



## **DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL**

**Case No. auDRP\_15\_03**

**Single Panelist Decision**

**Abel Concepts (Aust.) Pty Ltd v. Wooldridge Holdings Pty Ltd**

**<abelconcepts.com.au>**

### **THE PARTIES**

1. The Complainant is Abel Concepts (Aust.) Pty Ltd of Sunshine West, Victoria, Australia, represented by Aitken Partners, Solicitors of Melbourne, Victoria, Australia.
2. The Respondent is Wooldridge Holdings Pty Ltd of Cromer, New South Wales, Australia.

### **THE DOMAIN NAME, REGISTRAR AND PROVIDER**

3. The disputed domain name is <abelconcepts.com.au> ("the Domain Name"), registered with AussieHQ Pty Ltd ("the Registrar").
4. The Provider in relation to this proceeding is LEADR & IAMA, ABN 69 008 651 232.

### **PROCEDURAL HISTORY**

5. The Complaint was received by the Provider on May 5, 2015 and receipt was acknowledged that day. An amended complaint was received by the Provider on May 6, 2015 and receipt was acknowledged that day. Having found the amended complaint to comply with the .au Domain Name Dispute Resolution Policy ("the auDRP" or "the Policy"), auDA's Rules for the Policy ("the Rules") and the LEADR & IAMA Supplemental Rules for the Policy ("the Supplemental Rules"), on May 6, 2015 the Provider notified the Registrar of the Complaint, sought confirmation of the registrant details and asked that the Domain Name be locked. On May 12, 2015 the Registrar confirmed via email that the Respondent is the registrant and on May 25, 2015 that the Domain Name had been locked on May 14, 2015.
6. On May 12, 2015 the Provider advised auDA of the complaint and formally commenced the proceedings by sending written and emailed notification of the Complaint to the Respondent. The due date for a Response was June 1, 2015.

7. On June 1, 2015, the Respondent submitted a Response and on June 5, 2015 emailed the Provider to correct a typographical error in the Response, which the Panelist has taken into account.
8. On June 3, 2015 the Provider appointed Alan L. Limbury as Panelist. The Panelist is impartial and independent, having declared to the Provider, before accepting appointment, that there are no circumstances giving rise to justifiable doubt as to the Panelist's impartiality or independence.

## **FACTUAL BACKGROUND**

9. The Complainant manufactures and sells sporting equipment, including flags, flag poles, goal posts and coaches boxes. It was incorporated on June 25, 2002 under the name Abel Concepts (Aust.) Pty Ltd and has used the names Abel Sports and Abel Flags. Its website is at <www.abelsports.com.au>.
10. The Respondent registered the Domain Name on June 21, 2013. As of April 23, 2015 the Domain Name resolved to the website of PILA Group Pty Ltd at <www.pilagroup.com.au> offering sporting equipment including flag poles, goal posts and coaches boxes. The Respondent is a shareholder in PILA Group Pty Ltd.
11. A trademark search by the Panelist reveals that on July 15, 2013 the Complainant applied in Australia to register the trademark ABEL with respect to flags and goal posts in classes 24 and 28 and obtained registration of that mark on February 13, 2014.

## **PARTIES' SUBMISSIONS**

### **Complainant**

12. The Domain Name is identical and confusingly similar to the Complainant's company name. The Respondent has no rights or legitimate interest in the Domain Name, which the Respondent has registered or subsequently used in bad faith.
13. As to legitimacy, to the Complainant's knowledge the Respondent has not registered or applied to register any trademark, company name or business name reflecting the Domain Name. The Complainant has not authorized the Respondent to use the name Abel Concepts. As at the date of registration of the Domain Name the Respondent did not satisfy the Australian Domain Name Eligibility and Allocation Rules for Open 2LDS and the rules for com.au at Schedule C, in that the Domain Name did not exactly match or constitute an acronym or abbreviation of the Respondent's company or trading name, organization or association name or trademark and was not otherwise closely and substantially connected to the Respondent or PILA Group Pty Ltd.
14. To the Complainant's knowledge, the Respondent has not used the Domain Name or a name corresponding to the Domain Name in connection with an offering of goods and services and is using the Domain Name solely for the purpose of redirecting traffic to a domain name licensed to PILA Group Pty Ltd for the sale of its goods. The Respondent is not making a legitimate, non-commercial or fair use of the Domain

Name. The Respondent has no obvious on-line presence as Abel Concepts and is not actively engaged in any business as Abel Concepts.

15. As to bad faith, by the time the Respondent registered the Domain Name, the Complainant had already acquired substantial rights and established a reputation in the name Abel Concepts in Australia over a period of 11 years. The Respondent knew or ought to have known of the Complainant's rights to the name Abel Concepts because the Complainant was known to the Respondent which operates in direct competition. The Respondent registered, subsequently used and renewed the licence to the Domain Name in order to prevent the Complainant from obtaining the Domain Name, in order to redirect the public seeking the Complainant to PILA Group Pty Ltd by way of misleading and deceptive conduct, constituting bad faith use by leading the public to believe they are dealing with the Complainant when they are dealing with PILA Group Pty Ltd.

### **Respondent**

16. The Domain Name was legally purchased by the Respondent prior to the Complainant registering a trademark by that or similar names. The Complainant made no attempts to legally purchase the Domain Name when it was originally for sale. The Complainant does not openly publicise Abel Concepts as a brand and instead markets its products under the names Abel Sports and Abel Flag. The Complainant demands the Domain Name be theirs post registration of a trademark, retrospectively. The Respondent does not believe the Complainant has rights to the Domain Name when it was purchased legally by the Respondent prior to the registration of any trademark by the same name and when the Complainant made no attempts to purchase the Domain Name. The legal purchase by the Respondent did not infringe on any registered trademark at the time of purchase and is not used unjustly against the Complainant's business. The Respondent has and continues to maintain the costs associated with owning the Domain Name and the Complainant has made no financial offer for the Domain Name, believing it now simply has rights to ownership of the Domain Name retrospective to the trademark registration.

### **DISCUSSION AND FINDINGS**

17. Under paragraph 4(a) of the Policy the Complainant has the burden of proving the following three elements:
  - (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 has no rights or legitimate interests in respect to the Domain Name; and
  - (iii) the Domain Name has been registered or subsequently used in bad faith.

### **Identity or confusing similarity**

18. Note 1 to the Policy states that, for the purposes of the policy, auDA has determined that a "name ... in which the complainant has rights" refers to the complainant's

company, business or other legal or trading name, as registered with the relevant Australian government authority, or the complainant's personal name.

19. In referring to a name as well as a trademark or service mark the auDRP differs significantly from the UDRP, which is limited to trademark and service mark rights.
20. The Domain Name is clearly identical or confusingly similar to the Complainant's company name as registered with ASIC. The Complainant has established this element.

### **Rights or legitimate interests**

21. The auDRP Overview of Panel Views on Selected auDA Questions First Edition ("auDA auDRP Overview 1.0") states the general position that "a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests [...]. 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 disputed domain name. If the respondent fails to provide such evidence or assertions, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy".
22. The Complainant's contentions support a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name as it is not known by the name Abel Concepts and has not been authorized by the Complainant to use that name; it is likely that the Respondent, when it registered the Domain Name, was aware of the Complainant and its company name since the Respondent is a shareholder in PILA Group Pty Ltd, a competitor of the Complainant; the Respondent does not itself use Abel Concepts in relation to any goods or services and does not appear to have made any preparations to do so; and as at the date of registration of the Domain Name the Respondent did not satisfy the Australian Domain Name Eligibility and Allocation Rules for Open 2LDs and the rules for com.au at Schedule C.
23. The Respondent relies on its having "legally purchased" the Domain Name prior to the Complainant's application to register its trademark. The Panelist interprets this as a statement that the Domain Name was available and that the Respondent was able to register the Domain Name by making application to the Registrar do so and by paying the requisite fee.
24. As to this, Note 2 to the Policy states that, for the purposes of the policy, auDA has determined that "rights or legitimate interests in respect of the domain name" are not established merely by a registrar's determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration. Accordingly, the mere registration of the Domain Name does not establish that the Respondent has rights or legitimate interests in respect to the Domain Name.
25. As demonstrated by the 3 member Panel in *My Brilliance Pty Ltd. v. Amazon Corporate Services Pty Ltd.*, WIPO Case No. DAU2014-0018 (August 20, 2014), the question whether the Respondent actually satisfied the relevant eligibility criteria for

the Domain Name when it secured registration may be considered by the Panel when determining whether the Respondent has rights or legitimate interests in respect to the Domain Name.

26. As an Australian registered company, the Respondent satisfies the first element related to eligibility and allocation in Schedule C of the Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs. The second element requires the Domain Name to be an exact match, abbreviation or acronym of the registrant's name or trade mark, or otherwise closely and substantially connected to the registrant, in accordance with the categories of "close and substantial connection" set out in the Guidelines on the Interpretation of Policy Rules for Open 2LDs.
27. The Respondent has failed to show that the Domain Name is an exact match, abbreviation or acronym of its name or of any trade mark it may have. As to whether the Domain Name complies with auDA's "close and substantial connection" rule, the Panel in *My Brilliance Pty Ltd. v. Amazon Corporate Services Pty Ltd.*(supra) said:

"The purpose of the close and substantial rule is to allow some flexibility for registrants who do not want to register a domain name that is directly related to their name. Importantly, the Guidelines note that the rule is not intended to be a "free for all" and the degree of flexibility is limited for the ".com.au" 2LD by the categories outlined in paragraph 10.5. The categories of close or substantial connection are: a product or service that the Respondent provides, an event, activity or venue that it organises, facilitates or operates or a profession that its employees practise."
28. The Respondent has offered no evidence that any of these categories applies to it and has failed to rebut the *prima facie* case of the Complainant.
29. Accordingly the Panel finds that the Respondent has no rights or legitimate interests in respect to the Domain Name. The Complainant has established this element.

#### **Bad faith registration or use**

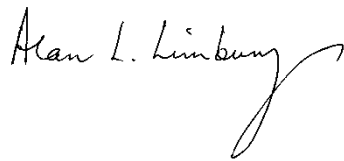
30. The Respondent has made no attempt to contradict the Complainant's assertions that the Respondent was aware of the Complainant when registering the Domain Name and that the Domain Name has been used to resolve to the website of a competitor of the Complainant in which the Respondent is a shareholder. The fact that the Complainant applied to register the trademark ABEL after the Respondent registered the Domain Name is irrelevant, given the similarity of the Domain Name to the Complainant's company name, which was registered in 2002.
31. Since the Domain Name embodies the Complainant's company name and resolves to a website offering goods that compete with those of the Complainant, the conclusion is inescapable that the Domain Name was both registered in bad faith and has been used in bad faith.
32. The Complainant has established this element.

## **DECISION**

33. The Panel notes that, as regards the Domain Name, the Complainant satisfies the auDA Australian Domain Name Eligibility and Allocation Rules for Open 2LDs and the rules for com.au at Schedule C.

34. For the foregoing reasons and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <abelconcepts.com.au> be transferred to the Complainant.

Dated June 10, 2015

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

**Alan L. Limbury**

**Panelist**