



## ADMINISTRATIVE PANEL DECISION

**David Harry Birch and Judith Alison Birch trading as *Aussie Soap Supplies***  
**v.**  
**Yvonne Tracey Cowell trading as *Aussie Soap Supply***

**LEADR-auDRP 10\_22**  
**<aussiesoapsupply.com.au>**

### 1 The Parties

The Complainants are **David Harry Birch** and **Judith Alison Birch** trading as *Aussie Soap Supplies* from Palmyra in Western Australia. They were represented in the proceedings by Glen Paoletto from Trademark Central in Brisbane, Queensland.

The Respondent is **Yvonne Tracey Cowell** trading as *Aussie Soap Supply* from Bellemere in Queensland. She was represented in the proceedings by Matthew Rouse from Rouse Lawyers in Brisbane, Queensland.

### 2 The Disputed Domain Name and Registrar

The Disputed Domain Name is <aussiesoapsupply.com.au>. The registrar of the Disputed Domain Name is Netregistry Pty Ltd.

### 3 Procedural History

This is an administrative proceeding pursuant to the .au Dispute Resolution Policy originally adopted by auDA on 13 August 2001, and subsequently amended on 1 March 2008 (“auDRP”); the auDA Rules for .au Dispute Resolution Policy (“Rules”) and the LEADR Supplemental Rules to Rules for .au Domain Name Dispute Resolution Policy (“LEADR Supplemental Rules”).

A LEADR Domain Name Dispute Complaint Form was filed with LEADR on 9 December 2010. On 23 December 2010 LEADR forwarded a copy of the Complaint to the Registrar and received confirmation of the registration particulars the following day. A copy of the Complaint was posted and emailed to the Respondent on 5 January 2011 and advised to auDA on the same day.

Under Rule 5(a) a Response was due 20 calendar days after the proceeding commenced. Under Rule 4(c) the proceeding is taken to have commenced on the date on which LEADR completed its responsibilities under Rule 2(a) in forwarding the Complaint to the Respondent. Under Rule 2(g) times are calculated from the date a communication was first made under Rule 2(f). Accordingly, the due date for a Response was 25 January 2011.

On 21 January 2011 Mr Rouse sought an extension of time within which to file a Response. LEADR granted an extension of time until 2 February 2011.

On 2 February 2011 Mr Rouse sent an email concurrently to the Complainants' lawyer and to LEADR. That email, marked 'Without Prejudice', contained certain propositions directed at the Complainant's lawyer and ended with the following two sentences:

"We therefore request that your client discontinue the administrative proceedings. We otherwise request a further extension to the due date for our client's response to allow the parties to finalise their without prejudice negotiations."

During the ensuing 24 hours LEADR was openly copied on two 'Without Prejudice' emails exchanged between the parties' legal representatives. LEADR therefore granted a further extension of time until 9 February 2011 for a Response to be filed "due to the negotiations taking place". However, on 3 February 2011 shortly after 4pm Mr Paoletto replied to LEADR's extension of time advice in the following terms (which were copied to Mr Rouse):

Our clients are of the opinion that there are no negotiations currently in progress, and that any discussions have been counter-productive to date. This being the case, we ask that a panelist be appointed to adjudicate the matter as soon as possible.

To that Mr Rouse responded, again openly copying LEADR, and concluded with these words:

Our client adopts your extension of a further week to file its response. Perhaps the parties can in this time avoid the need for this to go before a panellist.

Having considered the exchanges on which it had been copied, LEADR then advised the parties:

... it is in the best interest of LEADR as the Provider in this matter to continue the administration proceeding and allocate a panelist. The allocation of the panelist will be done tomorrow and both parties will be notified of who the panelist is. It is then at the discretion of the panelist whether not an extension of time is provided to provide a response.

On 7 February 2011 the parties were notified of the Panel's appointment. No further submission or communication of any kind has been received from either party. Given the terms of LEADR's last communication to the parties and the twice-extended time allowed by LEADR within which a Response could have been prepared and filed, the Panel declines to extend for a third time the period within which a Response may be filed, and proposes to proceed to render a decision. In any event, no Response had been filed by midnight on 20 February 2011.

All other procedural requirements in relation to the proceedings appear to have been satisfied.

#### **4 Factual Background**

The following salient background facts are taken from the Complaint and remain uncontested:

The Complainants own and operate in partnership the business known as *Aussie Soap Supplies*, and they have been doing so continuously and extensively by mail order, telephone and online since early 2003.

The Complainants' business focuses on soap making supplies and recipes, and is considered to be the first company in Australia to promote such goods and services online. On 20 February 2003 the Complainants registered the domain name [www.aussiesoapsupplies.com.au](http://www.aussiesoapsupplies.com.au) and the website to which that domain name resolves is the Complainants' main business website.

The Complainants registered the business names AUSSIESOAPSUPPLIES on 10 February 2003, and AUSSIE SOAP SUPPLIES on 1 July 2005. They are also the registered proprietors of two Australian word marks and two device marks in Class 3, all of which comprise or include the words AUSSIE SOAP SUPPLIES.

## 5 Parties' Contentions

### Complainant

The Complainants make the following principal contentions:

#### **A. The Disputed Domain Name is confusingly similar to a name, trademark or service mark in which the Complainant has rights.**

- The Complainants submit that the Disputed Domain Name is confusingly similar to their registered business name, *AussieSoapSupplies*, since it is identical save for the singular form of "supply" instead of "supplies". It is also confusingly similar to their registered trademarks for the same reason;
- There is considerable evidence of actual confusion by members of the public between the Disputed Domain Name and the Complainants' business name and trademarks;
- There is also evidence of deliberate deception on the part of the Respondent in seeking to attract to her website consumers looking for the online manifestation of the Complainants' business.

#### **B. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.**

The Disputed Domain Name was registered to the Respondent on 14 June 2009, two months after the Respondent had begun to order goods from the Complainants. The Respondent's business, which had formerly been known as "*Joey's Soap Shop*" on eBay, was then renamed *Aussie Soap Supply*, and became the subject of a website presence in the form of a target to which the Disputed Domain Name resolved, in addition to retaining the eBay shop under the new name.

The Complainants have not authorised the Respondent to use their business names or trademarks and submit that the Respondent is also engaged in typosquatting.

### **C. The Disputed Domain was registered or is being used in bad faith.**

- The chronology demonstrates the Respondent's orders from the Complainants beginning in April 2009 followed two months later by her registration of "*Aussie Soap Supply – QLD*" as a business name, her establishment of a website using the Disputed Domain Name, and the renaming of her eBay shop from *Joey's Soap Shop* to *Aussie Soap Supply*.
- The Respondent's website adopted the look and feel of the Complainants' website, included whole blocks of text copied from the Complainants' website, and made available for download copies of the literature that the Respondent had obtained from the Complainants' website but edited by replacing references to the Complainants' *Aussie Soap Supplies* business name with references to *Aussie Soap Supply*.
- The Respondent has continuously used the Complainants' website as a source of information, graphics, systems, presence, look and feel, and nomenclature. It also includes the Respondent's approach to advertising, both as seen with her AdWord bidding on the search term "aussie soap supplies", as well as blatant attempts to attract the Complainants' customers by flagrantly deceptive practices.
- The Respondent has also retained moneys inadvertently paid to her by customers of the Complainants (the Respondent having her bank account details on her website whereas the Complainants do not).
- The Respondent has a long history of plagiarism, deceit and bad faith *vis a vis* the Complainants' business

### **Respondent's Response**

As noted above, no Response had been filed by midnight on 20 February 2011. However, the Panel has gleaned from the email exchanges openly copied to LEADR and included in the case file that the Respondent "no longer" trades online using "[the Complainants'] trademarks" and that the Disputed Domain Name has been "redirected" to <www.simplynaturalsoapmakingsupplies.com.au>. The Panel's attempt to view the website at that location was unsuccessful, but the page available at <http://webcache.googleusercontent.com/search?q=cache:http://www.simplynaturalsoapmakingsupplies.com.au/epages/auau9075.sf> is assumed to be a snapshot of the Respondent's new site at an earlier point in time.

## **6 Discussion and Findings**

Paragraph 15(a) of the auDRP Rules requires the Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the auDRP, the Rules, and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the auDRP requires a Complainant to prove that:

- (i) the Disputed Domain is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain ; and

(iii) the Disputed Domain has been registered *or* subsequently used in bad faith.

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

### **Identical or confusingly similar to a trademark or name in which the Complainant has rights**

Unlike the UDRP, which requires a complainant to establish rights in trademarks, the auDRP offers an additional ground to a complainant that can establish rights in a name. In this case the Panel is entirely satisfied that the Complainant has common law rights in its registered business names, *AussieSoapSupplies* and *Aussie Soap Supplies*, as well as in its registered word and device trademarks, *Aussie Soap Supplies*.

The Panel is well satisfied that replacing “supplies” with “supply” is hopelessly inadequate to prevent the Disputed Domain Name from being confusingly similar to the Complainants’ registered business names and trademarks.

The Complainant has therefore made out the first limb of the auDRP.

### **Rights or Legitimate Interests in respect of the Disputed Domain Name**

Absent a Response the Panel is unable to afford the Respondent any latitude that might have existed given the Complainants’ use of the descriptive words “Aussie soap supplies” to describe its business in such goods. Despite there being strong evidence, accepted by the Trademarks Office, that those words had indeed become distinctive of the Complainants’ goods and services by the time the trademarks were granted, it would not have taken a great deal of effort for another respondent in different circumstances to persuade the Panel that there were plausibly legitimate interests in using those words in a domain name that pointed to a similar business. However, for the reasons given below, the Respondent’s reprehensible conduct has removed any shred of legitimacy that could theoretically have existed.

The second limb of the auDRP is clearly made out by the Complainants.

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

Paragraph 4(a)(iii) of the auDRP requires the Complainants to demonstrate that the Disputed Domain Name was *either* registered *or* subsequently used in bad faith.

The Panel is of the view that the Disputed Domain Name was both registered and continues to be used in bad faith by the Respondent. A finding of either of those forms of conduct would have been sufficient for the Complainants to succeed on this ground of the auDRP.

The Complainants’ evidence demonstrates quite convincingly that the Respondent has engaged in a pattern of deliberate if not malicious conduct that comprised the placing of orders for products from the Complainants over a period of some two months from April 2009, the downloading of many of the recipes and soapmaking instructional material that the Complainants make available on their website to their customers, and the adoption of a look and feel for the Respondent’s deceptively named *Aussie Soap Supply* online store that was strongly redolent of the Complainants’ *Aussie Soap Supplies* store. The evidence includes examples of consumers being misled to the point of engaging in communications with the Respondent in circumstances where it was perfectly obvious that she had been

mistaken for the Complainants, and in which a reasonable and honest person would be expected to have put the consumer in touch with the Complainants (with whose business the Respondent was very well acquainted). The Respondent in fact continued to engage with people to the point where orders intended for the Complainants were placed with the Respondent and paid for but not delivered on time or at all. When the Complainants received complaints about “their” poor service it quickly became apparent that it was the Respondent’s deceptive if not dishonest conduct that was responsible.

The flagrancy of the Respondent’s reproduction of the Complainant’s copyright works in her business is stark. Save for the replacement of “Supplies” by its singular form, the Respondent apparently simply engaged in wholesale copying of the Complainants’ website, look & feel, literature, and meta tags and appropriated that material for her own business. On the evidence there can be little doubt that the Respondent from the beginning set about attracting to her own website consumers that were loyal to the Complainants (or who by word of mouth had heard of the Complainants’ excellent service and reputation) and, having so attracted them, used dubious practices to prevent them from realising that they had been duped, often until after they had placed orders or sent money to the Respondent.

This is also a clear case where the Respondent made false representations and warranties under paragraph 2 of the Policy, which provides as follows:

By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) ...; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

The Disputed Domain Name presently is re-directed not to the Complainants’ site but to the Respondent’s new domain [www.simplynaturalsoapmakingsupplies.com.au](http://www.simplynaturalsoapmakingsupplies.com.au). Thus the Disputed Domain Name is continuing to be used to intercept Internet users looking for the Complainants’ website.

The Complainants have easily made out paragraph 4(a)(iii) of the auDRP to the Panel’s satisfaction.

## **8 Decision**

The evidence more than amply supports the grounds on which the Complainants rely. Accordingly, the Complaint must be upheld and the Panel therefore orders that <aussiesoapsupply.com.au> be transferred to the Complainants.

Dated this 21<sup>st</sup> day of February 2011

 Philip N Argy

Philip N Argy  
Sole Panellist