

## PANEL DECISION

Case number:	auDRP_17_02
Domain:	newcastlepaintball.com.au
Panel:	Andrew Robertson
Complainant:	Hunter Valley Paintball Pty Ltd
Represented by:	Timothy Miller
Respondent:	Delta Force Properties Pty Ltd
Represented by:	Leon Bubenicek
Date of decision:	23 February 2017

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**1. Procedural history**

- 1.1 The disputed domain name is <newcastlepaintball.com.au>.
- 1.2 From the material provided to me it appears that the complainant lodged a complaint pursuant to the .au Dispute Resolution Policy ("auDRP") with the Resolution Institute ("the Institute") on 31 January 2017. I am advised it was acknowledged by the Institute to the complainant that day.
- 1.3 The Institute advises that the registrar was advised of the complaint, with a request to clarify the respondent and lock the domain name, on 31 January 2017. The Institute indicated the registrar advised the Institute on 1 February 2017 that the disputed domain was locked, however the material provided to me suggests it occurred after business hours on 31 January 2017. Nothing turns on this.
- 1.4 I am informed that the Institute advised auDA of the dispute on 1 February 2017.
- 1.5 The panel was advised by the Institute that the respondent was advised of the complaint by the Institute on 1 February 2017 and their response sought by no later than 21 February 2017.
- 1.6 The respondent provided its response on 7 February 2017.
- 1.7 The panel was approached by the Institute to act as panellist in this matter on 10 February 2017. The panel verbally advised that he was not aware of any conflict on 10 February 2017. The panel signed and returned a declaration of impartiality and independence on 13 February 2017.
- 1.8 The panel received the case file on 10 February 2017.
- 1.9 The panel received the following material from the Institute with a covering email:
  - (a) Draft Statement of Impartiality and Independence;
  - (b) A Procedural History setting out the details as indicated above;
  - (c) An application dated 18 January 2017 on its face although one addendum is dated 31 January 2017;
  - (d) The notification to the registrar dated 31 January 2017;
  - (e) The registrar's response dated 31 January 2017;
  - (f) The Institute advice to auDA dated 1 February 2017;
  - (g) The Institute's advice to the respondent dated 1 February 2017;
  - (h) The respondent's communication to the Institute dated 7 February 2017;
  - (i) The notification of panellist allocated dated 10 February 2017.
- 1.10 A sole panellist has been requested.
- 1.11 The panel find that it was properly constituted for this complaint.

## 2. Parties

- 2.1 The applicant is a corporation, Hunter Valley Paintball Pty Ltd.
- 2.2 The respondent is also a corporation, Delta Force Properties Pty Ltd.
- 2.3 The disputed domain name is newcastlepaintball.com.au.

## 3. Background and Submissions

### The Applicant's submissions

- 3.1 The applicant asserts that the disputed domain name should be transferred to it.
- 3.2 The applicant's case is set out in the application filed with the Resolution Institute.
- 3.3 The applicant says that in 2010 the business name "Newcastle Paintball" was purchased and registered with ASIC with registration number BN98512998.
- 3.4 The applicant attaches to its submission material from ASIC indicating a NSW business name registration for "Newcastle Paintball".
- 3.5 The disputed domain name was registered by the applicant in 2013 "when it became available". I infer from this wording that it has been earlier registered by another.
- 3.6 The applicant attaches to its submissions a netregistry invoice dated 2 May 2013 recording payment for a website.
- 3.7 The applicant says that it overlooked maintaining the disputed domain name such that it lapsed in 2015.
- 3.8 On 16 January 2017, that is approximately three weeks prior to the panel's appointment, the applicant says that it became aware that the disputed domain name had been registered by another.
- 3.9 The applicant identifies that it had purchased the business name to set up another venture in the Newcastle area. The applicant says it has been delayed in its plans as it is still seeking a suitable site but wishes to still proceed with the venture and for that venture to have its own identity.
- 3.10 The applicant denies that the respondent has a legitimate interest in the disputed domain name.
- 3.11 The applicant asserts that the disputed domain name has no resemblance to the business name of the respondents, Delta Force Properties Pty Ltd. The use of the disputed domain name by the respondent would cause confusion with the paintball industry of Newcastle.
- 3.12 The applicant alleges that as at the time of the preparation of the application on 19 January 2017 the disputed domain name displayed a page with the applicant's business name, Newcastle Paintball, on the top.
- 3.13 A copy of what the page is said to contain is attached to the application. It also has the words "Coming Soon" and a picture of three people holding paintball guns

dressed in military like clothing with a helicopter and other stylised images behind them.

#### The Respondent's submissions

- 3.14 The respondent also provided submissions.
- 3.15 The respondent alleged that in August 2016 it entered into negotiations to purchase a lease holding from a third party for the purpose of establishing a paintball facility in the Newcastle region.
- 3.16 The respondent submitted that the facilities required renovation as they were “tired” and needed to be brought in line in with what the respondent described as “standards befitting the Delta Force Paintball brand”.
- 3.17 At some time, the exact timing is unclear, although the submission suggests it was subsequent to August 2016<sup>1</sup>, the respondent became aware that the disputed domain name was available for registration.
- 3.18 The respondent asserts that it has a policy of using domains employing a “<location>paintball” domain strategy. The respondent attached to its submission material showing websites hosted at:
- (a) canberrapaintball.com.au;
  - (b) sydneypaintballing.com.au; and
  - (c) brisbanepaintballing.com.au
- 3.19 I note that two of these three sites use a “<location>paintballing” strategy.
- 3.20 I also note that the material from the respondent displays a domain paintballing.com.au in the top right hand corner.
- 3.21 The respondent does not address in its submissions the different grammatical form, ie “<location>paintball” vs “<location>paintballing”.
- 3.22 The respondent says that a website at the disputed domain went live on 20 January 2017.
- 3.23 I note that it appears this date pre-dates the advice to the respondent by the Institute of the applicant's claim on 1 February 2017.
- 3.24 The website suggests that the respondent is operating a paintball facility in the Newcastle region.
- 3.25 The respondent submitted that it had gone to considerable expense to date with respect to promotional materials, printing and marketing of the website. The extent of this expense is not identified but annexed to the submission are photographs or mock-ups of:
- (a) A printed café barrier; and

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<sup>1</sup> There is a reference to “Upon further research”, which appears to be after the earlier reference to “In August 2016”.

- (b) A printed road sign.
- 3.26 There are also screenshots from a Facebook page for “Delta Force Paintball – Newcastle NSW”. There is at least one reference to the disputed domain name on that page and another reference to a webpage which is displayed truncated but which may be the disputed domain name.
- 3.27 The submissions then makes reference to the auDA policy and particularly reference the policy’s indication that domain names are allocated on a first come, first served basis.
- 3.28 The submissions also reference the categories for a close and substantial connections are:
- “a) a product that the registrant manufactures or sells; or*
- b) a service that the registrant provides; or*
- c) an event that the registrant organises or sponsors; or*
- d) an activity that the registrant facilitates, teaches or trains; or*
- e) a venue that the registrant operates; or*
- f) a profession that the registrant's employees practise.”*
- 3.29 The respondent’s broadly submit that its use of the disputed domain name meets these criteria in many ways.
- 3.30 The respondent then proceeds to respond to the complainant’s case.
- 3.31 The respondent says that the disputed domain name describes the venue and location of the respondent’s facility.
- 3.32 There is a reference to the domain name not attracting trademark protection.
- 3.33 The respondent say the domain name was available at the time of the registration and had been for more than 12 months.
- 3.34 The respondent says the applicant trades as “Hunter Valley Paintball”.
- 3.35 The respondent says that it has a justified and legitimate interest in the dispute domain name.
- 3.36 The respondent submits that as the applicant never used the domain the suggestion of alleged confusion is negated. The respondent alleges that applicant’s identity is “Hunter Valley Paintball” and that the applicant’s trading name has never operated and the domain name lapsed. This is contrasted with the respondent’s actions from August 2016.
- 3.37 The respondent says that the applicant's “poor business skills”, to which the applicant refers as the basis for the lapse in registration are not matters for the respondent “to consider or be held responsible for”.

- 3.38 The respondent says it acted in accordance with the auDA policy and intends to operate paintball facilities in Newcastle.
- 3.39 The respondent's submission rejects any bad faith on the respondent's part submitting that:
- (a) The disputed domain name was registered in keeping with the respondent's policy of registering domains outlining the service and the location of the paintball field and the customers it will service. The registration was as a result of the purchase of the lease-hold of a Paintball facility in Newcastle;
  - (b) The respondent did not register the disputed domain name to prevent the applicant from using its registered business name. The respondent says that the applicant trades as "Hunter Valley Paintball" and exhibited a website to their submission said to show the applicant trading using the domain `huntervalleypaintball.com.au`;
  - (c) The disputed domain name had not previously been used by the applicant. The respondent submits that, "Various web utilities show no content on the domain whatsoever until DFP published a "Coming Soon" page and subsequently launched its website in January 2017"<sup>2</sup>. Prior to the respondent's registration the domain has been unregistered for more than two years; and
  - (d) There were no false or misleading representations or warranties as to eligibility or third party rights given on application or renewal of this domain name.

#### 4. Relevant principles

- 4.1 This dispute is to be resolved in accordance with auDRP Policy published by .au Domain Administration Ltd including Schedule A to that document.
- 4.2 Paragraph 4 (a) of the auDRP Policy provides that for the dispute to come within the auDRP a complainant must establish that:
- (a) the disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and
  - (b) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
  - (c) the disputed domain name has been registered or subsequently used in bad faith.
- 4.3 Each of these elements must be established if the complainant is to succeed. The remedies available to the parties are limited in this process to those contained in the policy at paragraph 6. Therefore a decision in this determination resolves only the issues and the question of relief provided for in the auDRP.
- 4.4 In these proceedings the complainant bears the onus of proof for establishing it has made out the elements of auDRP.

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<sup>2</sup> This evidence was not expanded upon nor provided.

- 4.5 The panel will reach its determination based on the material provided to the panel. Where material is incomplete or uncertain the panel will not seek to clarify this material itself but will consider these issues in weighing the competing propositions advanced.

**Identical or confusingly similar**

- 4.6 I note that dispute domain name consists of a combination of two words. Newcastle and paintball.
- 4.7 The domain is a .au domain. I am aware that Newcastle is a well-known city, and region, in Australia. The city of Newcastle is a major city in the State of New South Wales and therefore is known as a geographic location.
- 4.8 Combined with the entertainment activity of paintball the words in combination suggest a link with undertaking paintball in the Newcastle region.
- 4.9 The applicant's submissions state, "I Timothy Miller purchased the business name Newcastle Paintball". The applicant is the corporate entity not the individual.
- 4.10 The applicant attached to the submission an ASIC extract. This confirmed that the business name had been registered however it did not confirm the owner of the business name.
- 4.11 The respondent has not addressed this issue in its submissions. It does not appear to concede the business name is registered by the respondent, although this is never expressly put in issue. Someone has registered the business name.
- 4.12 The respondent asserts that the domain had not been used and the applicant does not allege that it has, yet, traded under this business name. The applicant does say that it has been unable to find a suitable site in the Newcastle area.
- 4.13 The evidence appears to be that the business name was registered in 2010. The domain name registered three years later. It suggests some ongoing intention to trade but no activity in and of itself said to create rights in respect of the disputed domain name.
- 4.14 For the reasons set out below the panel does not need to reach a conclusion on the first element required in paragraph 4 (a) of the auDRP Policy.

**No rights or legitimate interests**

- 4.15 The second element of the policy requires the complainant to prove that the respondent lacks rights or legitimate interests in the domain name.
- 4.16 The auDRP makes clear in Note 2 that "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".
- 4.17 Therefore the respondent's submissions based on its acting in accordance with the auDA policy cannot of itself be sufficient to establish that it has a right or legitimate interest.



- 4.18 The auDRP, in paragraph 4 (c), sets out how a respondent may establish for a panel that a respondent has rights to and legitimate interests in the disputed domain name in order to satisfy this element.
- 4.19 The examples contained in sub-paragraphs (i) to (iii) are not exclusive of how the respondent may satisfy a panel but are indicative of issues the panel may consider.
- 4.20 Sub-paragraph (ii) provides, “before any notice to you of the subject matter of the dispute, your bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that you have acquired for the purpose of selling, renting or otherwise transferring)”. The references to you in that sub-paragraph are references to the respondent.
- 4.21 The panel may determine what evidence is to be admitted and the weight to be given to it (auDRP Rules 10 (b)). While the evidence may be not entirely clear the panel finds the following chronology of events appears to be established on the material submitted:
- (a) The applicant’s registration of the disputed domain name lapsed on or about May 2015 based on the netregistry invoice;
  - (b) In August 2016 the respondent entered into negotiations to purchase a leaseholding for a paintball facility in the Newcastle region;
  - (c) The disputed domain name was registered by the respondent, the exact timing is unclear as noted above but the evidence appears to be after the negotiations commenced and it must be before any page went live;
  - (d) The disputed domain name went live with the holding page exhibited to the applicant’s submissions. That page was said to be present on 19 January 2017. The applicant seeks to refer to this page adversely. The page is consistent with the respondent’s alleged preparations, displaying the words “Coming Soon”;
  - (e) The disputed domain subsequently was updated, in January 2017, with the page for the Newcastle facility exhibited to the respondent’s submissions;
  - (f) The respondent was made aware of the subject matter of the dispute by the Institute on 1 February 2017.
- 4.22 I cannot determine on the material provided to me how much of the Facebook page and the signage the respondent refers to was undertaken prior to the respondent being made aware of the subject matter of the dispute but noting that the respondent was made aware of the subject matter of the dispute on 1 February 2017 and the respondent’s submissions, exhibiting this material, are dated 7 February 2017 I infer some preparations to use the disputed domain name related to these matters were likely to have taken place prior to 1 February 2017.
- 4.23 The linkage of the domain name with a service offered and a geographic location in which it is offered and the chronology of events demonstrate the respondent’s legitimate interest in respect of the disputed domain name. Further, the evidence shows the use, and preparation for further usage, by the respondent of the disputed domain name in conducting its business at the Newcastle location.

- 4.24 For the reasons set out below the panel does concludes the applicant has failed to establish the second element required in paragraph 4 (a) of the auDRP Policy. As such the application must fail.

**Bad faith**

- 4.25 By reason of the conclusions identified above the panel does not need to consider this aspect.

**5. Conclusion and decision**

- 5.1 For the reasons set out in this determination the panel orders that the complaint be denied.



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**Andrew Robertson**

Dated: 23 February 2017