

LEADR DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

auDRP_11_13

Single Panelist Decision

OASE ASIA PACIFIC PTE LTD

v.

WIFITECH PTY LTD

1. The Parties

1.1 The Complainant is OASE Asia Pacific Pte Ltd, Company registration 200006998H (Singapore) of 151 Chin Swee Road #06-01 Manhattan House, Singapore 169876.

1.2 The Respondent is Wifitech Pty Ltd, Company registration ABN 43126215325 of 26a Production Avenue, Kogarah, Australia 2217.

2. Domain Name

2.1 The domain name upon which complaint is based is *www.oase.com.au* (Domain Name).

3. Procedural History

3.1 On 1-12-2011, the Complainant lodged a complaint with LEADR with a copy of the complaint submitted same day to the Registrar, TPP Domains Pty Ltd (TPP Internet) with a request to clarify Respondent details and lock the Domain Name during proceedings. On 2-12-2011 the Registrar confirmed that the Domain Name in dispute had been locked.

3.2 Notification of the complaint was given to the Respondent on 5-12-2011. The Respondent submitted a response to the Domain Name complaint on 22-12-2011.

3.3 LEADR appointed Rowena McNally as the sole panelist in the matter on 4-01-2012. The Panelist has confirmed that she has no conflict of interest in relation to the matter. All procedural requirements appear to have been satisfied.

4. Factual Background – The Respondent’s case

4.1 The Complainant seeks a transfer of the Domain Name. It says OASE is a leader in the field of creatively using water and that its parent company, OASE International Holding GmbH, has an international reputation, with several registered OASE trade marks in Australia and elsewhere throughout the world, including International Registration No. 819179 (OASE and device, classes 1, 7, 9, 11, 17, 19, 37 and 42); International Registration No. 938339 (OASE LIVING WATER and device, classes 1, 6, 7, 9, 11, 17, 19, 20, 21, 31, 37, 42 and 44); and International Registration No. 928323 (OASE and device, classes 1, 6, 7, 9, 11, 17, 19, 20, 21 and 31), copies of which have been provided.

4.2 The Complainant has also provided a company search extract conducted on 9-12-2010 which records OASE International Holding GmbH as sole shareholder of the Complainant as at that date.

4.3 Much of the Complainant's application refers to protracted communication between 2007-2010 about use of the OASE name between the respective lawyers for the Complainant and the owners of Sydney Pumps ("SP"), the previous registrant of the Domain Name.

4.4 On 16-03-2010 SP offered to de-register the domain name on terms including further supply of OASE products with the Complainant also seeking terms including undertakings from SP.

4.5 The Complainant's requirements and follow-up correspondence were not responded to and a domain name search by the Complainant on 9-12-2010 revealed that the Domain Name was no longer registered to SP, and was instead registered to the Respondent.

5. Complaint Elements and the Onus of Proof

5.1 Schedule A of the .au Dispute Resolution Policy (auDRP) applies to disputes which meet the requirements set out in paragraph 4(a) of Schedule A of the auDRP. Subparagraph 4(a) requires that any party holding a domain name licence issued in the 2LDs "*..submit to a mandatory administrative proceeding in the event that a third party (complainant) asserts to the applicable Provider, in compliance with the Rules of Procedure that:*

- (i) [the] domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and*
 - (ii) [the] have no rights or legitimate interests in respect of the domain name, and*
 - (iii) [the] domain name has been registered or subsequently used in bad faith.*
- In an administrative proceeding, the complainant bears the onus of proof."*

6. Is the Domain name identical to or confusingly similar to a name, trade name or service mark in which the Complainant has rights?

6.1 The Complainant says that the Domain Name is identical to or confusingly similar to a trade name or trade mark to which the Complainant and its parent company have rights; that the Complainant has "gained significant common law trade mark and other rights in its OASE name, through its genuine use, advertising and promotion" and that it has also "protected its valuable OASE name" by filing for trademark registrations, such as those identified above.

6.2 The Complainant's reputation and use of the OASE name is not disputed by the Respondent, but the Respondent says there can be no confusion between the Complainant's use and the Respondent's intended use. The Respondent says that it is a developer and provider of e-communications technology and services, including but not limited to local and international Voice Over IP communications, website hosting, web development, internet marketing campaigns, wireless networking technology development, desktop support and training.

6.3 The Respondent says it registered the Domain Name for a web forum for **O**verseas **A**ustralians **S**eeking **E**mployment, which forum will be dedicated to the activities and discussions relating to Overseas Australians who are seeking employment, as well as those wishing to employ or advertise to them. The Respondent expects this to facilitate paid banner advertising and banner advertising of the Respondent's own existing overseas communications products which include existing operational websites of *travelnumber.com.au* and *chatabox.com.au* (registered on 25-06-2010 and 30-06-2010, respectively) and a new website, *expatphone.com.au* registered 29-07-2009, which is still being developed.

6.4 The Respondent argues the Complainant's trademarks have no relevance to Internet forums and cannot be considered identical or confusing. The Respondent also points to the Complainant's failure to hold the domain name *www.oase.com*, (held by a surfing company) or *oase-livingwater.com.au*, which the Respondent says is available and more consistent with other of the Complainant's domain names, such as *oase-livingwater.com* and *oase-livingwater.com.sg*.

6.5 While the Panelist accepts there is no product similarity, it is the finding of the Panelist that the Domain Name is nonetheless identical or confusingly similar to OASE, being a name, trademark or service mark in which the Complainant has rights, thus satisfying para. 4(a)(i) of Schedule A.

6.6 The criteria in paragraph 4(a)(i) - (iii) of Schedule A of the auDRP Clause 4(a)(i) - (iii) are not alternatives however and all must be made out for the Complainant to succeed in its application.

7. Does the Respondent have a right or legitimate interest in the Domain name (4(a)(ii))?

7.1 The Complainant says the Respondent is not affiliated to the Complainant and that there is no evidence the Respondent registered the Domain Name to "advance legitimate interests or for the *bona fide* offering of legitimate OASE line of goods and services". The Complainant's evidence and submissions rely solely upon this absence of affiliation to demonstrate the asserted lack of a right or interest by the Respondent in the Domain Name.

7.2 The Respondent agrees that it is not affiliated with the Complainant; that it has no connection with the Complainant's OASE line of goods and services which are related to water treatment chemicals, pumps etc, and says its own internet-based activities products and services are not "remotely related" to those of the Complainant.

7.3 The Respondent asserts however that it does have rights and legitimate interests to the Domain name arising from its vision for the web forum for "Overseas Australians Seeking Employment", which it intends as part of a suite of e-communication sites that include *expatphone.com.au*; *travelnumber.com.au* and *chatabox.com.au*.

7.4 The Respondent says its *wifetech.com.au* domain is used for the commercial sale of wireless networking products and was not a suitable name for the intended forum, while "Overseas-Australians-Seeking-Employment.com.au", while available, is unsuitable due to the length of it.

7.5 The Respondent submits that auDA published policy 2008-06 (*Guidelines for Accredited Registrars on the Interpretation of Policy Rules for Open 2LDs*) s. 10.2 permits the registration of domain names which are an acronym, and that the Domain Name is an acronym of the forum which the Respondent intends to publish. The Panelist note that Domain names in the com.au 2LD must be an exact match, abbreviation or acronym of the registrant's name or trademark, or be otherwise closely and substantially connected to the registrant and in the current circumstances, the Respondent is not yet using the Domain Name, and nor has it established the OASE forum to which it aspires.

7.6 As to whether the Domain Name is otherwise "closely and substantially connected", s.10.2 of policy 2008-06 indicates this is intended to allow some flexibility for registrants who do not want to license a domain name that is directly related to their name (or cannot do so, because the domain name has already been licensed by another registrant with the same or similar name). Examples of categories of "close and substantial connection" (s. 10.5) include: a product that the registrant manufactures or sells; a service that the registrant provides; an event that the registrant organizes or sponsors; an activity that the registrant facilitates, teaches or trains; a venue that the registrant operates; or a profession that the registrant's employees practise.

7.7 The Respondent says that it registered the Domain Name for the purposes of an online forum for "Overseas Australians Seeking Employment", the provision of which product, service or activity would appear, to be *prima facie*, sufficient to constitute a "close and substantial connection" with the Domain Name.

7.8 However, the Respondent has indicated that it has not yet finalized the development of the intended OESE forum and accordingly, the Panelist is not satisfied that the Respondent does in fact currently provide a product, service or activity as would accommodate the claimed acronym, and nor that the Respondent's stated but unfulfilled plans for an "OASE Forum" are sufficient to establish the "close and substantial connection" with the Domain Name as contemplated in s. 10.5.

8. Has the Domain Name has been registered or subsequently used by the Respondent in bad faith: (4(a)(iii))?

8.1 The Complainant asserts the Domain Name was registered in bad faith. It refers to its protracted communications with SP and says that "despite some initial indication of a willingness to settle the matter amicably", SP did not transfer the Domain Name to the Complainant. The Complainant says it was "surprised to subsequently discover that the registration of the Domain Name had abruptly changed hands" from SP to the Respondent.

8.2 The Complainant asserts the transfer of ownership of the Domain Name is a "mere sham" and that SP is still using the Domain Name via the Respondent. Other than this bald assertion however, there is nothing in the material before me to substantiate either of these allegations.

8.3 The Respondent disputes the Complainant's allegations and says the Domain Name was not transferred to it by SP and has provided a copy of the TPP Internet's confirmation of requisition of the Domain Name "as a new registration on 9-11-2010"

8.4 The Respondent says that no other company uses or has used the domain since it was "cleanly" registered by the Respondent on 9-11-2010. It says that it is not and never has held a domain on behalf of any third party or company and that it is not affiliated with any of the entities that the Complainant has accused the Respondent of conspiring with.

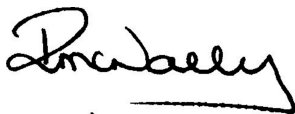
8.5 The Respondent disputes the validity of the Complainant's presented evidence of an orchestrated "sham", which it submits, is based on nothing more than "one Whois search on 5/2/2010 and another 9 months later on 9/12/2010".

8.6 There is nothing in the material to indicate to the Panelist's satisfaction that the Respondent either registered or has since used the Domain Name in bad faith and it is the finding of the Panelist that the Complainant has not discharged its onus in relation to this element of the complaint.

9. Decision

The Panelist finds that the Complainant's application and requested transfer of the Domain Name to the Complainant should be refused.

DATE: 10 January 2012



Rowena McNally
Panelist