

**RESOLUTION INSTITUTE DOMAIN NAME DISPUTE ADMINISTRATIVE
PANEL**

auDRP_16_02

Single Panelist Decision

Luxtown Pty Ltd t/as 2nds World

v.

Seconds World Pty Ltd

<2ndsworld.net.au>

Provider: Resolution Institute

Panelist: John E. McDermott

DECISION:

1. THE PARTIES

- 1.1** The Complainant in these proceedings is Luxtown Pty Ltd t/as 2nds World of 237 Military Road, Cremorne NSW 2090.
- 1.2** The Respondent is Seconds World Pty Ltd of c/- Vincent Mercuri & Associates, Suite 1, 37 Princes Highway, Dandenong VIC 3175.

2. THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 2.1** The Domain Name in dispute is:
2ndsworld.net.au
 (“**Domain Name**”) or disputed Domain Name.
- 2.2** The Registrar of the Domain Name is Synergy Wholesale Pty Ltd of 105/66 Victor Crescent, Narre Warren VIC 3805 (“**Registrar**”).
- 2.3** The Provider in relation to this proceeding is Resolution Institute (“**Provider**”).

3. PROCEDURAL MATTERS

3.1 These proceedings concern a complaint (“Complaint”) with respect to which the Provider and the Panelist provide a procedural history as follows:

- i. This Complaint was submitted for decision in accordance with the .au Dispute Resolution Policy (the **Policy**), approved by the auDA Board on 13/08/2010, the Rules for .au Dispute Resolution Policy (the **Rules**), and the Resolution Institute Supplemental Rules for .au Dispute Resolution Policy (the **Supplemental Rules**).
- ii. The Complaint was received by Resolution Institute from the Complainant on the 18/03/2016.
- iii. Resolution Institute sent an acknowledgement to the Complainant on the 22/03/2016.
- iv. Payment of the application fee was received by Resolution Institute on the 22/03/2016.
- v. A copy of the Complaint was submitted by Resolution Institute and a request to clarify Respondent details and to lock the Domain Name during proceedings was emailed to the Registrar on 30/03/2016.
- vi. On 30/03/2016 the Registrar confirmed via email that the Domain Name in dispute has been locked.
- vii. Resolution Institute advised auDA of the Complaint on 30/03/2016 via email.
- viii. On the 30/03/2016 Resolution Institute send the Respondent (Seconds World Pty Ltd according to the WHO IS Search Results) emails to two separate email addresses and a written notification of the Complaint lodged against them. A copy of this correspondence was also sent via express post to Vincent Mercuri & Associates, Suite 1, 37 Princes Highway, Dandenong VIC 3175. The Complainant was copied in on these notifications.
- ix. On the 31/03/2016 the parties were re-circulated with the information forwarded on the 30/03/2016 but with a correction as regards details of the Domain Name in issue.
- x. The due date for the Response to the Complaint was confirmed to be 19/04/2016 in accordance with Paragraph 5 of the Policy Rules.
- xi. On the 19/04/2016 the Response became due. The Respondent was contacted by Resolution Institute via telephone and email. No Response was submitted.
- xii. On 22/04/2016 the Provider approached the Panelist. The Panelist confirmed his availability, informed Resolution

Institute that he had no conflict issues with the parties and accepted the matter on 26/04/2016/

- xiii. The Case File and relevant correspondence was forwarded to the Panelist on 26/04/2016.
- xiv. The parties to the dispute were notified of the Panelist's allocation on 26/04/2016.
- xv. The date on which the decision is due is 10/05/2016.

4. FACTUAL BACKGROUND

4.1 Facts Alleged by Complainant

The Complainant is Luxtown Pty Ltd t/as 2nds World ("Complainant") of 237 Military Road, Cremorne NSW 2090 trading from six (6) retail and wholesale outlets throughout Australia.

The Respondent is Seconds World Pty Ltd ("Respondent") of c/- Vincent Mercuri & Associates, Suite 1, 37 Princes Highway, Dandenong VIC 3175 and is a competitor of the Complainant in Melbourne, Victoria.

The Complainant also states in support of its submissions that:-

- i. 2nds World holds a registered Trade Mark No. 1139164 for **2NDS WORLD** under class 35 of the *Trade Marks Act 1995* classes of goods and services ("Registered Trademark"). The Registered Trademark was registered from 05/10/2006.

I note that this submission is erroneous in that the Trade Mark is in fact held by the Complainant trading as 2nds World.

- ii. Since 06/08/1999, the Complainant has also been the proprietor of the Australian Companies called "2NDS WORLD APPLIANCES PTY LTD" (ACN 007 198 165) and "SECONDS WORLD TRADING PTY LTD" (ACN 080 660 055).
- iii. I again note that this allegation should refer to the Complainant but this does not affect the submission here or elsewhere where I will not repeat this observation.
- iv. On 21/10/1994 2nds World registered the Business Name "Seconds World". 2nds World has registered and has traded in numerous related business names since then.
- v. All of the trade names registered by the Complainant are claimed by it to be Common Law Trademarks and are referred to in the Complainant's submissions, along with the registered Trademark, as "Trademarks".

- vi. The goods and services that the Complainant's registered Trademark is registered with regard to are those in class 35 as previously observed.
- vii. The Respondent's website (<http://www.2ndsworld.net.au/>) asserts that the Respondent has been trading since 2004 "in Electrical Appliances, Kitchenware, Homeware, Cooling, Heating, Cookware, Home Entertainment and Bedding for all your business and domestic needs", which items overlap largely with the goods and services covered by the Complainant's registered Trademark pursuant to class 35.
- viii. When the Complainant became aware that consumers and suppliers were confusing its business and Trademarks with the Respondent's the Complainant began requesting and demanding that the Respondent cease.

To date the Respondent has either refused or failed cease using the Complainant's Trademarks.
- ix. The Respondent is in breach of paragraphs 4(a)(i), 4(a)(ii) and 4(a)(iii) of the Dispute Resolution Policy.

5. DISCUSSION AND FINDINGS

5.1 Discussion and Findings

In order to have the Domain Name either transferred to it or cancelled, the Complainant must make out each of the following elements under paragraph 4(a) of Schedule A of the auDRP:-

- i. The Respondent's Domain Name is identical or confusingly similar to a name, Trade Mark or service mark in which the Complainant has rights (**paragraph 4(a)(i)**);
- ii. The Respondent has no rights or legitimate interests in the Domain Name (**paragraph 4(a)(ii)**); and
- iii. The Respondent registered or subsequently used the Domain Name in bad faith (**paragraph 4(a)(iii)**).

The onus of proof is on the Complainant in relation to all three of these elements.

5.2 Identical or Confusingly Similar

Paragraph 4(a)(i)

The Panelist must firstly determine whether the Complainant has rights in a relevant name, Trade Mark or service name. It is then necessary to look at the issue as to whether it is "identical or confusingly similar".

I note that the Complainant relies on rights to its Trade Marks (registered and unregistered) but that it has also, see above, supplied

details of the ASIC registrations of Seconds World Trading Pty Limited ACN 080 660 055 and 2nds World Appliances Pty Limited ACN 007 198 165.A, the second in particular, strengthened this claim somewhat.

In this instance the registered Trade Mark of the Complainant is “2nds World”.

The Domain Name in dispute is “2ndsworld.net.au” which to the ordinary person, ignoring whether letters are upper case or lower case could appear to some people to be identical, save only the “.net.au” which might not be seen as a distinguishing characteristic but as simply indicating registration as a Domain Name.

The position as regards “confusingly similar” is much clearer. I have already referred to a number of names and Marks which the Complainant relies on. In dealing with paragraph 4(a)(ii) the Complainant notes the registration of nine (9) separate Domain Names which would appear to many people to be associated with the registered Trade Mark and attempts to better merchandise one or more of the items covered by class 35.

As regards “confusing similar” I have been provided with emails from suppliers following up on invoices actually intended for the Respondent by erroneously forwarded to the Complainant.

This notwithstanding that there was obviously a relationship on foot with the Respondent and the suppliers in question. The Complainant asserts, without supporting evidence that there were phone calls of a similar nature and that, again without supporting evidence, customers had confused the Respondent’s business with that of the Complainant because of the Domain Name in dispute.

The Respondent, by not making any submissions, a comment that applies here and elsewhere, has denied itself the opportunity to challenge these assertions.

The actual invoices, from GSM Sales Pty Ltd and from ARISIT Pty Ltd are sufficient to prove that confusion has occurred, without more.

The Complainant has succeeds as regards paragraph 4(a)(i).

5.3 Rights or Legitimate Interests

Paragraph 4(a)(ii)

The Complainant’s submissions can, having regard to the registered Trade Mark, the unregistered Trade Marks, the registered Company Names and the other Domain Names be regarded as an assertion that the Complainant has effectively “taken the field” as far as having legitimate interests in respect to the disputed Domain Names is concerned. The result of course would be that the Respondent has no legitimate interest.

The .au Dispute Resolution Policy (auDRP) (2016-01) (“**the Policy**”) usefully lists, in Schedule A, some circumstances “in particular but without limitation” which might be used to demonstrate a person’s rights to/or legitimate interests in a Domain Name in responding to a complaint.

Reference is made to the need to evaluate all evidence presented. In this instance, noting the emphasis on the use of the word “demonstrate” the Respondent’s silence has resulted in a failure to demonstrate any right or legitimate interest in the Domain Name.

In this instance, less it be inferred that actual registration of the Domain Name overcomes the Respondent’s difficulty I note that at footnote 1 of paragraph 4(a)(i) it is stated that:-

“for the purpose of this Policy, auDA has established 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”.

The Complainant succeeds as regards paragraph 4(a)(ii).

5.4 Registered or Subsequently Used in Bad Faith:

5.5 Paragraph 4(a)(iii)

The relevant portion of paragraph 4(a)(iii) of Schedule A of the Policy reads as follows:-

“Evidence of Registration or Use in Bad Faith.

For the purpose of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) ---
- (ii) ---
- (iii) *You have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or*
- (iv) *By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to a website or other online location, 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”*

It may be that the outcome referred to at subparagraph (iii) has occurred in that the Respondent’s invoices have been forwarded to the

Complainant. It may even be that this was even intended but I make no finding in this regard.

Once again the Respondent has made no submissions and the Complainant's evidence before me is persuasive.

I refer to my previous use of the phrase "taken the field".

Overwhelmingly the evidence before me suggests that the Respondent's intention in this matter has at all times been to create the type of confusion referred to in subparagraph (iv).

The forwarding of tax invoices to the Complainant could be evidence of an intention of the type described at subparagraph (iii) but is more likely to be a simple result of confusion as described in subparagraph (iv). Although the Complainant has not given any particulars of customers who have been diverted the unmet allegation has been made and it is consistent with what has occurred with the Respondent's creditors.

If creditors with an existing relationship are confused then it is considerably more likely that customers, aware of one or more of the Trade Marks, Company registrations or other Domain Names would be misled and that a competitor in the same business would not only be aware but intend this, having regard, inter alia to the longstanding and widespread nature of the Complainant's business.

The Complainant succeeds as regards paragraph 4(a)(iii).

6. DECISION

- 6.1 I am satisfied that the Respondent has been contacted, by email, mail and telephone on numerous occasions. It is possible to argue that mail and emails can go astray but a telephone contact speaks for itself. The Respondent has not taken the opportunity, despite the usual 20 day period and whilst apparently having the availability of legal advice if required, to contest this application.
- 6.2 There is no evidence before me that the Complainant has delayed for an unduly long time in seeking redress.
- 6.3 The Complaint alleges that this dispute is properly within the scope of the Policy and that the Panelist has Jurisdiction to decide this dispute. The Respondent does not demur. I so find.
- 6.4 The Complainant is a potential eligible registrant for the Domain Name and satisfies the eligibility requirement in accordance with the rule set out in **auDA's Domain Name Eligibility and Allocation Rules for open 2LDs 2012-04**.
- 6.5 The Complainant has satisfied all of the requirements for the Complaint to be upheld as regards the Domain Name in dispute. It has requested that the disputed Domain Name be transferred to it.

6.6 For the above mentioned reasons I direct and order that the disputed Domain Name be immediately transferred to the Complainant.



DATE: 2 May 2016

The Panelist

John Emmet McDermott