

**RESOLUTION INSTITUTE DOMAIN NAME DISPUTE
ADMINISTRATIVE PANEL**

Case No.au DRP._16_08

Single Panelist: The Honourable Neil Anthony Brown QC

Domain Name : <nswfcls.org.au>.

**New South Wales Federation of Community Language Schools Inc v.
The Australian Psychological Society Ltd**

1. SUBJECT MATTER OF COMPLAINT

The domain name in dispute : <nswfcls.org.au> (“the disputed domain name”).

Jurisdiction: auDRP Rules 3(a) and 3(b) (xv).

2. THE PARTIES

The Complainant is **New South Wales Federation of Community Language Schools Inc**, (ABN/ACN 88620784404), New South Wales, Australia, represented by Marque Lawyers Pty Ltd.

The Respondent is **The Australian Psychological Society Ltd.**, (ABN 23000543788) of idiq33535@163.com, Australia, unrepresented.

3. BASIS OF DETERMINATION

The Complaint was submitted for determination by a single Panelist under the provisions of Schedule A of the .au Domain Resolution Policy (“the .au DRP” or the Policy”) and the Rules for .auDRP (“the Rules for .auDRP” or “the Rules”) .The Policy was approved by auDA in 2001, commenced operation on 1 August 2002 and was most recently approved by the auDA Board and published as Policy 2016-01 on 15 April 2016.

The Policy includes the Rules and the Resolution Institute’s Supplemental Rules for .auDA (“the Supplemental Rules”).

Paragraph 4 of the .auDRP covers Mandatory Administrative Proceedings.

4. THE DOMAIN NAME AND REGISTRAR

The disputed domain name <nswfcls.org.au> is registered with InterNextX GmbH (the “Registrar”).

5. PROCEDURAL HISTORY

1. On 9 November 2016 Resolution Institute received the Complaint from the Complainant and acknowledged to the Complainant that it had received the Complaint.

3. On 11 November 2016 Resolution Institute forwarded a copy of the Complaint by email to the Registrar of the disputed domain name InterNextX GmbH with a request for registrar verification that the Respondent is the registrant of the domain name, a request for the Respondent’s contact details and a request to lock the domain name during the proceeding.

4. On 11 November 2016 the Registrar confirmed via email that the Respondent is the registrant of the disputed domain name and that the domain name had been locked.

5. Resolution Institute advised auDA of the Complaint on 14 November 2016 via e-mail.

6. On 14 November 2016 Resolution Institute sent to the Respondent by email at postmaster@nswfcls.org.au the written notification of the Complaint having been lodged together with a copy of the Complaint and the annexures thereto and advising the Respondent that the due date for the filing of the Response was 4 December 2016. The Complainant was copied in on these notifications.

7. The Respondent did not file a Response by 4 December 2016 or at all

8. On 14 December 2016 Resolution Institute as provider approached the Panellist, the Honourable Neil Anthony Brown QC to ascertain his availability as panellist in the proceeding and his confirmation that if appointed he had no conflict issues concerning the parties to the proceeding. The Panellist confirmed his availability, informed Resolution Institute that he had no conflict issues concerning the parties to the proceeding and accepted the appointment on 15 December 2016. On 15 December 2016, by virtue of the power vested in it by Rule 10(c), the

Panel on its own motion extended the period of time fixed by these Rules for the appointment of the Panel in this proceeding until 15 December 2016.

9. The Case file and relevant correspondence were forwarded to the Panellist on 16 December 2016.

10. On 16 December 2016, the Parties to the proceeding were notified of the appointment of the Panellist.

11. The date on which the decision is due is 30 December 2016.

12. The Panel is satisfied that this Domain Name dispute is subject to the .auDRP and falls within the requirements for resolution in a mandatory administrative proceeding as prescribed in Paragraph 4(a) of the .auDRP. This dispute is therefore conducted in accordance with the .auDRP, the Rules for .auDRP and the Resolution Institute's Supplemental Rules (auDRP 2016-01) ("the Supplemental Rules").

6. CONTENTIONS OF THE PARTIES

A COMPLAINANT

The Complainant made the following contentions.

1. The Complainant is an Australian-owned and run not-for-profit organisation whose function is to unite all community language schools and work together to sustain community languages and contribute to the multicultural assets of New South Wales.
2. To further its work, the Complainant registered the disputed domain name in 2008 and commenced to use it to promote its activities. It continued to do so until in or about July 2016, when its staff began receiving calls from the public to the effect that the website to which the domain name resolved was now hosting a fashion website and that it appeared to have been taken over. The website is now a commercial website selling clothes, shoes and accessories.
3. The Complainant has never consented to such a use being made of the domain name.
4. The lawyers for the Complainant conducted a WHOIS search of the domain name and found that it is presently registered to The Australian Psychological Society Limited ("the APS") and that Mr.

Oscar Ferreiro is listed as the Registrant Contact. The Complainant's lawyers thereupon contacted Mr. Ferreiro who informed them that he was not associated with the website and that his name and the name of The Australian Psychological Society Limited had been falsely used in securing the registration of the disputed domain name.

5. On 9 September 2016, the Complainant's solicitors wrote to the Respondent alleging that it was not an eligible registrant of the domain name. No reply has been received to that communication.

IDENTICAL OR CONFUSINGLY SIMILAR

6. The disputed domain name is identical to the acronym of the Complainant.
7. The disputed domain name is confusingly similar to the name of the Complainant.

RIGHTS OR LEGITIMATE INTERESTS

8. The Respondent has not used the disputed domain name in connection with any *bona fide* offering of goods or services.
9. The Respondent is not commonly known by the domain name.
10. The Respondent is not making a legitimate non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue.
11. The Respondent has not acquired any trademarks or service rights in respect of the disputed domain name.
12. The Complainant uses the acronym NSWFCLS in its communications.
13. The letters "nswfcls" have become known to represent the Complainant.
14. The Respondent is exploiting the goodwill of the Complainant to attract people to its website and is diverting supporters of the Complainant to its own webpage for commercial gain.

REGISTRATION OR USE IN BAD FAITH

15. The Respondent registered and is using the disputed domain name in bad faith by making numerous false and misleading representations and warranties as to its eligibility to register the domain name.

16. The representations and warranties are false as the APS is not the Registrant, the APS has not consented to the use of its name and ABN, and the name of Mr. Oscar Ferreiro, the Registrant Contact, has been used without his consent.

17. The Respondent could not validly be registered as the Registrant of a domain name in the open second level domains in the .au domain and, in particular, of an “.org.au” domain name.

RELIEF

The disputed domain name should be transferred to the Complainant or cancelled.

B RESPONDENT

The Respondent did not file a Response in this proceeding.

7. DISCUSSION AND FINDINGS

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered or subsequently used in bad faith.

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true

unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

The Panel will now deal with each of the three elements in turn.

Identical and/or Confusingly Similar

The first issue that arises is whether the Complainant has a trademark or service mark on which it can rely.

In this regard it appears that the Complainant does not have a registered trademark for NSWFCLS and none has been alleged. The Complainant therefore argues that the disputed domain name is identical to the acronym of the Complainant, NSWFCLS, and also that the domain name is confusingly similar to the name of the Complainant, New South Wales Federation of Community Language Schools Inc.

It is true that the Policy enables a complainant to rely on a name instead of a trademark, but the name must be a "company, business or other legal or trading name, as registered with the relevant Australian government authority." There is no evidence that the Complainant has registered its name with a relevant Australian government authority, which clearly means ASIC or a business names registry. The Complainant is registered as a charity and evidence of that fact has been adduced, but registration as a charity does not create the name and is made solely to set up an entitlement to Federal government tax concessions. Nor is there any evidence that the acronym has or could be registered and the Policy and Rules do not permit of an acronym being regarded as a substitute for a name. There must therefore be some doubt as to whether the Complainant can show its standing to bring the Complaint and whether there is a 'name' with which the domain name may be found to be identical or confusingly similar.

However, it appears that the Complainant has been in existence since 1978, according to the charities registration, and records to which the Panel will refer later show that it has been engaged in a variety of activities and the provision of related services since then under its full name and the expression NSWFCLS. It has also used the internet for several years to promote its activities and services and has become known

in a wide section of the community as NSWFCLS, a name that has become synonymous with its activities and services. It would therefore probably have a common law or unregistered trademark in NSWFCLS and it is well established that such a trademark is sufficient to found these proceedings.

The second issue that arises is whether the disputed domain name is identical or confusingly similar to Complainant's NSWFCLS mark. The Panel finds that the domain name is identical to the mark in that it contains the same letters as the mark and, in any event, it is confusingly similar to the mark, as an objective bystander considering the domain name and the trademark would probably regard the domain name as relating to or invoking the mark and hence the Complainant itself.

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

Rights or Legitimate Interests

It is now well established that complainants in proceedings under the Policy and in analogous proceedings under the Uniform Domain Name Dispute Resolution Policy, must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), 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 (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 (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 must therefore first decide if the Complainant has made out a *prima facie* case.

In assessing whether the Complainant has made out a *prima facie* case, the Panel has had regard to the following considerations:

- (a) the Respondent has chosen to take NSWFCLS, the Complainant's mark and to use it in its domain name, without any changes and without the knowledge or permission of the Complainant;
- (b) the Respondent registered the disputed domain name on a date that is apparently not known to the Complainant, but which appears to have been in the year 2016;
- (c) the Respondent then seems to have linked the domain name to a website called Australia-Clothes at www.australia-clothes.com which sells men and women's clothing and accessories such as sunglasses. The Complainant says that the business is operated from Russia or Germany, although the Panel is uncertain as to why that should be so, except that the domain name has been registered with a registrar that is a German company, InterNetX GmbH, as disclosed in Annexure C, the WHOIS report on the domain name.
- (d) The most important feature of the registration by the Respondent is the way in which the Registrant itself is expressed. The Registrant and therefore the proper Respondent to this proceeding, because it is the domain name holder, is described as The Australian Psychological Society Limited ("the APS") and the Registrant Contact and Technical Contact are given as Mr. Oscar Ferreiro. Mr. Ferreiro is an actual employee of the APS which also actually exists. The APS also has a website and domain name at www.psychology.org.au. The Complainant's solicitors were no doubt curious as to why the APS was conducting an online clothing store and accordingly telephoned Mr. Ferreiro who informed them "that he was not associated with the website and that his name and employer's name had been falsely used in securing the registration of the Disputed Domain Name." Thus it seems that someone, probably associated with interests engaged in the clothing industry, decided to register the domain name when it came up for availability and wanted to cover their tracks by registering it, not in their own name or in the name of those interests but in what is essentially a false name and with false contact details, for there is no evidence that the APS or Mr.

Ferreiro were parties to or consented to the use of their names for this purpose.

- (e) As to why anyone would want to use the domain name for a clothing business is one of the strange aspects of this case. For instance, the domain name <nswfcls.com> is still available for registration, as is <nswfcls.com.au> and one would have thought that both of those domain names would have been more useful and valuable for a business than <nswfcls.org.au>. Nevertheless, for some unexplained reason, those responsible have decided to register the less commercial domain name, the disputed domain name.
- (f) How this all came about is somewhat uncertain. The Complainant says in its Complaint that it registered the disputed domain name “in 2008” and in its cease and desist letter of 9 September 2016 it says that it “has owned” the domain name “from 2008.” It is not entirely satisfactory that the Complainant has not provided the date on which it registered the domain name or any information on whether it renewed the registration and, if so, when, as those facts are clearly important to decide whether the Respondent has any right or legitimate interest in the domain name. Nor is there any evidence of the date on which the Respondent became the registrant of the domain name; all that the Complainant is apparently able to provide is that in July 2016 its staff received queries from the public about the fact that the website was hosting a fashion website and appeared to have been taken over;
- (g) A little more light can be thrown on the history of the domain name by the Wayback Machine at www.archive.org. This shows that the Wayback Machine kept records of what appeared on the website for www.nswfcls.org.au from time to time. The first of such screenshots was taken on 23 February 2009 and clearly covers the activities of the Complainant in the field of its work in community languages. The screenshot also carries the statement that “Site last updated Monday November 10, 2008.” This suggests that the Complainant owned the domain name at least by that date. The Panel

can therefore only assume that the Complainant had probably registered the domain name shortly prior to November 10, 2008.

- (h) There are many other screenshots available of the website at www.nswfcls.org.au on the Wayback Machine and the last of them was taken on October 2, 2016 which again deals with the activities of the Complainant in the field of community languages. The two dates just mentioned suggest that at least between 10 November, 2008 and 2 October 2016, the Complainant was the registrant of the domain name or had control over it.
- (i) There are no other screenshots for the website on the Wayback Machine after 2 October 2016.
- (j) The fact that the Complainant has not been able to exercise control over the domain name in any demonstrable way since 2 October 2016 and possibly since July 2016, when the Complainant became aware of changes to the website, suggests that the Complainant was the registrant of and was in effective control of the domain name from at least 10 November, 2008 until the latter half of 2016.
- (k) The Panel is therefore prepared to hold that the Complainant was the registrant of the domain name from 10 November 2008 until sometime in the latter half of 2016 and on a date that is uncertain.
- (l) It is also apparent that the Respondent was the registrant of the domain name from that date and is still the registrant.
- (m) What is omitted from that history is the answer to the important question: how did the Complainant cease to be the registrant and how did the Respondent become the registrant of the domain name?
- (n) Again, it is a matter of regret that the Complainant has not been able to provide at least some information on how it ceased to be the registrant of the domain name. The Panel is left to conclude that the Complainant

probably did not renew the registration when it came up for renewal, that this was perhaps due to inadvertence and that the interests behind the current registrant took the opportunity to buy the domain name when it then came up for sale.

- (o) The Panel is left with the fact that the Respondent gave false information when it registered the domain name by describing itself as The Australian Psychological Society Ltd and giving the Registrant Contact Name as Oscar Ferreiro and the Technical Contact Name as Oscar Ferreiro. That information was false and its falsity is revealed by the statement in the Complainant's submission that Mr. Ferreiro told the Complainant's solicitors that he was not associated with the website and that his name and his employer's name, his employer being The Australian Psychological Society Ltd, had been falsely used in securing the registration of the disputed domain name.
- (p) The Complainant's solicitors have set out the facts in paragraph (o) above and certified that they are complete and accurate and on that basis the Panel accepts that they have been proved and that the Respondent provided false information when it registered the domain name.
- (q) Paragraph 4(b) (v) of the Policy provides that it is evidence of bad faith in both the registration and use of a domain name that the registrant made "...representations or warranties as to eligibility ... given on application ...(that) are... false or misleading in any manner." The person who made the application for registration made representations as to the eligibility of the proposed registrant that were false concerning the correct name of the registrant and the correct registrant and technical contacts. This information is vital for the smooth operation of the naming system on the internet and its falsity in the present case was therefore serious. As it must therefore be held that the registration and use of the domain name were in bad faith, it is clear that the same facts cannot have given the named registrant and Respondent a right or legitimate interest in the domain name. The Respondent's registration of the domain name

was without any right or legitimate interest because it was made in bad faith and was false and deceptive in the manner described.

(r) Those behind the registration of the domain name must also have known that the application was in breach of the eligibility requirements for ".org.au" domain names and in particular that, according to the Policy 2012-04 - Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs, the registrant had to be a non-commercial organization to register the ".org.au" domain name. The registrant in reality was and is a commercial organization and those who registered the domain name must have known that it was to be used for a commercial purpose, as it was.

For these reasons, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interest in the disputed domain name.

As the Respondent has not filed a Response or made any attempt to show by any other means that it has a right or legitimate interest in the domain name, the Panel finds that the Respondent does not have a right or legitimate interest in the domain name.

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

Bad Faith

It is clear that to establish bad faith for the purposes of the Policy, Complainant must show that the disputed domain name was registered in bad faith or that it has been used in bad faith. In that regard, paragraph 4(b) of the Policy sets out several criteria which, if they are established, show bad faith registration and use. Those criteria are as follows:

“b. Evidence of Registration or Use in Bad Faith. For the purposes 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) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or

(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; or

(v) if any of your representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.”

The above criteria are non-exclusive and complainants may therefore rely on other factors showing bad faith, other than the specific criteria mentioned.

It would be difficult for the Complainant to make out a case of bad faith registration or use by relying on the criteria set out in sub-paragraphs (i)-(iv) , as they each depend on aspects of the Respondent’s intention which would be very difficult for the Complainant to prove. Sub-paragraph (v), however, is capable of being proved by evidence that comes from the actual registration of the domain name and the information provided by the Respondent at that time.

The Complainant submits in that regard that the Respondent made certain representations and warranties about its eligibility to register the domain name that were false or misleading. Those representations and warranties were essentially that the Registrant was the APS, that its name was the APS, that the Australian Business Number of the APS was the Registrant ID and Eligibility ID, that it was a non-profit organisation and that the Registrant Contact Name and Technical Contact was Mr. Oscar Ferreiro. The Complainant also submits that those warranties and representations

were and are false, as the APS was not the Registrant as it had not consented to be so, it had not consented to the use of its name and ABN and nor had Mr. Ferriero consented to be the Registrant Contact and Technical contact. The Complainant also submits that as the domain name is a “.org.au” domain name that has certain specific eligibility requirements, it was false and misleading to claim that the Registrant was “a non-commercial organisation” when it was and is clearly a commercial organisation. The Panel agrees with the Complainant that the representations and warranties made by the Registrant were false and misleading. Clearly sub-paragraph (v) and the eligibility requirements, working together, mean that the applicant for a “.org.au” domain name must provide truthful information about the real registrant and contacts and that that truthful information must show that it is a “a non-commercial organisation”. The evidence shows that the real registrant gave false and misleading information as to whom it was, who its contacts would be and whether it was such a non-commercial organisation; it gave a false name as registrant, a false name as to its contacts and a false statement that it was a non-commercial organisation.

The Panel therefore finds that the Respondent, whatever its real name may be, made representations and warranties as to eligibility that were and remain false and misleading in breach of Paragraph 4(b) (v) of the Policy and which are evidence of the registration and use of a domain name in bad faith. The Complainant, of course need only show that the domain name was registered or used in bad faith, but it has shown that the domain name was both registered and used in bad faith.

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

Relief

The Complainant has made out its case and is therefore entitled to relief. It has stated that it wishes the domain name to be transferred to itself or cancelled.

The Complainant is eligible to hold the “.org.au” domain name under auDA’s Domain Name Eligibility and Allocation Rules for the Open 2LDs (2012-04) . It is a non-commercial organisation, a charity operating in Australia and a non-profit organisation operating in Australia, as defined in the registrant’s constitution or other documents of incorporation. The domain name itself is an abbreviation or acronym of the registrant’s name.

The Panel's view is that it is better if the Complainant now resumes its licence to use the domain name and resume its valuable work by using the domain name, rather than cancelling the licence.

The Panel therefore orders that the licence to the Domain Name <nswfcls.org.au> be transferred to the Complainant.

The Honourable Neil Anthony Brown QC
Sole Panelist

28 December 2016

