



Domain Name: *megatilt.com.au*

Name of Complainant: *ATB Engineering Pty Ltd ACN 073 445 280*

Name of Respondent: *Jacqst Trading Pty Ltd ACN 167 839 278 trading as Megatilt Heavy Haulage*

Provider: *LEADR*

Single Member Panelist: *Dennis Liner*

1. The Parties

- 1.1 The Complainant in this proceeding is ATB Engineering Pty Ltd ACN 073 445 280 of Units 8-10, 65 South Pine Road, Brendale Queensland 4500 (“the Complainant”).
- 1.2 The Respondent named in this proceeding is Jacqst Trading Pty Ltd ACN 167 839 278 trading as Megatilt Heavy Haulage of 46 Bellevue Street, North Parramatta New South Wales 2151 (“the Respondent”).

2. The Domain Name, Registrar and Provider

- 2.1 The Domain Name subject to this proceeding is “**megatilt.com.au**” (the Domain Name).
- 2.2 The Registrar of the Domain Name is TPP Wholesale Pty Ltd ACN 109 565 095 of Level 4, 1 Smail Street, Ultimo, New South Wales, 2007 (PO Box 270, Broadway, New South Wales 2007) (“the Registrar”).
- 2.3 The provider in this Proceeding is LEADR of Level 1, 13-15 Bridge Street, Sydney, NSW 2000 (“the Provider”).

3 Procedural Matters

- 3.1 This proceeding relates to the complaint submitted by the Complainant in accordance with:-
- (i) the .au Dispute Resolution Policy no.2010-05 published 13 August 2010 (“auDRP”) which includes Schedule A (Policy) and Schedule B (Rules); and
 - (ii) the Provider’s supplemental rules for the au Domain Name Dispute Policy.

3.2 The Provider was supplied with a copy of the ADR Domain Name Dispute Complaint Application Form on 7 August 2014, by way of a letter dated 6 August 2014 from Dundas Lawyers on behalf of the Complainant, such letter containing supporting documentation referred to below. The Provider was supplied with a copy of the Response of the Respondent lodged on its behalf by William Peter Knight (of Banki Haddock Fiora) and dated 2 September 2014 together with supporting documentation referred to below and was received by the Provider on 2 September 2014. I find that the making of the Complaint and the Response together with the supporting documentation referred to below comprise all the relevant matters submitted to the Panelist. I have perused the documents and I am satisfied that the service of the documents and the time for service of the documents complies with the Rules.

3.3 The documents supplied by the Complainant were as follows:-

ADR Domain Dispute Application Form comprising the letter of Dundas Lawyers dated 6 August 2014 to which the documents set out below were attached.

- i) Schedule 1 describing 13 Annexures as set out subsequent hereto.
- ii) Annexure A. A copy of the .au Dispute Resolution Policy (Policy No. 2010-05) published 13 August 2010 (note this was adopted as auDA published Policy 2012-04 published 17 December 2012) (“the Policy”).
- iii) Annexure B. MEGATILT – Trade Mark Certificate No. 114 1148 – and Australian Trade Mark On-line Search System results.
- iv) Annexure C. A copy of the approval documents issued by the Administrator of Vehicle Standards of the Department of Infrastructure and Regional Development to fit compliance plates with the model “Megatilt”.
- v) Annexure D. Evidence of registration of a number of Domain Names containing the Megatilt Trade Mark.
- vi) Annexure E. Australian Securities & Investments Commission company search result for the Complainant’s registrar.
- vii) Annexure F. A copy of the Australian Securities & Investments Commission and ABN Lookup search results for the Business Name.
- viii) Annexure G. A copy of the registration of the Domain Name search results from “whois.com”.
- ix) Annexure H. A copy of the email addresses contained on the Respondent’s website.
- x) Annexure I. A copy of the Australian Trade Mark On-line Search System results for the Respondent’s Trade Mark application and an ASIC Search of the applicant for registration Abbsolute Transport Logistics Pty Limited ACN 104 092 122 (“Abbsolute”).
- xi) Annexure J. Letter from Bankia Haddock Fiora of 18 July 2014.
- xii) Annexure K. A copy of the screenshots of the Domain Name typed into the address bar of the web browser and the Domain Name and website that the Domain Name redirects to.
- xiii) Annexure L. A copy of the description of the goods and services the Complainant and Respondent sell as contained on their respective websites.
- xiv) Annexure M. A copy of the cease and desist letter Dundas Lawyers sent the Respondent on 27 June 2014.

3.4 The documents supplied by the Respondent were as follows:-

Response prepared by William Peter Knight dated 2 September 2014 with various annexures as set out below.

- i) Annexure 1 being ASIC search of Jacqst Trading Pty Ltd 167 839 278 (the Respondent).
- ii) Annexure 2 being Contract for Sale of Business – 2014 edition dated 3 July 2014 between Abbsolute and Jacqst Asset Holdings Pty Ltd 167836759 (“JAH”) in regard to the business name “**MEGA TILT**” to which is attached Trade Mark 1631441 in respect to “**MEGA TILT**” (“J’c Trade Mark”).
- iii) Annexure 3 showing Business Name “**MEGA TILT**” registered 25 January 2006 and cancelled as at 4 August 2014.
- iv) Annexure 4 being copy “whois” search in regard to “**MEGATILT.NET**”.
- v) Annexure 5 being screenshot of home page of “**MEGA TILT**”
- vi) Annexure 7 showing screenshots of “**MEGA TILT**”.
- vii) Annexure 8 being letter of demand from the lawyers of the Complainant.

4 Factual background

FACTS ALLEGED BY THE CLAIMANT

- 4.1 The Claimant states that it is the legal and beneficial owner of registered Trade Mark 1141148 “**MEGATILT**”. A copy of such Trade Mark is Annexure B of the Complainant’s documents. such Trade Mark being registered from 17 October 2004 for Class 12 as described in such Annexure (“C’s Trade Mark”).
- 4.2 The Complainant has used “**MEGATILT**” as a brand since approximately 1998, 15 years before its Trade Mark was granted and has built up a reputation. Such reputation being in respect to, inter alia, its “heavy duty tilt-slide” and has received 6 Safety Standard Vehicles from the relevant government department/s pursuant to each compliance plates authorised to be affixed.
- 4.3 The Complainant promotes C’s Trade Mark in its website <http://www.towtrucks.com.au>. The Complainant is the registered holder of various Domain Names containing C’s Trade Mark, being:-

megatilt.com;

megatilt-trailers.com;

megatilt-trailers.com.au
- 4.4 The Complainant had previously held the Domain Name until its registration lapsed as a result of the Registrar being placed into external administration on 17 March 2014, the Complainant not having received any notification of this.

- 4.5 The Complainant claims that when the Respondent registered the Domain Name on 3 February 2014 it did not comply with Schedule C – Eligibility and Allocation Rules for com.au (“the Rules”) and it was not at that time eligible for the reason that it was not:-
- (a) an Australian registered company;
 - (b) trading under a registered business name in any Australian State or Territory; or
 - (c) an Australian partnership or sole trader; or
 - (d) a foreign company licensed to trade in Australia; or
 - (e) an owner of an Australian Registered Trade Mark; or
 - (f) an Complainant for an Australian Registered Trade Mark; or
 - (g) an association incorporated in any Australian State or Territory; or
 - (h) an Australian commercial statutory body.
- 4.6 The Complainant also claims that the Domain Name was not registered for the purpose of Domain Monetisation.
- 4.7 C’s Trade Mark was used by the Complainant since approximately 1998, was registered from 17 October 2004 (see clause 4.1 above) has received various approvals in respect to plates affixed to semitrailers (see clause 4.2) and only the Complainant and its authorised licensees may use C’s Trade Mark.
- 4.8 The Complainant claims that the Domain Name is identical to C’s Trade Mark.
- 4.9 The Respondent has infringed the Complainant’s intellectual property rights in utilising the email addresses associated with the Domain Name and its emails which contain the Domain Name.
- 4.10 The Complainant was the first in time to hold the Domain Name until it lapsed without the Complainant’s knowledge due to the situation that the Registrar Diggy Australia going into external administration and not notifying the Complainant.
- 4.11 At the time that the Respondent registered the Domain Name, namely 3 February 2014 it had no legitimate interest in the Domain Name and using such Domain Name is “trading off” the Complainant’s Trade Mark and its prior use of the Domain Name.
- 4.12 The Respondent registered the Business Name **MEGATILT HEAVY HAULAGE** (“the Business Name”) three months after registering the Domain Name.
- 4.13 The Complainant has not licensed or permitted the Respondent to use C’s Trade Mark or permitted its use in the Domain Name.
- 4.14 On 30 June Absolute Transport Logistics Pty Ltd applied for a Trade Mark **MEGA TILT** (“R’s Trade Mark”). The Respondent has no proprietary right to the Domain Name.

- 4.15 The Respondent has registered or used the Domain Name in bad faith as follows:-
- i) the Respondent registered the Domain Name in order to prevent the Complainant as owner of C's Trade Mark from reflecting such Trade Mark in a corresponding Domain Name.
 - ii) the Respondent has utilised the Domain Name to direct visitors to the site to its existing Domain Name **MEGATILT.NET**.
 - iii) the Respondent does not have any proprietary right to use the Domain Name as it obtained the Domain Name when it had no legitimate interest, such interest only arising three months after the registration of the Business Name.
 - iv) the Respondent does not directly use the Domain Name, it is only being used to redirect traffic to the Respondent's website at **MEGATILT.NET**. As a result the Domain Name is being used as a redirection and there is no bona fide reason for the continued retention of the Domain Name. The Domain Name and **MEGATILT.NET** Domain Name both contain "the well established mark of the Complainant" and utilising this to its advantage.
 - v) the use of the Domain Name by the Respondent is likely to cause confusion as to the "source, sponsorship, affiliation or endorsement". Also, there is a likelihood of confusion as to the description of goods and services provided, especially in the light of the emails used by the Respondent containing C's Trade Mark.

FACTS ALLEGED BY THE RESPONDENT

- 4.16 The Respondent was incorporated and became an Australian Registered Company on 3 February 2014, the date upon which it obtained the Domain Name and, accordingly, acquired and used the Domain Name pursuant to the Rules.
- 4.17 The Respondent agrees that the Domain Name is identical or confusingly similar to C's Trade Mark.
- 4.18 The Respondent has rights and legitimate interests in the Domain Name upon the following reasons:-
- i) JAH is a related Body Corporate to the Respondent and is the legal beneficial owner the business "**MEGA TILT**" having purchased such business 3 July 2014. The purchase included the the business assets operating under the name "**MEGA TILT**" and all associated IP including Domain Names and Trade Marks ("the business").
 - ii) JAH and the Respondent share the same Director/s and are under common control and, accordingly, are related Bodies Corporate.
 - (iii) Absolute registered the business name "**megatilt.net**" on 5 December 2010 and utilised such Domain Name from at least 2012. Thereafter such Domain Name was used for advertising the services of Absolute.

- (iv) The Respondent registered the Domain Name on 3 February 2014 on behalf of JAH in anticipation of the purchase of the business operating under the name of ‘**MEGA TILT**’ from Abbsolute, which was utilising such name in the operation of its business.
- (v) On 20 May 2014 the Respondent registered the Business Name “**MEGATILT HEAVY HAULAGE**” on behalf of JAH, also in anticipation of the purchase of the Business.
- (vi) On 30 June 2014 Abbsolute lodged a Trade Mark Application for “**MEGA TILT**” being in a different class to that of the Respondent’s Trade Mark, such Application was accepted without an Examiner’s report and is pending.
- (vii) On 4 August 2014 the beneficial interest in the name and mark “**MEGA TILT**” in respect to the business of Abbsolute vested in JAH. The Respondent sets out its response to the Complainant in paragraphs 19 to 25 inclusive in its Response and also notes that there are various business names registered being “**MEGA TILT**” in Western Australia and also a business name registration and “**NT MEGA TILT TRADE SERVICE**” has also been registered.
- (viii) The Respondent denies that the Domain Name has been registered or is being used in bad faith and sets out its reasoning in paragraph 33 to 34 inclusive in its Response.

5 Discussion

JURISDICTION

5.1 Paragraph 2.1 of the auDRP states:

“All Domain Name licences issued in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP.”

5.2 The Domain Name is an open 2LD within the scope of the aforementioned paragraph. It was registered with the Registrar in October 2007. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP.

Basis of Decision

5.3 Paragraph 15(a) of the Rules state:

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

5.4 Paragraph 4(a) of the Policy provides that a person is entitled to complain about the registration or use of a Domain Name where:

- i) the Domain Name is identical or confusingly similar to a name, Trade Mark or service mark in which the complainant has rights; and*

- ii) *the respondent to the complaint has no rights or legitimate interests in respect of the Domain Name; and*
- (iii) *the respondent's Domain Name has been registered or subsequently used in bad faith.*

I note that all three components of Paragraph 4(a) are required to be proven for any Complaint to be upheld.

i) Domain Name is identical and confusingly similar to names or Trade Marks

5.5 I have compared the Domain Name with the Domain Name required by JAH (“**megatilt.net**”) and note that it is identical to the Trade Mark Application lodged 16 July 2014. It is also utilised by the Respondent and its business name “**MEGATILT HEAVY HAULAGE**”. However, it is also similar to the various Domain names containing C’s Trade Mark referred to in paragraph 4.3 above and is also identical to C’s Trade Mark. The Domain Name is also similar to various other similar names referred to in paragraph 4.18 (vii) above. However, as the Complainant owns a registered Trade Mark identical to the Domain Name then I find clause 4 (a) (i) requirement satisfied.

Note, however, that the second and third requirements of the Policy are to be satisfied and I refer to my comments below. Clearly, in this instance, both the Complainant and the Respondent (and others) could all claim that the Domain Name is confusingly similar.

ii) Respondent has no rights or legitimate interests in respect of the Domain Name

The associate of the Respondent entered into a Contract to purchase, inter alia, intellectual rights including Domain Names associated with the Business. The associated company of the Respondent registered the Domain Name in anticipation of completion of such business. J’s Trade Mark was lodged for registration and has been accepted. The Respondent carries on a business with names associated with the Domain Name. The Respondent utilises the Domain Name for bona fide business purposes.

iii) The Domain Name was registered or was being used in bad faith

As set out in the previous paragraph, the Respondent intended to utilise and, in fact, utilised the Domain Name in association with the Business. It has not been shown that it intends to obtain any of the Complainant’s business (which, it is noted, is a different business). No evidence has been provided that the Respondent’s registration of the Domain Name would disrupt any person’s business or activities.

Accordingly, I find no evidence of bad faith in respect to the registration of the Domain Name by the Respondent.

6 Decision

6.1 Accordingly, I find that the Respondent has bona fide used or prepared to use the Domain Name corresponding to the business with a similar name which offers goods and services. There is no evidence submitted to me that the Respondent is using the Domain Name to trade

off the Complainant's Trade Mark rights and is clearly using it for legitimate commercial and fair use.

- 6.2 As a result of the matters raised above, I find that the Respondent does have rights or legitimate interests in respect of the Domain Name. However, this is subject to the Panel determining that the Domain Name was not registered or was not being used in bad faith.
- 6.3 For the reasons set out above, I find that the Domain Name was not registered or was not being used in bad faith.
- 6.4 The Policy provides that there are no proprietary rights in the Domain Name system, a Registrar does not own a Domain Name, but merely holds a licence to use such Domain Name for a specified period of time. Here, it is clear that the Complainant did have the right to use the Domain Name. However, unfortunately, the registration was not renewed and, accordingly, lapsed.
- 6.5 I find that when a Domain Name lapses there is no registration and, accordingly, Schedule A 1 applies in that the Domain Licence may be allocated on a "first come, first served" basis.
- 6.6 The Respondent, accordingly, was entitled pursuant to the Rules to make application and to obtain the Domain Name.
- 6.7 Furthermore, only the first of the three components of paragraph 4 (a) as referred to in paragraph 5.5 hereof has been satisfied, whereas all three components are required to be proven, which I do not find proven in this matter.
- 6.8 For the above reasons, I direct that the Respondent is entitled to use the Domain Name and the Complaint should be dismissed.

Dated this 24th September 2014.

Dennis Liner

Panelist