

LEADR DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL**auDRP_13_04****Single Panelist Decision****BOSE CORPORATION and BOSE PTY LTD****v.****AAA 01 CENTER WS DS LIMITED****bose.net.au****Procedural History**

1. The complaint was submitted for decision in accordance with the (auDRP) Policy and Rules, which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplementary Rules (LEADR is the Provider).
2. The complete application was received from the Complainant by LEADR on 15 March 2013.
3. The Respondent was issued a copy of the complaint by LEADR on 21 March 2013 and it appears from the documents before me that the Complaint had also been served on the Respondent by the Complainant. That service was effected by courier. I have used the service by LEADR as the basis for calculating a date for a response from the Respondent. On 18 March 2013 advice was also sent to the Registrar advising of the complaint and requesting the domain name be locked. The Registrar of the domain is NetRegistry.
4. On 19 March 2013, Netregistry advised the domain name lock was applied on 18 March 2013 at 20:48:45 UTC.
5. On 21 March 2013 LEADR sent the Respondent (AAA 01 Centre WS DS Limited) an email notification of the complaint lodged against them. The Complainant was copied in on these notifications. A written notification was sent to unit 3, 9 Knight Street, Homebush. That express envelope was returned. Further addresses were sourced and on 2 April 2013 written notifications were sent to 3 Lexington Place, Maroubra and 131 Curlewis Street, Bondi Beach. These were also returned. LEADR also emailed the Respondent on 2 April 2013 seeking confirmation the three emails containing the notification of dispute had been received. The Respondent responded on 3 April 2013 that he'd received emails and didn't require a written copy. The Respondent advised he should be contacted at suite 1, level 11, 309 Pitt Street, Sydney.

6. The due date for the response to the complaint was confirmed to be 11 April 2013. Acknowledgement of notification was received from the Respondent on 12 April 2013 together with a document entitled “in response to a letter from Baker&McKenzie dated 4.02.2013”. I accept that document is the Response to the complaint.
7. On 10 April 2013 the Provider approached the Panelist. The Panelist confirmed his availability, informed LEADR that they had no conflict issues with the parties and accepted the matter on that date.
8. The Panelist received the package containing the Complaint including submissions and attachments on 13 April 2013. Pursuant to the timelines provided in the auDRP I calculate this decision is required to be completed on or before 29 April 2013

Factual Background

9. The Complainant has not used or registered the domain name “bose.net.au” (the domain). The Complainant does, however, hold registered trademarks for the name ‘Bose’ and also holds a variety of domain names incorporating the trademark including bose.com.au, thebosystore.net.au, bose.com, bosenz.com, and other similar domains.
10. The Complainant asserts that the name relates directly to the founder of the company and is not usual. Bose is an internationally recognised provider of sound systems and related accessories.
11. The Complainant became aware of the registration of the domain and contacted the Respondent by telephone and subsequently in writing. The written correspondence was undertaken by its legal representatives. The stated aim, and this appears to be common ground from the submissions, was to recover registration of the domain. The correspondence included an offer, but it does not appear that any responses were issued. It appears the conversation indicated, at least as far as the Complainant understood it, that a commercial settlement could be reached.

Complainant

12. The Complainant’s contentions, as they bear on resolution of this dispute, are discussed individually under consideration of the applicable elements of proof below. I also address the Respondent’s submissions as I understand they apply to the elements that must be established. For the avoidance of doubt, I note the obligations rest with the Complainant to establish the facts upon which they rely. Those facts must be established on the balance of probabilities in regard to each proof required. Those proofs are cumulative and the Complainant must meet each element.

Discussion and Findings

13. When a person registers a domain name with any domain name registrar, the person accepts a contract that forbids “cybersquatting” – the bad faith registration of a domain name that is confusingly similar to someone else’s trademark. When a trademark holder finds that someone has registered a domain name that they believe is too close to their own trademark, they can initiate an arbitration under the Policy. To prevail in such auDRP action, Paragraph 4(a) of the Policy requires that the trademark holder – the Complainant – must prove each of the following:
- a. *The domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and*
 - b. *The Respondent has no rights or legitimate interests in respect of the domain name and*
 - c. *the domain name has been registered or subsequently used in bad faith.*
14. Because this dispute is between two parties who are Australian entities and would otherwise be subject to jurisdiction before Australian courts to resolve any disagreement regarding trademark infringement by the domain name in question, the Panelist concludes that pursuant to Paragraph 15(a) of the Rules, it is appropriate to apply rules and principles of Australian trademark law between the parties.

Paragraph 4(a)(i) - Identical or Confusingly Similar

15. This limb has two sub limbs, firstly that the domain in dispute is identical or confusingly similar to a service mark, trademark, business name or the like, and that the Complainant has rights in that name.

Domain is identical or confusing

16. The Complainant asserts that the name is identical to the name they hold as a registered trademark, and the internet presence they hold in other domain names. Given the information establishing the identical registered Trademark, I am satisfied this is established.

Complainant has rights in the name

17. The word ‘bose’ is a registered trademark. That trademark is owned by the Complainant. The Complainant has traded using that trademark and variants of that trademark for many years.
18. The Respondent does not contest that the Complainant has rights in the word ‘bose’.
19. I accept this is established.

Conclusion

20. I am satisfied that the Complainant has shown that the domain is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights. I make this finding with particular cognisance of the note to this element as advised in the rules which states:

[1] 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.*

Paragraph 4(a)(ii) - Rights or Legitimate Interests of Respondent in domain

21. The Complainant has asserted that the Respondent has no legitimate interest or rights in the domain because:
- a. mere registration does not establish entitlement, which accords with Note 2 to the auDRP Policy
I accept this submission as a statement of the policy and intent of auDA.
 - b. The Respondent is not now or previously known as the owner of any intellectual property rights in the domain or the name 'bose'.
I accept this submission and note that the Respondent has activated many pages of the domain since it was acquired.
 - c. The Respondent is not and has not at any time been authorised by the Complainant to use the name.
I accept this submission and accept that it weighs on the limb in issue.
 - d. The Respondent has used the domain for commercial purposes so as to accord with the purpose test (see auDA policy 01-2005 states at schedule C: 'ELIGIBILITY AND ALLOCATION RULES FOR COM.AU').
I accept this submission and note that while the Respondent submits that the intention is altruistic and is to be used for garnering research information and to act as a forum for uses of Bose equipment, that action in my view has itself a commercial value. The Respondent's position faces some difficulties when it is uncontested that the domain has included statements such as:
Are you going to buy Bose products ? Contact us and we will get the best deal for you.¹
 - e. The Respondent only deals with Bose products on the site
I accept this submission and note this is not contested.

¹ See paragraph 7.3(g)(ii)(B) of the Complaint.

- f. The Respondent is not making a 'bona fide' offering of goods and services as discussed in Oki Data Americas, Inc v ASD, Inc WIPO D2001-0903
I accept this submission and note this is not contested, save for the discussion regarding the intention to secure marketing data.
- g. The Respondent asserts the presence of the domain and the forum would generate increased exposure and could, subject to suitable arrangements being in place, be used as a marketing and/or customer complaint management forum to the advantage of the Complainant.
I accept this submission, however, I am not persuaded that it assists the Respondent and could be characterised, so far as the current limb applies, as being an admission against interest.
- h. Prior to the dispute advancing, the website displayed no disclaimers or the like and no approach was made to the Trademark owners (the Complainant) to use the name.
I accept this submission and note this is not contested
22. The Respondent registered the domain in order to garner information to support a marketing operation. I am satisfied the registration was not undertaken to deny the Complainant the benefit of the domain.
I accept the submission and it does weigh upon my determination of the satisfaction of this limb. I do not find that they registered the domain name to deny the Complainant, however, I am satisfied that they registered the domain for the purpose of commercial gain, which I also observe accords with the intent of this 2LD.
23. The Respondent's response is suggestive of seeking a collaborative agreement to provide a benefit to both the Complainant and the Respondent. However, this was not communicated to the owner of the rights in the name. While it may be the case that this was the Respondent's intention, it has not taken any steps prior to the issue of the Complaint to advance this proposition. It does not, in my view, effect the right of the Complainant to recover the domain name. The development of the site must be based on a right in the Respondent and none is evidenced.

Conclusion

24. I am satisfied having considered the submissions of the parties and the materials supplied, that the Respondent did not at the time of registration of the domain, hold any legitimate rights in the domain name.

Paragraph 4(a)(iii) - Registered or subsequently used in bad faith.

25. Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by, among other things, evaluating four (non-exhaustive) factors set forth in the Policy:

- a. circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or
 - b. the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or
 - c. the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
 - d. by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location. Paragraph 4(b) of the Policy.
26. The Complainant has relied on the fourth ground; that is, the Complainant asserts the Respondent sought to gain a commercial advantage from the use of the domain. The Complainant has also faintly pressed the first ground. In support of that contention, the Complainant relies on the telephone conversation of 29 January 2013. Particular reliance is placed on the words said to have been uttered by the Respondent's director. The context of these words follows an offer of the Complainant to refund the cost of registration:
- ... if the opportunity presents itself a commercial arrangement could be found to suit both parties.*
27. I am not persuaded that those words satisfy the first element of the limb. These words, when construed in light of the Respondent's submissions, adhere to the view that he was seeking a collaborative relationship.
28. I accept that the first, second and third elements are not evidenced in any measure. However the fourth element is in my view sufficiently evidenced.
29. The fourth element is evidenced by the processes the Respondent has used the site. It acts to direct traffic to its other sites, and also was intended to generate revenue by securing information relevant to marketing of the products of the Complainant. It is relevant to record that, in my view, websites that host forums, product reviews and the like do not axiomatically offend the fourth element of the current limb. However, by utilising the name in which the rights were properly and lawfully held by the Complainant, the Respondent sought to and probably did, secure a commercial advantage.

30. It does not alter the force of the relevant codes that establish entitlement, that subsequent to registration, the Respondent has sought to put commercial propositions to the Complainant. For the first two limbs some element rests on the intention at the time of Registration. The current limb in the fourth element deals with actions after the registration and in this regard, all material before me, including the Respondent's submissions are supportive of commercial gain for the Respondent.

Conclusion

31. The appropriate evidential level in these determinations is the balance of probabilities. When this test is applied ie:
- a. the established use of the domain by the Respondent, which included approaching a reseller of the Complainants products,
 - b. the core activity of the Respondent being marketing, and
 - c. the belated approach to the Complainant of a commercial collaboration
- I am satisfied that the requirements of this third limb are satisfied.

Decision

32. Having read all of the submissions of both parties and for all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panelist orders that the domain name <bose.net.au> be transferred to the Complainant.



Scott Pettersson
Panelist

28 April 2013