

Decision

Matter Number: auDRP_17_07

Date:	30 June 2017
Panelist:	Philip N Argy
Complainant:	Into Blinds Pty Ltd and John and Mark McDonald
Respondent:	Cost Less Décor Blinds Pty Ltd (as trustee for Cost Less Décor Blinds ABN 87 670 942 726, a discretionary trading trust)
Disputed Domain Names:	intoblindsandplantationshuttersmelbourne.com.au intoblindsandpsm.com.au intublinds.com.au intoshuttersawningsblinds.com.au
Date complaint lodged:	2 nd May 2017; amended 10 th May 2017
Date response lodged:	21 st May 2017
Lock of domain names confirmed:	1 May 2017 for intoblindsandplantationshuttersmelbourne.com.au intoblindsandpsm.com.au intublinds.com.au 17 May 2017 for intoshuttersawningsblinds.com.au

1. THE PARTIES

- 1.1 The Complainant is Into Blinds Pty Ltd together with Messrs Mark and John McDonald of Melbourne, Victoria. They are represented by Mr Dean McNamara of Logie-Smith Lanyon Lawyers of Melbourne, Victoria.
- 1.2 The Respondent, Cost Less Décor Blinds Pty Ltd of Essendon, Victoria, is trustee of a discretionary trading trust known as Cost Less Décor Blinds, which is the recorded registrant of the Disputed Domain Names. Its sole action was the transmission of an email from its nominated contact, Mr Robert Burgueño, refusing to participate in these proceedings.

2 THE REGISTRARS

- 2.1 The Registrar of intoblindsandplantationshuttersmelbourne.com.au, intoblindsandpsm.com.au and intublinds.com.au is Web Address Registration (formerly known as Crazy Domains).
- 2.2 The Registrar of intoshuttersawningsblinds.com.au is TPP Wholesale.

3. PROCEDURAL HISTORY

The original complaint was filed with Resolution Institute (**RI**) on 2 May 2017. After correction of administrative deficiencies a revised complaint (the **Complaint**) was filed on 10 May 2017 pursuant to the .au Dispute Resolution Policy (the “Policy”), the Rules for .au Dispute Resolution Policy (the “Rules”), both as adopted by auDA on 13 August 2001 and amended on 1 March 2008, and RI’s Supplemental Rules for .au Dispute Resolution Policy (“Supplemental Rules”).

Pursuant to paragraph 3(b)(xii) of the Rules, the Complaint recites that it was served on the Respondent before filing. Under paragraph 2(f) of the Rules an email sent to the contact email address in the WhoIs record is a valid communication to the Respondent, subject to any contrary decision of the Panel.

On 10 May 2017 RI wrote to the registrars of the Disputed Domain Names requesting confirmation of the WhoIs information. By 17 May 2017 the requested confirmation had been duly received. RI then used the WhoIs contact email address to notify the Respondent’s Administrative Contact, Mr Burgueño, of the Complaint on 19 May 2017, thus starting the 20 day period within which a Response had to be filed.

On 21 May 2017 at 11:26 pm Mr Burgueño sent an email to RI disputing its authority, denying the validity of this administrative proceeding, and stating that the Respondent had “written to Logie-Smith Lanyon Lawyers on more than one occasion and clearly indicated that Cost Less Décor Blinds disputes the allegations but will only ventilate all the evidence to support the position of Cost Less Décor Blinds if the matter proceeds to Court”. The following day RI replied by providing Mr Burgueño with information about auDA and explaining the legal foundation for the Policy. No further communication was received from the Respondent or anyone acting on its behalf.

RI appointed Philip N Argy as the sole panellist in this matter on 16 June 2017 after the Panel had furnished the requisite Declaration of Impartiality.

The Disputed Domain Names are all registered to “COST LESS DÉCOR BLINDS” with an Australian Business Number of 87670942726. According to the Australian Business Register that number corresponds to a discretionary trading trust the trustee of which is the named Respondent in this proceeding which has an Australian Business Number of 54078220461. When proceedings are taken against a trust it is appropriate to bring the proceedings against the trustee of the trust as it is the trustee who is responsible

for the conduct of the trust. Accordingly, the Panel regards it as quite appropriate for these proceedings to be brought against the trustee of the registrant trust and upholds RI's direction to the Complainants to that effect.

All other administrative requirements appear to have been satisfied.

4. Factual Background

In the absence of a Response, the following facts, taken from the Complaint, remain unchallenged apart from the broad disputation of allegations made in the Respondent's email of 21 May 2017 referred to above.

Messrs John and Mark McDonald have since 1 September 2009 been the registered proprietors of Australian trademark number 1318488 for INTO BLINDS in class 35 for "Sale of blinds". They are also the proprietors of an INTO BLINDS trademark in class 20 for blinds and related goods and another word mark for INTO BLINDS covering classes 6, 19, 20, 22, 24, 35 and 37. And they are the proprietors or applicants for other marks comprising or including the word INTO in various classes.

The corporate Complainant obviously also owns the company name Into Blinds Pty Ltd and has done so since 2 June 2009.

In May 2016 the Complainants became aware that the Respondent had begun using INTO BLINDS in the Disputed Domain Names, as Google advertising keywords, and in the registration of numerous business names. The Respondent also used photographs and images from the Complainants' website on the website to which all of the Disputed Domain Names resolved.

The Complainants also sent a letter of demand to the Respondent requesting that it cease and desist from the above activities but the Respondent "ignored and refused" the Complainants' attempts to resolve the matter.

5. Parties' Contentions

A. *Complainant*

The Complaint is based on all three elements of paragraph 4(a) of the Policy, namely, that the Disputed Domain Names are identical or confusingly similar to a name, trademark or service mark in which the Complainants have rights, that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names, and that the Disputed Domain Names were registered or have subsequently been used in bad faith.

In relation to the first element the Complainants assert that the Disputed Domain Names are confusingly similar to their registered trademarks and names embodying INTO and INTO BLINDS.

In relation to the second element they assert that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because the Complainants began using INTO BLINDS in June 2009 and have secured trademark rights and built up common law rights in the family of names using those words since

that time. They go on to submit that they have built up a significant reputation in the marketplace from sales and advertising over that period of time and say that the Respondent has sought to capitalise on this “in order to confuse consumers, detract business from the Complainants and for their own commercial gain”.

And in relation to the third element they assert that the Disputed Domain Names were registered and have subsequently been used in bad faith “for the reasons outlined above”. In particular, the Complainants allege that the Respondent has “deliberately sought to register identical or confusingly similar domain names ... for the purposes of confusing consumers and detracting potential and actual work leads from the Complainants”.

At best, the Complainants say, the Respondent registered and has used the Disputed Domain Names in bad faith and, at worst, has engaged in misleading and deceptive conduct involving customers.

B. Respondent

Apart from the email disputing the validity of these proceedings and denying the allegations made, referred to in section 3 above, there has been no further communication from the Respondent or anyone on its behalf.

6. Discussion and Findings

The Panel has to determine whether on the available material it is satisfied in relation to each of the Disputed Domain Names that each of the three elements of the Policy has been made out, the onus being on the Complainants.

The Complaint is brief and not well tuned to the elements of the Policy. Nor does it include documentary evidence of the kind that usually accompanies a complaint under the Policy. For example, there is no information about the dates on which the Disputed Domain Names were registered, no evidence of the claimed trademark registrations, no evidence of the business name registrations and little more than a bare assertion in relation to the second element of the Policy. It is not for a panel to make good a complainant’s case. It must make good all of the grounds of its complaint on the balance of probabilities based on cogent submissions with supporting documentary evidence.

Despite the deficiencies of the Complaint, the Panel has been able to verify a number of the facts asserted by reference to publicly available information from IP Australia and from the Australian Business Register.

Another respect in which the Complaint is of concern to the Panel is the way it elides the difference between the trademark rights vested in John and Mark McDonald by virtue of their formal trademark registrations, and the name rights vested in the corporate Complainant. Furthermore, there is no explanation of the relationship between Messrs McDonald and the corporate Complainant nor any statement that the corporate Complainant is licensed to use the registered trademarks which it does not own. Especially when, as here, the proceedings are brought in respect of multiple Disputed Domain Names, it is important to align each element of the Policy with the

relevant Complainant whose rights are asserted in respect of each of the Disputed Domain Names.

A. *Identical or Confusingly Similar*

None of the Disputed Domain Names is identical to a name or trademark in which any of the Complainants have rights. However, in relation to the first element of the Policy it is beyond argument that *intoblindsandplantationshuttersmelbourne.com.au* and *intoblindsandpsm.com.au* include and commence with the natural Complainants' INTO BLINDS trademark. On that basis it is easy for the Panel to conclude that those two domain names are confusingly similar to that trademark. Those two Disputed Domain Names are for the same reason also confusingly similar to the corporate Complainant's name. The suffixing of descriptions of goods or geographic locations that are entirely consistent with the corporate Complainant's business does nothing to dispel the confusing similarity once the initial interest confusion has been created by use of the natural Complainants' precise trademarks.

In relation to the other two Disputed Domain Names, namely *intublinds.com.au* and *intoshuttersawningsblinds.com.au*, the position is not as straightforward. Despite this the Panel is comfortably satisfied that "intublinds" is at least homophonically the same as INTO BLINDS. *intoshuttersawningsblinds.com.au* commences with INTO which is the subject of an independent trademark registration by the natural individual Complainants and, in the Panel's view, the corporate Complainant has a well-established long-standing common law trademark using INTO in various forms as well as in its corporate name.

The Panel therefore concludes that all of the Disputed Domain Names are at least confusingly similar to trademarks in which the natural Complainants have rights as well as, in the case of three of the Disputed Domain Names, being confusingly similar to the corporate Complainant's name.

On the balance of probabilities, the Panel is unable to conclude that *intoshuttersawningsblinds.com.au* is confusingly similar to the corporate Complainant's name but finds it confusingly similar to the INTO trademark owned by the natural Complainants.

B. *Rights or Legitimate Interests*

In relation to the second limb of the Policy the Panel has to determine whether the Respondent has any rights or legitimate interests in respect of the Disputed Domain Names. In the absence of any Response it is not the role of the Panel to be a proper contradictor to the Complainants. However, the public record does disclose that the Respondent trust owns a number of business names. These include INTU Blinds & Shutters (registered on 11 April 2017), INTO BLINDS & PLANTATION SHUTTERS MELBOURNE (registered on 27 October 2015) and INTO SHUTTERS AWNINGS BLINDS (registered on 14 September 2015). Furthermore, the Respondent trustee also owns the business names Into Blinds & Shutters and Into Blinds & Plantation Shutters.

In addition to the Policy, auDA has a published policy called the *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs*. This key policy contains the eligibility rules that must be met before a domain name can be registered in the open

second level domains under .au (2LDs). Relevantly, paragraph 2 of Schedule C provides:

2. Domain names in the com.au 2LD must be:
 - a) an exact match, abbreviation or acronym of the registrant's name or trademark; or
 - b) otherwise closely and substantially connected to the registrant.

On the basis of the available evidence the Respondent could plausibly cite its business name registrations in support of its registration of the Disputed Domain Names. However, it having chosen not to file any Response, and absent any explanation of the source of the Respondent's right to the business name registrations which it has procured, the Panel is not prepared to draw that inference in the Respondent's favour.

It would have been useful if the Complaint had made explicit that the Respondent was not authorised by any of the Complainants to register business names that conflicted with the natural Complainants' registered trademarks and the corporate Complainant's company name. The closest the Complaint gets is the curious statement "whilst the registration of the business names is not directly relevant to this matter, it demonstrates the type of behaviour engaged in by the Respondents [sic] is and was calculated to cause damage to our client's business and confusing customers". Based upon the length of time the corporate Complainant has been using its name and business names it does seem odd that the Respondent was able to register such similar business names. But for those registrations the Panel assumes that the Respondent would not have been able to register the Disputed Domain Names.

On balance the Panel is satisfied that the Respondent has no rights or legitimate interests in respect of any of the Disputed Domain Names.

C. Registered or Subsequently Used in Bad Faith

Under this limb of the Policy the Complainant's submission is that the Respondent has "deliberately sought to register identical or confusingly similar domain names to those used by our clients since 2009 for the purposes of confusing consumers and detracting potential and actual work leads from our client. At best, the Respondents [sic] have registered and used those domain names in bad faith and, at worst, have engaged in misleading and deceptive conduct involving customers".

Whilst the submission is poorly adapted to engage the relevant provisions of the Policy, considering the Respondent's breach of the Complainants' copyright in some of the photographs displayed on the website to which the Disputed Domain Names resolve, and its refusal to recognise the legitimacy of, nor participate in, these proceedings, the Panel has come to the view that the Respondent is using the Disputed Domain Names in bad faith and probably also registered them in bad faith.

7. Remedy

Under paragraph 4(i) of the Policy a Panel is unable to order that a domain name be transferred to a complainant unless that complainant "is otherwise eligible to hold that domain name". The Complaint does not address this issue in terms and

the Panel has been left to deduce the Complainants' eligibility from the material available to it. For the most part that shows that the trademark registrations owned by John and Mark McDonald are the strongest rights giving rise to the success of the Complaint save for the corporate Complainant's slightly superior rights in the Disputed Domain Name that is a homophonic equivalent to its corporate name.

8. Decision

The Complainants having variously made out the three grounds on which they needed to succeed, the Panel orders pursuant to Paragraphs 4(i) of the Policy and 15 of the Rules:

- a) that the domain name *intoblindsandplantationshuttersmelbourne.com.au* be transferred to John and Mark McDonald, who the Panel determines to be eligible to hold the Disputed Domain Name by virtue of their Australian trademark registrations for INTO BLINDS;
- b) that the domain name *intoblindsandpsm.com.au* be transferred to John and Mark McDonald, who the Panel determines to be eligible to hold the Disputed Domain Name by virtue of their Australian trademark registrations for INTO BLINDS;
- c) that the domain name *intoshuttersawningsblinds.com.au* be transferred to John and Mark McDonald, who the Panel determines to be eligible to hold the Disputed Domain Name by virtue of their Australian trademark registrations for INTO; and
- d) that the domain name *intublinds.com.au* be transferred to Into Blinds Pty Ltd, which the Panel determines to be eligible to hold the Disputed Domain Name by virtue of its corporate name and business name registrations.



Philip N. Argy
Sole Panellist

Dated: 30th June 2017