

ADMINISTRATIVE PANEL DECISION

LEADR Case No: auDRP_11_05

Domain Name:	buildingcpd.com.au
Name of Complainant:	Confo Pty Ltd
Name of Respondent:	Meridian Project Consulting Pty Ltd
Provider:	LEADR
Panellist:	John A. McGruther
Date:	16 May 2011

1. THE PARTIES

- 1.1 The Complainant is Confo Pty Ltd (“Complainant” or “Confo”).
- 1.2 The Respondent is Meridian Project Consulting Pty Ltd (“Respondent” or “Meridian”).

2. THE DOMAIN NAME REGISTRAR AND PROVIDER

- 2.1 The Domain Name at issue is **buildingcpd.com.au** (“the Disputed Domain Name”).
- 2.2 The Trade Marks, names or service marks upon which the Complaint as submitted and dated 21 March 2011 (“Complaint”) is based are:
 - Builders CPD (Business Name 98340905);
 - Builders CPD Pty Ltd (wholly owned subsidiary); and,
 - Other references as to basis for the Complaint set out in Reasons and discussion following.
- 2.3 The provider in relation to this proceeding is LEADR (“Provider”).

3. PRELIMINARY MATTERS

- 3.1 Schedule A of the *au Dispute Resolution Policy* (“auDRP”) (“Policy”) applies to disputes which meet the requirements set out in Paragraph 4a of Schedule A of the auDRP. This subparagraph 4a

requires that any party holding a domain name licence "...submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure that:

- (i) [their] domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and
- (ii) [they] have no rights or legitimate interests in respect of the domain name; and
- (iii) [their] domain name has been registered or subsequently used in bad faith.

In an administrative proceeding, the complainant bears the onus of proof."

4. PROCEDURAL HISTORY

- 4.1 The procedural history in this matter is set out in Annexure 'A' to this determination.
- 4.2 LEADR has appointed this Panellist as the sole Panellist ("Panel") in the matter. The Panellist has had no prior knowledge of or association with either party and has no conflict of interest. The Panel received the Complaint delegation from the Provider on 4 May 2011.
- 4.3 All procedural requirements appear to have been satisfied. The Panel has been properly constituted. So far as the Panel is aware all pertinent written communications by the parties to or with the Provider have been concurrently copied to the other party.
- 4.4 The Panel is satisfied that the Respondent has been served with and/or is on full notice of this Complaint. The content of the Procedural History Annexure 'A' affirms this and, further, the Respondent has responded to the Complaint.
- 4.5 Certain written material has been submitted to the Panel as provided by the Complainant and the Respondent to the Provider. The content of the Procedural History Annexure 'A' also affirms this. The observations in this determination arise singularly from the material submitted. I have read all of the materials. There is no need

that I traverse all of it in the reasons here given, but all of it has been noted and analysed.

4.6 Paragraph 15(a) of the auDRP Rules states:

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

4.7 The Policy applies to the Disputed Domain Name.

5. FACTUAL BACKGROUND: The Complainant’s (Confo’s) case

5.1 In submissions made with its Complaint, the Complainant essentially raised some of the following matters (re-stated below in no special priority order), namely that:

- (a) It has been actively trading under the business name “Builders CPD” since approx 1 February 2008 (registered Business Name certificate attests).
- (b) A related corporation of the Complainant is “Builders CPD Pty Ltd”.
- (c) The Complainant has operated Builders CPD in partnership with TAFE NSW as one of the largest builder continuing professional development training providers across many diverse locations in NSW, since 2008 training in excess of 2,000 builders.
- (d) Operating as Builders CPD the Complainant has spent over \$500,000 in marketing both face-to-face and online courses in the last approx three years.
- (e) Builders CPD has the first natural (generic) listing appearing in the Google listing for most “builders cpd” related searches consistent with being one of the first registered domain names promoting (amongst other) its training services online.

- (f) The Respondent recently changed its trading name from “CPD for builders online” to “buildercpd”, notwithstanding not previously having had a registered trading (business) name in NSW. There was a previous proceeding auDRP_10_20 between the parties in February 2011 where the then domain in dispute was “buildercpd.com.au”. By reference to some of the antecedent history to this prior Complaint of the Complainant, that the Respondent had registered on 8 December 2010 the domain name now in dispute “buildingcpd.com.au”.
- (g) In response to this latter step by the Respondent, the Complainant was occasioned to register the business names and web domains of “buildingcpd.com”, “building industry cpd”, and “built cpd”.
- (h) The Complainant was also occasioned to register the company “Builders CPD Pty Ltd” to reinforce name protection against the Respondent.
- (i) The website of the Respondent not only bears an almost identical name to that of the Complainant but has also been re-designed “to look and feel” almost identically also.
- (j) That (in effect) the Respondent’s working of its website is a clear attempt to capitalise on the goodwill of the Complainant trading as “builders cpd” or residing in the Complainant’s traditional domain name “builderscpd.com.au”.
- (k) That the Respondent had attached to its domain name designation the NSW State Government logo (akin to that appearing in the Complainant’s domain name designations but there by specific reference to the Complainant’s conjunction building training work with TAFE NSW), and which the Respondent, by Government correspondence, has recently been asked to remove (and has since removed).
- (l) By reference to more specific criteria attaching to this immediate Complaint:

- (i) The Disputed Domain Name “buildingcpd.com.au” is almost identical with and confusingly similar to the Complainant’s domain of “builderscpd.com.au”.
- (ii) The Respondent has attempted to re-direct traffic from the domain name disputed in the prior successful proceeding (referred to above), namely from the Complainant’s “buildercpd.com.au” to the Respondent’s new domain name “buildingcpd.com.au”.
- (iii) That the Respondent has no rights in respect of the Disputed Domain Name here not being a registered business name proprietor of any business, trademark or company name with the same or similar name.
- (iv) That the Respondent has had knowledge of the Complainant’s business and has taken the step to register the Disputed Domain Name in bad faith to capitalise on the goodwill of the Complainant in the event, as has occurred by reference to the prior decision, the Respondent was unable to utilise its previously attempted registration of “buildercpd.com.au”.
- (v) That the presentation by the Respondent of its website is an attempted duplication of the domain name presentations of the Complainant and is, as such, not a bona fide use including under auDRP policy.
- (vi) The domain name change initiatives of the Respondent are, taken globally, an effort by the Respondent to capitalise on the longstanding goodwill attaching to the business of the Complainant including with reference to the marketing and delivering by the Complainant of its traditional services in building education including in conjunction with TAFE NSW.
- (vii) That the recent domain name steps of the Respondent including with reference to the Disputed Domain Name have been disruptive to the core business of the Complainant and comprise an intentional attempt to

attract, for commercial gain, Internet users to buildingcpd.com.au, by creating a likelihood of confusion with the Complainant's name, namely "builderscpd.com.au", including in re-directing traffic from "buildercpd.com.au" to the new "copy site" of the Disputed Domain Name "buildingcpd.com.au".

6. FACTUAL BACKGROUND

The Respondent's (Meridian's) case

6.1 Through its representation by Pope and Spinks solicitors, including in the email from the latter to the Provider of 21 April 2011, the Respondent raised some of the following response matters (expressed in no special priority order as below), namely that:

- (a) The Respondent commenced building industry online education in February 2002 through its then website "buildingchecklist.com.au".
- (b) In July 2004 a business name "CPD for Builders" was registered by the Furnishing Industry Association of Australia Ltd (an entity unrelated to either party here). In February 2009, the Respondent under a website "cpdforbuildersonline.com.au" began online building industry educational services as at October 2009.
- (c) Asserts that the above history was ". . . all over 1 year . . . prior to . . ." the Complainant's business commencement.
- (d) From 23 September 2010 the Respondent started using the domain "buildercpd" as its main online services URL for the same business previously carrying the online designation of "cpdforbuildersonline.com.au" (for two asserted reasons).
- (e) The Respondent did not investigate competing businesses including that of the Complainant.
- (f) The Complainant's web presence until the second half of 2010 was solely for referral of inquirers for CPD services for TAFE face-to-face based courses of the Complainant.

- (g) The Respondent did not realise that the Complainant had registered a business name “Builders CPD” in February 2008, six (6) years after the Respondent began providing building CPD services.
- (h) The Complainant having registered “builderscpd.com.au” in December 2009 successfully invoked the prior auDRP procedure (previously referred to).
- (i) In consequence of the prior Complaint, the Respondent registered the Disputed Domain Name here “buildingcpd.com.au” on 6 December 2010 and that the Complainant subsequently registered its business name “Building CPD” and commenced this Complaint.
- (j) That the Respondent incorporated Building CPD Australia Pty Ltd on 18 February 2011, a company associated with it.
- (k) Acknowledges that both parties here are competitors for online education services to the building industry, asserting a Respondent online service history pre-dating that of the Complainant.
- (l) That the websites comparatively do not have similar “get up” and are not confusing to consumers.
- (m) As to the question of the Disputed Domain Name being identical to or confusingly similar to the registrations of the Complainant that the law (and some cited case authorities) on misleading and deceptive conduct are supportive only of such words as “building” and “builder” as being descriptive of CPD services provided by both parties – and that any risk of confusion must be accepted.
- (n) That both parties have a “legitimate right” to the use of the respective domain names with neither having acted in bad faith.

7. SUPPLEMENTARY SUBMISSION/RESPONSE FROM THE COMPLAINANT

7.1 On 1 May 2011 the Provider received a response submission from the Complainant by reference to the Confo Pty Ltd letter of 1 May 2011 to the Provider. Its content is incorporated within discussion following.

8. DISCUSSION AND FINDINGS

Elements of a successful complaint

8.1 According to Paragraph 4a of the .auDRP Policy, a person is entitled to complain about the registration or use of a domain name where it is contended that:

- (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.*

8.2 It is to be noted that the three elements of a complaint under Paragraph 4a of the auDRP Policy are cumulative; all of them must be proved if the Complaint is to be upheld.

Is the Disputed Domain name identical or confusingly similar to a name, Trade Mark or service mark in which the Complainant has rights? (auDRP 4a(i))

8.3 The Panel must determine whether the Complainant has rights in a relevant name, Trade Mark or service mark.

8.4 The auDRP Policy 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;*

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

8.5 The auDRP Policy does not provide guidance as to the intended meaning of "*identical*" or "*confusingly similar*". However, "*essential or virtual identity*" is sufficient. (*BlueChip Info Tech Pty Limited v Roslyn Jan and another* [LEADR case 06/03]).

8.6 Although it may appear that there is no exactitude as to what is contemplated in the term "*confusing*", the test of "*confusing similarity*" could have reliable precedent in the trade mark infringement case application of the expression, where the concept of "*deception*" contemplates consumers who may be deceived or "*caused to wonder*" about the source or origin of goods or services. (as, for example, noted in *Camper Trailers WA Pty Ltd v Off Road Equipment Pty Ltd* [LEADR 06/04]).

8.7 In the view of the Panel, it is worthy from the outset of recounting the following:

- The Disputed Domain Name is "buildingcpd.com.au" chosen to be registered by the Respondent at or around 6 or 8 December 2010;
- The names, trademarks or service marks upon which this immediate Complaint is based are business name "Builders CPD" (BN98340905) and company "Builders CPD Pty Ltd" – both under the proprietorship or subsidiary proprietorship of the Complainant;
- Business name "Builders CPD" has been the registered property of the Complainant since 1 February 2008;
- The Company "Builders CPD Pty Ltd" commenced registration in NSW as the proprietorship of the Complainant on 1 December 2010;

- Additionally, historically the Panel further notes:
 - On 1 December 2010 the Complainant applied for Australian Federal Trade Mark registration (trademark category 41) of trademark “Builders CPD”;
 - On 14 December 2010 the Complainant registered the additional Business Name “Building CPD” in NSW; and
 - On 18 February 2011 the Respondent chose to incorporate a company “Building CPD Australia Pty Ltd”.

The Panel returns to elements of some of that history in some discussion following.

8.8 On the material before the Panel it accepts that:

- The Complainant appears to have first provided continuing professional development (“CPD”) to the building industry from around September 2005;
- That such building educational course provision has been provided, through face-to-face and/or online course provision somewhat intensely since September 2005, and certainly in the last three to four years;
- The latter is consistent with the Complainant having first registered, and beginning to trade under “Builders CPD” from 1 February 2008;
- The Complainant has consequently trained numerous builders including (but not exclusively) in conjunction or in a joint venture with TAFE NSW;
- Historically, the Respondent first traded under a domain representation of “cpdforbuildersonline.com.au” from about October 2009;

- The Respondent then altered this on 23 September 2010 to a domain name representation of “buildercpd.com.au”;
- The latter move instigated the successful auDRP Complaint 10_20 of this Complainant made on 12 February 2011 with which (and the reasons for determination of which) will be familiar to the same parties here;
- In the view of the Panel, there can be no doubt (and it appears not to be specifically disputed) that the Complainant has rights in respect of a number of the antecedent names, registrations and/or applications referred to above. At the least, those rights appear to attach to:
 - Company Builders CPD Pty Ltd;
 - Trade Mark registration application for “Builders CPD”;
 - Business Name “Builders CPD”; and,
 - Business Name “Building CPD”.

8.9 In the view of the Panel, it would not be unreasonable to conclude that some of the more recent Complainant initiatives relative to the above were driven by the rationale to protect its historic goodwill attaching to its active trading in the core business of building education courses of some relative longstanding, some referred to in the brief recited history above.

8.10 Accordingly, the Panel does not hesitate to conclude that the Complainant does hold relevant rights under this heading.

8.11 The central description in the Disputed Domain Name here is “buildingcpd”. It is a derivative, selected by the Respondent, from its earlier selected domain of “buildercpd”, found offending at the instance of the same Complainant in the prior proceeding. The only alteration would appear to be the addendum at the end of the word “build” of “ing”, as now presents, from the final letters “er” in the offending earlier name from the prior proceeding.

8.12 Noting closely the entirety of all submissions from both parties under this (and the other) headings, the Panel makes the observations following and in no selected priority order.

8.13 The two (2) reasons recited by the Respondent for initially changing from its domain presentation of “cpdforbuildersonline.com.au” to “buildercpd.com.au” in September 2010, namely the historic description was “too long”, and for “search engine optimisation”, are not in any context pertinent to this Complaint.

8.14 Although there is some later brief discussion on this same point, any acknowledged Respondent historic failure to previously “investigate competing businesses” does not avoid or excuse a Complaint challenge, as here, of identity confusion, or confusing similarity.

8.15 The Respondent draws upon some judgmental authority in urging an argument that there can be no confusing similarity at law by reference, for example, to the words “building” and “builder” being “. . . descriptive of the CPD services provided by both parties”. Some of this is put by reference to section 52 misleading and deceptive conduct considerations under the Trade Practices Act. Respectfully, the Panel does not concur, in the circumstances of this matter, with the interpretations said to be drawn from *Hornsby Building Information Centre v Sydney Building Information Centre* (1978) 140CLR216 or from *Dodds Family Investment v Lane Industries* (1993) 26IPR261, selected passages from which the Respondent quotes.

8.16 Here, in short, the Respondent seeks to urge that:

- A risk of confusion must be accepted if the words are descriptive and therefore can be applied “to any business of like kind” (*Hornsby*); and,
- The more descriptive a name the more a Plaintiff may need to show that the name has obtained a secondary meaning “. . . equating it with the product of the Plaintiff . . .” (*Dodds*).

8.17 These judicial pronouncements, respectfully, do not exclude analysis of potential name or identity confusion by reference to the overall context of each presentation. More accurately, in the view of the Panel, as expressed by His Honour Windeyer J:

“. . . The likelihood of deception must be judged not by the degree of similarity alone, but by the effect of that similarity in all the circumstances” (Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd (1963) 109CLR407 at 415-416)”.

8.18 His Honour Lockhart J reiterated as much, in several places, in *Johnson and Johnson Australia Pty Ltd v Sterling Pharmaceuticals Pty Ltd* [1991] FCA310 namely:

“. . . The mere fact that a word is descriptive or has a descriptive flavour does not necessarily prevent it being distinctive of somebody’s goods or services . . . the question is one of degree . . . a word which is prima facie descriptive may become distinctive in connection with particular goods or services and yet retain its descriptive meaning . . . what is important is that a significant number of consumers in the relevant market identify the Plaintiff’s goods or services as coming from one trade source . . .”.

8.19 Further, the High Court in *BM Auto Sales Pty Ltd v Budget Rent A Car System Pty Ltd* (1976) 12ALR363 at 369 (also referred to in *Dodds*) affirmed:

“But even descriptive words may become distinctive of the business of a particular person and if the use of such words by another is calculated to deceive persons into believing that the business of their originator is carried by the parasitic user and is likely to cause damage to the originator’s business, then a claim for relief for passing off may succeed . . .”

8.20 In the view of the Panel, the circumstances of this immediate presentation, do not properly restrict any analysis to the degree of words or wording similarity alone, or to whether the words “builder” and “building” are merely descriptive where the matter must end at that. The effect of the similarity is examinable in all the circumstances of each presentation (*Shell Co*).

8.21 For example but specifically, the Panel would observe that whether or not the word “Builders” in “Builders CPD” and in “Builders CPD Pty Ltd”, each entity the property of the Complainant, is of itself descriptive does not negate examination of the potential for confusing similarity with the word “building” appearing in the Disputed Domain Name here under contest.

8.22 Respectfully, the Panel does not accept the Respondent’s submission that “some confusion” is “. . . the price to be paid” by a Complainant choosing to use a descriptive name. In the view of the Panel, there is no reliable authority or benchmark for that proposition in the factual circumstances of this presentation.

8.23 The effect of the similarity is not excluded from examination in the overall. Here, the Panel notes (illustratively only):

- That the Complainant has acquired a substantial reputation in its building educational CPD courses by reference inter alia to its training in excess of 2,000 builders across many geographic regions actively in NSW since 2008;
- Under the banner of “Builders CPD” having spent in excess of \$500,000 in a recent three or four year period in marketing of such courses;
- That it has maintained across that period an active building industry course delivery with TAFE NSW;
- Has had a reported customer confusion, including as arising from a period of domain redirection from the Respondent’s prior site of “buildercpd” to the Disputed Domain Name over the more recent period; and,
- There does not emerge on the balance of reliable material before the Panel any substantive dispute or argument from the Respondent as to the Complainant’s rights attaching to the traditional name designations (as above) of the Complainant.

8.24 One element of this line of argument is that, and although it may fall under separate examination relative to considerations of bona fides or exercise of bad faith, there is an inherent acknowledgement by the Respondent, in so submitting, of name confusion or of the serious potential for such confusion.

8.25 The Panel is not persuaded that any of the submissions of the Respondent are of conviction as to lessen the inevitable confusion of the Disputed Domain Name with the Complainant's business and company names caused by the substantial similarity of the Disputed Domain Name to those names. Nor is such confusion lessened or diminished by reference to other broader analysis of matters here undertaken.

8.26 For these reasons, on the balance of material before the Panel, there is in its determination, the real potential for, and the actuality of, identity confusion in the terms which meet the foundation for the Complaint under this heading and where the Complainant, in the determination of the Panel, has established the requisite onus.

8.27 Accordingly, the Panel determines that the Complainant has satisfied the requirement of "*identical or confusingly similar*" in Paragraph 4a(i) of the auDRP Policy.

Does the Respondent have any rights or legitimate interests in respect of the Disputed Domain Name? (auDRP 4a(ii) and 4c(i)-(iii))

8.28 This is the second element for establishment within a Complaint under the auDRP. It involves deliberation upon the issue as to, whether or not, a Respondent has, in the circumstances of the particular presentation, no rights or legitimate interests in the Disputed Domain Name (as contended by the Complainant here). This is relative to considerations pursuant to Paragraph 4a(ii) of auDRP Policy and to 4c(i)-iii) of the Policy.

8.29 Firstly, it is imperative to note, including here, that 'rights or legitimate interests in respect of the Disputed Domain Name' are not established merely by a Registrar's determination that the Respondent satisfied any relevant registration criteria for the Disputed Domain Name at the time of its Respondent registration

(and refer Note 2 of the Policy). There is accordingly no basis for any Respondent argument (had there been any) singularly put by reference to registration, or necessarily, as to later use since registration, on that basis. In any event, the Respondent has made no submission on this or on any other basis to this Complaint.

- 8.30 The relevant burden of proof is to the extent that the Complainant need only make out a prima facie case that the Respondent has no legitimate interest, whereupon that burden then shifts to the Respondent to produce evidence of any relevant interest in the name in issue, as to satisfy the Panel (*Document Technologies, Inc v International Elec Communications Inc* (WIPO Case D2000-0270) (June 6, 2000).
- 8.31 The auDRP does not attempt to define forensically what is meant by a right or legitimate interest in a Domain Name. Paragraph 4c of auDRP lists three (3) (and importantly, non-exclusive) examples of what may comprise any contended 'right or legitimate interest', namely (briefly stated):
- (i) Use, or demonstrable preparations to use, the Domain Name in connection with a bona fide offering of goods or services; or
 - (ii) The Respondent being commonly known by that Domain Name; or,
 - (iii) Making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers.
- 8.32 It is not necessary for the Panel to traverse in fullness the written material pertinent to this heading. The following observations are made on the material before the Panel, and in no priority order.
- 8.33 The Respondent asserts that its prior industry website "cpdforbuidersonline.com.au" as at October 2009 was one year prior to the commencement of business by the Complainant. If this is meant to be a reference to the 14 December 2010 Business Name registration by Confo Pty Ltd of "Building CPD", it is correct. But, it is distinctly incorrect with reference to the "Builders CPD" Business Name registration of the Complainant from 1 February 2008 which in fact, conversely, obviously precedes the

Respondent's online assertion here by one year. Nor does the Respondent's assertion, even if correct (which it is not) in any event displace the Complainant's antecedently acquired goodwill attaching to its prior domain presence.

8.34 From 23 September 2010 the Respondent refers to having started using "buildercpd.com.au" as its main URL to replace the former name of "cpdforbuidersonline.com.au" (for the two commercial reasons referred to earlier). The Panel is uncertain as to the Respondent's reliance on this further element of chronology (some of it already subsumed within discussion in the prior proceeding). However, the Panel would note that this was over two years after the Complainant's Business Name registration of "Builders CPD" in February 2008. Further, the "two reasons" asserted by the Respondent for its change to "buildercpd" (earlier name too long and for "search engine optimisation") are nugatory and are not central to any analysis under this heading.

8.35 The Panel further notes the following also in no priority order:

- The Complainant has never granted the Respondent any right or authority to use or register the Disputed Domain Name;
- There is no association or any relationship between the Complainant or Respondent;
- There is no authority, express or implied, from the Complainant to the Respondent to utilise the Disputed Domain Name; and,
- The Panel has already earlier concluded that the Disputed Domain Name is confusingly similar to the names in which the Complainant has rights and under which the Complainant has actively to date conducted its core business.

8.36 The Panel is not satisfied that the Respondent has provided any reliable material evidencing any circumstances giving rise to a right or legitimate interest in the Disputed Domain Name including those illustrated within Paragraph 4c of auDRP, or generally. Here, the Panel notes that, other than for the Disputed Domain Name registration itself by the Respondent on or around 6 December

2010, its only historic reference to any associated trading under the reference of “Building” is its incorporation, only as recently as 18 February 2011, of the company “Building CPD Australia Pty Ltd”. The Panel concludes that this is not the making of a bona fide use of a disputed domain name in the circumstances here. That the word “building” in the Disputed Domain Name may be descriptive of the Respondent’s services does not necessarily convert to a conclusion of good faith. In this regard, and generally, the Panel additionally notes:

- The Respondent has for long been sharply aware of the Complainant’s core business;
- That there is a distinct comparative similarity in the website presentations of the Complainant and that of the Disputed Domain Name; and,
- That in submitting that disregard should be had of descriptive names of “builder” and “building”, the Respondent itself acknowledges that there is “some confusion” as to the “price to be paid” for the use of “. . . similar names (which is the case here)”.

8.37 Consequently, the Panel is not led to any reliable conclusion that the Respondent has a sustainable “right or legitimate interest” in the Disputed Domain Name as illustrated (for example) within Paragraph 4c of auDRP including, and not limited, to a bona fide offering of goods or services, to the Respondent being commonly known by the Disputed Domain Name, or by any of other circumstances illustrated within Paragraph 4c.

8.38 Further, any offering of services by the Respondent is not bona fide if use of the Disputed Domain Name is likely to cause consumer confusion including, such as and by one illustration only, that it may infringe a Complainant’s trade name rights or acquired reputation (*Universal City Studios Inc v GAB Enterprises* (WIPO Case D2000-0416)). Such consumer confusion is a noted element of the Complaint here.

8.39 The Panel accordingly determines that the Complainant has made out its prima facie case that the Respondent does not have rights or legitimate interests in the Disputed Domain Name. The material before the Panel from the Respondent does not rebut that position as to have the Panel reliably concluding that there is any evidence of any relevant interest of the Respondent in the Disputed Domain Name (*Document Technologies, Inc v International Elec Communications Inc* (WIPO Case D2000-0270) (June 6, 2000).

8.40 Accordingly, the Panel finds that the Respondent has no right or legitimate interest in the Disputed Domain Name. Paragraph 4a(ii) of the auDRP Policy has been satisfied by the Complainant.

9. Has the Disputed Domain Name been registered or subsequently used in bad faith? (paragraphs 4a(iii) and 4b of auDRP Policy)

9.1 The Panel has noted and studied the full context and content of all requisite material under this heading.

9.2 Paragraph 4b of the auDRP Policy sets out circumstances of “*evidence of the registration and use of a domain name in bad faith*”. This Paragraph contains four sets of circumstances, any one of which, if established, can constitute evidence of registration in bad faith. It is important to note also that it is a non-exhaustive list of circumstances such that, for example, the Panel is not necessarily constrained from a finding of bad faith should it arise (also by example) from not only any one or other of them, but from a combination of them, or indeed, upon the basis of other reliable material before the Panel inclusive of the illustrated list. In other words, the circumstances illustrated in paragraph 4b are not an exclusive or limited listing.

9.3 The essence of each of the subparagraph illustrations in Paragraph 4b of the Policy as non-exclusive examples of evidence of bad faith are (briefly stated):

- (i) Circumstances indicating that the subject registration is primarily for the purpose of selling, renting or otherwise transferring it including for valuable consideration in excess of documented out-of-pocket costs directly related to it; or,

- (ii) A registration to prevent the owner of a name, trademark or service mark from reflecting those same names or marks in a corresponding domain name; or,
- (iii) Registration primarily to disrupt business; or,
- (iv) Use of the domain name as to intentionally attempt to attract, for commercial gain, Internet users to a website by creating a likelihood of confusion.

9.4 As indicated, these are non-exclusive illustrations. Also, as previously stated, the establishment of any one of them can be enough as to a finding of relevant bad faith. Other factors may also demonstrate bad faith.

9.5 The Panel has had earlier discussion here on the likelihood of confusion. This remains pertinent with reference, for example, to Paragraph 4b(iv) above. In the view of the Panel, this element of Complaint alone has integrity, but the Panel enters upon some further discussion as follows.

9.6 The Respondent had a sharp awareness of its competitor's position viz a viz the Complainant in particular relative to the core business of the Complainant attaching to online and face-to-face building education courses, not the least being, the conjunctive work of the Complainant with TAFE NSW.

9.7 The Respondent acknowledges that it "did not investigate competing businesses" at least as at about 23 September 2010 when it began using the domain "buildercpd" (found offending under the prior proceeding). Here, the Panel does not necessarily concur with the blanket submission of the Complainant (in its 1 May 2011 letter of response) that "a person wishing to commence business has positive obligations to assess competition and business names and existing good will to ensure the provision of the trade practices (*sic*) and other acts (*sic*) are not breached". However, proper due diligence, even at a basic level, would strongly invite the prudence of prior investigation and inquiry by a potential name registrant. Conversely, the lack of any such deliberate exercise invites inquiry

as to registrant motivation within the parameter of which falls the potential question of lack of bona fides, that is to say bad faith, in the absence of normally prudent pre-registration inquiry or research being evident.

9.8 In short, the Respondent's own submission that, at the time it registered the "buildercpd" domain it "did not investigate competing businesses including the Complainant" is, respectfully, not helpful to it here, and also appears to run counter to the determination in the prior proceeding. Ignorance or inaction (deliberate or not) does not diminish any potential offence against the rights of a Complainant. The Panel is satisfied, and it appears reasonably clear, that the Respondent cannot claim that it held no historic or longstanding realisation of the existence of the Complainant's core business, that it was fully functional and active, and that it has included (not exclusively) the conjunctive partnership with TAFE NSW.

9.9 The Panel notes that the Respondent states that it has conducted "investigations" since September 2010. The Respondent asserts that such "investigations" show that ". . . until the second half of 2010" the Complainant's "web presence" was ". . . solely to provide referral by persons inquiring about CPD services to the TAFE based face-to-face courses provided by the Complainant".

9.10 Respectfully, the reliable balance of other material before the Panel suggests that this is a misconstruction of the accurate background which includes that:

- The Complainant's CPD training to builders is not a "referral" business to TAFE or otherwise. It is training work which the Complainant provides in conjunction with TAFE NSW, both online and as to its face-to-face delivery. It is apparently not the only business or core business of the Complainant; and,
- The Complainant's marketing of its builder training courses, including under reference "Builders CPD" has been active since at least February 2008. This marketing has been for both online and face-to-face courses. Its monetary extent is exhibited by reference to an expenditure on marketing by the Complainant of over \$500,000.

9.11 Even if the Panel were to accept the Respondent's contention that until recently " . . . it did not realise" the Complainant's prior February 2008 Business Name "Builders CPD" or "investigate" competitor or competing businesses, such does not displace the balance of material before the Panel strongly suggestive of a sharp awareness residing within the Respondent as to the active business of the Complainant under its domain of "builderscpd", and of the other registered business and corporate name designations of the Complainant, at all relevant stages.

9.12 It is curious against the total background that, after the Complainant's notice of its prior complaint (auDRP_10_20) by reference to "buildercpd.com.au", the Respondent (as itself here acknowledges), by registering on or about 6 or 8 December 2010 the domain "buildingcpd.com.au" (the Disputed Domain Name here) effected resultantly a redirection of Complainant customer inquiry traffic to the Disputed Domain Name.

9.13 The Panel can only concur with that element of submissions of the Complainant that, in the face of the (ultimately successful) challenge by the Complainant in the prior proceeding to the then Respondent's "buildercpd.com.au" domain registration, the deliberative step of the Respondent to register the Disputed Domain Name here has a motivation not founded in bona fides. It appears that one immediate consequence of this measure by the Respondent has been the diversion for several months of online inquirers not to the site of the Complainant, but from the Respondent's first (offending) site to the domain name now disputed.

9.14 Some of the above observations are reinforced by reference to the complaint of comparative current website similarity again repeatedly raised by the Complainant here. The Panel has considered this element of matters closely with these additional observations and in no priority order:

- There is the commonality of a "2 colour" format between "builder" and "cpd" and "building" and "cpd" in both;

- There is the commonality of a tradesman’s picture central to each;
- There is the commonality of government or purported governmental endorsement or association to each (in the case of the Respondent having recently been requested by the NSW Department of Fair Trading to remove its logo from the claimed domain designations of the Respondent);
- The Facebook position of the Respondent’s website still appears to display a Respondent business description of “Builder CPD” notwithstanding the prior proceedings outcome; and,
- Part of the sustained and continuing Complaint of the Complainant in this context is that many of its customers continue to be confused as to the two websites.

9.15 Against that background, the Panel does not adopt the Respondent’s submissions that the complaints of the Complainant in this context are “bare assertion” or are unsustainable.

9.16 It is to be noted that using a confusingly similar domain name to attract Internet users in a way that dilutes the value of a Complainant’s name or mark or intellectual property is likely to amount to bad faith (*Universal City Studios Inc v GAB Enterprises* (WIPO Case D2000-0416)).

9.17 In the view and determination of the Panel there is no doubt as to the deliberateness of the activity of the Respondent in selecting and initiating the registration of the Disputed Domain Name, in particular, against some of the background recited, including by reference to Paragraph 4b(iv) of the Policy.

9.18 Individually and collectively, it is the view and determination of the Panel, that such Respondent behaviours contravene this bad faith heading of auDRP Policy (*Telstra Corporation v Nuclear Marshmallows* (WIPO Case D2000-0003) 18 February 2000).

- 9.19 Further, there is no material before the Panel indicative of any initiative of the Respondent towards any clear website disclaimer as to attempt to diffuse or remove any potential confusion or to identify that the Respondent is a qualified or unauthorised registrant only of the Disputed Domain Name (*AGDEST v Blogger Pty Ltd*, IAMA-3058 (2007)).
- 9.20 Further, as already stated, using a confusingly similar domain name in a way which dilutes the value of a complainant's Trade Mark, or any of its Trade Marks, is likely to amount to bad faith, including in particular by reference to Paragraph 4b(ii) to (iv) of the Policy (*Universal City Studios* as above). This, in the view of the Panel, is such a presentation.
- 9.21 To the extent of these matters, the Panel has given the closest deliberation to the requisite elements of bad faith as exhibited within paragraph 4b of the Policy. It is reiterated that the paragraph 4b circumstances in paragraphs (i) to (iv) thereof are not exclusive, are illustrative only, but that one only of any of them can connote a reliable finding of bad faith. Other circumstances, other than those illustrated at Paragraph 4b, can equally do so.
- 9.22 In the Panel's view and determination, each of these considerations, and all such matters taken together, reliably establish that the registration by the Respondent of the Disputed Domain Name has been and become evidenced by registration and continuing use in bad faith.
- 9.23 For the reasons outlined, the Panel determines that the Complainant has satisfied the requirements of Paragraph 4a(iii) of the auDRP Policy as to Disputed Domain Name registration in bad faith, and in particular, that the Respondent has offended the non-exclusive examples of evidence of bad faith described in paragraphs 4b(ii), (iii) and (iv) of the Policy earlier described, and as the Complainant here urges.

10. **DECISION**

10.1 The Panel concludes for the reasons stated:

- (a) That the Disputed Domain Name is confusingly similar to a name, trade mark, or service mark in which the Complainant has rights; and,
- (b) That the Respondent has no rights or legitimate interests in the Disputed Domain Name; and,
- (c) That the Respondent registered and used the Disputed Domain Name in bad faith; and that,
- (d) Complainant complies with auDA's Policy, *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs (2008-05)*, in respect of the Disputed Domain Name.

10.2 For the reasons outlined, the Complainant has satisfied the elements of Paragraph 4a of the auDRP Policy.

11. **RELIEF**

11.1 The Panel orders that the Disputed Domain Name "buildingcpd.com.au" be transferred to the Complainant.

11.2 The Panel notes that the Complainant is eligible to hold the Disputed Domain Name under Schedule A, Paragraph 4a(i) of the auDA Policy as the owner of a 'name, trademark or service mark' in which the Complainant has rights.

Dated this 16 day of May 2011

JOHN A. McGRUTHER
SOLE PANELLIST

Annexure "A"

Procedural History

[buildingcpd.com.au]
[auDRP_11_05]

1. The complete application was received from the Complainant by LEADR on **23/03/2011**.
2. 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 **Distribute.IT** on **25/03/2011**.
3. On the **28/03/2011** the Registrar confirmed via email that the domain name in dispute has been locked.
4. LEADR advised auDA of the complaint on **01/04/2011** via e-mail.
5. On the **01/04/2011** LEADR sent the Respondent (**Meridian Project Consulting Pty Ltd**) an email and written notification of the complaint lodged against them. The complainant was copied in on these notifications.
6. The due date for the response to the complaint was confirmed to be **21/04/2011**
7. On the **21/04/2011**, James Pope on behalf of the Respondent (**Meridian Project Consulting Pty Ltd**) submitted a response to the domain name complaint.
8. On **01/05/2011** a supplementary submission was received by the Complainant.
9. On **02/05/2011** the provider approached the Panellist. The panellist confirmed their availability, informed LEADR that they had no conflict issues with the parties and accepted the matter on **04/05/2011**.
10. The Case file and relevant correspondence was forwarded onto the Panellist on **04/05/2011**

11. The parties to the dispute were notified of the panellist's allocation on the **04/05/2011**.

12. The date on which the decision is due is **18/05/2011**