

**RESOLUTION INSTITUTE DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL****auDRP\_15\_12****Single Panelist Decision****Compass Capital Partners Pty Ltd (COMPLAINANT)****v.****Nationwide Appliance Repairs (RESPONDENT)****Kleenmaid.com.au****Procedural History**

1. The complaint was submitted for decision in accordance with the (auDRP) Policy and Rules, which was approved by auDA in 2001 and commenced operation on 1 August 2002 and the Supplementary Rules of the Provider.
2. The complete application was received from the Complainant by the Resolution Institute (the Provider) on 3 December 2015. The Complaint had been submitted in incomplete form on 30 November 2015 and was amended by the Complainant prior to registration and notification of the relevant parties.
3. The Respondent was issued a copy of the Complaint by the Provider on 15 December 2015. At that time the Provider had already also advised auDA and the Registrar (Go Daddy LLC). The Registrar locked the domain and confirmed that in writing to the Provider. Documents supporting those actions have been provided to me as part of the case file.
4. Pursuant to the scheme's timelines, the Respondent had until 4 January 2016 to provide a response to the Complaint. The Respondent, through its adviser sought an extension of time until the end of January 2016. That request was issued on 29 December 2015.
5. The auDRP allows for an extension of time for a response to be provided pursuant to clause 5(d) of the scheme. That clause provides:

*(d) At the request of the Respondent, the Provider may, in exceptional cases, extend the period of time for the filing of the response. The period may also be extended by written stipulation between the Parties, provided the stipulation is approved by the Provider.*

6. Applications for an extension based on the “exceptional case” provision of the scheme have been the subject of comment in many decisions<sup>1</sup>. The Provider elected to exercise its discretion and awarded an extension of 7 calendar days. The adjusted date for the provision of response being 11 January 2016. That extension was conveyed to the Respondent on 4 January 2016. On that same date the Respondent again requested an extension until the end of January 2016. The Provider advised that would require the consent of the Complainant.
7. On 11 January 2016, the Provider contacted the Respondent advising that absent an agreed extension the response was due on that day. On this occasion the Respondent’s adviser sought an extension until 18 January 2016. The Claimant advised that while it had negotiated with the Respondent no suitable resolution was reached and it did not agree to an extension of time. While this is a decision of the Provider, and in certain circumstances a Panelist can adjust the entitlement to make submission (see Rule 10(c)) I have elected not to exercise that discretion. I accept the Provider’s decision is correct because:
  - a. The scheme embodies a desire for expeditious resolution and as observed in the Union Square decision (see footnote 1):

*The Policy and the Rules are intended to facilitate expeditious consideration of a limited class of cases, and strict adherence to their deadlines is a necessary corollary of this objective.*
  - b. There is no evidence of an exceptional circumstance, the holiday period occurs each year and the first extension should have allowed a reasonable period, despite the holiday period to enunciate a break.

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<sup>1</sup> See for example Union Square Partnership, Inc., Union Square Partnership District Management Association, Inc. v. unionsquarepartnership.com Private Registrant and unionsquarepartnership.org Private Registrant, WIPO Case No. D2008-1234; The Knot, Inc. v. Julia Bitton, The Nest, WIPO Case No. D2006-0377; Mobile Communication Service Inc. v. WebReg, RN, WIPO Case No. D2005-1304 and Sharp Corporation of Australia Pty Ltd v. Sharp Computing Services Pty Ltd LEADR-auDRP 11\_09

- c. It appears the Respondent in any event changed advisers during the period moving from Mr Lehman initially to Ballards Solicitors at the time of the second request for an extension.
  - d. The Respondent initially advised its advisers were on holiday until 4 January 2016. That was, as I understand the basis of the extension granted until 11 January no further extension should have been required beyond that point.
  - e. No material was produced in support of any assertion as to availability that would indicate any exceptional circumstance.
8. As at the date of appointment and more particularly the 11<sup>th</sup> of January 2016, no response to the complaint was received by the provider.
  9. On 13 January 2016 the Provider approached the Panelist. The panelist confirmed his availability, informed the Provider that they had no conflict issues with the parties and accepted the matter on that date.
  10. The Panelist received the package containing the Complaint including submissions and attachments on the date of acceptance. The determination was due from the Panelist to the Provider on or before 28 January 2016.

### **Factual Background**

11. The Complainant is the owner of the Trademarks Kleenmaid in various forms both graphically and the word 'Kleenmaid'. The Complainant has not used or registered the domain name "kleenmaid.com.au" (the domain). The Complainant does hold a of domain name incorporating the trademark notably [kleenmaid.appliances.com.au](http://kleenmaid.appliances.com.au).
12. The Respondent has provided no submission.

### **Complainant**

13. The Complainant's contentions, as they bear on resolution of this dispute, are discussed individually under consideration of the applicable elements of proof below. I also address the Respondent's submissions as I understand they apply to the elements that must be established. For the avoidance of doubt I note the obligations rests with the Claimant to establish the facts upon which they rely. Those facts must be established on the balance of

probabilities in regard to each proof required. Those proofs are cumulative and the Complainant must meet each element.

### **Discussion and Findings**

14. When a person registers a domain name with any domain name registrar, the person accepts a contract that forbids “cybersquatting” – the bad faith registration of a domain name that is confusingly similar to someone else’s trademark. When a trademark holder finds that someone has registered a domain name that they believe is too close to their own trademark, they can initiate an arbitration under the Policy. To prevail in such a UDRP action, Paragraph 4(a) of the Policy requires that the trademark holder – the Complainant – must prove each of the following:
- a. The domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
  - b. The Respondent has no rights or legitimate interests in respect of the domain name and
  - c. the domain name has been registered or subsequently used in bad faith.
15. Because this dispute is between two parties who are Australian entities and would otherwise be subject to jurisdiction before Australian courts to resolve any disagreement regarding trademark infringement by the domain name in question, the Panel concludes that pursuant to Paragraph 15(a) of the Rules, it is appropriate to apply rules and principles of Australian trademark law between the parties.

### **Paragraph 4(a)(i) - Identical or Confusingly Similar**

16. This limb has two sub limbs, firstly that the domain in dispute is identical or confusingly similar to a service mark, trademark, business name or the like, and that the Complainant has rights in that name.

### **Domain is identical or confusing**

17. The Claimant asserts that the name is identical to the name they hold as a registered trademark, and the internet presence they hold in another domain name, relevantly [kleenmaid-appliances.com.au](http://kleenmaid-appliances.com.au). Given the information establishing the identical registered Trademark, I am satisfied this is established.

**Complainant has rights in the name**

18. The word 'Kleenmaid' is a registered trademark. That trademark is owned by the Complainant. The Complainant has traded using that trademark and variants of that trademark for many years.
19. The Respondent does not contest that the Complainant has rights in the word 'Kleenmaid' and there is no material in the Complaint that provides any basis for the Complainant's entitlement to be questioned.
20. I accept this is established.

**Conclusion**

21. I am satisfied that the complainant has shown that the domain is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights. I make this finding with particular cognisance of the note to this element as advised in the rules which states:

*[1] For the purposes of this policy, auDA has determined that a "name ... in which the complainant has rights" refers to:*

- 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.*

**Paragraph 4(a)(ii) - Rights or Legitimate Interests of Respondent in domain**

22. The Complainant has asserted that the Respondent has no legitimate interest or rights in the domain. I understand that is because:
  - a. Mere registration does not establish entitlement, which accords with Note 2 to the auDRP Policy.  
I accept this submission as a statement of the policy and intent of auDA.
  - b. The Respondent is not now or previously known as the owner of any intellectual property rights in the domain or the name 'kleenmaid'.  
I accept this submission, and note that the Respondent has activated the page of the domain since it was acquired, however merely to take the user through to alternate sites.
  - c. The Respondent is not and has not at any time been authorized by the Complainant to use the name.  
I accept this submission and accept that it weighs on the limb in issue.

- d. The Respondent has used the domain and has used the domain for commercial purposes so as to accord with the purpose test (see auDA policy 01-2005 states at schedule C: 'ELIGIBILITY AND ALLOCATION RULES FOR COM.AU').
- I accept this submission and note that the diversions are to sites that are clearly commercial.

### Conclusion

23. I am satisfied having considered the submissions of the Complainant and the materials supplied that the Respondent did not at the time of registration of the domain hold any legitimate rights in the domain name.

### Paragraph 4(a)(iii) - Registered or subsequently used in bad faith.

24. Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by, among other things, evaluating four (non-exhaustive) factors set forth in the Policy:
- a. circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or
  - b. the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or
  - c. the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
  - d. by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or

service on the registrant's website or location. Paragraph 4(b) of the Policy.

25. The Complainant has, at least by necessary inference from its scant submissions relied on the fourth ground; that is, the Complainant asserts the Respondent sought to gain a commercial advantage from the use of the domain.
26. I accept that the 1<sup>st</sup>, 2<sup>nd</sup> and 3<sup>rd</sup> elements are not evidenced in any measure. However the 4<sup>th</sup> element is in my view sufficiently evidenced.
27. The 4<sup>th</sup> element is evidenced by the processes the Respondent has used the site. It acts to direct traffic to its other sites thereby probably generating revenue and improving results on search algorithms. These two outcomes are in my view a 'commercial gain'.

### **Conclusion**

28. The appropriate evidential level in these determinations is the balance of probabilities. When this test is applied it appears the domain was acquired to capture persons seeking the Complainant's site and the Respondent sought to secure a commercial benefit.
29. I am satisfied that the requirements of this third limb are satisfied.

### **Outcome Sought**

30. It is possible to direct the cancellation of the domain name or to order the transfer. In this instance, as I understand the submissions of the Complainant in the amendment it seeks the domain be returned (see page 32 of the Case File PDF provided to me) which provides:

Compass Capital Partners Pty Ltd, as the legal and beneficial owner of all trademarks and intellectual property associated with the Kleenmaid brand, hereby asserts its rights to the Kleenmaid domain name and seeks the return of the said domain name to its rightful ownership.

31. While not expressed with complete clarity I accept only a single meaning is available, and that is transfer. Transfer would allow the removal of the risk of another party securing the domain in the period between deregistration and acquisition by the Complainant.

**Decision**

32. Having read all of the submissions of the Complainant and for all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <kleenmaid.com.au> be transferred to Complainant.



**Scott Pettersson**  
Panelist

**26 January 2016**