

Domain Name: plantspecs.com.au
Name of Complainant: Informa Australia Pty Ltd ACN 086 268 313
Name of Respondent: Equipment Research Group Pty Limited ABN 41 092 269 997
Provider: LEADR
Panel: John E. McDermott

1. THE PARTIES

- 1.1 The Complainant in these proceedings is Informa Australia Pty Ltd of Level 2, 120 Sussex Street, Sydney in the State of New South Wales ("**Complainant**").
- 1.2 The Respondent is Equipment Research Group Pty Limited of Level 1, 109-133 Burwood Road, Hawthorn in the State of Victoria ("**Respondent**").

2. THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 2.1 The Domain Name in dispute is 'plantspecs.com.au' ("**Domain Name**") or Disputed Domain Name.
- 2.2 The Registrar of the Domain Name is Melbourne IT Limited of Level 2, 120 King Street, Melbourne in the State of Victoria ("**the Registrar**").
- 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 have provided a procedural history as follows:
 - i. 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).
 - ii. The complete application was received from the Complainant by LEADR on 24 December 2010.
 - iii. LEADR contacted the Respondent via telephone and confirmed that the application had been received on 24 December 2010.
 - iv. On 13 January 2011, LEADR emailed to the Registrar (in 18 separate emails) a copy of the Complaint.
 - v. On 17 January 2011, LEADR emailed to the Respondent a notification of the subject Complaint, once again forwarding over 18 emails.
 - vi. On 17 January 2011, LEADR advised auDA of the Complaint via email.
 - vii. On 15 February 2011, the Provider approached the Panellist. The Panellist confirmed his availability, informed LEADR that he had no conflict issues with the parties and accepted the matter on 17 February 2011.

- viii. The response was due on 6 February 2011 and was emailed to the Provider on 4 February 2011.
- ix. The Complainant made and emailed to the Provider further submissions on 11 February 2011.
- x. The Respondent made and emailed to the Provider on 15 February 2011 further submissions in reply.
- xi. Initially it was intended that all material relating to the Complaint would be received by the Panellist on 16 February 2011 and that a decision by the Panellist would be completed by 2 March 2011. Owing to the bulk of the material available and the fact that "Annexure J" was made up of multi-coloured front pages, the documents were ultimately delivered by hand rather than by email. All relevant materials came to hand by 21 February 2011. The period within which the Panellist undertook to provide a decision was accordingly extended until 7 March 2011.

4. FACTUAL BACKGROUND

4.1 Facts Alleged by Complainant in its Two Submissions

The Complainant is Informa Australia Pty Ltd ACN 086 268 313 of Level 2, 120 Sussex Street, Sydney, New South Wales ("Complainant"). The Complainant's principal place of business is in Australia.

The Respondent is Equipment Research Group Pty Limited ABN 41 092 269 997 of Level 1, 109-133 Burwood Road, Hawthorn, Victoria ("Respondent").

The Complainant states, amongst other things, that;

- It is Australia's largest conference organiser and a trade publisher which publishes the *Earthmover* and *Civil Contractor* (the "**Earthmover**") with a 2010 print run of over 4,000 copies in book format.
- It publishes an annual reference manual for the civil construction industry entitled *Plant Specs*. It is a resource that details the specifications for all earthmoving, construction and mass excavation equipment available in Australia, targeted to all of the stakeholders in the Australian earthmoving industry.
- By virtue of the unparalleled industry knowledge it has acquired over 25 years of publishing the *Plant Specs* title, the Complainant has secured and continues to develop a valuable reputation in Australia in the PLANT SPECS (trade mark) when used in connection with publishing specialist information to the Australian civil construction industry.
- The Respondent has conducted the business of market research and sale of its results to the industrial sector for almost 30 years, in a variety of formats. It has never to the Complainant's knowledge published the information contained in *Plant Specs* in any format in the past.
- The Respondent is well aware of the *Plant Specs* manual, in respect of which the parties had a commercial relationship for several years until 2010.
- The Respondent is a wholly owned subsidiary of Carsales.com Limited (Carsales.com) which company (through its business Datamotive Business Intelligence) intends to launch an online directory of earthmoving, construction and mass excavation equipment available in Australia in January 2011.

- The Disputed Domain Name is being used to redirect searches for the *Plant Specs* manual to the Carsales.com website on which the proposed publication is being promoted.
- The Respondent does not have any rights in the Disputed Domain Name. The Complainant believes that the Disputed Domain Name was registered, and is being used, in bad faith, and seeks the transfer to it of the Disputed Domain Name in accordance with clause 6.1(b) of the Policy.
- The Complainant uses the PLANT SPECS trade mark in a very specific and niche market. It does not target consumers in general.

The Complainant also states that;

- The Respondent is the registrant of the Disputed Domain Name. It provides market research to the industrial sector worldwide.
- The registrant of the Respondent's website is Carsales.com Limited ACN 074 444 018 (Carsales.com), a listed public company.
- The Respondent is a wholly owned subsidiary of, and controlled by, Carsales.com. The directors of both companies are the same. Carsales.com is Australia's largest online automotive, motorcycle and marine classifieds business.
- The Respondent and Complainant are well known to each other. From about 2004 to about 2010 the Complainant was a licensee of certain intellectual property contained in equipment codes from the Respondent, which the Complainant used in connection with its *Plant Specs* manual.

4.3 In replying to the Complainant the Respondent puts little of a factual nature in issue. The Respondent does not contest the Complainant's circulation figure of 4,000 as set out in paragraph 5.7 of the Complainant's submissions (indeed accepts, possibly in error, a higher figure of 4,200 copies in its own submissions).

The Respondent also accepts the Complainant's assertion that the parties are well known to each other and had been in a commercial relationship from about 2004 to about 2010.

Unless there is a question of fact which is contested and relevant to my decision the focus will tend to be on issues of interpretation or law flowing from the submissions put before me.

4.4 Facts Alleged by the Respondent in its Two Submissions

The Respondent registered the Disputed Domain Name as part of a wider business strategy, which it continues to develop and work towards implementing along with its related businesses.

The Respondent also states that;

- At the time of registering the Disputed Domain Name, the Respondent also registered a number of other domain names, including;
 - Bikespecs.com.au;
 - Boatspecs.com.au;
 - Caravanspecs.com.au;
 - Carspecs.com.au;

- Earthmoverspecs.com.au;
 - Farmspecs.com.au;
 - Plantspecs.com.au;
 - Truckspecs.com.au.
- The Respondent recognised that there was an opportunity in the market for a range of online and 'real time' specification products (for cars, bikes, boats, caravans, plant equipment etc, etc). These products were not, to the Respondent's knowledge, being offered by anyone at that time.
 - The Disputed Domain Name was selected as part of this wider strategy, without consideration of the Complainant or its business activities. It was never the intention of the Respondent to mislead consumers.
 - The Respondent did not think it necessary to register a business name or trade mark for any of these domain names as the reason for the choice of the domain names were they were basic and descriptive of the products to be offered.
 - The Respondent was acquired by carsales.com Limited (Carsales) in October 2005. The range of 'specs' domain names held by the Respondent was aligned with Carsales' business strategy – to develop a family of websites in a market.
 - In September 2007, Carsales acquired another business, Automotive Data Services Pty Ltd (trading as RedBook) to expand its data offering which has since become a focus of the Carsales' business.
 - The "specs" domain names are part of the Carsales Network's future strategy bringing together the expertise of a range of its businesses, including the Respondent and RedBook, which has been in the automotive data business for over 60 years. There has been some delay in executing this strategy since the domain names were first registered, but it remains a focus within the Carsales 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)(ii)**); and
- (iii) The Respondent registered or subsequently used the Domain Name in bad faith (**paragraph 4(a)(iii)**).

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

5.2 Paragraph 4(a)(i)

The Panel 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.

The Complainant has not asserted rights with respect to a "relevant name" as described in the said footnote. Nor, despite the reference in the Complaint to "trade and service mark", does it pursue an argument asserting rights in respect to a service mark.

The Complainant's submissions make it clear that its focus is upon claiming rights with respect to PLANT SPECS as a trade mark, although frequently the single word "mark" is used.

The phrase "trade mark" is usefully defined in the Trade Marks Act as;

...a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.

The word "sign" is usefully defined in the same Act as;

...includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.

Nowhere does the Complainant allege the existence of a registered trade mark and the evidence before me is that there is none. In the circumstances the Complainant's submissions rest on it having acquired a common law trade mark and such rights as might flow therefrom.

As is pointed out in the recent (6 January 2011) decision *Yaffa Publishing Group Pty Ltd v Australian Panorama Photography auDRP19/10 ("Yaffa")*, there is a useful commentary on the relationship between a common law trademark and a "secondary meaning" in two long standing decisions, one being *Universal City Studios Inc. v Burns* (WIPO D2001-0784) ("**Universal**") where it is stated that;

*...names are protectable as trademarks or service marks upon a showing that the name has become distinctive through the acquisition or secondary meaning. See *Adray v. Adray-Aart, Inc.*, 68 F.3d 362 (9th Cir. 1995), amended on other grounds, 76 F. 3d 984 (9th Cir. 1996) (personal names are capable of becoming strong trademarks upon a showing of secondary meaning). See also, *McCarthy on Trademarks and Unfair Competition* '13:2 (4th ed. 2000). Secondary meaning is the consumers' association of the mark with a particular source or sponsor and is established out of long association of the name with the business, whereby the name and the business have become synonymous in the mind of the public, submerging the primary meaning of the name in favour of its meaning as a word identifying that business.*

The other decision referred to is *Australian Trade Commission v Matthew Reader* (WIPO D2002-0786) ("**Austrade**") where it is stated that;

*...Complainant must show that the name 'Austrade' has achieved secondary meaning or association with Complainant. *Universal City Studios Inc. v Burns*, Case No. D2011-0784 (WIPO October 1, 2000). It is undisputed that Complainant has been identifying itself and its services with the 'Austrade' mark since 1986. Also undisputed are Complainant's claims that, in recent fiscal years, it has invested over 10 million Australian dollars to raise awareness of its services, and raised as much in annual revenue for services provided, all in conjunction with its use of the 'Austrade' identifier.*

Additionally, the name has appeared in brochures and other written materials published by Complainant for a wide audience. Complainant also demonstrates awareness of its name and services both within and outside of Australia.

Both these cases are helpful decisions in this context because;

- They emphasise the need not only for a Complainant to assert awareness of its name but to demonstrate it. Austrade in fact is based upon "undisputed evidence provided by the Complainant".
- Both demonstrate the relevance of the use of a generic term. The difficulties of obtaining a common law trade mark are not as great as the Respondent's submissions assert.
- Both give numerous examples of the attempts to proselytize a "secondary meaning" which will be taken into account. Universal places considerable stress on evidence as to "a consumer linking of the mark to the source" and "unsolicited media coverage".

5.3 The Respondent says, amongst other things, that;

- (i) "Plant specs" is a generic or descriptive, rather than distinctive term. It is comprised of two common words and, in the industry relevant to this matter, is used to import those words' everyday meaning to describe information that is being provided – that is, specifications of plant equipment and machinery.
- (ii) By the Complainant's own admission in paragraph 5.11 of the Complaint, it selected the term "plant specs" to use in association with its Earthmover & Civil Contractor brand to allude to the plan specification schedules it produced. The term "plant specs" is merely a common abbreviation of the term "plant specifications". Rather than being intended to indicate the source of any goods or service as a trade mark or any other proprietary name, the term "plant specs" merely describes those goods or services.
- (iii) For this reason, the Respondent contends that no entity should be able to claim exclusive rights to the term in the industry, as this would significantly inhibit others from legitimately describing their goods or services. Accordingly, the term is not capable of being a proprietary name.

If the Respondent's submission at (iii) is correct then the phrase "plant specs" would not be capable of acquiring the status of a common law trademark in the circumstances of this matter or in any circumstance.

5.4 Both parties make submissions about the "genericness" of plant specs.

The fact that a generic term is used may be relevant but does not make a fundamental difference as is suggested in two decisions being;

- *Yaffa Publishing Group Pty Ltd v CA, PD and RD Scott trading as GO BOATING PUBLICATIONS* auDRP01/08 ("**Yaffa v Go Boating**") in which it was stated that;

auDRP and UDRP Panels have regularly upheld that respondents have a legitimate interest in a domain name, where generic or descriptive domain names have been used by the Respondent for offering goods or services.

- *Jupitermedia Corporation and Australia.Internet.com Pty Ltd v Spotpress Pty Ltd trading as Internet Printing* Case No. DAU2003-0005 in which it was stated that;

We accept the evidence of the Respondent, and conclude that it clearly has a legitimate interest in the name. Our analysis on this ground is influenced by the genericness of the domain name and the marl. In the case of a term as generic as

"internet" we consider that a Complainant must make a strong showing of the absence of legitimate interest if it is to succeed. This the Complainants have utterly failed to do. The Respondent has provided adequate evidence that it is using and will use the domain name in conjunction with its business.

In this case the Complainant's contentions are not assisted by the fact, of which I can take notice as a member of a specialist tribunal, that a reasonably similar phrase "plans and specs" is in wide use in the building industry and at the Local Government level, generally to describe architectural plans and the written specifications which accompany them.

- 5.5 The generic nature of a phrase is one only of the matters to be taken into account.
- 5.6 The Respondent's submissions which are of course a reply to the Complainant's submissions, include one to this effect;

The Plant Specs reference manual was first published in 1985 and has been published in around February each year since. Annexure J comprises copies of the front covers of each published issue between 1985 and 2010. Hard copies are available upon request.

As the publication's covers attest, the Complainant has used the PLANT SPECS trade mark consistently throughout the manual's history. Its use of the PLANT SPECS trade mark on the publication to indicate its source is evident from the covers of past and present editions; the trade mark is printed in thick block letters and stands apart from the other words on the cover. The juxtaposition of the other words on the cover further highlights the identification of PLANT SPECS as the Complainant's trade mark.

I have some concerns about this submission. They include;

- a) The suggestion that the publication, nowhere described in "Annexure J" to the Complainant's submissions as a manual, is somehow separate to the basic publication of the registered publication "The Earthmover and Civil Contractor" ("the Earthmover").
- b) To the extent that the source of the publication is indicated on the cover the Complainant's argument would appear to be at its highest in 1990 and 1991 but this would not assist the Complainant in arguing for the trade mark which it asserts.
- c) It is not true to say that on all occasions "the trade mark is printed in thick block letters and stands apart from the other words on the cover". It is not clear what the phrase "the juxtaposition of other words on the cover" means.

I have already pointed out that there is little consistency amongst the materials which constitute Annexure J. This is because;

- a) In 1985 the endorsement on the cover of the Earthmover was "SPECIAL PLANT SPECS BOOK ISSUE". The whole phrase appears in the same type style and colour with no attempt to emphasise the words "plant specs" within it. The cover clearly refers to the publication "The Earthmover and Civil Contractor".

In Informa Australia Pty Limited v Reed Business Information Pty Limited auDA02/09 the Complainant was successful and established to the satisfaction of the Panel that "Earthmover" was a trade and service mark. In that instance it was clear that the name of the publication highlighted the phrase "the Earthmover", as it does (mostly but not always) throughout Annexure J, and that its use was brought to the attention of subscribers frequently.

It appears that the Panel on that occasion was persuaded that the Earthmover had a "print run of the order of or exceeding Australian distribution of 6,500 units". The

discrepancy with the evidence in this matter appears odd but I attach no significance to it.

Distribution, once again, is one only of the matters to be taken into account. In *Yaffa v Go Boating* the Panel regarded a distribution number of "4,000 copies (up from 3,127)" as sufficient in those circumstances.

- b) The same comments, as applied to the 1985 issue, apply to the 1986 issue.
- c) In 1987 the relevant phrase, presented in a similar cohesive fashion, in "1987 PLANT SPECS". Here, as with each front sheet in Annexure J, there is an advertisement of machinery, referred to by brand name, on the front page. Taken singly each reference to plant specs, in their various forms, presents as a separate advertisement intended to tempt potential buyers.
- d) In 1988 "Plant Specs" has its own separate type style but is described as the 1988 version and as a "Guide" rather than a "Manual".
- e) Nowhere does the Complainant explain why its submissions as regards paragraph 4(a)(i) adopt the use of the word "manual" which does not appear on the outside cover of any of the copies of the Earthmover at "Annexure J" or why read alone its submissions, at 5.2 for example, suggest that the "Manual" is a stand alone annual publication rather than something that appeared annually in the Earthmover which was published monthly.

It is difficult not to gain the impression that the Complainant takes the view that its position would be stronger if the former was the case. I must however deal with the matter by examining all of the facts and submissions before me.

- f) The February 1989 version of the Earthmover had no reference to "plant specs" either alone or in combination with other material endorsed on it.
- g) In February 1990 the wording on the outside of the magazine was "Earthmover Plant Specs 1990" with "Earthmover" dominating the phrase by virtue of its being in larger type and a lighter colour.

This form of presentation might, in appropriate circumstances, strengthen an argument for a secondary meaning for "Earthmover Plant Specs" (although not for "Earthmover Plant Specs 1990") but does not assist the Complainant in this context.

- h) The position was similar in 1991 but the entire phrase was printed in one colour. At this stage there had been no consistency in presentation. The phrase "plant specs" had not been presented in a manner which suggests the Complainant was attempting to create an identifiable sign.

To this extent it differs from the Earthmover masthead, which is accompanied by a logo, on each copy of the Earthmover in evidence before me.

- i) There is a further departure in 1992 when the wording on the cover is "1992 Plant Specifications" with the year dominating.
- j) In 1993 the Complainant adopted, for the first time, a somewhat stylised printing of "Plant Specs" followed by the phrase "Annual 1993" in a different type style.
- k) A similar approach was adopted between 1994 and 2005 although there are some differences in the stylised form of printing. The word "annual" and the relevant year are incorporated after a fashion.
- l) In 2006 the Complainant reverted to a more normal type style using the phrase "Plant Specs 2006" with the year in a different colour.

- m) In 2007, 2008, 2009 and 2010 a plain type style was still adopted with the year in the same colour and the same size print and presenting (the word "annual" having been dropped) as part of a single phrase such as "Plant Specs 2010".

The position is reasonably similar with regard to Annexures K and M. The Complainant refers to advertisements in Google "Add words", display stands at major earthmoving equipment contracting shows, and with respect to third party retailers (advertisements presumably) such as i.Subscribe.com.au. No examples are given and therefore there is no evidence before me.

- 5.7 I have dealt with the matters at paragraph 5.6 at some length because of the emphasis that the Complainant has placed on the wording quoted at the head of that paragraph.
- 5.8 The Complainant could have placed whole copies of its magazine in evidence but has chosen not to do so. It may be that reading the entire magazine would somehow assist the Complainant but in the circumstances it would appear that the principle in *Jones v Dunkel* (1959) 101 CLR 298 applies. This principle is to the effect that if a party to litigation has the opportunity to produce certain evidence and declines to do so then such evidence as is available (but not produced) would not assist that party.

Seeing the full magazine may have assisted one of the parties as a result of a consistent use of the phrase "plant specs" in some proprietary fashion, alternatively in a totally generic sense. I simply do not have any assistance which might have been derived from reading the magazine as a whole.

The deficiencies in this approach were, I note, commented upon in **Yaffa** where the Panel also took the view that the Complainant's evidence was insufficient.

It is not for a Panel in these matters which are to be resolved as inexpensively and as expeditiously as possible to, apart from the need for strict impartiality, call for the production of further evidence from either party in ordinary circumstances.

- 5.9 It does not appear to me that the editions of Earthmover at "Annexure J" are consistent as alleged. The description of the publication, whether it is within the publication, as a Manual, does not appear to be correct.

The position as regards arguing that the words on the cover of the Earthmover indicate the source of the specifications available is probably strongest in 1985 and 1986 because of the use of the word "issue" which suggests a strong association with the Earthmover and therefore the source of the publication.

The phrase used in the definition of a "trade mark" is "a sign". It is not "various forms of a similar sign".

- 5.10 I have noted the Complainant's submission that it has "invested significant resources to ensure that its readership is accurately targeted and promoted". It has produced little evidence of this. More importantly the Complainant has not indicated whether it refers to the readership of the Earthmover published monthly or the annual February edition dealing with specifications. The former would not appear to assist the Complainant. There is no clear evidence of the latter.
- 5.11 The Respondent's further submissions appear to tacitly accept that the phrase "plant specs" is a trade mark but suggests because it is generic there is a "greater burden on the Complainant to demonstrate that the mark has acquired distinctiveness when associated with the Complainant's goods or services". In this regard the Respondent relies on an American decision in *Business Architecture Group, Inc v Reflex Publishing* (NF Case No. 97051) ("Business Architecture"). I do not, apart from my previous references to the decisions in *Universal*, *Austrade* and *Yaffa v Go Boating*, see that that decision is authority for the proposition put.
- 5.12 The Respondent does however say that the trade mark has not acquired a sufficient degree of "distinctiveness" for the Complainant to have rights, which could be violated, in it.

This argument can clearly be formulated as a result of matters raised in paragraph 5.6 above.

The degree of conformity when stylised versions were used between 1993 and 1995 does assist the Complainant somewhat. As against that other covers, such as those used in 1985 and 1986, as well as those in 1990, 1991, 1992 and in recent years suggest that the phrase is in fact used in a generic sense which would be understood by magazine subscribers as a generic use rather than as a trade mark with the necessary degree of distinctiveness.

- 5.13 Clearly the Domain Name is confusingly similar to what the Claimant says is its trade mark. The issue is whether the Claimant in fact has a common law trade mark. The Complainant's submissions state, at 5.11 that;

The PLANT SPECS trade mark has been used to identify the Complainant's reference manual in the Australian market since 1985. The mark was carefully selected out of plant specification schedules produced pre-1985 within the Earthmover magazine to inform consumers about the source of goods and services. Whilst comprising 2 commonly used terms in the construction industry, their use in combination was novel.

This submission is not persuasive.

The evidence before me does not support the contention that "the mark was carefully selected out of plant specification schedules produced pre-1985 within the Earthmover magazine to inform consumers about the source of goods and services".

The advertisements which appear on the 1985 and 1986 versions of Earthmover suggest that circulation is being sought by advertising this issue. The phrase "special plant specs book issue" and the phrase "plant specs book issue for 1986", are not suggestive of the Complainant's contention. Neither could be described as a "sign".

- 5.14 As regards other matters;

- The Complainant relies on the fact that the Respondent has not sought to register "plant specs" as a trade mark. Neither has the Complainant.

This is very much a double-edged sword having regard to the submission at 5.11.

- I do not see how the Claimant's contentions as regards what a reasonable person might do, assist it in this context.
- Whilst the Complainant refers to "universal recognition" (which description the Respondent resists) I have no evidence of this. This does not concern me. Numerous cases, such as Austrade, have established that this is not necessary.
- More relevantly, as previously indicated, there is no evidence before me of "very significant good will in the brand name and trade mark due to its long term, nationwide, industry-targeted use". If the Complainant's activities have generated such goodwill then it is up to the Complainant, again the word onus is relevant, to demonstrate this.

In this Application the Complainant frequently makes assertions which it does not seek to demonstrate the accuracy of. One such is the use of the word "redirect" when the Complainant asserts the aim of the Respondent is to "redirect" the Complainant's potential customers to the Respondent.

It is clear that the Complainant has followed the steps referred to at 5.22 of its initial submissions. It appears likely that this was the result of the Complainant's own application for registration being refused.

There is no evidence before me of a potential customer for the Complainant being "redirected" to the Respondent.

It is clear to me that it would have been open to the Complainant to produce evidence, perhaps by a Statutory Declaration, of people involved in the industry who could give independent evidence in support of the Complainant. This has not occurred.

- It is unclear to me what the use of the word "brand" means in its context.
- To the extent that the Complainant reveals that it "only became aware of the Disputed Domain Name" in late August 2010 (5.19), this also appears to be at variance with the submissions at paragraph 5.11.

5.15 The weight of the evidence before me is to the effect that the Complainant did not set out to create a common law trade mark as regards "plant specs". The various forms of advertisement on the Earthmover from year to year do not suggest this.

There is some evidence of expenditure of the type that assisted the successful parties in Universal and Austrade but there is no evidence that any such expenditure resulted in the creation of a secondary meaning or;

That the name and the business have become synonymous in the mind of the public, submerging the primary meaning of the name in favour of its meaning as a word identifying that business.

A different Panel arrived at the opposite decision as regards "Earthmover" having a secondary meaning but the materials before me in this matter indicate that the word "Earthmover" dominated the phrase "The Earthmover and Civil Contractor" with some consistency on a frequent basis. It is also clear that the Panel was persuaded that in Case auDA02/09 the Complainant had carried the onus.

In this matter I am not so persuaded, although an opposite result would not assist the Complainant having regard to my conclusions as regards paragraphs 4(a)(ii) and 4(a)(iii).

6. Paragraph 4(a)(ii)

- 6.1 The Complainant asserts that the Respondent has no rights or legitimate interests in the Domain Name, this being the second of three elements which the Complainant must make out.
- 6.2 The Complainant must prove, as indicated, that the Respondent has "no rights or legitimate interests" in respect of the Disputed Domain Name. The Complainant's submissions (5.10 to 5.20 inclusive) focus more upon what the Claimant suggests are its rights rather than the subject matter of this paragraph.
- 6.3 The Respondent refers to the registration of the domain name in 2004 but that registration is what is in issue here, rather than something that can be relied upon.
- 6.4 Separately, the Respondent states those facts which are set out at 4.2 to 4.8 that demonstrate a longstanding business strategy which, despite considerable delay, appears to be on the point of meaningful implementation as the Complainant itself asserts at paragraph 3.7.
- 6.5 The Respondent's submissions at 4.2 onwards are consistent with a businesslike, if slow to be implemented, strategy. The amount which the Respondent has expended on this strategy is not clear but implementation is apparently nigh. It is relevant that the registration was effected in January 2004, at which time the Complainant asserts that it was building the secondary meaning for its trademark.
- 6.6 If the Complainant had made this application in early 2004, when the Respondent had not developed its strategy or expended money on it, then its argument as regards this sub-paragraph, as opposed to the trade mark issue, might have been stronger.

Whilst the wording of paragraph 4 is clear it was also recognised in *Lonely Planet Publications Pty Ltd v Mike Tyler* (WIPO Case No. D2004-0670) that even when the Panel finds that a domain was clearly registered and/or used in bad faith, the domain will not be transferred if the Complainant cannot prove its claim under paragraph 4(a)(ii) of the Policy.

The same applies to paragraph 4(a)(i) of the Policy where, as here, I am not satisfied that the Respondent has "no rights or legitimate interests".

7 Paragraph 4(a)(iii)

7.1 The third element which the Complainant has to prove is that the Respondent "registered or subsequently used the domain name in bad faith".

Paragraph 4(b) of Schedule A of the auDRP sets out a non-exhaustive list of circumstances which can be taken as "evidence of the registration or use of a domain name in bad faith". The grounds under paragraph 4(b) include:

- (i) circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of the Respondent documented out-of-pocket costs directly related to the domain names; or
- (ii) the Respondent has registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or
- (iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
- (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to a website 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 website or location or of a product or service on that website or location.

Although specific circumstances constituting bad faith are expressly identified as above, bad faith is not exhaustively defined in the auDRP: *ADHD (Aust) Inc v ADDults with ADHD (NSW) Inc* (LEADR auDA 05/07).

It is open to the Complainant to persuade me of bad faith on other grounds.

7.2 As regards these four non-exclusive grounds;

- (i) There is no evidence of this.
- (ii) The onus on the Complainant has not been satisfied on this ground.
- (iii) Again the onus has not been satisfied and the suite of registrations referred to at paragraph 4.2 of the Respondent's initial submissions suggests otherwise.
- (iv) The phrase "by using the domain name" relates not only to the initial registration but subsequent use.

The important phrase however is;

creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location.

The Complainant describes certain mechanics at paragraph 5.22 of its original submissions but that paragraph does not suggest a type of confusion, if any at all, of which I am required to be persuaded.

Certainly the various steps referred to suggest an attempt will be made to persuade internet users to use the Respondent's services. There appears to be nothing however in the page headed "Datamotive" and "WebLookUp Construction" which would lead an internet user to believe that this is the Complainant's website.

Whether (Respondent's submissions at 5.5) an internet user would be persuaded that the website belongs to the Complainant (as opposed to just being persuaded that it is owned by somebody other than the Complainant) is open to question but there is no evidence before me to suggest the type of necessary confusion, even if I accepted that "plant specs" is a common law trade mark, contrary to the view I have formed.

- 7.3 The Complainant asserts, correctly, that there is no disclaimer on the Respondent's website to dispel any confusion which might (this not having been proved to me) occur in the mind of a person who visits the website. I am referred to the decision in *AGDEST v Blogger Pty. Ltd*, IAMA-3058 (2007) where this issue was canvassed, as it has been in a number of more recent auDRP decisions.

Whilst the suggestion that a disclaimer might assist in some cases is interesting;

- There is no reason why an innocent party should need to have one.
- I am not sure what form a disclaimer could take without mentioning the other entity involved in the confusion and becoming counter-productive for the owner of the website.
- If bad faith is established a disclaimer would not appear to alter the position and could lead to difficult situations if a Respondent had a disclaimer upon which it relied to defeat a Complainant who had otherwise carried the onus as regards paragraphs 4(a)(i) and 4(a)(ii).

- 7.4 The Complainant does rely on the Respondent's knowledge of its business as being an indicator of bad faith in the circumstances of this matter. The Complainant says that bad faith is thoroughly demonstrated by the email of 16 July 2004 which accompanies the Complainant's supplementary submissions.

- 7.5 That email of course post-dates the registration of the domain name by approximately seven months. Interestingly the letter, from the Respondent, makes specific reference to a "Trade Mark Licence Agreement" on three separate occasions. It would be injudicious, had the Respondent acted improperly, to have repeated this phrase in the context of references to the "2004 Plant Specs Edition" of the *Earthmover and Civil Contractor* magazine thereby alerting the Complainant that it should protect its rights as regards any trade mark or domain name registration or challenge.

- 7.6 I prefer the Respondent's explanation as to significance of this email over that of the Complainant's.

- 7.7 Remembering always that the onus is on the Complainant I am not satisfied that the Respondent has acted in good faith by reference to this letter, any one of the four criteria in paragraph (b) as referred to, or on any other basis.

- 7.8 I find that the Complainant has not satisfied the requirements of paragraph 4(a)(iii) of the auDRP.

8. DECISION

I find that the Complainant has not made out the elements of paragraph 4(a)(i), of 4(a)(ii) or 4(a)(iii) of the auDRP. Accordingly the Complaint is dismissed.

A handwritten signature in black ink, appearing to read 'John Emmet McDermott', with a large, stylized flourish extending to the right.

John Emmet McDermott

Sole Panellist

3 March 2011