary filing in “exceptional” circumstances – such as where the information or evidence was unanticipated as relevant, or was unavailable, at the time of the original filing. The party submitting a supplemental filing would normally need to show its relevance to the case and why the

circumstances are exceptional. Panels that have accepted a supplemental filing from one side typically allow the other party the opportunity to file a reply to such supplemental filing.

#### Relevant decisions – 4.6

- [Jupitermedia Corporation and Australia.Internet.com Pty Ltd v. Spotpress Pty Ltd. Trading as Internet Printing](#), WIPO Case No. DAU2003-0005 (2004), <internet.com.au>, Denial
- [Clark Equipment Company v. AllJap Machinery Pty Ltd](#), WIPO Case No. DAU2011-0042 (2012), <usedbobcats.com.au>, Transfer
- [Terra Plana International Ltd. V. The Summer House Australia Pty Ltd / Tanya Greenwood](#), WIPO Case No. DAU2012-0025 (2012), <vivobarefootaustralia.com.au> *et. al.*, Transfer
- [Brilliance Publishing, Inc. v. My Brilliance Pty Ltd / Ceinwen Schneider](#), WIPO Case No. DAU2013-0007 (2013), <brillianceaudiocollections.com.au> *et. al.*, Transfer
- [M/s Info Edge \(India\) Limited v. Harjeet Singh / Harry Singh](#), WIPO Case No. DAU2013-0022 (2013), <99acres.com.au>, Transfer
- [Australian Postal Corporation v. Jason Soares](#), WIPO Case No. DAU2015-0003 (2015), <mypost.com.au>, Denial
- [Carman's Fine Foods Pty Ltd v. Ross Wayne Carman, Carmans Consulting](#), WIPO Case No. DAU2015-0041 (2016), <carmans.com.au>, Denial
- [Signature Nail Systems, LLC v. Diamond Nails Supplies Pty Ltd as Trustee for the DT Pham & PTT Nguyen Family Trust](#), WIPO Case No. DAU2020-0010 (2020), <snsnail.com.au>, Transfer
- [Global Car Group Pte Ltd., Cars24 Services Private Limited, Global Cars Aus Pty Ltd. V. Aman Nagpal, Proven Associated Services Pty Ltd](#), WIPO Case No. DAU2021-0022 (2021), <cars24.com.au>, Transfer
- [EventXtra Limited v. Event X Pty Ltd / Catherine L'Huillier, DPMEW Pty Ltd](#), WIPO Case No. DAU2021-0033 (2021), <event-x.com.au>, Denial

#### 4.7 Under what circumstances would an auDRP panel issue a Procedural Order?

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

- 4.7.1 Paragraph 10 of the auDRP Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and requires the panel to ensure that the proceeding takes place with due expedition. Paragraph 12 of the auDRP Rules provides that, in addition to the complaint and the response, the panel may request or permit, in its sole discretion, further statements or documents from either of the parties.
- 4.7.2 While not commonly done, panels have issued procedural orders requesting parties to provide such information, evidence or arguments that they believe is necessary to determine the matter. Merely by way of example, panels have issued procedural orders: (i) to obtain evidence proving an unsubstantiated assertion, such as about use of a trademark/name or a domain name; (ii) to obtain information about any action subsequent to an identified event, such as whether any response was given to a communication; (iii) to ascertain the status of, or relationship between, parties, for the purpose of determining standing to bring an action or entitlement to consolidate complaints.; and (iv) to determine whether a complainant satisfies the eligibility requirements entitling it to receive a transfer of the domain name. Typically, a procedural order requesting something from one party will expressly provide the other party with an opportunity to make submissions on the content of anything provided pursuant to the order.
- 4.7.3 Although panels have the power to make such procedural orders, they are cognisant of the principle that it is the responsibility of the parties (and especially of the complainant), not the panel, to provide the information necessary to make out their case under the Policy.

#### Relevant decisions – 4.7.2

- [Clinic Care Pty Limited v. Emma Redgate Payne \(also known as Emma Johnson\)](#), WIPO Case No. DAU2011-0027 (2011), <dermaroller.com.au>, Denial
- [Christine Schrammek Kosmetik GmbH & Co. KG v. Advanced Laser Therapy Clinics Australia Pty Ltd](#), WIPO Case No. DAU2014-0034 (2014), <greenpeel.com.au>, Transfer
- [William Hill Organization Limited v. The trustee for Bean Media Group Trust, Bean Media Group Pty Ltd](#), WIPO Case No. DAU2017-0003 (2017), <eurogrand.com.au> *et. al.*, Transfer
- [Smartmark Pty Ltd v. Dash Corp Pty Ltd, Robert Kaay, Registry Australia Pty Ltd](#), WIPO Case No. DAU2019-0031 (2020), <smartmark.com.au>, Denial
- [LovePop, Inc. v. KCG PTY LTD](#), WIPO Case No. DAU2021-0037 (2021), <lovepopcards.com.au>, Cancellation or Transfer
- [Allergan, Inc. and Allergan Australia Pty Ltd v. Denise Costa](#), WIPO Case No. DAU2021-0038 (2021), <hairbotox.com.au>, Transfer

#### Relevant decisions – 4.7.3

- [Air Charter Service \(Aust\) Pty Ltd v. AVMIN Pty Ltd](#), WIPO Case No. DAU2021-0029 (2021), <aircharterservices.com.au>, Denial

### 4.8 May a panel perform independent research in assessing the case merits?

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, consulting an Internet archive repository in order to obtain an indication of how a domain name may have been used in the past, reviewing dictionaries or encyclopedias to determine any common meaning of words, or discretionary referencing of online trademark registration databases. A panel may also rely on personal knowledge.

#### Relevant decisions – 4.8

- [Frenbray Pty Ltd v. Weyvale Pty Ltd](#), LEADR Case No. auDRP06/06 (2006), <newcars.com.au>, Denial
- [Google Inc. v. Dmitri Rytsk](#), WIPO Case No. DAU2007-0004 (2007), <googlebay.com.au>, Transfer
- [SKYCITY Adelaide Pty Limited \[ABN 72 082 362 061\] v. Trellian Pty Ltd \[ABN 55 098 223 048\]](#), IAMA Case No. 3353 (2009), <adelaidecasino.com.au>, Transfer
- [Into Blinds Pty Ltd and John and Mark McDonald v. Cost less Décor Blinds Pty Ltd \(as Trustee for Cost Less Décor Blinds ABN 87 670 942 726, a discretionary trading trust\)](#), RI Case No. auDRP\_17\_07 (2017), <intoblindsandplantationshuttersmelbourne.com.au>, *et. al.*, Transfer

### 4.9 Can auDRP proceedings be suspended for purposes of settlement?

The general position is **not yet established** under the auDRP (as it has not yet been considered by an auDRP Panel).

Paragraph 17(a) of the auDRP Rules states that if, before the panel's decision, the parties agree on a settlement, the panel shall terminate the administrative proceeding. However, the Rules and the Policy are silent on whether a panel can and should suspend proceedings during, or to permit, settlement discussions.

No auDRP case has yet addressed the issue of suspending a complaint for the purposes of settlement. Thus, it is not clear whether – and, if so, in what circumstances – a complaint would be suspended during, or to permit, settlement discussions.

#### 4.10 How do panels handle cases involving a respondent's informal or unilateral consent for the transfer of the domain name to the complainant outside the "standard settlement process" described above?

The general position is *similar* to that under the UDRP.

Where a respondent has stated, either in its response or some other communication to the panel, that it consents to a transfer of a domain name, auDRP panels have given effect to this by ordering transfer. For this to occur, the respondent's consent to transfer must be genuine, unconditional and unilateral. Where the consent to transfer is conditional – e.g., in return for payment of a fee – panels generally proceed to consider the merits of the complaint.

##### Relevant decisions – 4.10

- [ABC Learning Centres Limited \(ACN 079 736 664\) v. MJ Central Pty Ltd \(ACN 096 048 716\)](#), LEADR Case No. 04 of 2004 (2004), <abclearningcentres.com.au> *et.al.*, Transfer
- [PARROT v. Binh An Nguyen](#), WIPO Case No. DAU2011-0016 (2011), <ardrone.com.au>, Transfer
- [Marvel Characters, Inc, Pixar and Disney Enterprises Inc v. Jason Carmody, James Kite](#), WIPO Case No. DAU2013-0036 (2014), <avengers.com.au> *et. al.*, Transfer

#### 4.11 How do panels address consolidation scenarios?

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

- 4.11.1 Paragraph 4(f) of the Policy provides that where there are multiple complaints by the same complainant against the same respondent, either party may petition to consolidate the disputes before a single administrative panel. Paragraph 10(e) of the auDRP Rules grants a panel the power "to consolidate multiple domain name disputes in accordance with the Policy and these Rules". At the same time, paragraph 3(c) of the auDRP Rules provides that a "complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder". These provisions are the same as the equivalent provisions in the UDRP and the UDRP Rules.
- 4.11.2 Where **multiple complainants** have a "common grievance" against the respondent, consolidation will be permitted, subject to the general requirement that it is equitable and procedurally efficient to have consolidation. The most obvious case of multiple complainants having a common grievance against a single respondent is where the complainants have a *common legal interest* in the rights on which the complaint is based. Examples of such a common legal interest include: (i) where the multiple complainants have a shared interest in a trademark, such as may exist between a licensor and a licensee; (ii) where the multiple complainants form part of a single entity, such as being individual companies that are part of a larger corporate group or a joint venture; and (iii) where the multiple complainants are members of an association or league – such as an authors' guild, an artists' collecting society or a sporting association – which is authorised to enforce the members' rights.
- 4.11.3 Where the multiple complainants do not have a common legal interest in the rights on which the complaint is based, the complainants would need to make a compelling case that the respondent has engaged in *common conduct* that has affected their individual rights in like fashion. Examples of conduct affecting individual rights in like fashion include: (i) where the respondent has clearly targeted multiple rights holders; (ii) where the rights relied on, and all of the domain names complained about, involve certain obvious and specific commonalities; and (iii) where there appears to be a clear pattern to the registration and use of all disputed domain names.



- 4.11.4 Multiple complainants to a complaint should decide between themselves, and state in the complaint, which complainant is to receive transfer of which domain name(s) in the event the complaint is successful. [See also section 5.3.]
- 4.11.5 Where a complaint is filed against **multiple respondents**, panels look at: (i) whether the domain names (or corresponding websites) are subject to “common control”; and (ii) whether the consolidation would be fair and equitable to all parties. [See also section 4.12.]
- 4.11.6 Factors that are relevant to determining whether or not a consolidation would be **equitable and procedurally efficient** include the number of parties (both complainants and respondents), the number of domain names, the number of legal and factual issues in contest, the strength of the contest between the parties on the issues, and the extent to which the issues in contest differ among the parties and the domain names.
- 4.11.7 Factors that are relevant to determining whether or not a consolidation would be **fair** on multiple respondents include the burden on the respondents and whether the actions and intentions of one respondent might have the effect of “tainting” the panel’s perceptions of the other respondent(s).

Relevant decisions – 4.11.2

- [National Dial A Word Registry Pty Ltd and others v. 1300 Directory Pty Ltd](#), WIPO Case No. DAU2008-0021 (2009), <13cars.com.au> *et. al.*, Denial
- [HCOA Pty Ltd, Molescan Australia Pty Ltd v. The Trustee for the Terantica Trust / Terry Lockitch](#), WIPO Case No. DAU2013-0003 (2013), <molescan.com.au>, Transfer
- [Mark Livesey QC and The New South Wales Bar Association v. Derek Minus and Dispute Resolution Associates Pty Ltd](#), WIPO Case No. DAU2014-0011 (2014), <austbar.com.au> *et. al.*, Denial
- [Smart Fee Pty Ltd and KJR Passover Pty Ltd v. Quickfee Pty Ltd](#), WIPO Case No. DAU2015-0032 (2015), <smartfee.com.au>, Transfer
- [Top Connect OU v. Karl Gye, Lawsearch Australia Pty Ltd](#), WIPO Case No. DAU2016-0044 (2016), <travelsim.com.au>, Transfer
- [Adelaide Oval Hotel Pty Ltd, Adelaide Oval SMA Ltd v. Hines Property Asset Services Pty Ltd](#), WIPO Case No. DAU2020-0021 (2020), <adelaideovalhotel.com.au>, Transfer
- [Global Car Group Pte Ltd., Cars24 Services Private Limited, Global Cars Aus Pty Ltd. v. Aman Nagpal, Proven Associated Services Pty Ltd](#), WIPO Case No. DAU2021-0022 (2021), <cars24.com.au>, Transfer
- [Kyndryl, Inc. and Kyndryl Australia Pty Ltd v. Mohamedzakwan Mohamedsharif Mansuri](#), WIPO Case No. DAU2022-0007 (2022), <kyndrylsolutions.com.au>, Transfer

Relevant decisions – 4.11.3

- [National Dial A Word Registry Pty Ltd and others v. 1300 Directory Pty Ltd](#), WIPO Case No. DAU2008-0021 (2009), <13cars.com.au> *et. al.*, Denial
- [Mark Livesey QC and The New South Wales Bar Association v. Derek Minus and Dispute Resolution Associates Pty Ltd](#), WIPO Case No. DAU2014-0011 (2014), <austbar.com.au> *et. al.*, Denial
- [Eva-Last Hong Kong Limited v. Ben Ranieri, The Trustee for B J Trust](#), WIPO Case No. DAU2019-0022 (2019), <eva-last.com.au>, Denial

Relevant decisions – 4.11.4

- [HCOA Pty Ltd, Molescan Australia Pty Ltd v. The Trustee for the Terantica Trust / Terry Lockitch](#), WIPO Case No. DAU2013-0003 (2013), <molescan.com.au>, Transfer

Relevant decisions – 4.11.5

- [Smart Voucher Ltd T/A Ukash v. Chowdhury, MD Abu Russel and Sydney Business & Technology Group Pty Ltd](#), WIPO Case No. DAU2013-0006 (2013), <ukash.com.au> *et. al.*, Transfer

- [Mark Livesey QC and The New South Wales Bar Association v. Derek Minus and Dispute Resolution Associates Pty Ltd](#), WIPO Case No. DAU2014-0011 (2014), <austbar.com.au> *et. al.*, Denial
- [William Hill Organization Limited v. The trustee for Bean Media Group Trust, Bean Media Group Pty Ltd](#), WIPO Case No. DAU2017-0003 (2017), <eurogrand.com.au> *et. al.*, Transfer
- [Smartmark Pty Ltd v. Dash Corp Pty Ltd, Robert Kaay, Registry Australia Pty Ltd](#), WIPO Case No. DAU2019-0031 (2020), <smartmark.com.au>, Denial
- [Keep Australia Beautiful National Association Ltd v Keep Australia Beautiful Council Qld Inc, Community Projects Queensland Ltd \(also known as Keep Queensland Beautiful\)](#), WIPO Case No. DAU2020-0016 (2020), <keepaustraliabeautiful.org.au> *et. al.*, Denial

#### Relevant decisions – 4.11.6

- [National Dial A Word Registry Pty Ltd and others v. 1300 Directory Pty Ltd](#), WIPO Case No. DAU2008-0021 (2009), <13cars.com.au> *et. al.*, Denial
- [Mark Livesey QC and The New South Wales Bar Association v. Derek Minus and Dispute Resolution Associates Pty Ltd](#), WIPO Case No. DAU2014-0011 (2014), <austbar.com.au> *et. al.*, Denial

#### Relevant decisions – 4.11.7

- [Mark Livesey QC and The New South Wales Bar Association v. Derek Minus and Dispute Resolution Associates Pty Ltd](#), WIPO Case No. DAU2014-0011 (2014), <austbar.com.au> *et. al.*, Denial

### **4.12 Under what circumstances may additional domain names be added to a filed complaint/ongoing proceeding?**

The general position is *similar* to that under the UDRP.

Paragraph 3(c) of the auDRP Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by “the same domain name holder”. Paragraph 1 of the Rules defines “Respondent” to be “the holder of a domain name registration against which a complaint is initiated”.

The use of the word “holder” rather than “registrant” in the paragraph 1 definition of “Respondent” indicates that the “holder” of a domain name may be someone other than the registrant of it – *e.g.*, where: (i) the registrant is in some way under the control of another person, such that it is appropriate to consider the other (*i.e.*, the controlling) person as a holder of the disputed domain name [see also section 5.1.1]; and (ii) the different registrants of record are, in fact, one and the same entity (*i.e.*, where the different registrant names are simply aliases for a single entity), such that the “holder” of the disputed domain names is the single entity for which the names of the registrants of record are aliases. Where the holder of each of several domain names is the same person, the one complaint may be brought in relation to those domain names. Thus, additional domain names may be added to a complaint where the holder of those domain names is the named respondent. [See also section 4.11.5.]

#### Relevant decisions – 4.12

- [Mark Livesey QC and The New South Wales Bar Association v. Derek Minus and Dispute Resolution Associates Pty Ltd](#), WIPO Case No. DAU2014-0011 (2014), <austbar.com.au> *et. al.*, Denial

### **4.13 How do panels address domain names involving the mark of a third party trademark owner not joined in the complaint?**

The general position is *not yet established* under the auDRP (as it has not yet been considered by an auDRP Panel).

No auDRP panel has yet addressed the situation of a domain name consisting of or containing more than one trademark or name where the complainant does not have rights in all of them. However, consistent with the approach taken by panels under the UDRP, where the domain name contains both the complainant's trademark/name and the trademark/name of the third party (e.g., <[complaintrademark/name]+[thirdpartytrademark/name].2LD.au>), it is likely that an auDRP panel would make any transfer order without prejudice to the rights of the third party. [See also section 1.12.]

#### 4.14 What is the relationship between the auDRP and court proceedings?

The general position is *similar* to that under the UDRP.

- 4.14.1 The purpose of the auDRP is described in paragraph 1.2 of auDA Policy No. 2016-01 as being “to provide a cheaper, speedier alternative to litigation for the resolution of disputes between the registrant of a .au domain name and a party with competing rights in the domain name”. Paragraph 4(k) of the auDRP states that neither the complainant nor the respondent is prevented from submitting the dispute to a court of competent jurisdiction for independent resolution, either before an administrative proceeding under the Policy has commenced or after it has concluded. Where either party initiates legal proceedings in relation to a domain name the subject of a complaint, either prior to or during the administrative proceeding, paragraph 18(a) of the auDRP Rules provides that the panel has the discretion to decide whether to suspend, to terminate or to continue with the proceeding.
- 4.14.2 Although at least one auDRP panel has considered a request under paragraph 18(a) of the auDRP Rules to suspend or terminate a complaint due to a pending court proceeding, it appears that no auDRP panel has yet exercised its discretion to do so. In considering whether to exercise its discretion (which it declined), one panel took account of the following factors: (i) paragraph 4(k) contemplates the parallel operation of both auDRP and court proceedings; (ii) even where both sets of proceedings deal with the same issues and offer similar relief, court proceedings are determined using very different rules of evidence and procedure; and (iii) a decision to terminate or suspend proceedings requires strong justifying circumstances, to ensure the result is not at odds with the purpose of the Policy.
- 4.14.3 Panels recognise that the auDRP is not designed to address all disputes concerning a .au domain name. Rather, the Policy is crafted to apply to a particular, rather limited type of dispute about a domain name – “cybersquatting” (abusive registration or use of a domain name). As a result, panels have refused to apply the auDRP to complex business or contractual disputes that raise issues beyond those which the Policy was designed to address.

##### Relevant decisions – 4.14.2

- [Jacuzzi, Inc. v. Wangra Pty Ltd](#), WIPO Case No. DAU2005-0001 (2005), <jacuzzispas.com.au>, Denial

##### Relevant decisions – 4.14.3

- [Phillip Island Nature Park Board of Management Inc. v. The Trustee for the Langford Family Trust No. 4, Technology Consulting and Solutions Pty Ltd](#), WIPO Case No. DAU2016-0014 (2016), <churchillislandcafe.com.au>, Denial
- [Aquarian Foundation, Inc. v. Daryl Wardenaar, Church of Higher Spiritualism](#), WIPO Case No. DAU 2022-0003 (2022), <hispirit.org.au>, Denial

#### 4.15 To what extent is national law relevant to panel assessment of the second and third auDRP elements (rights or legitimate interests, and bad faith)?

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

Paragraph 15 (a) of the auDRP Rules provides that a panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable. Like the UDRP, the auDRP is rooted in generally-recognised principles of trademark law and is designed to operate in the context of the Internet – and, for this reason, generally does not require resort to concepts or jurisprudence specific to national law. In the small number of cases where a panel has referred to Australian legal principles or case law, the references are usually to trademark law, and are either for the purpose of assessing whether the complainant has rights in a trademark or for determining whether the respondent has rights or legitimate interests in a domain name.

#### Relevant decisions – 4.15

- [\*The Crown in Right of the State of Tasmania trading as "Tourism Tasmania" v. Gordon James Craven\*](#), WIPO Case No. DAU2003-0001 (2003), <discover-tasmania.com.au>, Denial
- [\*Emirates, Emirates Group v. Bluecom Consulting Group Pty Ltd\*](#), WIPO Case No. DAU2008-0004 (2008), <emirates.com.au>, Denial
- [\*101domain GRS Ltd. v. 101 Web Technology Pty Ltd\*](#), WIPO Case No. DAU2021-0009 (2021), <101domains.com.au>, Transfer
- [\*Air Charter Service \(Aust\) Pty Ltd. v. AVMIN Pty Ltd\*](#), WIPO Case No. DAU2021-0029 (2021), <aircharterservices.com.au>, Denial

#### **4.16 In what circumstances will panels issue a finding of Reverse Domain Name Hijacking (RDNH)?**

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

- 4.16.1 Paragraph 15(e) of the auDRP Rules provides that, if the panel finds that the complaint “was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder”, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. Paragraph 1 of the auDRP Rules defines “Reverse Domain Name Hijacking” to be “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name”.
- 4.16.2 Circumstances that panels have considered to be **indicative** of a complaint having been brought in bad faith include: (i) the complainant knew it had no rights in the trademark or name upon which it relied, and nevertheless brought the complaint; (ii) the complainant had, by the time the complaint was filed, been informed of or had otherwise ascertained all the facts necessary to establish that the respondent had legitimate interests in the disputed domain name; (iii) the complainant had, in communications with the respondent, expressly acknowledged that the respondent had rights to the domain name; (iv) the complainant had knowledge of the respondent’s rights or legitimate interests in the domain name and engaged in harassment or similar conduct in the face of such knowledge (such as repeated cease-and-desist communications, or prolonging the dispute in order to exploit superior financial resources); (v) the complainant had known from the beginning that its rights in the domain name were not exclusive, that the domain name was generic, and that the domain name described the activities for which the respondent used it; (vi) the complainant knew that its trademark was limited to a narrow field, and that the respondent’s registration and use of the domain name could not, under any fair interpretation of the facts, constitute bad faith; (vii) the complainant intentionally attempted to mislead the panel by omitting relevant evidence; (viii) the complaint was silent on key matters, riddled with unexplained inconsistencies, and contained numerous unsubstantiated and potentially false claims; and (ix) the complainant set out to harass the respondent and to procure the domain name “by fair means or foul”.

- 4.16.3 A finding of Reverse Domain Name Hijacking will rarely be made where there is a genuine dispute. Where a complainant has an arguable case that is merely weak on the evidence, a panel is unlikely to find the complaint to have been brought in bad faith. Circumstances that have been found **not** to be indicative of a complaint having been brought in bad faith include: (i) a failure to contact the respondent prior to filing the complaint; (ii) the filing of a supplemental submission; (iii) the incorporation of a dictionary word in the domain name; (iv) carelessness in the preparation of the complaint; (v) a brief and somewhat skewed explanation of a complex history; and (vi) a failure to satisfy the eligibility and allocation requirements for a valid holding of the domain name.
- 4.16.4 It is open to a panel to make finding of Reverse Domain Name Hijacking even though the respondent has not requested it.

Relevant decisions – 4.16.2

- [WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd](#), WIPO Case No. DAU2007-0003 (2007), <wow.com.au>, Denial
- [Adjudicate Today Pty Limited v. The Institute of Arbitrators and Mediators](#), WIPO Case No. DAU2012-0033, (2013) <adjudicate.org.au>, Denial
- [Cairns Airport Pty Ltd. v. Chris Ford \(Christopher William Ford\) / C and C Family Discretionary Trust](#), WIPO Case No. DAU2013-0023 (2013), <cairnsairportparking.com.au> *et. al.*, Denial
- [Stephens Valuation and Consultancy Pty Ltd v. SLR Consulting Australia Pty Ltd](#), WIPO Case No. DAU2013-0026 (2013), <quarryvaluations.com.au> *et. al.*, Denial
- [Orient Express Travel Group Pty Ltd v. Mookstar Media Pty Ltd \(ACN 083 167 293\)](#), WIPO Case No. DAU2015-0004 (2015), <etg.com.au>, Denial
- [Paessler AG v. Assured IT Pty Ltd.](#), WIPO Case No. DAU2015-0030 (2015), <paessler.com.au> *et. al.*, Denial
- [Datacom Group Limited v. Datacom Communications Pty Ltd](#), WIPO Case No. DAU2019-0032 (2020), <datacomaccounting.net.au> *et. al.*, Denial
- [Smartmark Pty Ltd v. Dash Corp Pty Ltd, Robert Kaay, Registry Australia Pty Ltd](#), WIPO Case No. DAU2019-0031 (2020), <smartmark.com.au>, Denial
- [City of Parramatta Council v. Publishing Australia Pty Ltd](#), RI Case No. auDRP\_21\_05 (2021), <parramatta.com.au>, Denial
- [Affirm, Inc. v. Internet Products Sales & Services Pty Ltd](#), WIPO Case No. DAU2021-0014 (2021), <affirm.com.au>, Denial
- [PB Fintech Private Limited v. Wayde Knight, The Trustee for WDK Trust, trading as Knightcorp Insurance Brokers](#), WIPO Case No. DAU2021-0010 (2021), <policybazaar.com.au> *et. al.*, Denial

Relevant decisions – 4.16.3

- [Securitas AB v. Lion Global Pty Ltd](#), WIPO Case No. DAU2018-0008 (2018), <securitas.com.au>, Denial
- [Australian Rugby Union Limited v. Domain Manager / Domain Services Pty Ltd](#), WIPO Case No. DAU2018-0037 (2019), <wallabies.com.au>, Denial
- [Keep Australia Beautiful National Association Ltd v. Keep Australia Beautiful Council Qld Inc. Community Projects Queensland Ltd \(also known as Keep Queensland Beautiful\)](#), WIPO Case No. DAU2020-0016 (2020), <keepaustraliabeautiful.org.au> *et. al.*, Denial

Relevant decisions – 4.16.4

- [Carman's Fine Foods Pty Ltd v. Ross Wayne Carman, Carmans Consulting](#), WIPO Case No. DAU2015-0041 (2016), <carmans.com.au>, Denial

**4.17 Does “delay” in bringing a complaint bar a complainant from filing a case under the auDRP?**

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

- 4.17.1 auDRP panels have recognised that the doctrine or defence of laches does not generally apply under the auDRP. Thus, delay in bringing a complaint – as judged by reference to the time since registration of the disputed domain name – does not, of itself, prevent a complainant from filing under the auDRP or from succeeding under the auDRP. However, panels have noted that a delay in bringing a complaint may make it more difficult for a complainant to establish its case on the merits, especially in relation to the second and third elements of the Policy. In particular, delay in bringing a complaint in the situation where the respondent is using the domain name in connection with relevant goods or services may result in the respondent acquiring a right or legitimate interest in the domain name, when it previously had none, that is sufficient to defeat a claim under the Policy – even where the initial registration of the domain name was in bad faith.
- 4.17.2 It is possible that a panel would refuse to order a remedy where a complainant's delay in bringing proceedings has prejudiced the respondent as a result of the respondent's detrimental reliance on the complainant's conduct.

Relevant decisions – 4.17.1

- [Jacuzzi, Inc. v. Wangra Pty Ltd](#), WIPO Case No. DAU2005-0001 (2005), <jacuzzispas.com.au>, Denial
- [Colmar Brunton Pty Ltd v. Alta Computer Systems Pty Ltd](#), LEADR Case No. auDRP 10\_18 (2010), <opinionspaid.com.au>, Denial
- [Clinic Care Pty Limited v. Emma Redgate Payne \(also known as Emma Johnson\)](#), WIPO Case No. DAU2011-0027 (2011), <dermaroller.com.au>, Denial
- [Victoria's Secret Stores Brand Management, Inc. v. Linda Cameron Pickard, Linda Watson](#), WIPO Case No. DAU2012-0015 (2012), <victoriassecrets.com.au>, Denial
- [Illycaffè S.p.A. v. John Frisco & Associates Pty Ltd trading as Illycafe / CEW Pty Ltd](#), WIPO Case No. DAU2015-0009 (2015), <illy.com.au>, Transfer

Relevant decisions – 4.17.2

- [Twitter, Inc. v. Jason Boyce](#), WIPO Case No. DAU2015-0034 (2015), <twitter.com.au>, Transfer
- [BuzzFeed, Inc. v. Steven Asnicar, Urban Executive Pty Ltd](#), WIPO Case No. DAU2019-0027 (2019), <buzzfeed.com.au> *et. al.*, Transfer

#### 4.18 Under what circumstances would a refiled case be accepted?

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

- 4.18.1 A refiled case is one where the complainant submits a second complaint involving the same domain name(s) and the same respondent(s) as in an earlier complaint that was denied.
- 4.18.2 A refiled case will only be accepted in limited circumstances. These circumstances include: (i) that relevant new actions have occurred since the original decision; (ii) that a breach of natural justice or of due process occurred; (iii) that there was some other serious misconduct in the original case, such as perjured evidence; or (iv) that there is available now material evidence which was reasonably unavailable to the complainant during the original case.

- 4.18.3 The burden of establishing that a refiled complaint should be accepted rests on the complainant. The burden is high. The grounds which allegedly justify accepting the refiled complainant need to be clearly identified by the refiling complainant. The dispute resolution service provider with whom the refiled complainant has been filed has responsibility for determining if, *prima facie*, the refiling complainant has pleaded grounds which might justify acceptance of the refiled complaint. Where the service provider determines that such a ground has been pleaded, the refiled complaint will be submitted to a panel for determination of whether it should be accepted and, if so, of the merits of the claim.
- 4.18.4 In certain, highly limited circumstances, a panel in a previous case may have found it appropriate to record in its decision that a future refiled complaint should be accepted if certain conditions are met. Where this has occurred, the extent to which any such previously-stipulated panel conditions have been met may also be a relevant consideration in determining whether the refiled complaint should be accepted.

Relevant decisions – 4.18.2

- [Doteasy Technology Inc. v. M Makras & E.A Nahed, Dot Easy](#), WIPO Case No. DAU2011-0041 (2012), <doteasy.com.au> *et. al.*, Denial

Relevant decisions – 4.18.3

- [Cash Converters Pty Ltd v. Casshies Investments Pty Ltd.](#), WIPO Case No. DAU2014-0035 (2015), <casshies.com.au>, Denial

Relevant decisions – 4.18.4

- [Inbound Telecommunications Pty Ltd, Phonename Marketing Australia Pty Ltd v. 1300 Directory Pty Ltd, Demetrio Padilla](#), WIPO Case No. DAU2009-0018 (2010), <1300fitness.com.au> *et. al.*, Denial

#### **4.19 Can a registry or registrar be liable under the auDRP?**

The position is ***not yet determined*** under the auDRP (as it has not yet been considered by an auDRP Panel).

It appears that no auDRP case has yet addressed the situation where the named registrant of the domain name is the .au ccTLD registry operator or a registrar. The likely reason for this is that clause 19.2(a) of the *auDA Registrar Agreement* requires that the registrar must not register any domain names for itself on its own behalf unless such is for its own legitimate use in providing registrar services. (It is assumed that a similar prohibition applies to the .au ccTLD registry operator.)

While it is unlikely, it is not inconceivable that a registrar would be the holder of a domain name in respect of which a complaint is filed under the auDRP. In that situation, given the approach of auDRP panels to the issue of who is to be regarded as the respondent [see section 5.1.1] and consistent with the approach taken by panels under the UDRP, there appears to be no reason why a registrar could not be subject to an auDRP complaint in the event that it either was the named registrant of a domain name or exercised such control over the named registrant that it should be treated as the holder of the domain name.

#### **4.20 How does the expiration or deletion of a domain name subject to an auDRP proceeding affect the proceeding?**

The general position is ***somewhat different*** to that under the UDRP. In particular:

- Unlike a proceeding under the UDRP (where the complainant is given the option to renew or restore a domain name that expires or is deleted while a UDRP proceeding is pending), no provision is made in auDA policies for the situation where under a domain name expires or is deleted while an auDRP proceeding is pending.

- 4.20.1 The ICANN *Expired Domain Deletion Policy* (“EDDP”), paragraph 3.7.5.7 (which is incorporated into the ICANN *Registrar Accreditation Agreement*) states: “In the event that a domain which is the subject of a UDRP dispute is deleted or expires during the course of the dispute, the complainant in the UDRP dispute will have the option to renew or restore the name under the same commercial terms as the registrant. If the complainant renews or restores the name, the name will be placed in Registrar HOLD and Registrar LOCK status, the WHOIS contact information for the registrant will be removed, and the WHOIS entry will indicate that the name is subject to dispute. If the complaint is terminated, or the UDRP dispute finds against the complainant, the name will be deleted within 45 days. The registrant retains the right under the existing redemption grace period provisions to recover the name at any time during the Redemption Grace Period, and retains the right to renew the name before it is deleted.”
- 4.20.2 When a proceeding under the auDRP is commenced, the service provider sends a copy of the complaint to the registrar of the disputed domain name. Under auDA Policy No. 2003-01 ‘Clarification of Registrar Obligations’, within 24 hours of receiving a copy of the complaint the registrar must request the .au registry operator to place a server lock on the domain name. There is, however, no provision in any auDA policy equivalent to paragraph 3.7.5.7 of the ICANN EDDP. Accordingly, the expiration or deletion of a domain name during an auDRP proceeding is treated no differently from an expiration or deletion of any domain name.
- 4.20.3 If a domain name that is the subject of an auDRP proceeding expires or is deleted during the proceeding and is not renewed/restored, the service provider will deem the case to be withdrawn (on the basis that there is no longer a domain name registration to be disputed).
- 4.20.4 If a domain name expires or is deleted *prior* to a complaint being filed under the auDRP, the service provider will not accept the filing of the complaint (on the basis that there is no domain name registration to be disputed).

#### **4.21 What is the service provider’s role, if any, in decision implementation?**

The general position is *similar* to that under the UDRP.

The auDA-approved providers of dispute resolution services under the auDRP are neutral. As such, their role concerns the administration of the procedure and normally ends upon notification of a panel decision to the parties, the registrar and auDA (or as the case may be, upon termination/settlement).

According to paragraph 8 of the Policy, implementation of a panel’s decision ordering transfer or cancellation of a domain name is the responsibility of auDA, acting through the registrar of the domain name. auDA will wait 10 business days after being informed of the decision before implementing a panel’s decision. If the losing respondent commences a lawsuit against the complainant in a court of competent jurisdiction within that 10 business days period, auDA will refrain from implementing the panel’s decision until: (i) the matter is settled between the parties by agreement; (ii) the lawsuit is dismissed, withdrawn or abandoned; or (iii) a court dismisses the lawsuit or orders that the respondent does not have the right to continue to use the domain name.

#### **4.22 What is the relation of the auDRP to the URS?**

This issue *does not arise* under the auDRP.

The ICANN-created Uniform Rapid Suspension (URS) system does not apply to registrations in the .au ccTLD. Thus, the issue of how the auDRP relates to the URS does not arise.





## 5 OTHER ISSUES

### 5.1 Who is the Respondent for the purposes of the auDRP?

5.1.1 Paragraph 1 of the auDRP Rules defines the “Respondent” to be “the registered holder of the domain name against which a complaint is initiated”. Generally, the registered holder is considered to be the entity listed in the Whois record for a domain name as being the “registrant” (as distinct from the “registrant contact”). However, the use of the word “holder” rather than “registrant” in the paragraph 1 definition of “Respondent” indicates that the respondent may, in exceptional circumstances, be someone other than the registrant of the domain name – *e.g.*, where the registrant is in some way under the control of another person, it may be appropriate to consider the other (*i.e.*, the controlling) person as a holder of the disputed domain name and hence the respondent for the purposes of a complaint under the auDRP.

5.1.2 In the situation where it appears that registration of a domain name was obtained by fraud – such as through identity theft – the name of the registrant may be redacted from the panel’s decision.

#### Relevant decisions – 5.1.1

- [Clark Equipment Company v. AllJap Machinery Pty Ltd](#), WIPO Case No. DAU2011-0042 (2012), <usedbobcats.com.au>, Transfer
- [Mark Livesey QC and The New South Wales Bar Association v. Derek Minus and Dispute Resolution Associates Pty Ltd.](#), WIPO Case No. DAU2014-0011 (2014), <austbar.com.au> *et. al.*, Denial
- [Hydro Building Systems France \(formerly SAPA Building Systems France\) v. Nader Ragheb](#), WIPO Case No. DAU2018-0033 (2019), <technal.com.au>, Transfer
- [Ulendo Roode, Curatura Pty Ltd v. Eco Care Services Pty Ltd](#), WIPO Case No. DAU2020-0001 (2020), <caretocare.com.au>, Denial

#### Relevant decisions – 5.1.2

- [Iqoption Europe Limited v. Name Redacted](#), WIPO Case No. DAU2020-0004 (2020), <iqoption.com.au>, Transfer

### 5.2 What is the relevance of a complainant’s failure to satisfy the eligibility and allocation requirements in relation to a domain name?

auDA has promulgated eligibility and allocation requirements for the registration of domain names in the .au ccTLD. Prior to 12 April 2021, the eligibility and allocation requirements for the registration of a domain name at the third level were set out in auDA Policy No. 2012-04 ‘Domain Name Eligibility and Allocation Policy Rules for Open 2LDs’. Since 12 April 2021, those requirements, and the requirements for the registration of a domain name at the second level, are contained in auDA Policy 2019-01 ‘.au Domain Administration Rules: Licensing’.

The general view of panels is that a complainant’s failure to satisfy the eligibility and allocation requirements for a domain name effects only the availability of a particular remedy; it does not preclude the complainant from bringing, or succeeding in, a complaint (*i.e.*, it does not effect the complainant’s standing). Where a complaint succeeds but, in the panel’s view, the complainant does not or may not satisfy the eligibility and allocation requirements for a domain name, the panel may state that its order transfer of the domain name is subject to the complainant or an entity nominated by the complainant satisfying the registrar of its eligibility. Panels recognise that it is for the registrar in the first instance, and for auDA ultimately, to determine the eligibility of any particular entity to receive a transfer of a domain name.

#### Relevant decisions – 5.2

- [Rainbow Sandals, Inc. v. Malua Point Holdings Pty Limited, Anthony Brown / Malua Point Holdings Pty Limited a/k/a Malua Point Merchants](#), WIPO Case No. DAU2013-0014 (2013), <rainbowsandals.com.au>, Transfer / Cancellation

- [\*Persistent Systems, LLC v. AAV Pty Ltd\*](#), WIPO Case No. DAU2016-0052 (2017), <waverelay.com.au>, Transfer
- [\*PB Fintech Private Limited v. Wayde Knight, The Trustee for WDK Trust, trading as Knightcorp Insurance Brokers\*](#), WIPO Case No. DAU2021-0010 (2021), <policybazaar.com.au> *et. al.*, Denial
- [\*LovePop, Inc. v. KCG PTY LTD\*](#), WIPO Case No. DAU2021-0037 (2021), <lovepopcards.com.au>, Cancellation or Transfer
- [\*Allergan, Inc. and Allergan Australia Pty Ltd v. Denise Costa\*](#), WIPO Case No. DAU2021-0038 (2021), <hairbottox.com.au>, Transfer

### 5.3 What is the appropriate remedy where a complaint succeeds?

- 5.3.1 Paragraph 4(i) of the auDRP states: “The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant (provided that the complainant is otherwise eligible to hold that domain name).” This reflects the provisions of auDA Policy No. 2016-01, which states in paragraph 6.1: “A Complainant may seek to have the domain name licence: cancelled, in which case the domain name will become available for registration in the normal way; or transferred to themselves, but only if the registrar determines that they are eligible to hold the domain name under the relevant policy rules”.
- 5.3.2 Generally, panels take the view that their responsibility does not extend to determining, definitively, whether or not the party to whom it orders transfer of the disputed domain name in fact satisfies the eligibility requirements for such a transfer to take place. Rather, that responsibility rests with the registrar of the domain name. Thus, panels recognize that an order of transfer to the complainant may be subject to the registrar requiring the complainant either to demonstrate that it satisfies the eligibility requirements or to nominate another person (being one who does satisfy the eligibility requirements) to receive the transfer of the domain name. However, where complainant has requested transfer of the domain name to another person and there is no evidence that the other person has rights under the first element of the Policy, the panel might refuse to order transfer to that other person and instead order transfer to the complainant (where the complainant has demonstrated it has rights under the first element).
- 5.3.3 Paragraph 3(b)(x) of the auDRP Rules requires the complaint to specify the remedy sought. Where a complaint succeeds, generally the panel will award the remedy specified in the complaint (which, typically, is transfer of the domain name to the complainant). In exceptional circumstances, however, panels have exercised their discretion to award a different remedy. This discretion derives from the general power of the panel, set out in paragraph 10(a) of the auDRP Rules, “to conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules”.

- 5.3.4 In a number of cases, the panel has found that there were exceptional circumstances justifying an order that the domain name be cancelled, even though the remedy requested was transfer to the complainant. Instances of such exceptional circumstances are: (i) the domain name contained the family name of a beneficiary of the respondent; (ii) transfer of the domain name to the complainant would cause continuing confusion in the minds of Internet users; (iii) the complainant had not used its trademark, had no reputation in its trademark, had produced no evidence of a proposed future use of its trademark, and the domain name was a dictionary word that would not distinguish the complainant's goods from the goods of other traders; (iv) there were many owners of names or marks who would have a right or legitimate interest in the domain name, and the complainant did not have an exclusive or dominant right to it; and (v) the complainant did not satisfy the eligibility requirements to hold the domain name [see also section 5.2].

Relevant decisions – 5.3.2

- [Miltenyi Biotec GmbH v. Rachel A. Liu-Williams](#), WIPO Case No. DAU2015-0033 (2015), <miltenyibiotec.net.au>, Transfer
- [Smart Fee Pty Ltd and KJR Passover Pty Ltd v. Quickfee Pty Ltd](#), WIPO Case No. DAU2015-0032 (2015), <smartfee.com.au>, Transfer

Relevant decisions – 5.3.4

- [E.F.G. Nominees Pty Limited \[CAN 092 156 717\] v. Lenland Property Development Pty Ltd. \[ACN 143 463 816\]](#), IAMA Case No. 3658 (2012), <thepointkirribilli.com.au>, Cancellation
- [Woopie-Do Pty Ltd v. Goodwin Reading Diagnostic Centre](#), IAMA Case No. 3714 (2013), <dyslexia.com.au>, Cancellation
- [Jaguar Land Rover Limited v. The Trustee for the Trivett Family Trust](#), WIPO Case No. DAU2016-0033 (2016), <actrangerover.com.au> *et. al.*, Transfer and Cancellation
- [Peachbulk Pty Ltd v. Domain Boutique Pty Ltd](#), WIPO Case No. DAU2020-0013 (2020), <bromance.com.au>, Cancellation
- [Discovery Holiday Parks Pty Ltd. v. B2B Network Pty Ltd](#), WIPO Case No. DAU2021-0027 (2021), <gday.net.au>, Cancellation