

Resolution Institute

ADMINISTRATIVE PANEL DECISION

Commonwealth Department of Social Services v Australaw Pty Ltd

Case No. auDRP 18-10

1. The Parties

Complainant: Commonwealth Department of Social Services, 71 Athllon Drive, Greenway ACT 2900.

The authorised representative of the Complainant is Ashurst Australia, Level 11, 5 Martin Place, Sydney NSW 2000, attention: Ms Lisa Ritson and Ms Hannah Rumble.

Respondent: Australaw Pty Ltd, c/o Waterford Accountants, 75 Tudor Street, Hamilton NSW 2303.

The authorised representative of the Respondent is Kelso Lawyers, PO Box H9 Australia Square NSW 1215, attention: Mr Ashley Kelso.

2. The Domain Name and Registrar

The disputed domain names are <nationalredress.com.au> and <nationalredressscheme.com.au> registered with Netregistry Pty Ltd.

3. Procedural History

On 26 September 2018, the Complaint (**Complaint**) was filed with the Resolution Institute dispute resolution centre (**Institute**). By email, the Institute transmitted to Netregistry Pty Ltd a request for registrar verification in connection with the domain names at issue.

On 5 October 2018, by email, Netregistry Pty Ltd advised the Institute of its verification response confirming that the Respondent is listed as the registrant and providing contact details for the administrative, billing and technical contact.

The Institute verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (**Policy**), the Rules for .au Dispute Resolution Policy (**Rules**) and the Institute's Supplemental Rules for .au Dispute Resolution Policy (**Supplemental Rules**).

On 5 October 2018, in accordance with the Rules, by email (and by express post), the Institute formally notified the Respondent of the Complaint, including that the proceeding commencement date is 5 October 2018. In accordance with the Policy and Rules, paragraph 5, the due date for the Response was 25 October 2018.

On 25 October 2018, the Respondent sent to the Institute its response (**Response**).

On 30 October 2018, the Institute appointed Michael JF Sweeney as the sole panelist (**Panel**) in this matter and advised the parties.

On 31 October 2018, by email, the Institute received from the Complainant (copied to the Respondent), a further statement and documents (**Supplementary Complaint**) with a request for permission from the Panel, pursuant to paragraph 12 of the Rules. The Institute forwarded the Supplementary Complaint to the Panel on the same day.

On 31 October 2018, the Panel issued Directions that the Supplementary Complaint be permitted pursuant to paragraph 12 of the Rules and that the Respondent be permitted to file a reply by 7 November 2018. The Panel also directed that the time by which a decision is required under paragraph 15 of the Rules be extended to 20 November 2018.

On 6 November 2018, by email, the Respondent filed with the Institute its Reply to the Supplementary Complaint (**Reply**). The Institute forwarded the Reply to the Panel.

On 16 November 2018, due to the nature of the matters raised in the dispute, including the further matters subsequently raised by the Supplementary Complaint and the Reply, the Panel issued further Directions that the time by which a decision is required be extended to 11 December 2018.

The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Institute, to ensure compliance with paragraph 7 of the Rules.

4. Factual Background

The Complainant

The Complainant is a department of the Australian Commonwealth Government (Government). The Complainant's role is the Government's main source of advice on social policy. It works in partnership with other Government and non Government organisations, managing a diverse range of programmes and services designed to support and improve lives of Australians.

The Complainant is responsible for the administration and operation of the National Redress Scheme. This scheme was established to respond to recommendations of the Royal Commission into Institutional Responses to Child Sexual Abuse held between 2013 and 2017. It was officially launched on 1 July 2018. The *National Redress Scheme for Institutional Child Sexual Abuse Act 2018* was assented to on 21 June 2018. Under the Act, the Scheme Operator is the Department of Social Services. Amongst other matters, its role is to help people who have experienced institutional child sexual abuse to gain access to redress in the form of counselling and psychological services and redress payments.

The Complainant is the registrant of 'nationalredress.gov.au' and offers access to the National Redress Scheme, including through its web site 'www.nationalredress.gov.au'.

The Respondent

The Respondent operates a law firm, predominately in New South Wales, under the name, Kelso Lawyers. A Director of the Respondent is Mr Peter Kelso who is also the Principal of Kelso Lawyers. The Respondent's Response states that Mr Kelso suffered 13 years of child abuse as a former NSW State ward and foster child.

The core work of Kelso Lawyers is representing the rights of those who have suffered institutional child sexual abuse. It does this through, amongst other matters, representation at the Royal Commission into abuse, obtaining statutory compensation through compensation schemes, including the National Redress Scheme for Institutional Child Sexual Abuse and law reform. It also provides news and information services to those who have suffered child sexual abuse, including through several Facebook pages where it has attracted a following.

On or about 10 and 11 November 2016, the Respondent registered with Netregistry domain names 'nationalredress.com.au' and 'nationalredressscheme.com.au'.

5. Parties' Contentions

A. Complainant's Contentions

The Complainant's contentions include that it has rights to trademarks or has acquired common law rights to trademarks, 'national redress' and 'national redress scheme', sufficient to bring legal action for use of its trademarks against a party using them without consent through:

- (a) The National Redress Scheme was first announced by the Government on 4 November 2016 as a scheme to provide redress to victims of institutional child sexual abuse;¹
- (b) On 27 June 2018, it acquired rights through lodgment of applications for trademarks with IP Australia for both 'national redress scheme' and 'national redress scheme for people who have experienced institutional child sexual abuse'.²
- (c) The Complainant's scheme has been publicly identified,³ as the NATIONAL REDRESS SCHEME, since September 2015. It was publicly identified through the Royal Commission into Institutional Responses to Child Sexual Abuse reports and through 'Redress and Civil Litigation Report' and 'National Redress Scheme Participant and Cost Estimates' report (Reports).
 - (i) The Reports refer to the scheme as the 'National Redress Scheme' and used in conjunction with Complainant's scheme for more than a year prior to the registration of the Respondent's domain names;
 - (ii) The Reports include a recommendation to establish a 'national redress scheme' and include the report by Finity, a consultancy, as to costs and funding associated with 'an Australian National Redress Scheme for victims of institutional sexual abuse'.

¹ Paragraph 13, Complaint, dated 26 September 2018.

² Paragraph 12, Complaint, dated 26 September 2018.

³ Supplementary Complaint, dated 31 October 2018.

(d) The Complainant and the Government promoting the ‘National Redress’ and ‘National Redress Scheme’ names extensively throughout Australia since 4 November 2016, including:⁴

- (i) Offering support and redress under the ‘national redress scheme’ name;
- (ii) Offering access to the National Redress Scheme through use of the names, its domain name, nationalredress.gov.au and through the Complainant’s operation of its web site, www.nationalredress.gov.au;
- (iii) 145,080 views, since 1 July 2018 to 8 August 2018, on the web site www.nationalredress.gov.au;
- (iv) 23 media releases in connection with the National Redress Scheme;
- (v) Ministerial media releases referring to National Redress Scheme as identified with the Complainant;
- (vi) Since 8 March 2018, publication of newsletters under the National Redress Scheme name to 3,341 subscribers;
- (vii) 6,002 downloads of Complainant’s National Redress Scheme application forms;
- (viii) 11 fact sheets uploaded, since 31 August 2018, onto web site;
- (ix) Contact email address: ‘nationalredressscheme@dss.gov.au’;
- (x) Advertising National Redress Scheme on its web site: www.dss.gov.au’, prior to scheme’s launch;
- (xi) Provision of wallet cards to Ministers and others for clients or constituents as at 31 August 2018;
- (xii) Recognition of the Complainant by a large number of publications in Australia as the operator of the National Redress Scheme.

(e) ‘National Redress’ and ‘National Redress Scheme’ are names that have achieved a secondary meaning or association with the Complainant;⁵

The Complainant put additional contentions relating to sub paragraphs 4(a)(ii) and (iii) of the Policy, which for the reasons given below, I do not need to summarise.

The Complainant alleges that the Respondent has registered the disputed domain names where:

- (i) they are identical or confusingly similar to names or trademarks in which the Complainant has rights;
- (ii) the Respondent has no right or legitimate interest in respect of the disputed domain names; and
- (iii) the Respondent has registered or subsequently used the disputed domain names in bad faith.

The remedy sought by the Complainant is the transfer to it of the disputed domain names.

B. Respondent’s Contentions

The Respondent’s contentions include:

⁴ Paragraph 15, sub paragraphs (a) to (i), Complaint, dated 26 September 2018.

⁵ Paragraph 16, Complaint, dated 26 September 2018.

- (a) In lodging applications for trademarks, the Complainant has not acquired rights in trademarks where the applications have not yet been examined and have not been published for comment. Further, the trademarks applied for may not be registrable as they are generic;⁶
- (b) The Complainant did not lodge its application for trademarks until approximately one a half years after the Respondent had registered its domain names in November 2016;
- (c) The Complainant did not register its domain name until approximately one a half years after the Respondent had registered its domain names in November 2016;
- (d) At and around the time when the Respondent registered its domain names in November 2016, the Complainant did not refer to ‘National Redress Scheme’.⁷ Instead the Complainant in media releases on 4 November 2016 and 16 December 2016 used the expressions ‘Commonwealth redress scheme for survivors of institutional child sexual abuse’ and ‘the Commonwealth redress scheme’, respectively;⁸
- (e) At the time when the Respondent registered its domain names, the Complainant had no rights in the phrase ‘national redress scheme’ and was not using the phrase;
- (f) Between the time when the Respondent registered its domain name in November 2016 until the Complainant’s media release on 9 March 2018, the phrase ‘National Redress Scheme’ had not been used by the Complainant;⁹
- (g) Until 1 July 2018, there was no redress scheme in existence called the ‘National Redress Scheme’;
- (h) The Complainant has not asserted registration of any variants of ‘National Redress Scheme’ as a business name or name of a corporation;
- (i) The Complainant’s contentions, including those at sub paragraph 5(c) above, that the Complainant says it has used the phrase ‘National Redress Scheme’ since September 2015, are not correct. A ‘Control F search’ will disclose that the phrase ‘national redress scheme’ was used in the Reports and in the ‘Consultation Paper: Redress and Civil Litigation’ in a descriptive sense to refer to a hypothetical scheme, with the phrase being used in a generic sense.¹⁰

The Respondent put additional contentions relating to sub paragraphs 4(a)(ii) and (iii) of the Policy, which do not need to be summarised.

6. Discussion and Findings

Pursuant to paragraph 10 of the Rules, I am required, as the Panel, to conduct the administrative proceeding in such manner as I consider appropriate in accordance with the Policy and Rules.

⁶ Paragraphs 6.4(a) and (i), Respondent’s Response, dated 25 October 2018.

⁷ Paragraph 6.4(d), Respondent’s Response, dated 25 October 2018.

⁸ Paragraph 5.1, Timeline Table, Respondent’s Response, dated 25 October 2018.

⁹ Paragraph 5.1, Timeline Table and paragraph 6.4(f), Respondent’s Response, dated 25 October 2018; Annexure K, Complaint, dated 26 September 2018.

¹⁰ Paragraph 2.4, Respondent’s Reply, dated 6 November 2018.

Pursuant to sub paragraph 3(b)(viii) of the Rules, the Complainant is required, relevantly, to specify the trademark on which the Complaint is based and the goods or services with which the mark is used.

Pursuant to sub paragraph 3(b)(ix) of the Rules, the Complainant must describe, in accordance with the Policy, the grounds on which the Complaint is made.

Pursuant to sub paragraph 3(b)(x) of the Rules, the Complainant must specify, in accordance with the Policy, the remedies sought.

Paragraph 4(a) of the Policy requires a complainant to prove:

- (i) the respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
- (ii) the respondent 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.

The mandatory administrative proceeding under paragraph 4(a) of the Policy requires that the Complainant must prove all three of the stated elements. A failure to prove any one element will result in the Complainant's proceeding being unsuccessful.

A. Identical or confusingly similar to a name or trademark in which the Complainant has rights

The first element required to be established by the Complainant, under sub paragraph 4(a)(i) of the Policy, is whether the Respondent's domain names are identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights.

Determining whether a domain name is identical or confusingly similar to a name or trademark, as the first step, requires the Complainant to establish that it 'has rights' to a name, trademark or service mark. This is a threshold matter. Establishing the existence of such a right is necessary for a complainant to have standing to bring its complaint under the Policy.

The Complainant contends it has rights on two grounds. First, rights arising from lodgment of names for registration. Second, rights arising from unregistered common law right acquired through usage.

First ground: Complainant has rights from lodging trademark applications

The first ground contended for by the Complainant is its right to the names 'national redress scheme' and 'national redress scheme for people who have experienced institutional child sexual abuse', based on it having lodged on 27 June 2018 Australian Trademark Application No. 1936923 and Australian Trademark Application No. 1936924, respectively.¹¹

Against this, the Respondent contends that there is no right created in the Complainant simply by the making of the above applications. It says the Complainant's trademark applications have not been examined. It further contends that one or both may be

¹¹ Annexure G, Complaint.

rejected, even before being advertised, because they may offend due to the phrase ‘redress scheme’ being used to refer to a type or species of scheme and the word ‘national’ being ineligible as a geographical indicator of the reach of the scheme.

The process for applying for and seeking registration of a trademark is governed by the *Trademarks Act 1995* (Cth) (Act). Broadly stated, sections 31, 33 and 34 provide for the Registrar to examine the application and, if in compliance with the Act, notify acceptance of the application and advertise. Section 52 is concerned with the procedure for a party to oppose the granting of a trademark following acceptance. Sections 68 provides for registration of a trademark that has not been opposed or where opposed, has been dismissed. Section 71 provides for issuing a certificate of registration and advertising the same.

On the evidence of the Complainant concerning its applications lodged with IP Australia, Trademarks Office, the trademark applications have not yet been examined, accepted or advertised by the Registrar. There is no legislative right created by the mere fact of making an application, the more so where the trademark has not been examined by the Registrar for compliance with the Act nor accepted. This finding is consistent with the consensus view of numerous UDRP decisions that a pending trademark application would not of itself establish trademark rights under sub paragraph 4(a)(i) of the Policy.¹²

To the extent the Complainant relies on the lodging of its applications as evidence that the Complainant has rights to trademarks in the manner provided under sub paragraph 4(a)(i), the requisite right has not been made out.

Second ground: Complainant has rights arising under common law

The second ground contended for by the Complainant is that it has rights to the names ‘national redress’ and ‘national redress scheme’ acquired as common law rights arising through usage. One of the earliest recognised principles arising from arbitral panel decisions under the UDRP Policy, which the auDRP is modelled on, is that the Policy does not distinguish between registered and unregistered trademark rights.¹³

To bring a claim within the Policy based on an unregistered trademark, a complainant must show that it ‘has rights’ in a trademark at common law, such as arising through usage, acquiring a secondary meaning, in order to have standing to bring a complaint. Given my finding that the Complainant has no rights arising from lodging for registration, demonstrating that it has common law rights is a threshold issue about whether the Complainant has ‘standing’ to proceed with its Complaint.

In support that it ‘has rights’ and therefore standing as required under paragraph 4(a)(i) of the Policy, the Complainant contends that it has acquired common law rights in the names, through:

- (a) The use of the name in its domain name ‘nationalredress.gov.au’;¹⁴

¹² Paragraph 1.1.4, WIPO Overview 3.0.

¹³ *The British Broadcasting Corporation v Jaime Renteria* D2000-0050 (WIPO March 23, 2000), in construing paragraph 4(a)(i) of the Policy.

¹⁴ Paragraph 16, Complaint, dated 26 September 2018.

- (b) The promotion and use of the trademarks ‘national redress’ and ‘national redress scheme’ in the materials evidenced in the Complaint sufficient to bring legal action against third party use without consent;¹⁵
- (c) Achieving a secondary meaning or association with the Complainant.¹⁶

The requirement that a complainant ‘has rights’ in a trademark, provided for in sub paragraph 4(a)(i) of the Policy, is construed to mean that the complainant has rights as at the time of filing the complaint rather than having had them (past tense), such as prior to registration of the disputed domain name.

This construction as to timing is not controversial. It has been almost universally accepted as such in UDRP decisions. More importantly, the construction flows from a plain interpretation of 4(a)(i) understood in the context of 4(a)(ii) and 4(a)(iii) of the Policy, as expanded on in 4(b) and 4(c) of the Policy. Those sub paragraphs, concerning a respondent’s right or legitimate interest in the domain name or registration of a domain name in bad faith, are to be determined by reference to rights and behaviour in the present and the past. In contrast, sub paragraph 4(a)(i) uses language in the present tense, meaning the relevant time at which a complainant must possess rights to a trademark to have standing to bring a complaint is at the time of making its Complaint.

Consistent with the above view, WIPO Overview 3.0 comments¹⁷ that the fact that a domain name may have been registered before a complainant has acquired trademark rights does not of itself preclude a complainant’s standing to file a UDRP case, nor a panel’s finding of identity or confusing similarity under the first element of sub paragraph 4(a)(i).

Thus, the question of whether the Complainant has established standing under sub paragraph 4(a)(i) of the Policy becomes an evidentiary one: Has the Complainant acquired rights or secondary meaning in the trademarks prior to the time it made its Complaint against the Respondent?

The inquiry into whether there are common law rights in a trademark (so as to satisfy the threshold requirement under the Policy) usually resolves to the question whether the trademark is distinctive. Whilst this is a simplification of the law, most domain name panels have focused on whether the trademark has acquired a secondary meaning.¹⁸

The WIPO Overview summarises the clear requirements of panels in determining what a complainant needs to prove to successfully assert unregistered trademark rights. To establish this under the Policy, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods or services.¹⁹ The focus is on evidence that supports the acquisition of distinctiveness or secondary meaning in the public mind.²⁰ The consensus view of panel decisions is that conclusory allegations of unregistered common law rights is not normally sufficient to show secondary meaning.²¹

¹⁵ Including paragraphs 13 to 16, Complaint, dated 26 September 2018.

¹⁶ Paragraph 16, Complaint, dated 26 September 2018.

¹⁷ Paragraph 1.1.3, WIPO Overview 3.0.

¹⁸ *International Domain Name Law ICANN and the UDRP*, David Lindsay, 2007 at paragraph 5.19.3.

¹⁹ *WIPO Jurisprudential Overview 3.0, 2017* paragraph 1.3.

²⁰ *San Diego Hydroponics & Organics v. Innovative Growing Solutions, Inc.*, D2009-1545 (3 March 2010).

²¹ *WIPO Jurisprudential Overview 3.0, 2017* paragraph 1.3.

With this focus in mind, relevant considerations include factors²² such as:

- (a) The duration and nature of use of the mark;
- (b) The amount of sales under the mark;
- (c) The nature and extent of advertising using the mark;
- (d) The degree of actual public recognition e.g. consumer, media, industry recognition.

Concerning the duration and nature of use of the asserted common law trademarks and summarising some of the relevant contentions above, the Complainant contends its use of the mark ‘national redress scheme’ since September 2015 as evidenced by its use in the Reports and by a Government announcement of the scheme on 4 November 2016. The Respondent contends that the Complainant did not use the expression before the Respondent registered its domain names on 10 November 2016 and, further, that it did not use the expression ‘national redress scheme’ at all until 9 March 2018.

The evidence from a word search of the Consultation Paper, the Reports and a number of media releases disclose the following.

- (a) Consultation Paper: Redress and Civil Litigation, early 2015 (306 pages): The expression predominately used is ‘a national redress scheme’, appearing approximately 32 times. At page 144 is a reference to ‘the Government of Ireland established a national redress scheme under the *Residential Institutions Redress Act 2002*.’
- (b) Participant Cost Estimates (Finity) Report, July 2015 (76 pages): In introductory comment, the report refers to provisions cost estimates for an ‘Australian National Redress Scheme’. At pages 4 and 10, footnotes 1 and 3 respectively, the report qualifies the use of the expression, stating: ‘Our estimate are for a single national redress scheme or the combination of separate nationally consistent schemes in each State and Territory.’ Otherwise, the expressions used are ‘a National Redress Scheme’, ‘a theoretical National Redress Scheme’ and a few ‘the National Redress Scheme’. A total of 120 usages, predominately ‘a National Redress Scheme’.
- (c) Redress & Civil Litigation Report, 2015 (659 pages): There were many 100s of references to a redress scheme, but overwhelming usage is the expression ‘a single national redress scheme’ and to a lesser degree, ‘the national redress scheme’.
- (d) Final Report of the Royal Commission: Preface and Executive Summary, 15 December 2017 (217 pages): The expression predominately used is ‘a national redress scheme’, appearing approximately 18 times;
- (e) Joint media release, 4 November 2016:²³ The expression used is ‘Commonwealth redress scheme for survivors of institutional child sexual abuse’. The web site referred to for seeking assistance is www.childabuse.royalcommission.gov.au.

²² WIPO Jurisprudential Overview 3.0, 2017 paragraph 1.3.

²³ Annexure K and N, Complaint.

- (f) Media release for independent advisory council, dated 16 December 2016, media release, dated 26 October 2018 and media release announcing introduction of legislation, dated 15 December 2017:²⁴ The references are to ‘Commonwealth redress scheme’.

Based on the search outcomes for the various reports described above, I find that the expressions most used are ‘a national redress scheme’ or ‘a single national redress scheme’. For the several media releases, the expression used is a ‘Commonwealth redress scheme’.

I find the context of the usage of the expression ‘national redress scheme’ persuasive in my determination that the usage in the reports is of a generic nature. The context of the Consultation Paper being at the early days of the enquiry is such that it is perhaps not surprising that the general expression ‘national redress scheme’ is employed. The context of the usage of ‘national redress scheme’ in the Participant and Cost Estimates (Finity) report and the Redress and Civil Litigation report also demonstrate that, at those points in time, it is a reasonable inference that the expression had not taken on a particular or distinctive meaning. Common words ‘national’, ‘redress’ and ‘scheme’ have not been used to denote a specific identified organisation or agreed process, but used as descriptive and in a generic nature.

The two media releases, one on 16 December 2016²⁵ and the on 26 October 2017,²⁶ both used the expression ‘Commonwealth redress scheme’. The 26 October 2017 release foreshadowed the introduction of legislation for ‘Commonwealth Redress Scheme for Institutional Child Sexual Abuse Bill 2017’. No reference was made to national ‘redress scheme’ as an identifier that was the contemplated name or marker for the proposed scheme.

A media release was made on 15 December 2017 in respect of the handing down of the Final Report on the same day. Again, that release referred to the proposed establishment of a ‘Commonwealth Redress Scheme’.²⁷ No reference was made to ‘national redress scheme’ as an identifier that was the contemplated name or marker for the proposed scheme.

As stated above, the Final Report: Preface and Executive Summary, delivered on 15 December 2017, referred to a ‘national redress scheme’ approximately 18 times. At page 33 it refers to the Australian Government having announced the establishment of a national redress scheme. At page 34, it refers to the introduction of legislation on 26 October 2017 for the ‘Commonwealth Redress Scheme for Institutional Child Sexual Abuse Bill 2017 (Cth)’. It does not refer to the proposed scheme by use of the expression ‘national redress scheme’. At this point in time, it appears that the Complainant and the Australian Government have selected the ‘Commonwealth Redress Scheme’ as its preferred name for the redress body. But even if that is not so, insufficient evidence has been made out to support the contention that ‘national redress scheme’ has become a distinctive identifier.

Another media release was issued on 9 March 2018. On the evidence submitted to the Panel, this appears to be the first time that the expression ‘National Redress Scheme’ was used by the Complainant for the redress body that the Government was to introduce. It foreshadowed the introduction into Parliament on 10 May 2018 of the

²⁴ Both releases, Annexure K, Complaint.

²⁵ Annexure K, Complaint.

²⁶ Annexure K, supra.

²⁷ Annexure K, supra.

‘National Redress Scheme for Institutional Child Sexual Abuse Bill 2018’. Following this, the ‘National Redress Scheme for Institutional Child Sexual Abuse’ was established on 1 July 2018. A matter of days later, the Complainant lodged its applications for the two trademarks.

For the above reasons, I find that the use by the Complainant of the expression ‘National Redress Scheme’ commenced from 9 March 2018, consistent with the Respondent’s contention, and that the scheme by that name did not become operative or established until on or about 1 July 2018. I find that the Complainant has not proved that the scheme was first announced by the Government by the title the ‘National Redress Scheme’ on 4 November 2016. It was of course referred to, by use of that expression, in a generic sense on that date. I find that the Complainant has not proved that the Complainant’s scheme has been publicly identified as the ‘National Redress Scheme’ since September 2015. This means that the duration and usage of the asserted unregistered trademarks have been of a very brief duration, manifestly insufficient to support common law rights on this basis.

To the extent that the Complainant asserts that it has defensible common law rights on the basis of the duration and nature of usage of its asserted trademarks, as contended for above, it has failed to prove its case.

In determining whether the Complainant has common law rights to its asserted trademarks, there are a number of other elements which were previously referred to above. These elements include considerations such as the amount of sales under the mark, the nature and extent of advertising using the mark and the degree of actual public recognition, such as consumer, media and industry recognition.

A number of the Complainant’s contentions in support of its unregistered common law rights are of a conclusory nature or, following from the above findings of lack of duration and nature of usage, are activities and endeavours of relatively recent advent.

The Complainant asserts that it offers support under the ‘national redress scheme’ name. On my findings above, offering support under that name, other than in a generic sense, cannot be said to have commenced until at least some time after March 2018. In a like vein, 23 media releases and Ministerial media releases (including those examined above), to the extent that they are prior to March 2018, do not of themselves provide evidence of material weight in determining distinctiveness of the asserted trademarks. To the extent they are after that date, they are of very brief duration. Also, on similar reasoning, the publication of 8 newsletters since March 2018 and uploading 11 fact sheets since 31 August 2018, whilst indicative of connection with the relevant public and demonstrative of the Complainant’s endeavours in the field for which it has been given responsibility, they are of such relatively recent advent and short duration that it is not greatly probative of the acquisition of distinctiveness in the trademarks.

The Complainant relies for some support on its ownership through registration of domain names ‘nationalredress.gov.au’, operation of the associated web site and its email address. This is not determinative or of particular probative value as support for unregistered rights to trademarks. The schedule to the Policy provides that rights or legitimate interests in respect of the domain name are not established merely by a registrar’s determination that the respondent has satisfied the relevant eligibility criteria for the domain name at the time of registration.²⁸ Conversely, where the

²⁸ Schedule A, final footnote 2, auDRP Policy.

Complainant asserts unregistered rights to trademarks supported by a registrar's determination that it has satisfied relevant eligibility criteria is not of significant probative value.

The Complainant contends that it has engaged in advertising the National Redress Scheme on its web site, prior to the scheme's launch, issued wallet cards to Ministers and further engaged with the public as demonstrated through over 6,000 downloads of application forms and 145,000 views on its web site, July to August 2018. Against the background of my findings above, based as they are on the recent adoption by the Complainant of the asserted unregistered trademarks, these further factors are not sufficiently persuasive to displace those findings.

The Complainant relies on several domain name decisions of past panels.²⁹ In *British Heart Foundation v Harold A Meyer III*,³⁰ the panel commented that, for an unregistered trademark, it is necessary for the complainant to prove that the mark is in fact a trademark. The complainant must prove by evidence that it provides goods or services under the unregistered mark and that it has a reputation in the provision of those services such that members of the public would associate those goods or services with the complainant, and such that it would enable the bringing of a legal action against a third party using it without its consent. There was insufficient evidence before that panel to make this out.

There are two observations to be made. First the unregistered mark must in fact be a trademark. This means that the term must have become distinctive and acquired a secondary meaning by virtue of use. That is a prerequisite to bringing a legal action, such as under the tort of passing off. Second, *British Heart Foundation* (supra) was decided on the facts and an insufficiency of evidence to prove the trademark in question. I have found, to the extent that it may now use the term National Redress Scheme, that the Complainant has failed to prove that its use of the term has become distinctive and acquired a secondary meaning through usage. There is insufficient evidence that has been put to me as would support the Complainant's proposition that its unregistered marks would enable it to bring and maintain a 'legal action against a third person'.

The Complainant also relies on a domain name decision *Australian Trade Commission v Matthew Reader*³¹ as support for its asserted trademarks having achieved secondary meaning or association with it. The *Australian Trade Commission* case and determination of the panel is factually driven. The unregistered mark, Austrade, was in use and greatly promoted by the Complainant since 1986, in circumstances where the respondent had not registered its disputed domain name until 2002. The panel found that the use of the generic parts of the component parts of the words 'aus' and 'trade' did not bear on the specific secondary meaning acquired for the word created by their combination. It also found that an Australian court would likely find that the complainant had a prima right that could be protected by an action in tort for passing off, or breach of statutory provisions for misleading or deceptive conduct. Again, on a factually driven basis, the contention that was proved in the

²⁹ The Panel must decide the issues for itself based on the evidence before it. Previous decisions made under .auDA Dispute Resolution Policy and under the Uniform Domain Name Dispute Resolution Policy have led to a body of decisions which, whilst not binding, demonstrate a broad consensus view on questions that regularly arise in domain name dispute resolution. To that extent the relevant broad consensus may be useful, but only to the degree of the persuasiveness of the reasoning of the decisions giving rise to that consensus.

³⁰ eResolution Case No. AF0957 (13 November 2001).

³¹ WIPO, Case No. D2002-0786 (12 November 2002).

Austrade case that it had acquired a secondary meaning through usage has not been proved in the present case.

Conclusion

The first ground contended for by the Complainant under paragraph 4(a)(i) of the Policy was its right to the names ‘national redress scheme’ and ‘national redress scheme for people who have experienced institutional child sexual abuse’, based on it having lodged on 27 June 2018 Australian Trademark Application No. 1936923 and Australian Trademark Application No. 1936924, respectively. There is no right in a trademark by reason only of lodging an application for a trademark. The Complainant failed to prove it has rights under this head.

The second ground contended for by the Complainant under paragraph 4(a)(i) of the Policy, was that it has rights in ‘national redress’ and ‘national redress scheme’ as unregistered common law trademarks, arising through acquiring a distinctive secondary meaning through usage. For the reasons given, this contention was not borne out by the evidence. The Complainant has failed to prove it has rights arising from unregistered trademarks.

Under the first element of the Policy therefore, the Complainant failed to prove it has rights in a name or trademark sufficient to give it the threshold requirement for standing to bring its Complaint. The Complaint must therefore be dismissed.

B. Rights or legitimate interests

C. Registered or subsequently used in bad faith

The Complainant has also asserted that the Respondent has no rights or legitimate interests in the domain names (paragraph 4(a)(ii) of the Policy) and that the Respondent has registered or subsequently used the domain names in bad faith (paragraph 4(a)(iii) of the Policy).

For the reasons stated above, the Complainant has not demonstrated that it ‘has rights’ to a trademark and has therefore failed to prove that it has standing to pursue its claim under the Policy.

For that reason, it is not necessary for the Panel to make findings concerning the Respondent’s rights or legitimate interests in the domain names or whether the it has registered the domain names or subsequently used them in bad faith.

Other considerations

There is no doubt concerning the sincerity, seriousness and gravity of the Complainant in carrying out its most important and sensitive charter. It should be emphasised that that is not in any question under these proceedings.

Further, the decision of panels under the Policy are made pursuant to the procedure mandated. The dispute must be decided based on the evidence produced in accordance with that procedure which is necessarily limited and which is not tested through examination in chief and cross examination. In any event, the Policy provides for other avenues to parties, including the potential availability of court proceedings.

7. Decision

For the foregoing reasons, in accordance with paragraph 4(a)(i) of the Policy and paragraph 15 of the Rules, the Panel orders that the Complainant's Complaint is dismissed.

Signed: _____

Michael JF Sweeney

Panelist

5 December 2018