

ADMINISTRATIVE PANEL DECISION

LEADR Case No. auDRP_14_14

Domain Names: <messageonholdgoldcoast.com.au>, <messageonholdbrisbane.com.au>, <messageonholdperth.com.au>, <messageonholdsydney.com.au>, <messageonholdadelaide.com.au> and <messageonholdmelbourne.com.au>.

Name of Complainant: Messages on Hold Australia Pty Ltd, ACN 009 438 528

Name of Respondent Media Group Pty Ltd
ACN: 131 594 057

Provider: LEADR

Panellist: The Honourable Neil Anthony Brown QC

THE PARTIES

The Complainant is Messages on Hold Australia Pty Ltd, ACN 009 438 528 of 21 Moore Street, East Perth, WA, 6004.

The Respondent is Media Group Pty Ltd
ACN: 131 594 057 of 2/2 Spencer Road, Nerang, Qld, 5211

THE DOMAIN NAMES, REGISTRAR AND PROVIDER

The disputed domain names are <messageonholdgoldcoast.com.au>, <messageonholdbrisbane.com.au>, <messageonholdperth.com.au>, <messageonholdsydney.com.au>, <messageonholdadelaide.com.au> and <messageonholdmelbourne.com.au> (“the disputed domain names”), which are registered with TPP Wholesale Pty Ltd.

LEADR is the Provider in relation to this administrative proceeding.

PROCEDURAL HISTORY

The Complaint was submitted for decision in accordance with the auDRP Policy (“the Policy”), the auDRP Rules (“the Rules”) that were approved by auDA in 2001 and commenced operation on August 1, 2002 and the Provider’s Supplemental Rules.

The Provider received the Complaint on December 4, 2014 and an acknowledgement of receipt of complaint was emailed to the Complainant on November 14, 2014. A copy of the complaint was sent to the Respondent.

On December 8, 2014, 2014 a copy of the complaint was submitted to the Registrar by email together with a request to clarify the Respondent details and to lock the domain name during proceedings.

On December 10, 2014 the Registrar confirmed to the Provider that the Domain Name had been locked.

On December 10, 2014 LEADR advised auDA of the complaint via e-mail.

On December 10, 2014 the Provider sent the Respondent by email a written notification of the Complaint. The Complainant was advised of these notifications.

The due date for filing of the Response to the Complaint was determined to be December 31, 2014.

On December 20, 2014 the Respondent filed a Response to the Complaint.

On December 22, 2014 the provider approached the Panellist; the Panellist confirmed to LEADR that he was available, was in a position to accept the matter and had no conflict issues with the parties and accepted the matter on December 23, 2014.

The Panel is satisfied that it was properly appointed.

The case file and relevant correspondence was forwarded onto the Panellist on December 23, 2014.

The parties to the dispute were notified of the Panellist's allocation on December 23, 2014.

The date on which the decision is due is January 7, 2015.

FACTUAL BACKGROUND TO THE DISPUTE

The factual background to the dispute appears sufficiently from the submissions of the parties.

PARTIES' CONTENTIONS

THE COMPLAINANT

A. The Domain Names are identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

(Policy, para. 4(a)(i), Rules, paras. 3(b)(viii), (b)(ix))

The Complainant is the owner of the following Australian registered trademarks.

- 9.1 Australian trademark number 952389 is a composite image of a logo and the words MESSAGES ON HOLD AUSTRALIA and is registered in the following classes of goods and services:
- Class: 9** Digital announcers, digital memory chips for storing audio, answering machines that play downloaded recorded announcements mixed with music; and
- Class: 35** Recording services namely recording announcements read from customised script for advertising and promotional purposes.
- 9.2 Australian trademark number 952462 is a composite image of a logo and the words MESSAGES ON HOLD and is registered in the following classes of goods and services:
- Class: 9** Digital announcers, digital memory chips for storing audio, answering machines that play downloaded recorded announcements mixed with music; and
- Class: 35** Recording services namely recording announcements read from customised script for advertising and promotional purposes.
- 9.3 Australian trademark number 1202729 is a logo bearing the words MESSAGES ON HOLD and is registered in various classes of goods and services, namely Class 9, relating to audio services, Class 38 relating to transmission and Class 38 relating to distribution.
- 9.4 Copies of each of the trademark details obtained from IP Australia's trademark database ATMOSS are attached as **Annexure 9** to this Complaint.
- 9.5 As the owner of the registered trademarks above (**Trademarks**), the Complainant has an exclusive right to use the Trademarks and to authorise other persons to use the Trademarks in relation to the goods and services in respect of which the Trademarks are registered.
- 9.6 The Respondent's Domain Names are confusingly similar to the Complainant's Trademarks comprising a logo and the words MESSAGES ON HOLD AUSTRALIA, a logo and the words MESSAGES ON HOLD and a logo bearing the words MESSAGES ON HOLD, as the Domain Names contain the phrase 'MESSAGEONHOLD'.
- 9.7 In the Complainant's view, the omission of the final 'S' from the word 'MESSAGES' within the phrase 'MESSAGEONHOLD' should not preclude a finding by the Panel Member that the Domain Names are confusingly similar to the Trademarks.
- 9.8 The Complainant's website (accessible at www.messagesonhold.com.au) features the Complainant's Trademark comprising a logo bearing the words

'MESSAGES ON HOLD'. The Trademark is prominently displayed on the banner at the top of every page of the Complainant's website. The Complainant's name Messages on Hold Australia Pty Ltd is displayed at the bottom of the web pages, indicating that there is a connection between the Trademark and the Complainant. A set of copies of screenshots from the Complainant's webpage pages are attached as **Annexure 10** to this Complaint.

- 9.9 If an objective bystander were to be presented with both the words of the disputed Domain Names (but more specifically the phrase 'MESSAGEONHOLD' that is a common feature between them all) and the words of each of the registered Trademarks he or she would probably conclude that the Domain Names were referring to the registered Trademarks, and hence to the Complainant's business.
- 9.10 There are no sufficiently distinguishing features between the Domain Names and the Trademarks to dispel the likely confusion which could occur: the omission of an 'S' and the addition of geographical suffixes to the words does not prevent the Domain Names from being confusingly similar to the Complainant's Trademarks.
- 9.11 The Respondent's Domain Names are, therefore, substantially identical or confusingly similar to the Complainant's Trademarks for the purposes of clause 4(a)(i) of the Policy.

B. The Respondent has no rights or legitimate interests in respect of the Domain Names;

(Policy, para. 4(a)(ii), Rules, para. 3(b)(ix))

- 9.12 Because the Complainant has established that it is the registered owner of the Trademarks, the Respondent cannot establish that it has any rights or legitimate interests in respect of the Domain Names.
- 9.13 For more than 25 years the Complainant has provided on-hold message services under the name 'Messages On Hold'. During that time, it has grown to be the largest on-hold services provider in Australia, has a strong presence in South East Asia and has developed a substantial and identifiable reputation in its name and Trademarks. The Complainant advertises broadly throughout Australia, and overseas in countries such as Singapore. A screen print showing the Complainant's contact details in these countries can be found within **Annexure 10** to this Complaint.
- 9.14 The Complainant is widely known for its contribution to community services, being a regular supporter of charities, such as the Salvation Army Christmas Appeal, ACT for Kids, Mission Australia Osborne Park, the Telethon Speech

and Hearing Centre, TLC for Kids, the Yirra Yaakin Noongar Theatre and Youth Focus.

- 9.15 The Complainant is also a proud sponsor of the West Coast Eagles. By virtue of that sponsorship, it is entitled to display signs bearing its Trademarks at Patersons Stadium, a sporting ground in Western Australia. A set of copies of images displaying the Trademarks at the venue are attached as **Annexure 11** to this Complaint.
- 9.16 Advertisements bearing the Complainant's Trademark and interviews promoting the Complainant's goods and services have also been featured on numerous television programs, such as 'The Footy Show' and the 'Today Show'. Examples of some of the video footage can be viewed online at <http://www.messagesonhold.com.au/in-the-media>.
- 9.17 Like the Complainant, the Respondent provides on-hold message services in Australia, however, it trades through an entity called Media Group Pty Ltd. The Respondent's business is branded as an entity called 'Phone Sound'. The Respondent's website at <http://www.phonesound.com.au/messages-on-hold.php> (**Phone Sound Website**) clearly displays the name Phone Sound. A screenshot of that website is attached as **Annexure 12** to this Complaint.
- 9.18 From the Phone Sound Website there are a set of links to the following ancillary pages:
- 12.18.1 Message on Hold Gold Coast;
 - 12.18.2 Message on Hold Brisbane;
 - 12.18.3 Message on Hold Sydney;
 - 12.18.4 Message on Hold Melbourne;
 - 12.18.5 Message on Hold Adelaide; and
 - 12.18.6 Message on Hold Perth.
- A screenshot of the links in question is attached as **Annexure 3** to this Complaint.
- 9.19 Upon clicking on each of these links, the user is directed to a corresponding webpage, which is accessed through the relevant Domain Name. For example, by clicking on Message on Hold Gold Coast, the user will be directed to the page accessible at messageonholdgoldcoast.com.au. A set of copies of each of the numerous pages is attached as **Annexure 13** to this Complaint.

- 9.20 Neither the use of the phrase 'MESSAGEONHOLD' or the use of the distinct words 'MESSAGE ON HOLD' were ever authorized by the Complainant.
- 9.21 The Complainant did not authorise or give permission to the Respondent to register the Domain Names incorporating the phrase 'MESSAGEONHOLD'.
- 9.22 There are no records in the ATMOSS trademark database that the Respondent has registered any trademarks bearing the phrasing 'MESSAGEONHOLD'. Neither are there any records showing the Respondent had registered any other mark.
- 9.23 By virtue of the reasons set out above, the Respondent's use of the Domain Names amounts to an illegitimate non-commercial use. Accordingly, the Respondent has no rights or legitimate interests in respect of the Domain Names pursuant to clause 4(a)(ii) of the Policy.

C. The Domain Names were registered or are subsequently being used in bad faith.
(Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix))

- 9.24 The Respondent's use of the Domain Names constitutes passing off in light of the Complainant's well established and identifiable reputation in the words 'Messages On Hold' of over 25 years.
- 9.25 As a competitor, it is unlikely that the Respondent was not aware of the Complainant's reputation and goodwill in its business. The fact that the Respondent registered the Domain Names on 7 and 8 November 2012 and that there is no evidence of its prior or concurrent use of the words 'message on hold', proves it is using the Domain Names in bad faith.
- 9.26 It is obvious that consumers may make a connection with the Respondent's Domain Names and the Complainant's Trademarks, being the trademarks bearing the logo and words MESSAGES ON HOLD AUSTRALIA, the logo and words MESSAGES ON HOLD and a logo bearing the words MESSAGES ON HOLD. The Respondent is therefore misrepresenting to consumers that there is a connection between the Complainant and the Respondent, and this is likely to damage the Complainant's business reputation by reason of its perceived affiliation with the Respondent.
- 9.27 What is arguably more serious is this Complaint is not the first instance of legal steps having been taken against the Respondent or its directors by the Complainant. On 13 March 2013 a complaint was submitted to LEADR on behalf of the Complainant in respect of the following domain names which had been registered by the Respondent:
- 9.27.1 messagesonholdperth.com.au;
- 9.27.2 messagesonholdbrisbane.com.au;

- 9.27.3 messagesonholdsydney.com.au;
9.27.4 messagesonholdmelbourne.com.au; and
9.27.5 messagesonholdadelaide.com.au.
- 9.28 In that case orders were made by a LEADR Panelist on 16 April 2013, compelling the domain names listed at [9.27.1-5] above to be transferred to the Complainant. Mr Loftus was reminded of this by letter of 26 September 2014, but elected not to comply with the Complainant's cease and desist demand, despite understanding the seriousness with which it will protect its brand and Trademarks. A copy of that letter is attached as Annexure 4 to this Complaint. The fact that the Respondent has persisted in utilizing the Domain Names in circumstances where the infringement of the Complainant's rights is ultimately a continuation of an earlier one, further evidences that the Respondent is acting in bad faith.
- 9.29 By having registered the Domain Names, the Respondent is also preventing the Complainant from utilizing the Complainant's registered Trademarks in corresponding Domain Names. The Complainant and Respondent are in direct competition and both rely on their websites to attract potential clients and provide information to clients in respect of their goods and services. The Respondent's use of the Domain Names is intended to prevent the Complainant from using the Domain Names.
- 9.30 There is no reason why the Respondent could not transfer the disputed Domain Names to the Complainant given that it has no entitlement to use them, and that it also uses Phone Sound Website for the basis of its online operations.
- 9.31 Accordingly, the Panel should infer that the Respondent has registered and is using the Domain Names listed at [8] above in bad faith pursuant to clause 4(a)(iii) of the Policy.

THE RESPONDENT

1. The Policy

The domain name(s) is identical or confusingly similar to a trademark, or service mark in which the complainant has rights.

Our Position:

Before we registered the domain names that are in dispute we were mindful that the complainant had been unsuccessful in getting a trade mark for the

words as the Trade Marks Office was of the view that they had no exclusive rights in the words "messages on hold"

The decision of the Trade Marks Office in relation to the opposition is set out in M2 Technology Pty Ltd v Messages on Hold Pty Ltd [2007] ATM57 (10 September 2007). In this decision, Iain Thompson, the Delegate of the Registrar of Trade Marks, found that due to the general use of the expression 'messages on hold' as a descriptive term within the relevant industry, this expression has no inherent adaptation to distinguish your goods and services. It is interesting to note the Delegate's statement in the decision at paragraph 24 that: 'There is also no doubt from the evidence before me that the applicant has attempted to enforce what it perceives as its rights in the plain words MESSAGES ON HOLD against various other traders. However, the success with which it has apparently done so is in the absence of judicial finding in its favour and might be explained in large part by the slowness of traders to involve themselves in expensive litigation rather than an appreciation of any rights in the expression MESSAGES ON HOLD.'

The Delegate went on to decide that despite your client's use of the expression 'messages on hold', these words are not capable of distinguishing your client's goods and services from those of other traders. Further, that the evidence shows that the words are in widespread use by many traders in relation to the relevant goods and services.

In light of this, the claim that the 5 domains names infringe on the composite marks through its use of the words 'message on hold' is clearly an overstatement and may even constitute groundless threats of legal proceedings in breach of s 129 of the Trade Marks Act 1995 (Cth).

We therefore contend that we have not breached this element of the Policy in that the complainant has no exclusive rights.

2. The Policy

You have no rights or legitimate interests in respect to the domain name

Our Position

In September 2012 we agreed to hand over the domain name messagesonholdaustralia.com.au because this name was the same as the complainant's company trading name, and we believed we were acting in good faith to release it. In 2013 we were then required by Messages On Hold Australia's legal team to hand over our domain names that contained "**messagesonhold**". After they successfully won rights to take these domains we handed them over. Another year later they are attacking more of our domains and in this case domains that contain "**messageonhold**". Messages On Hold Australia's trade mark logo does contain the words MESSAGES ON HOLD but where is the line drawn as to the different definitions that may resemble a product that is used worldwide which contain similar words? Media Group is simply using a domain name that represents its core product and in no way does it reflect or mislead visitors to believe that we are Messages On Hold Australia. You simply need to visit one of the domain names in dispute to realise that it has nothing to do with Messages On Hold Australia or resemble its trade marked logo. Our legitimate interest in a domain name that has "message on hold" in it is because it reflects the nature of our core business.

The domain names that are in dispute are not company trading names and we have been heavily influenced by the Registrar of Trademarks, who, as referenced in the case above involving the complainant, found that due to the general use of the expression " messages on hold as a descriptive term within the relevant industry, this expression has no inherent adaptation to distinguish your client's goods and services".

We therefore contend that we are using a descriptive term that is widely used in a specific industry that is worldwide, it is core to our business, and it not misleading towards the complainant's trade mark logo.

3. The Policy

The domain name has been registered and is being used in bad faith

These domain names were registered because they contain those descriptive names of our core products and services rather than to deceive the market place that we are Messages On Hold Australia Pty Ltd. This is proven when you click on the link and go to our web page- and clearly discover the Phone Sound website.

Once again we revert to the findings of the Registrar of Trade Marks reference above and add that a quick Google search of various countries including the USA, UK and Australia shows evidence of the widespread use of the term "message on hold". Please also refer to the below response to Lavan Legal that clearly shows other Australian competitors that use the same and similar words in their domain names and throughout their website contents. Appendix 1a highlights a competitor using the domain **messageonhold.com.au** which we feel has, if any, more interest into the complainant's case.

3. Conclusion

We have acted in good faith including when asked to release one of our domain names in 2012. The creation of domains with the words "message on hold" was done because we understood it was consistent with findings of the Trade Marks Office and would also satisfy the requirements of the ICANN Policy.

We wish to retain them. (End of submission).

The Panel now proceeds to consider the issues and evidence in this proceeding.

CHRONOLOGY AND GENERAL ASSESSMENT OF THE EVIDENCE

A short chronology of events may make clear the Panel's overall response to the evidence and submissions of the parties and the reasons why the Panel has concluded on the balance of probabilities that the Respondent's intention was to take the Complainant's trademark and to use it improperly to confuse the internet public and divert business away from the Complainant and towards the Respondent. The salient events and dates to bear in mind when considering the issues are:

7 February 1990. Complainant registered as a company. Certificate of registration given date of 12 July 1991.

2 May 2003. Complainant's MESSAGES ON HOLD AUSTRALIA trademark lodged and subsequently registered.

2 May 2003. Complainant's MESSAGES ON HOLD trademark lodged and subsequently registered.

10 September 2007. Remarks of delegate of Registrar of Trademarks in *M2Technology Pty Ltd v. Messages on Hold Pty Ltd* (2007)ATM0 57 (10 September 2007) on the expression "messages on hold."

4 October 2007. Complainant's MESSAGES ON HOLD trademark lodged and subsequently registered.

20 September 2011 and 30 September 2011; Respondent registered domain names being the subject of a previous proceeding, namely < messagesonholdbrisbane.com.au>, <messagesonholdperth.com.au>, <messagesonholdsydney.com.au>, <messagesonholdadelaide.com.au> and <messagesonholdmelbourne.com.au>.

September 2012. Respondent agrees to transfer the domain name <messagesonholdaustralia.com.au> to the Complainant¹.

7 and 8 November 2012. Disputed domain names in the present proceeding registered.

13 March 2013. Prior Complaint filed by the Complainant ² seeking transfer of the domain names < messagesonholdbrisbane.com.au>, <messagesonholdperth.com.au>, <messagesonholdsydney.com.au>, <messagesonholdadelaide.com.au> and <messagesonholdmelbourne.com.au> from the Respondent to the Complainant.

16 April 2013. Decision and Order made by panellist in *Messages on Hold Australia Pty Ltd v. Media Group Pty Ltd*, LEADR Case No. auDRP_13_01 that the Respondent transfer the domain names < messagesonholdbrisbane.com.au>, <messagesonholdperth.com.au>, <messagesonholdsydney.com.au>, <messagesonholdadelaide.com.au> and <messagesonholdmelbourne.com.au> to the Complainant.

26 September 2014. Letter of demand from Complainant's solicitors to Respondent requiring transfer of the domain names in the present proceeding, namely <messageonholdgoldcoast.com.au>,< messageonholdbrisbane.com.au>, <messageonholdperth.com.au>, <messageonholdsydney.com.au>, <messageonholdadelaide.com.au> and <messageonholdmelbourne.com.au> from the Respondent to the Complainant.

December 4, 2014. Present Complaint filed.

¹ Source: Response of Respondent, 18 December 2014.

² *Messages on Hold Australia Pty Ltd v. Media Group Pty Ltd*, LEADR Case No. auDRP_13_01.

DISCUSSION OF THE ISSUES

Pursuant to Rule 15 of the Rules, a Panellist is required to 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 the Panellist deems applicable.

Paragraph 4(a) sets out those matters that are required to be established by a Complainant, namely that

- (i) (the Respondent's) domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (ii) (the Respondent) has no rights or legitimate interests in respect of the domain name; and
- (iii) (the Respondent's) domain name has been registered or subsequently used in bad faith."

All of the elements of paragraph 4(a)(i), (ii) and (iii) must be met and the Complainant bears the onus of proof in this respect.

The Panel now turns to examine the various elements of paragraph 4(a) in turn.

Identical or confusingly similar.

The Complainant's case is that it has a trademark or service mark in which it has rights and that the disputed domain names are "substantially identical or confusingly "to that trademark. In support of that submission, the Complainant adduced evidence of three Australian trademarks, namely Nos 952389, 952462 and 1202729, details of which are set out above, for MESSAGES ON HOLD AUSTRALIA, MESSAGES ON HOLD and MESSAGES ON HOLD. The Panel accepts that evidence.

The Panel therefore finds that the Complainant has registered trademark rights. However, as one of the trademarks, No 952389, for MESSAGES ON HOLD AUSTRALIA, is in words similar to the wording of the disputed domain names, the Panel need concern itself only with that trademark, as it is sufficient to establish by a single trademark the Complainant's rights and its standing to make the present Complaint.

The Complainant therefore has a "trademark or service mark in which the complainant has rights", pursuant to paragraph 4(a) (i) of the Policy. Consequently, it has rights to bring the present application with respect to the disputed domain names.

The next question that arises with respect to each of the disputed domain names is whether they are identical or confusingly similar to the Complainant's MESSAGES ON HOLD AUSTRALIA trademark.

The Panel finds that each of the domain names <messageonholdgoldcoast.com.au>,<messageonholdbrisbane.com.au>, <messageonholdperth.com.au>, <messageonholdsydney.com.au>, <messageonholdadelaide.com.au> and <messageonholdmelbourne.com.au> is confusingly similar to the Complainant's registered

trademark for MESSAGES ON HOLD AUSTRALIA .That is so because if an objective bystander compared the domain names with the trademark, he or she would naturally conclude that, for example, the first domain name, <messageonholdgoldcoast.com.au> , relates to the Complainant and its business on the Gold Coast of Australia and would reach a similar conclusion with respect to each of the other domain names. Indeed it is difficult to see how an objective bystander could reach a different conclusion.

Nor is it of any consequence that the domain names invoke the notion of a single message whereas the trademark has a concept of multiple messages. That is so because the test is how an objective bystander would see the domain names and the trademark and that test is determined by the substance or the thrust of the message conveyed by each. Accordingly, it has often been held in the context of the UDRP as well as the auDRP that a singular domain name may still convey the same substance as a pluralised trademark because it will be assumed that they are both referring to the same object and either one or more of them. In the present case, the substance of both the domain names and the trademark is the notion of messages for telephone users whether they consist of a single message or multiple messages.

The Complainant has thus made out the first of the three elements that it must establish.

Rights or legitimate interests

The question here is: does the Respondent have a right or legitimate interest in respect of the disputed domain names.

It is now well established that the Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain names under paragraph 4(a)(ii) of the Policy and then the burden shifts to Respondent to show it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); *see also AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

The Panel finds that the Complainant has established a *prima facie* case as required. This is based on the following considerations:

- (a) the Respondent has chosen to take the Complainant’s trademark MESSAGES ON HOLD AUSTRALIA and to use it in its domain names which are confusingly similar to the trademark, making as the only alteration to the trademark the omission of the word “Australia” and the addition of a geographic indicator which is the name of a city or region of Australia, thus giving the impression that the domain names are official domain names of the Complainant and that they will lead to a

- website that is an official website of the Complainant dealing with the Complainant's activities in the places specified ;
- (b) the Respondent has then used the domain names to lead internet users to the Respondent's own websites which are at www.messageonholdgoldcoast.com.au and ,with appropriate amendments, at the respective website incorporating the other geographic identifiers , and which promote on-hold message services as does the Complainant, services which are clearly in competition with the Complainant;
 - (c) the Respondent has engaged in these activities without the knowledge or consent of the Complainant.

Having established that there is a *prima facie* case against the Respondent it remains to be seen if the Respondent can rebut it and establish that it does in fact have a right or legitimate interest in the domain names.

The case advanced by the Respondent to show that it has such a right or legitimate interest is unpersuasive and the Panel does not accept it. The Respondent's submission is in effect that it devised the domain names because they represent the Respondent's core product, or, as the Respondent elaborated on the point, the domain names are descriptive terms with no specific invocation of the goods or services of the Complainant. In that regard, the Respondent places great reliance on a decision of a delegate of the Registrar of Trade Marks in a 2007 proceeding³ to the effect that "messages on hold" is a descriptive term which does not distinguish the goods and services of a particular party.

It should also be added that another submission of the Respondent is that the domain names in no way "reflect or mislead visitors to believe that we are Messages On Hold Australia. You simply need to visit one of the domain names in dispute to realise that it has nothing to do with Messages On Hold Australia or resemble its trade marked logo."

The Panel does not accept any of these submissions. First, the domain names may be a description of the Respondent's business as the Respondent claims and that is often used as the basis of a right or legitimate interest in a domain name. It is a principle that is often put along the lines that if the domain name is generic, or if it consists of common or dictionary words, the registrant has a right to use it as a domain name even if the complainant has a trademark in the same words, provided that the domain name is not used to target a trademark owner, mislead internet users or direct them away from the complainant's website and towards the respondent's website. But that is exactly what has happened here; the Respondent has registered the domain names using the dominant and substantive part of the Complainant's trademark and then linked them to its own websites where they are used to promote a rival business run under a different name from either the Complainant's or the Respondent's name, a process that takes inquiries away from the Complainant, directs them to the Respondent and offers them the same but a competing service as the Complainant. The Panel finds that this process has real potential to mislead internet users into thinking that they have arrived at the Complainant's website or that the website they have arrived at is part of the Complainant's enterprise or endorsed by it when that is not the

³ *M2Technology Pty Ltd v. Messages on Hold Pty Ltd* (2007)ATM0 57 (10 September 2007).

case and is misleading. The Panel also draws the inference that it was the Respondent's intention when it registered the domain names to bring about that result.

Secondly, the remarks of the delegate of the Registrar of Trade Marks are of course noted and should be treated with respect, but they do not strengthen the Respondent's case. The remarks were made in different proceedings; the Complainant undoubtedly has been issued with several valid trademarks that are entitled to protection and domain names that are used improperly, as in the present case, for targeting a trademark owner or misleading internet users cannot give rise to a right or legitimate interest, no matter how generic or descriptive they are. The Panel should also note here that it agrees with the whole of the decision by the panellist in *Messages on Hold Australia Pty Ltd v. Media Group Pty Ltd*, LEADR Case No. auDRP_13_01 on 16 April 2013 when it considered the significance of the delegate's remarks in the context of the Complainant's claim to other domain names held by the Respondent and in particular the panel's observations as follows:

"The fact that the three Trade Mark names were subsequently registered means that on three separate occasions these Trade Marks did not contain the flaws that Mr Thompson apparently saw at an earlier time. Once the subject Trade Marks were registered their registration has the opposite effect to what the Respondent is arguing for. "

Thirdly, the Panel does not accept the argument of the Respondent that the domain names in no way "reflect or mislead visitors to believe that we are Messages On Hold Australia." The Panel's view is that the domain names would have exactly the effect that the Respondent denies. They use the Complainant's trademark that embodies its name and business name which the Complainant has used in this industry for over 20 years and divert internet users seeking the Complainant, deflect them to the Respondent's websites, offer a competing service and do this by conduct that is potentially misleading. In any event it is disingenuous for the Respondent to mount its argument when it is the Respondent itself who has devised the whole process and directed hits on the domain names to be diverted to the Respondent's own websites that promote a rival business.

The Respondent has also advanced an argument that it has a right or legitimate interest in the domain names because the Complainant's trademark contains the plural "messages", whereas the disputed domain names contain the singular "message". That is a distinction without a difference; the Respondent has no right to use another's trademark in a domain name, not only where the domain name is in the identical words of the trademark, but also where it is open to being confused with the trademark, as is the case here.

Nor is there any evidence to show that the Respondent can bring itself within any of the criteria in paragraph 4 (c) of the Policy that may be relied on to show a right or legitimate interest in a domain name, namely that the Respondent was using the domain name for a *bona fide* offering of goods or services; that the Respondent is commonly known by the domain name; or that it is making a legitimate non-commercial or fair use of the domain name. All of the evidence is to the contrary of each of those criteria.

Nor is there any other ground relied on by the Respondent.

The Respondent has therefore not rebutted the *prima facie* case against it. The Complainant has thus made out the second of the three elements that it must establish.

Registration or use in bad faith

The foregoing observations apply equally to this, the third issue and there is no need to repeat them here, for the lack of a right or legitimate interest in the domain names shows that they were registered and have been used in bad faith. The evidence leads to the conclusion that the Respondent both registered and has used the domain names in bad faith, although only one or the other of those criteria must be established under the Policy.

It is also clear that the criteria set out in Paragraph 4(b) for establishing bad faith are not exclusive, but that complainants in auDRP proceedings, as with UDRP proceedings, may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Having regard to those principles, the Panel finds that the disputed domain names were registered and used in bad faith. That is so for the following reasons.

First, the conduct of the Respondent and the clear intention behind it brings the case within paragraph 4(b)(ii) of the Policy for the intention of the Respondent must be inferred to have been to prevent the Complainant from becoming the registrant or owner of the domain names <messageonholdgoldcoast.com.au>, <messageonholdbrisbane.com.au>, <messageonholdperth.com.au>, <messageonholdsydney.com.au>, <messageonholdadelaide.com.au> and <messageonholdmelbourne.com.au>. The Panel draws the conclusion from the evidence that the Respondent registered the domain names so as to prevent the Complainant from using the dominant and substantive part of its trademark in domain names that invoke its services in specified regions and capital cities in Australia. That is clearly bad faith as defined.

Secondly, the facts also come within paragraph 4(b)(iii) of the Policy, because the equally clear intention of the Respondent in registering and using that domain name must have been to disrupt the Complainant's business by taking its name and product name, entice internet users on their way to visit the Complainant's site to go to the Respondent's sites instead and then to try to sell them the same or similar on -hold message products that they were minded to buy from the Complainant, so that the Complainant's business was thereby damaged. This is also clearly bad faith as defined.

Thirdly, the facts also bring the case squarely within paragraph 4(b) (iv) of the Policy as the intention in using the domain names was clearly to confuse internet users into believing that the Respondent's website was in fact the Complainant's site or that the site was approved by the Complainant or endorsed by it and that the products being offered were those of the Complainant or were being sold with its endorsement, all of which were false. This is also clearly bad faith as defined.

In addition to the specific provisions on bad faith in the Policy, and having regard to the totality of the evidence, the Panel finds that, in view of the Respondent's registration and use of the disputed domain names using the MESSAGES ON HOLD AUSTRALIA mark and in view of the conduct that Respondent has engaged in when using them, Respondent both registered and used the disputed domain names in bad faith within the generally accepted meaning of that expression.

The Complainant has thus made out the third of the three elements that it must establish.

FINDINGS

The Panel makes the following findings:

1. The Complainant has established each of the three elements of Paragraph 4 of Schedule A of the auDRP with respect to the domain names <messageonholdgoldcoast.com.au>,< messageonholdbrisbane.com.au>,<messageonholdperth.com.au>, <messageonholdsydney.com.au>,<messageonholdadelaide.com.au> and <messageonholdmelbourne.com.au>, namely:
 - (i) That the Domain Names are confusingly similar to a trademark in which the Complainant has rights; and
 - (ii) That the Respondent has no rights or legitimate interests in respect of the Domain Names; and
 - (iii) That the Domain Names were registered or have been used in bad faith.

RELIEF

The Complainant has requested that the Domain Names be transferred to it pursuant to Clause 6.1(b) of the Policy.

DECISION

I order and direct that the Domain Names <messageonholdgoldcoast.com.au>,< messageonholdbrisbane.com.au>, <messageonholdperth.com.au>,<messageonholdsydney.com.au>, <messageonholdadelaide.com.au> and <messageonholdmelbourne.com.au> be transferred to the Complainant.

The Honourable Neil Anthony Brown QC
Panelist

Date : January 5, 2015