

## LEADR DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

Messages on Hold Australia Pty Ltd

-v-

Media Group Pty Ltd

Case No. auDRP\_13\_01

Complainant: Messages on Hold Australia Pty Ltd  
Respondent: Media Group Pty Ltd  
Case No: LEADR - auDRP 13/01  
Domain Names: messagesonholdperth.com.au  
messagesonholdbrisbane.com.au  
messagesonholdsydney.com.au  
messagesonholdmelbourne.com.au  
messagesonholdadelaide.com.au  
Provider: LEADR  
Panellist: John E. McDermott

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### 1. THE PARTIES

- 1.1 The Complainant in these proceedings is Messages on Hold Australia Pty Ltd of 21 Moore Street, East Perth Western Australia 6004.
- 1.2 The Respondent is Media Group Pty Ltd of Unit 2, 2 Spencer Road, Nerang Queensland 4211.

### 2. THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 2.1 The Domain Names in dispute are:

messagesonholdperth.com.au  
messagesonholdbrisbane.com.au  
messagesonholdsydney.com.au  
messagesonholdmelbourne.com.au  
messagesonholdadelaide.com.au

(“**Domain Names**”) or disputed Domain Names.

- 2.2 The Registrar of the Domain Names is Planet Domain of L4, 1-3 Smail Street, Ultimo Sydney New South Wales Australia 2007.
- 2.3 The Provider in relation to this proceeding is LEADR (“**Provider**”).

### 3. PROCEDURAL MATTERS

- 3.1 These proceedings concern a complaint (“Complaint”) with respect to which the Provider and the Panellist provide a procedural history as follows:
- i. This Complaint was submitted for decision in accordance with the .au Dispute Resolution Policy (the **Policy**), approved by the auDA Board on **13/08/2001**, the Rules for .au Dispute Resolution Policy (the **Rules**), and the LEADR Supplemental Rules for .au Dispute Resolution Policy (the **Supplemental Rules**).
  - ii. The Complaint was received by LEADR from the Complainant on the **25/02/2013**.
  - iii. LEADR sent an acknowledgment to the Complainant on the **25/02/2013**.
  - iv. The Complainant advises that a copy of this Complaint, together with the cover sheet as prescribed by the Supplemental Rules, has been sent or transmitted to the Respondent on **25/02/2013** by email to its representative at meadie@rouselawyers.com.au.
  - v. A copy of the complaint was submitted and a request to clarify Respondent details and lock the domain name during proceedings was emailed to the Registrar **Planet Domain** on **5/03/2013** (in three emails).
  - vi. On **8/03/2013** the Registrar confirmed via email that the domain names in dispute had been locked.
  - vii. LEADR advised auDA of the complaint on **11/03/2013** via email.
  - viii. On the **11/03/2013** LEADR sent the Respondent (**Media Group Pty Ltd**) an email and written notification of the complaint lodged against it. The Complainant was copied in on these notifications. The Respondent’s Solicitor received the Complainant’s document on **15/03/2013**.
  - ix. The due date for the response to the complaint was confirmed to be **31/03/2013**.
  - x. Acknowledgement of notification was received from the Respondent on **28/03/2013**.
  - xi. On **28/03/2013**, Joshua Loftus on behalf of the Respondent (**Media Group Pty Ltd**) submitted a response to the domain name complaint.

- xii. On **28/03/2013** the Provider approached the Panellist. The Panellist confirmed his availability and informed LEADR that he had no conflict issues with the parties and accepted the matter on **2/04/2013**.
- xiii. The Case file and relevant correspondence was forwarded to the Panellist on **2/04/2013**.
- xiv. The Parties to the dispute were notified of the Panellist's allocation on the **2/04/2013**.
- xv. The date on which the decision is due is **17/04/2013**.

#### **4. FACTUAL BACKGROUND**

##### **4.1 Facts Alleged by Complainant**

The Complainant is Messages on Hold Australia Pty Ltd of 21 Moore Street, East Perth Western Australia 6004 ("Complainant"), the Complainant's principal place of business is in Australia.

The Respondent is Media Group Pty Ltd of Unit 2, 2 Spencer Road, Nerang Queensland 4211 ("Respondent").

The Complainant states in support of its Submissions, where relevant, that;

- i. It was in the past successful in persuading the Respondent to transfer the domain name <messagesonholdaustralia.com.au> to it.
- ii. Over a period from on or about 24 January 2013 until it was in the course of preparing the complaint, the Complainant became aware that the Respondent was using the domain names the subject of this complaint and on 8 February 2013 it gave notice to the Respondent's Solicitors, Rouse Lawyers, that it would be lodging this complaint.
- iii. The disputed domain names were registered on 20 September 2011 except for the last name listed which was registered on 30 September 2011.
- iv. The disputed names are identical or confusingly similar to one or more of three Trade Marks in which the Complainant has rights see Policy (Policy, para. 4(a)(i), Rules, paras. 3(b)(viii), (b)(ix)).

The relevant Trade Marks are:-

- (a) Australian Trade Mark number 952389 being a composite image of a logo and words MESSAGES ON HOLD AUSTRALIA registered in class 9 and class 35. An image has been provided.
- (b) Australian Trade Mark number 952462 being a composite image of a logo and the words MESSAGES ON HOLD,

registered in class 9 and class 35. An image has been provided.

- (c) Australian Trade Mark number 1202729 being a logo bearing the words MESSAGES ON HOLD registered in class 9 and class 38. An image has been provided.

Broadly speaking the Trade Mark classes cover digital announcers, answering machines on recording services, customised script for advertising and promotional purposes and apparatus for recording and audio communications. These services are largely similar to some areas of the Respondent's business including what the Respondent's advertising (see Annexure "6" to the Claimant's Submissions) describes as "on hold and in store advertising" and "professional messages on hold for business telephones".

- v. As the registered owner of its Trade Marks, the Complainant has the exclusive right to use them.
- vi. Each of the disputed domain names is substantially identical or confusingly similar to (on occasions the Complainant's submissions are limited to "confusingly similar to") the Complainant's registered Trade Marks.
- vii. Trade Mark number 1202729 is displayed at the top of every page of the Complainant's website whilst the Complainant's Company name Messages on Hold Australia Pty Ltd is displayed at the bottom of every web page indicating a clear connection between the Trade Mark and the Complainant (images provided).
- viii. The Respondent's website at <mediamessages.com.au> features the Respondent's trading name MEDIA MESSAGES at the top of every page of the Respondent's website. At the bottom of every page of the Respondent's website, the links to each of the disputed domain names are displayed.

By clicking on any of the links, members of the public are directed to a website displaying the Respondent's goods and services. A screen print of the Respondent's contact page is attached as Annexure 6 to the Complainant's Submissions, as previously referred to.

- ix. Independently of the Trade Marks, the Complainant says that (see paragraphs 11.11 to 11.4 inclusive which I will not repeat here) it is the largest provider of on-hold messages in Australia and elsewhere, that it has been providing this service for more than 20 years and that it is otherwise widely known as a result of its community activities and the promotion of its goods and services generally.
- x. The Respondent, by way of contrast, says the Complainant features the name "Media Messages" on its website and has produced no evidence to suggest that it is commonly known by any of the disputed names.

- xi. The Complainant can rely on the High Court decision in *EJ Gallo Winery v Lion Nathan Australia Pty Limited* (2010) 241 CLR 144 as authority for the proposition that the respondent has used its Trade Mark (wrongly therefore) in these circumstances.
- xii. The Respondent's actions constitute passing off and a misrepresentation to consumers that there is a connection between the Complainant and the Respondent and are intended to prevent the Complainant from using any of the disputed names, such conduct being calculated to injure the Complainant's goodwill.

#### 4.2 Facts Alleged by the Respondent

Joshua Loftus, one of the Directors of the Respondent, rather than a member of a firm of Solicitors such as Rouse Lawyers which was apparently involved at an earlier stage, has made written Submissions on behalf of the Respondent.

Those Submissions are brief and frequently do not respond to the Complainant's Submissions.

The Respondent states that:

- i. The Complainant's Company name and logo bear the same names as a worldwide industry with many competitors including the Respondent.
- ii. The Respondent relies on a decision of Iain Thompson, the Delegate of the Registrar of Trade Marks in *M2 Technology Pty Ltd v Messages on Hold Pty Ltd* [2007] ATMO 57 (10 September 2007) ("M2 Technology") as authority for the fact that the phrase "Messages on Hold" is not capable of distinguishing the Claimant's goods and services from those of other traders.
- iii. The agreement previously reached with the Claimant as a result of a disputed domain name was simply an act of good faith.
- iv. The Respondent was heavily influenced by the Registrar of Trade Marks' (should be delegate of the Registrar of Trade Marks) finding see above;
 

*"that due to the general use of the expression 'messages on hold' as a descriptive term within the relevant industry, this expression has no inherent adaptation to distinguish your client's goods and services".*
- v. "Messages on Hold" is merely a descriptive term which is widely used on an industry wide and worldwide basis and which is core to the Respondent's business.

## 5. DISCUSSION AND FINDINGS

### 5.1 Discussion and Findings

In order to have the Domain Name either transferred to it or cancelled, the Complainant must make out each of the following elements under paragraph 4(a) of Schedule A of the auDRP:

- i. The Respondent's Domain Name is identical or confusingly similar to a name, Trade Mark or service mark in which the Complainant has rights **(paragraph 4(a)(i))**;
- ii. The Respondent has no rights or legitimate interests in the Domain Name **(paragraph 4(a)(i))**; and
- iii. The Respondent registered or subsequently used the Domain Name in bad faith **(paragraph 4(a)(i))**.

The onus of proof is on the Complainant in relation to all three of these elements.

### 5.2 Identical or confusingly similar

#### Paragraph 4(a)(i)

The Panellist must firstly determine whether the Complainant has rights in a relevant name, Trade Mark or service name. It is then necessary to look at the issue as to whether it is "identical or confusingly similar".

The footnote 1 of paragraph 4(a)(i) states:

*For the purposes of this policy, auDA has determined that a "name... in which the complainant has rights" refers to*

*(a) The complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority ; or*

*(b) The complainant's personal name.*

I note as a preliminary matter that the Complainant relies on rights to its Trade Marks not to its name. Given the name that the Company bears I find this curious.

The Respondent is, of course, entitled to know "the Case it has to answer" and thus I shall not explore this line further even though the Respondent's own Submissions state in part that "the Domain Names that are in dispute are not company trading names" thus tempting some discussion on this topic.

What the Complainant does rely on is the fact that it has three registered Trade Marks (as opposed to one registered Trade Mark which is more common in such cases).

The Complainant can obviously establish the first arm of paragraph 4(a)(i). It clearly has rights in the three Trade Marks referred to.

As regards the second arm, the Complainant occasionally appears to rely upon the disputed domain names being “identical or confusingly similar to” its registered Trade Marks but on other occasions it simply relies in their being “confusingly similar”. Obviously it is only the latter which could apply.

The Complainant of course has rights in the Domain Name <messagesonholdaustralia.com.au> since that name was transferred to it. Once again the Complainant does not rely on that fact.

I am left with the association between the Complainant’s Trade Marks and its reputation built up over 20 years and the phrase “Messages on hold”.

The Complainant says, as previously noted and as is uncontested, that the Respondent has no evidence to suggest that the Respondent is commonly known by any of the disputed Domain Names.

The Complainant puts a fair test at paragraph 11.9 of its Submissions where it submits that:-

*“If an objective bystander were to be presented with each of the links referred to in paragraph 11.8 above, it is likely that he or she would conclude that the links form part of the Complainant’s website, in that, they are branches of the Complainant’s business across the major capital cities in Australia. This presumption is not unreasonable given that there are no distinguishing features setting apart each of the disputed domain names from the Complainant’s Trade Marks.”*

I accept that this is the case. The Complainant has established the second arm of paragraph 4(a)(i).

### **5.3 Rights or legitimate interests**

#### **Paragraph 4(a)(ii)**

The Complainant’s argument is essentially that it can rely on M2 Technology and that it has “taken the field” as far as having legitimate interests in respect of the disputed Domain Names is concerned.

Curiously again, the Respondent’s argument that it has legitimate interests in respect of the Domain Name appears to rely on the “descriptive term” argument which, if accepted, could mean that neither the Complainant nor the Respondent had legitimate interests in the disputed names.

Secondly, again curiously, the Respondent relies upon the decision of the delegate of the Registrar of Trade Marks in refusing to register a Trade Mark application. I have not researched that decision because I do not regard the Respondent’s argument as in any way viable.

The fact that the three Trade Mark names were subsequently registered means that on three separate occasions these Trade Marks did not contain the flaws that Mr Thompson apparently saw at an earlier time. Once the

subject Trade Marks were registered their registration has the opposite effect to what the Respondent is arguing for.

The .au Dispute Resolution Policy (auDRP) (2010-05) (“the Policy”) usefully lists, in Schedule A, some circumstances “in particular but without limitation” which might be used to demonstrate a person’s rights to/or legitimate interests in a Domain Name in responding to a complaint. The Respondent has not qualified itself with regard to any of these circumstances or, they being not being exhaustive, on any other basis.

The Complainant succeeds as regards paragraph 4(a)(ii).

#### **5.4 Registered or subsequently used in bad faith:**

##### **Paragraph 4(a)(iii)**

I should state firstly that I regard the previous transfer of the Domain Name <messagesonholdaustralia.com.au> as irrelevant to my decision herein. That was a negotiated outcome not the decision of a Court or Tribunal which might have some precedent value in this matter.

Prima facie, the Claimant puts a strong argument that the Respondent is “passing off in light of the Complainant’s well established and identifiable reputation in the words ‘Messages on Hold’ of over 20 years.”

Although the Complainant does not explicitly say so, there is a correspondingly strong prima facie argument as regards misrepresentation under the Trade Practices Act and/or the Competition and Consumer Act as they have applied from time to time.

There is some force also in the Complainant’s reliance and commentary on the New Zealand decision in Oggi Advertising Ltd v McKenzie (1998) 44 IPR 661 at 667.

That case, however, focused on cyber-squatting, although the registration of the relevant Domain Names was said to hinder Oggi in its business activity and to be calculated to damage of its goodwill which is relevant here.

What I find overwhelmingly persuasive, however, is the Respondent’s own counterproductive assertion that:-

*“When you click on the link and go to our webpage – and clearly discover we are Media Messages”*

In order to do this, it is necessary to start on the Media Messages’ webpage and then click one of the disputed name links at the bottom.

Whilst the above quoted assertion is strictly correct, clicking merely takes the objective bystander from one Media Messages webpage to another one via a link which is one of the disputed Domain Names. This circular process, on any objective analysis, serves no necessary purpose of the usual type. Any information on the second webpage would be obtainable from the first or could be added to it. Transferring from one webpage to another, on which the phrase “Messages on Hold” features prominently, creates the impression that



one has dealt both with “Media Messages” and with “Messages on Hold” thus creating a strong inference that one need look no further, as regards an organisation connected with the reputation of “Messages on Hold”.

The effect is also to suggest that “Media Messages” and the Complainant’s organisation are one and the same.

It is here that paragraph 4b of Schedule A of the Policy is directly relevant. The relevant portion reads as follows:-

*“Evidence of Registration or Use in Bad Faith.*

*For the purpose of Paragraph 4(a)(ii), 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) ----*
- (ii) ----*
- (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 web site 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 web site or location or of a product or service on that web site or location.”*

It may be that the outcome referred to at subparagraph (iii) has occurred. It may be that it was even intended. The Respondent’s comments on M2 Technology make it clear that, whatever the rationale it knew what it was doing.

Overwhelmingly, however, the evidence before me is persuasive that the Respondent’s intention in this matter has at all times been to create the type of confusion referred to in subparagraph (iv).

The Complainant has satisfied paragraph 4(a)(iii).

I find that each of the disputed Domain Names is being used in bad faith.

## 6. DECISION


- 6.1** The Complainant alleges that this dispute is properly within the scope of the Policy and that the Panellist has Jurisdiction to decide this dispute. The Respondent does not demur. I so find.
- 6.2** The Complainant is a potential eligible registrant for the Domain Names and satisfies the eligibility requirements in accordance with the rules set out in auDA’s Domain Name Eligibility and Allocation Rules for open 2LDs 2012-2014.

- 6.3** The Complainant has satisfied all of the requirements for the complaint to be upheld as regards each name in dispute. It has requested that the disputed Domain Names be transferred to it.
- 6.4** For the above mentioned reasons I direct and order that the disputed Domain Names be immediately transferred to the Complainant.

Date: 16 April 2013

The Panellist

John Emmet McDermott

A handwritten signature in black ink, appearing to be 'John Emmet McDermott', written in a cursive style. The signature is located below the printed name.