



## ADMINISTRATIVE PANEL DECISION

Yaffa Publishing Group Pty Ltd  
-v-  
Australian Panorama Photography

Case No. LEADR-auDRP 19/10

**Domain Name:** australianphotography.com.au  
**Complainant:** Yaffa Publishing Group Pty Ltd  
**Respondent:** Australian Panorama Photography  
**Provider:** LEADR  
**Panellist:** Sara Delpopolo

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### 1. THE PARTIES

- (a) The complainant is Yaffa Publishing Group Pty Ltd (ABN 542 002 699 354) of 17-21 Bellevue Street, Surry Hills NSW 2010 (**Complainant**).
- (b) The respondent is Australian Panorama Photography of PO Box 310, Port Douglas Queensland 4877 (**Respondent**).

### 2. THE DOMAIN NAME AND REGISTRAR

The disputed domain names are <australianphotography.com.au> (**Domain Name**).  
The registrar is Enetica (**Registrar**).

### 3. PROCEDURAL HISTORY

- (a) 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).
- (b) The complete application was received from the Complainant by LEADR on 13 October 2010.
- (c) On 19 October 2010, LEADR sent an acknowledgement of receipt of complaint to the Complainant via email.
- (d) On 1 November 2010, a copy of the Complaint, and a request to clarify the Respondent's details and lock the Domain Name during proceedings was emailed to the Registrar. On the same date, the Registrar confirmed that the Domain Name has been locked.

- (e) On 3 November 2010, LEADR advised auDA of the Complaint via email.
- (g) On 3 November 2010, LEADR sent the Respondent a written notification of the Complaint by email along with a copy of the notification letter sent to the Complainant.
- (h) The due date for a response to the Complaint was confirmed to be 23 November 2010.
- (i) On 22 November 2010, Graham Maltby on behalf of the Respondent submitted a response to the Domain Name complaint (**Response**).
- (j) On 23 November 2010, the Provider approached the Panellist. The Panellist confirmed her availability, informed LEADR that they had no conflict issues with the parties and accepted the matter on 23 November 2010.
- (k) The Panellist was informed on 29 November 2010 that the package was being sent for Adjudication.
- (l) The parties to the dispute were notified of the panellist's allocation on 29 November 2010.

#### 4. FACTUAL BACKGROUND

##### 4.1 Facts Alleged by Complainant

The Complainant is Yaffa Publishing Group Pty Ltd (ABN 542 002 699 354) and the owner of *Australian Photography* magazine (**Magazine**).

The Complainant is also the co-owner of the NSW business name "Australian Photography" with Page Publications Pty Ltd, registered on 7 March 2000.

The Complainant states that the Magazine has been in continuous publication since 1950 and the total circulation is in excess of 9,000 copies. It also carries an ABC-audited circulation making it Australia's top-selling photography title under publishing industry rules.

The Complainant asserts that "Australian Photography" is its common law trade mark as it has been used to such an extent that it is recognised in Australia as distinguishing its services from those of other businesses.

The Complainant states that the Respondent does not use the Domain Name itself in the Domain Name website but uses other names such as "Steve Brennan Photography" and "Australian Panorama Photography". In the Complainant's view, the Domain Name website did not appear to be active.

At some time, the Complainant called the telephone number listed at the Domain Name website, which redirected callers to a mobile telephone number belonging to Mrs Anne Brennan. Mrs Brennan advised the Complainant that Mr Steve Brennan was taking time out from his business to take care of his mother, but could be contacted via email at *images@australianphotography.com.au*.

Mr Jeremy Light, Publisher of the Complainant then sent an email to this email address on 10 September 2010 advising that he wanted to discuss the Domain

Name with Mr Brennan. There was no reply to this email.

A second email was sent by Mr Light to the above email address on 21 September 2010. In this email, the Complainant offered to purchase the Domain Name for \$2,000.00. Additionally, the Complainant offered a series of free six advertisements in its publications *AdNews* and *Australian Creative*, having the value of more than \$31,000.00.

On 28 September 2010, Mr Light received a letter from Tonkin Drysdale Partners who act for Mr and Mrs Brennan. In this letter, the Respondent's lawyer advised Mr Light that the Respondent had constantly used the Domain Name for the past 10 years and, as such, it had no intention to relinquish the Domain Name. However, they said the Respondent would transfer the Domain Name if the Complainant pays \$50,000.00. The letter reads:

*"Clearly that offer would need to be well in excess of that proposed by you, and would need to be by way of a cash offer as our clients have no current need for the advertising that you so kindly offered.*

*Given that you put a value of this advertising at the sum of \$31,000.00, can we propose that our clients transfer the domain to you for \$50,000.00?"*

The Complainant asserts that the Respondent's counter-offer indicates their bad faith use of the Domain Name as he attempted to transfer the Domain Name for valuable consideration in excess of out-of-pocket costs directly related to the Domain Name under paragraph 4(b)(i) of Schedule A of *.au Dispute Resolution Policy (auDRP)*.

The Complainant asserts that it is hard to believe that Mr Brennan was unaware of the Magazine (i.e. "Australian Photography") at the time of registering the Domain Name because of the Complainant's continuous and successful publishing history, coupled with the fact that its sister publication *Capture magazine*, is published specifically for the professional photographer sector (in which Mr Brennan works).

The Complainant therefore seeks to have the Domain Name either transferred to it or cancelled under this Complaint.

#### 4.2 **Facts Alleged by the Respondent**

Mr Graham Maltby submitted a Response on behalf of the Respondent within the time required under paragraph 5 of the auDRP.

The Respondent has traded under the registered business name "Australian Panorama Photography" in NSW from 29 October 1999 and has held the Domain Name (which is an abbreviation of its business name) for more than 10 years. The Domain Name has been used solely for the promotion of the Respondent's business and career.

The Respondent disagrees with the Complainant's assertion that it has a common law trade mark for "Australian Photography". The Respondent argues that the words "Australian" and "Photography" are generic in nature and the non-exclusivity of the words is easily demonstrated in numerous databases. In this regard, a search for the words within ASIC's National names Index returns 37 current trading entities with similar names. Also a search on the Australian Business Number Registry returns 617 entries while a Google search shows results from photographers such as Nick Rains, Mark Gray and Ken Duncan along with many other websites.

The Respondent also claims that the registration date for its business name “Australian Panorama Photography” pre-dates the Complainant’s registration date for business name “Australian Photography” by more than five months.

In relation to the use of other names (i.e. “Steve Brennan Photography” and “Australian Panorama Photography”) than the Domain Name itself, the Respondent asserts that paragraph 2 of Schedule C of *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs (Eligibility and Allocation Rules)* does not require that a domain name exactly match its trading name but can be either an abbreviation of the registrant’s domain name or trade mark, or be otherwise closely and substantially connected to the registrant.

The Respondent also submits that a domain name licence does not mandate that the website branding and/or content reflect the domain name or trading name. It refers by way of example to the Complainant’s own publication “Australian Yachting”, where the online companion website is “mysailing.com.au” and points out that this does not reflect the domain name holder “Page Publications Pty Ltd”.

In relation to the Complainant’s allegation that the Domain Name website is currently inactive, the Respondent responds that Mr Brennan stepped back from his business for a short time to care for his parents and the outdated information on the website reflects nothing more than recent changes that have not been updated.

The Respondent also argues that potential high end commercial clients would not consider a consumer of photography magazine as a starting point in their search for a professional photographer. In its view, no one can believe that the Respondent is a supplier of the Complainant’s magazine (i.e. “Australian photography”) when examining the Domain Name website. Likewise, it points to fact that no one looking for a photography magazine would be confused or misled by the Domain Name website which clearly provides photographic services.

The selection of the Domain Name was made by the Respondent because it best served the Respondent’s business model and marketing goals. The Respondent states:

*“The registrant’s website is essential to marketing his skills and it cannot be overlooked that careful selection of keywords is essential for effective search engine optimization. As such, the wording within the website, including the domain name, is required to best compete within the registrant’s own market.”*

The Respondent argues that the Complainant’s alleged bad faith was, in fact, a simple response to the Complainant’s offer to purchase the Domain Name and not an unsolicited offer to sell. The Respondent further states:

*“With no desire to sell or otherwise dispose of the domain, the registrant has felt unwanted pressure from the complainant to enter into negotiations for the transfer of the domain name, only to be accused of bad faith when doing nothing more than suggesting a price the complainant didn’t like.”*

Finally, the Respondent claims that the Respondent has operated a successful business for over ten years using the Domain Name, and it has not attempted to conceal the real name of the business nor gain benefit from the Complainant’s suggested popularity of the Magazine.

The Respondent therefore seeks to have the Complaint dismissed.

## 5. DISCUSSION AND FINDINGS

### 5.1 Further Documents Provided By the Parties

The Panel points to the printed copies of the websites of ASIC or NSW Office of Fair Trading submitted by the both parties in relation to their business name registration for “Australian Photography” (from the Complainant) and “Australian Panorama Photography” (from the Respondent).

On 1 December 2010, the Panel requested via the Provider a copy of Certificates of Registration of Business Names related to the parties, as the submitted documents do not show the proprietors of the business name.

On 2 December 2010, the Panel received a copy of Certificate of Registration of Business Name for “Australian Photography” from the Complainant.

On 7 December 2010, the Panel received a copy of Certificate of Registration of Business Name for “Australian Panorama Photography” from the Respondent.

### 5.2 Discussion and Finding

In order to have the Domain Name either transferred to it or cancelled, the Complainant must make out each of the following elements under the 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.

#### 5.2.1 Paragraph 4(a)(i)

The Panel must determine whether, on the basis of the facts set out in paragraph 4(a)(i) above, the Complainant has rights in a relevant name, trade mark or service name.

The footnote 1 of the 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 asserts that it has a registered business name for “Australian Photography” as the co-owner with Page Publications Pty Ltd from on 7 March 2000.

However, the Complainant did not provide any information about who the Page Publications Pty Ltd is and what relationship exists between them. Moreover, the Certificate of Registration of Business Name for “Australian Photography” submitted by the Complainant does not show that the Complainant is either the owner or the co-owner with the Page Publications Pty Ltd. The Certificate clearly shows that the proprietor of the business name is Page Publications Pty Ltd *solus*.

Even though the principal place of business for the Business Name is the same as the Complainant’s stated address, there is no evidence that the Complainant is indeed the owner of the business name or, if it is not the owner, how it is connected to the owner of the Business Name.

The Panel is only bound by the evidence presented to it, namely, that the Business Name is not owned by the Complainant.

Secondly, the Complainant asserts that “Australian Photography” is its common law trade mark. The Complainant states that it has published the Magazine since 1950 and the total circulation is in excess of 9,000 copies. It also said that it carries an ABC-audited circulation making it Australia’s top-selling photography title under publishing industry rules.

To establish the common law trade mark rights, the Complainant must show that the name “Australian Photography” has achieved a “secondary meaning” in that the name has become a distinctive identifier associated with the Complainant or its goods or services: *Universal City Studios Inc. v Burns* (WIPO D2001-0784).

As appeared in numerous UDRP cases such as *Uitgeverij Crux v W. Frederic Isler* (WIPO D2000-0575), *Skattedirektoratet v Eivind Nag* (WIPO D2000-1314) and *Amsec Enterprises, L. C. v Sharon McCall* (WIPO D2001-0083), *Imperial College v Christophe Dessimoz* (WIPO D2004-0322), relevant evidence of such “secondary meaning” includes the duration and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition. In this case, the evidence is that circulation of “Australian Photography” magazine is 9,000 copies, however, there is no evidence whatsoever that this is the monthly or weekly circulation.

In *Australian Trade Commission v Matthew Reader* (WIPO D2002-0786), when determining whether the Australian Trade Commission has acquired a secondary meaning in “Austrade” the Panel had regarded to investment figures, annual revenue, brochures and other written materials published by the complainant and public awareness of its name and services both within and outside of Australia in coming to a conclusion that this was enough evidence to show common law trade mark rights.

Here, the only evidence presented by the Complainant is a copy of the cover page of the Magazine published in October 2010, and an article about its history of publishing the Magazine dated November 2000, which celebrated its 50 years (together with the cover page of that edition).

The Panel notes that this evidence only shows the length of publication and it is insufficient to show that the Complainant has a right to prevent all photographers from using the name “Australian Photography” to describe their photography

services. To support its common law trade mark rights on the name, the Complainant should have presented further persuasive evidence like one listed above (in *Australian Trade Commission* case). At best, the Complainant can claim a reputation in respect of publication but not to the services themselves.

The Panel also points to the name “Australian Photography” which includes the geographical term “Australian” and further points the fact that the Complainant has no registered trade mark for that name.

In relation to IP rights in geographical terms, the latest report of the Second WIPO Internet Domain Name Process titled “The Recognition of Rights and the Use of Names in the Internet Domain Names System” specifically declined to extend protection to geographical terms under the UDRP. Accordingly, subsequent UDRP cases uniformly denied finding trade mark rights in geographical terms unless a complainant has a registered trade mark consisting of or containing a geographical term: *Kur-und Verkehrsverein St. Moritz v StMoritz.com* (WIPO D2000-0617), *Skipton Building Society v Peter Colman* (WIPO D2000-1217), *City of Hamina v Paragon International Projects Ltd* (WIPO D2001-0001), *Brisbane City Council v Joyce Russ Advertising Pty Limited* (WIPO D2001-0069), *Land Sachsen-Anhalt v Skander Bouhaouala* (WIPO D2002-0273), *FC Bayern Munchen AG v People Net Services Ltd* (WIPO D2003-0467) and *BAA plc, Aberdeen Airport Limited v Mr. H. Hashimi* (WIPO D2004-0717).

In the absence of sufficient evidence to support the Complainant’s assertions, the Panel thus cannot find that the Complainant has acquired a substantial reputation in “Australian Photography” as a common law trade mark for photography services.

The Panel therefore finds that paragraph 4(a)(i) is not satisfied and as such the Complaint must be dismissed. However, the Panel proposes also to address the parties’ submissions in relation to the second and third limbs of the paragraph 4(a) of Schedule A of the auDRP.

#### 5.2.2 **Paragraph 4(a)(ii) of Schedule A of the auDRP:**

The Panel must determine whether, on the basis of the facts set out in paragraph 4(a)(ii) above, the Respondent has rights or legitimate interests in the Domain Name.

The Complainant claims that the Respondent has no right to the Domain Name as it does not use the subject Domain Name in its website. Rather it uses other names such as “Steve Brennan Photography” and “Australian Panorama Photography”.

The Panel refers to *Overview of WIPO Panel Views on Selected UDRP Questions*<sup>1</sup> and notes that if the Complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interest, the evidential burden of demonstrating rights or legitimate interests in the domain name then shifts to the Respondent to rebut that prima facie case: *Croatia Airlines d.d v Modern Empire Internet Ltd* (WIPO D2003-0455) and *Transfer Belupo d.d. v WACHEM d.o.o* (WIPO D2004-0110).

However, the Panel considers that the Respondent has a legitimate interest in the use of the term “Australian Photography” (which consists of geographical term and is descriptive of the services) because the Respondent has provided photography services in Australia. As long as the Complainant failed to establish its common law trade mark rights in the name “Australian Photography”, the use of this name as the

<sup>1</sup> <http://www.wipo.int/amc/en/domains/search/overview/index.html> at 2.2

Domain Name in the Respondent's website does not constitute trade mark infringement at all. Moreover, on the Complainant's own evidence, the Respondent does not use the Domain Name "as a trade mark" in the website to which the Domain Name resolves.

Under the Eligibility and Allocation Rules there is a close and substantial connection that is discernable between the Complainant's business (i.e. offering photography services) and its choice of the Domain Name and/or its business name "Australian Panorama Photography".

The Panel also notes that paragraph 4(c) of Schedule A of the auDRP provides the list of circumstances to be taken to demonstrate the registrant's rights or legitimate interest to the domain name for purpose of paragraph 4(a)(ii) of Schedule A of the auDRP:

- (i) the registrant's bona fide use of, or demonstrate preparations to use, the domain name in connection with an offering of goods or service (not being the offering of domain names that the registrant has acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) the registrant (as an individual, business, or other organisation) has been commonly known by the domain name, even if the registrant has acquired no trademark or service mark rights; or
- (iii) the registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trade mark at issue.

The Panel has regarded to the copy of the Domain Name website as archived on 14 September 2000, and an archived report showing the website has been in active from 2000 to 2008. The Panel further considers the Respondent's business in nature, namely, providing professional photographic services to public members. Taking into account this evidence presented, the Panel has no difficulty in finding that the Respondent has used the Domain Name on a bona fide basis in connection with offering its services. The Respondent's business of photography services provided by "Australian" or to "Australian" clearly has a nexus with the Domain Name and the website.

The Panel therefore finds that the Respondent has legitimate interests in the Domain Name, and as such, the Complainant fails to satisfy paragraphs 4(a)(ii) of Schedule A of the auDRP.

### 5.2.3 **Paragraph 4(a)(iii) of Schedule A of the auDRP:**

Paragraph 4(a)(iii) of Schedule A of the auDRP requires that the Domain Name has been registered or subsequently used 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).

The Complainant claims that the Respondent would have had knowledge of the Complainant's magazine at that time of registering the Domain Name because the Complainant's magazine "Australian Photography" and/or its associate's magazine (which have been in publication for long time), which specifically aimed at professional photographers, such as Mr Brennan of the Respondent.

Again, in the absence of evidence to support this assertion, the Panel cannot weigh the Complaint's claim that the Respondent had knowledge of the Complainant's magazine(s) and that there was a bad faith intention to register (or subsequently use) the Domain Name for commercial gain by creating a website which is confusingly similar to the Complainant. In any event, IP rights will still rest on whether this reputation extends so as to preclude photographers using what is otherwise a generic phrase to describe their services.

The Complainant also submits that the Respondent's counter-offer (requesting \$5,000.00) indicates that the Respondent has registered the Domain Name primarily for the purpose of selling it for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the Domain Name.

The Panel points to the fact that the Complainant first approached the Respondent and offered to purchase the Domain Name for \$2,000.00 with a series of advertisements in its publications to the value of more than \$31,000.00. The Respondent then counter-offered with the price of \$50,000.00. In reliance of this fact, the Panel cannot conclude that the Respondent registered the Domain Name *primarily* for the purpose of selling. The Panel emphasises that it would require stronger evidence by the Complainant to discharge this third limb onus.

Although the Respondent has left its business for a while (to care his family member), the Respondent has continuously used the Domain Name for more than ten years. There is a perfectly plausible nexus between the Domain Name and the Respondent's business activities. That precludes any reliance on paragraph 4(b) above. The Complainant has not put together any other cogent submission to support its contentions.

The Panel therefore concludes that the Domain Name has not been registered nor subsequently used in bad faith. Thus, the Complainant has not satisfied the requirements of paragraph 4(a)(iii) of the auDRP.

**6. DECISION**

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

Sara Delpopolo  
Sole Panelist

6 January 2011