

**Domain Name:** *fintech.com.au*

**Name of Complainant:** *Fintech Financial Services (AFSL 408634)*

**Name of Respondent:** *David Butler*

**Provider:** *Resolution Institute*

**Single Member Panellist:** *Dennis Liner*

### **1. The Parties**

- 1.1 The Complainant in this proceeding is Fintech Financial Services (AFSL 408634) ABN 59 107 892 473, Level 3, 4 Kyabra Street, Fortitude Valley, Queensland 4006 (“the Complainant”).
- 1.2 The Respondent named in this proceeding is David Butler, 5/22 Wayland, Street, Stafford, Queensland 4053 (“the Respondent”).

### **2. The Domain Name, Registrar and Provider**

- 2.1 The Domain Name subject to this proceeding is “*fintech.com.au*” (the Domain Name”).
- 2.2 The Registrar of the Domain Name is Go Daddy (“the Registrar”).
- 2.3 The provider in this Proceeding is Resolution Institute of Level 2, 13-15 Bridge Street, Sydney, NSW 2000 (“the Provider”)

### **3 Procedural Matters**

- 3.1 This proceeding relates to the complaint submitted by the Complainant in accordance with:-
- (i) the .au Dispute Resolution Policy no.2016-01 published 15 April 2016 (“auDRP”) which includes Schedule A (Policy) and Schedule B (Rules); and
  - (ii) the Provider’s supplemental rules for the au Domain Name Dispute Policy.

- 3.2 The Provider was supplied with a copy of the ADR Domain Name Dispute Complaint Application Form on Friday 21 September 2018 by way of an email, such email attaching supporting documentation referred to below.

The Provider was supplied with a Response of the Respondent lodged by way of an email Sunday 14 October 2018.

I find that the making of the Compliant and the Response together with the supporting documentation referred to below comprise all the relevant matters submitted to the Panellist. I have perused the documents and I am satisfied that the service of the documents and the time for service of the documents complies with the Rules.

- 3.3 The documents supplied by the Complainant were as follows:-

ADR Domain Dispute Application Form comprising the email letter of the Complainant dated 21 September 2018 to which the documents set out below were attached:

- i) Resolution Institute Domain Name Dispute Complaint Application Form.
- ii) Complaint headed "Rectified Complaint from Fintech Financial Services Pty Ltd" ('the details of Complaint').
- iii) Certificate of Registration of Trade Mark "FINTECH" (No. 1759063) with Attachment.
- iv) Extract from the Australian Business Register for ABN 59 107 892 473
- v) Extract from the Whois report for FINTECH.COM.AU
- vi) Extract from the Australian Business Register for David Butler
- vii) Copy of auDA Policy

- 3.4 The document supplied by the Respondent was as follows:-

Response by way of email dated 14 October 2018 to which the documents set out below were attached:

- i) Tax Invoice from NetAlliance Pty Ltd Trading as Netfleet to Vidmat Media Pty dated 13 August 2018
- ii) Search of Current Details for ABN of Vidmat Media Pty Ltd.
- iii) Document (16 pages) titled "Fintech.com.au planned pages" endorsed on each page "Confidential and commercially sensitive .....Respondent Submission".
- iv) Whois search of Fintechfinancialservices.com.au.

#### **4 Factual background**

##### **FACTS ALLEGED BY THE CLAIMANT**

- 4.1 The Claimant is the legal owner of the "Fintech" trade mark which has been registered in Australia (Document 3.3 iii).

- 4.2 The Complainant states that it operates other businesses under the same ABN as set out in its Document 3.3 iv (“Fintech Services” and “Yodal”).
- 4.3 The registered Trade Mark, “Fintech” is held by the Complainant’s holding company, IF Solutions Pty Ltd.
- 4.4 The Complainant provides financial advice, SMSF advice and management, Accounting services, utilises latest technology platforms and develops its own in-house technical processes and is investigating AI (artificial intelligence) into its business.
- 4.5 The registration of the Domain Name prevented the Complainant to register such Domain Name. Further, the Domain Name has been parked (unused) since it was registered and accordingly it could indicate that that the current owner registered it primarily for the purpose of selling, renting or otherwise transferring the Domain Name to another person for valuable consideration in excess of the direct registration costs, this being in contravention of au Dispute Resolution Policy (auDRP) Schedule A, clause 4.b(ii).

#### **FACTS ALLEGED BY THE RESPONDENT**

- 4.6 The Domain Name was purchased in the name of the Respondent with intention of it becoming registered in the name of the Vidmat Media Pty Ltd (“Vidmat”), of which the Respondent is a Director. The Respondent still intends to rectify such registration. Prior to such purchase, the Respondent was unsuccessful in purchasing other domain names.
- 4.6 The Domain Name was not registered in bad faith as Vidmat and the Respondent planned an Australian “Fin Tech” directory and news hub. As such, he has a bona fide intention to use the Domain Name and has taken steps towards such use, thereby demonstrating his rights and legitimate interests in the Domain Name. Vidmat has undertaken significant amounts in preparing to build its website. There have been numerous meetings and many hours have been spent in development, planning the structure of the website, researching the best Content Management System for the website and branding. The Respondent’s Document 3.4 iii) sets out 646 proposed pages for the website, etc. This evidences the work done. This work commenced prior to the purchase of the Domain Name and was ongoing in the 6 weeks between the purchase and this Complaint. Further, any parking (non-use) prior to 13 August 2018 cannot be attributed to the Respondent or Vidmat .
- 4.7 The contents of Paragraph 4.6 above also demonstrates that there is a connection between the Domain Name’s descriptive meaning and the Respondent’s offering of goods and services to comply with a bona fide use of the Domain Name in accordance with paragraph 2.1A of the auDA Overview of Panel Views on Selected auDRP Questions First Edition (“Panel Views”).

- 4.8 The Domain Name is not identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights. “FinTech” is an amalgamation of the words “financial technology” and is a commonly used word for the generic name of the financial technology industry. It is a descriptive rather than distinctive term not capable of being registered under the Trade Marks Act 1995 or monopolised by anyone. The Complainant’s name is “Fintech Financial Services Pty Ltd whereas the Domain Name is “fintech.com.au”. Accordingly, the name is not identical to a name in which the Complainant has rights, nor is it confusingly similar.

The use of the Domain Name does not infringe the Complainant’s trade mark (Complainant’s Document 3.3 iii). The trade mark comprises both a word and a logo and does not extend to the word “FinTech” alone. There is no infringement by the use of “fintech” in a domain name, as it is not substantially identical or deceptively similar to the composite mark owned by the Complainant. Neither the Respondent nor Vidmat intend to use the Domain Name to provide services in the classes as approved in the trade mark or provide similar financial services that the Complainant provides.

## **5 Jurisdiction**

- 5.1 Paragraph 2.1 of the auDRP states:

“All Domain Name licences issued or renewed in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP.”

- 5.2 The Domain Name, being “com.au”, is an open 2LD within the scope of the aforementioned paragraph. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP

## **6 Basis of Decision**

- 6.1 Paragraph 15(a) of the Rules state:

*“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy (auDRP Policy), these Rules and any rules and principles of law that it deems applicable.”*

- 6.2 Paragraph 4(a) of the Policy provides that a person is entitled to complain about the registration or use of a Domain Name where:

- i) the Domain Name is identical or confusingly similar to a name, Trade Mark or service mark in which the complainant has rights; and*
- ii) the respondent to the complaint has no rights or legitimate interests in respect of the Domain Name; and*

*(iii) the respondent's Domain Name has been registered or subsequently used in bad faith.*

I note that all three components of Paragraph 4(a) are required to be proven for any Complaint to be upheld.

- **Domain Name is identical and confusingly similar to names or Trade Marks in which the Complainant has rights.**

The Complainant contends that the Domain Name is identical to the name and Trade Mark of the Complainant. The Respondent contends that "fintech" alone would not be accepted for trade mark registration, but because a logo is also included it is not identical or confusingly similar to the Domain Name.

Panel Views, paragraph 1.11 states: "As figurative, stylized or design elements in a trademark are generally incapable of representation in a domain name, such elements are typically disregarded for the purpose of assessing the identity or confusing element of a domain name with a trademark. Accordingly, the assessment is generally made between the alpha-numeric components of the domain name and the dominant textural component of the relevant trademark".

Accordingly, if the logo in the trademark is disregarded, then the trademark is identical (omitting "com.au"). It is irrelevant if the goods, services provided or business being operated by the Respondent is different to that of the Complainant.

*The Domain Name is identical to the trade mark of the Complainant. Accordingly, I find that Paragraph 4(a) (i) is satisfied.*

- **Respondent has no rights or legitimate interests in respect of the Domain Name**

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name upon the basis that the Complainant has the exclusive rights to "fintech" as a result of its registered trade mark, carries on a business under the name of Fintech Services, is prevented from registering a domain name the same as the Domain Name and the Respondent has not used the Domain Name.

*Pursuant to Schedule A of auDRP the Respondent is required to demonstrate its rights or legitimate interests in respect to the Domain Name by inter alia, any of the following:*

- *before any notice to the respondent of the subject matter of the dispute, the respondent's bona fide use of, or demonstrable preparations to use, the domain name or a domain name corresponding to the domain name in connection with an offering of goods or services(not being the offering of domain names that it has acquired for the purpose of selling, renting or otherwise transferring); or*

- *the respondent (as an individual, business, or other organisation) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or*
- *the respondent is 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.*

The Respondent contends before any notice of this dispute it was preparing to use the Domain Name (see paragraph 4.6).

In support of this contention, the Respondent details work carried out and Document 3.4 iii does, in fact much preparation has been done. However, the Respondent states that work was carried out prior to the acquisition of the Domain Name and, in fact, had been trying to acquire other names. It therefore seems that this work was carried out for a proposed business to commence under any name, not necessarily the Domain Name that was subsequently purchased.

*Upon evaluating all the evidence provided to me I find that the Respondent has not demonstrated its rights or legitimate interests to the Domain Name for the purposes of Paragraph 4(a)(ii).*

- **The Domain Name was registered or was subsequently used in bad faith**

The Complainant contends that the Domain Name was registered or was being used in bad faith as it has been parked (unused) since it was registered and this could indicate that it was registered primarily for the purpose of selling, renting or transferring it to another person for valuable consideration (see paragraph 4.5).

The Respondent denies bad faith upon the basis that it was acquired with the intention of using it and had taken steps to do so (see paragraph 4.6)

*Pursuant to Schedule A of auDPR the following circumstances, inter alia, shall be evidence of the registration and use of a domain name in bad faith:*

- (i) *circumstances indicating that the domain name has been registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for a profit; or*
- (ii) *the registration of 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) *registering the domain name primarily for the purpose of disrupting the business activities of another person; or*
- (iv) *using the domain name to intentionally attempt 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.*

The Respondent purchased the Domain Name from NetAlliance Pty Ltd Trading as NetFleet. For NetFleet to register the Domain Name, it would have had to comply with the prescribed eligibility as set out in “Domain Name Eligibility and Allocation Policy Rules for Open 2LDS” (“Eligibility Policy”) which provide, inter alia:

*“ 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.....”*

There is no evidence to indicate that NetFleet complied with either of these requirements . Accordingly the Domain Name was registered in bad faith (Panel Views 3.2A)

(It is noted that NetFleet was the Registrar and should have known that the Domain Name should not have been registered due to breaching of the eligibility Rules.)

In these circumstances transferring the Domain Name to the Respondent would not provide the Respondent with any better right to use the Domain Name than NetFleet would have had.

Also, it seems from the information provided that NetFleet registered the Domain Name *“primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for a profit”*, evidencing bad faith in accordance with Schedule A of auDRP referred to above.

I find that the Domain Name was registered in bad faith. I do not have to determine whether it was subsequently used in bad faith

*Accordingly, I find that Paragraph 4(a)(iii) is satisfied.*

**7. Decision.**

7.1 As I have found that each element of Paragraph 4(a) has been proven, the Complainant is entitled to complain.

7.2 Accordingly, for the above reasons, I direct that the Domain Name be transferred to the Complainant.

Dated 29 October 2018

***Dennis Liner***

Panellist

