

LEADR & IAMA DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

auDRP_15_06

Single Panelist Decision

FEDERATION TUCK POINTING (WA) PTY LTD ACN 079 825 291

v.

BRICK AND MORTAR RESTORATIONS PTY LTD ACN 602 844 682

1. The Parties

- 1.1 The Complainant is Federation Tuckpointing (WA) Pty Ltd ACN 079 825 291 (ABN 85 079 825 291) an Australian registered company with its registered office in Western Australia.
- 1.2 The Respondent is Brick and Mortar Restoration Pty Ltd ACN 602 844 682, an Australian registered company with its registered office in Western Australia.

2. Domain Name, Registrar and Provider

- 2.1 The Domain Name upon which complaint is based is <federationtuckpointing.com.au> ("the Domain Name"), registered with Crazy Domains of Sydney, New South Wales ("the Registrar").
- 2.2 The Domain Name was registered on 14-05-2015 to Brick and Mortar Restoration Pty Ltd ("the Respondent"), registered contact Lee Burns.

3. Procedural History

- 3.1 On or about 23-06-2015, the Complainant lodged a complaint under the auDRP with LEADR&IAMA. A copy of the complaint was submitted on 24-06-2015 to the Registrar with a request to clarify Respondent details and lock the Domain Name during proceedings.
- 3.2 On or about 24-06-2015 the Registrar confirmed that the Domain Name in dispute had been locked, with notification of this sent to the Respondent at *lee@3lminstallations.com.au*.
- 3.3 The Complaint was subsequently also sent via email by LEADR&IAMA to the Respondent on 25-06-2015 to *lee@3lminstallations.com.au* and *lee@brickmortar.com.au* enclosing the Respondent Notification of Complaint document and a copy of the Complaint. That correspondence advised, *inter alia*, that the Respondent had 20 calendar days to respond to the Complaint.
- 3.4 The Complaint was also sent by Express Post to the Respondent at 20 Caldera Close, Mindarie, WA 6030 on 25-06-2015.

- 3.5 The Respondent provided its response at 8.33 am on 14-07-2015 to LEADR & IAMA.
- 3.6 LEADR appointed Rowena McNally as the sole panelist in the matter on 20-07-2015. The Panelist ("Panel") has confirmed that she has no conflict of interest in relation to the matter.
- 3.11 In relation to the procedural requirements, the Panel finds that all procedural requirements appear to have been satisfied.

4. Factual Background

- 4.1 The Complainant owns and has been operating a business known as Victorian Tuck Pointing since at least 1989 and was registered as a company, "Federation Tuckpointing (WA) Pty Ltd 079 825 291" on 22-08-1997.
- 4.2 The Complainant has produced an ASIC Record of Registration of the business name "Federation Tuckpointing" which records registration of that name of 31 January 1989. Both registrations remain current. The Applicant is the licensed user of a similar domain name <tuckpointing.com.au>.
- 4.3 The Complainant says that it has been specialising in work associated with brickwork and mortar work and repairs since 1989, providing essentially, says the Complainant, "the exact same services" as the Respondent now provides. Those services include brickwork, mortar-repointing and tuck pointing and a range of other associated services.
- 4.4 The Respondent is Brick and Mortar Restoration Pty Ltd ACN 602 844 682. The contact registered with the Domain Registrar is Lee Burns, who is also the registered owner of a business, Brick and Mortar Restoration ABN 65 251 976 963, which was registered on 7-08-2014, and which has its principal place of business at 20 Caldera Close, Mindarie in Western Australia".
- 4.5 The Complainant says that Lee Burns, the registered owner of the business "Bricks and Mortar restoration", and registered contact for the Domain Name, is a friend and is closely associated with a recent former employee of the Complainant, Ross Fernihough.
- 4.6 Mr Fernihough was employed by the Complainant from November 2012 until October 2014, with Mr Fernihough's wife Tammy having also been employed by the Complainant as a production co-ordinator from October 2014 until July 2014. The Complainant has produced a copy signed Letters of Employment Offer confirming the employment of Ross and Tammy Fernihough and the Respondent's response does not dispute these matters.
- 4.7 The Respondent company was registered on 13-11-2014, shortly after Mr Fernihough left the employ of the Complainant, and the Domain Name under dispute was registered by the Respondent on 14-05-2015.
- 4.8 The Complainant has provided a copy of pages of the Respondent's own "Bricks and Mortar" website, to which the Domain Name is being re-directed, which describes the owners of the "Bricks and Mortar" business as "Lee Burns and Ross Fernihough".
- 4.9 The Complainant says that the Respondent is using the Domain Name to re-direct business to the Respondent's own website and to divert the Complainant's customers, or potential customers, away from the Complainant and to the Respondent's business.

5. Complaint Elements and the Onus of Proof

5.1 Schedule A of the .au Dispute Resolution Policy (auDRP) applies to disputes which meet the requirements set out in paragraph 4(a) of Schedule A of the auDRP. Subparagraph 4(a) requires submission *"..to a mandatory administrative proceeding in the event that a third party (complainant) asserts to the applicable Provider, in compliance with the Rules of Procedure that:*

- (i) [the] domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and*
- (ii) [the] have no rights or legitimate interests in respect of the domain name, and*
- (iii) [the] domain name has been registered or subsequently used in bad In an administrative proceeding, the complainant bears the onus of proof."*

6. Element (i): Is the Domain name identical to or confusingly similar to a name, trade name or service mark in which the Complainant has rights (4(a)(i))??

6.1 For the purposes of the .au Dispute Resolution Police, auDA has determined that a "name ... in which the complainant has rights" includes "the complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority".

6.2 The Respondent does not dispute the Complainant's status as a registered company, nor the Complainant's long-standing registration of the business name, "Federation Tuckpointing" but says that the "almost identical wording" between these and the Domain Name is "purely coincidence".

6.3 The Respondent also submits in any event that it was "within our rights to [purchase the Domain Name] since it had not already been purchased."

6.4 The Panel notes that applicants for a domain name are required to warrant, *inter alia*, that to their knowledge the registration of the domain name will not infringe upon or otherwise violate the rights of any third party.

6.5 The Panel does not accept the Respondent's submissions on any of these matters and finds that element (i) has been satisfied, in that the Domain Name is the same or confusingly similar to the Complainant's registered business name and company name, being a name in which the Complainant has rights.

7. Element (ii): Does the Respondent have a right or legitimate interest in the Domain name (4(a)(ii))?

7.1 The Respondent trades under names "Brick and Mortar Restoration which he registered in 2014. The Respondent is not affiliated to the Complainant who has traded since 1989 under the name "Federation Tuckpointing".

7.2 The Respondent says that it feels that it was not misleading to purchase the the Domain Name because the work it undertakes includes tuck pointing and carrying out other works on Federation homes.

7.3 It is clear from the material that the Complainant has provided, which has not been refuted by the Respondent, that the Respondent knew the Complainant

- had long operated a business in the same area under the same name as the Doman Name.
- 7.4 The Respondent does not trade under the name <Federation Tuckpointing> but under "Bricks and Mortar Restoration" and the mere fact that the domain name that has been registered reflects elements of some work that might be undertaken by the Respondent from time to time is insufficient of itself to give the Respondent a "right or legitimate interest" in the Domain name.
- 7.5 The Panel finds that the Respondent does not have a right or legitimate interest in the Doman Name.
- 8. Element (iii): Has the Domain Name has been registered or subsequently used by the Respondent in bad faith: (4(a)(iii))?**
- 8.1 The Complainant has operated in this area of business in Perth since 1989.
- 8.2 Over the several months, the Respondent (one of the business owners of whom until recently worked for the Complainant) has set up a business in Perth in competition with the Complainant; has registered a domain name which bears the same name as the Complainant's business; has redirected traffic to the Domain Name to the Respondent's own newly established business and business website, "Bricks and Mortar"; has undertaken paid/sponsored advertisements using the words "Federation Tuckpointing" and advertises the Complainant's former salesman, Ross Fernihough, as a "co-owner" on the "Bricks and Mortar" website to which "Federation Tuck Pointing" searches are re-directed.
- 8.3 The Complainant says that the Respondent has engaged in a course of conduct that has included re-directing enquirers from the Doman Name to the Respondent's "Brick and Mortar Restoration" website. This has not been refuted by the Respondent.
- 8.4 The Complainant says that the Respondent has engaged in other conduct by which it has also sought to intentionally attract internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's business, including by means of sponsoring paid advertisements targeting the Complainant's business name. The Respondent has also prominently displayed on the website its association with the Complainant's former sales representative, Ross Fernihough.
- 8.5 It defies credulity to suggest, as the Respondent has, that registration of the Complainant's name by the Respondent to offer the same services as the Complainant, in the same area; to the same customer base, and in partnership with a former employee of the Complainant, was a matter of "pure coincidence".
- 8.7 It is the finding of the Panel that the Respondent's conduct supports the assertion that the Respondent was well aware of and deliberately registered the Domain Name in the name of the Complainant's business and has since acted in a deliberate manner to seek to divert business to from the Complainant to itself through the registration of a domain name that used the name of the Complainant's business.
- 8.8 The Complainant says, and the Panel accepts the Respondent's conduct supports the assertion that the Respondent deliberately registered the domain in the name of the Complainant's business to divert business to itself.

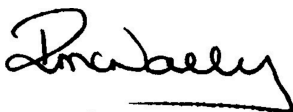
- 8.9 That the Respondent was successful in this is evidenced by the Respondent's own submission which speaks of the success of the redirection from the Domain Name to its own "Bricks and Mortar" website in growing its business.
- 8.10 The Respondent submits that it should be allowed to keep the Domain Name because, inter alia, "...as a result of purchasing the domain we have been awarded many new projects which have been vital to the success of our company. The domain has been of great benefit to our company and by taking ownership from us, work would be lost." This is of course, at the nub of the Complainant's complaint, which the Panel finds to have been satisfactorily demonstrated, which is that work has been diverted from its own business to that of the Respondent through the Respondent's use of the Domain Name; creating the likelihood of confusion with the Complainant's business and thereby re-directing business to itself.
- 8.11 The Policy sets out in Paragraph 4(b) circumstances that, if found by a Panel to be present, will provide evidence of the registration and use of a domain name in bad faith.
- 8.12 The Panel finds that the Respondent registered the Domain Name in bad faith, primarily for the purpose of disrupting the business or activities of the Complainant as referred to in Paragraph 4(a)(iii) of the Policy and Paragraph 4(b)(iii) of the Policy.
- 8.13 The Panel also finds that the Respondent has, by using the Domain Name, intentionally attempted to attract, for commercial gain, Internet users to the Domain Name by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation or endorsement of that website or location or of a product or service on that website or location, as referred to in Paragraph 4(b)(iv) of the Policy.
- 8.14 The Panel finds that the Domain Name was registered and has been subsequently used by the Respondent in bad faith.

9. Decision

- 9.1 The Complainant seeks the transfer to it of the Domain Name on the basis that the Domain Name is (a) identical or confusingly similar to a name, trade mark or service mark in which the Complainants have rights, (b) the Respondent has no rights or legitimate interests in the Disputed Domain Name, and (c) the Domain Name was registered or subsequently used in bad faith.

The Panel upholds the Complainant's Complaint and application and finds that the Domain Name should be transferred to the Complainant.

DATE: 28 July 2015



Rowena McNally

Panelist