



ADMINISTRATIVE PANEL DECISION

Shane Keith Warne v. Sure Thing Services Pty Ltd

LEADR-auDRP 10_08
<warnie.com.au> and <warney.com.au>

1 The Parties

The Complainant is **Shane Keith Warne**. He was represented in the proceedings by Melinda Upton and Amy Reynolds of the law firm Blake Dawson Waldron in Sydney and gave only that firm's address as his contact.

The Respondent is **Sure Thing Services Pty Ltd**, a company with its office in Kogarah Bay, NSW. It was represented in the proceedings by its Director, Mr John Smith* of [redacted].

2

The Disputed Domain Names and Registrar

The disputed domain names are <warnie.com.au> and <warney.com.au>. The registrars of the disputed domain names are Net Registry and Aust Domains respectively. For the purposes of this decision, and except where otherwise indicated, the Panel refers to both of the disputed domain names as the Disputed Domain Name.

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 in 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 or about 6 April 2010. On 9 April 2010 LEADR forwarded a copy of the Complaint to both Registrars and to the Respondent, and advised auDA of the Complaint. NetRegistry and Aust Domains confirmed to LEADR on 12 April 2010 that they had received a copy of the Complaint and that the Disputed Domain Name had been locked.

The Response was due 20 calendar days after the Respondent was first notified of the Complaint. Under Rule 5(a) the Response was therefore due by 29 April 2010.

On 30 April 2010 the Respondent lodged a Response which LEADR copied to the Complainant. On 7 May 2010 the Complainant filed with LEADR a "supplementary document ... to address some of the issues raised in the Response". LEADR advised the Complainant that the Panel would determine the admissibility of its supplementary filing.

The Panel was appointed on 10 May 2010 having advised LEADR that there was no conflict of interest with either of the parties.

Having perused the Complainant's supplementary submission the Panel determined that only paragraph 14 appeared to be responsive to an element of the Response that the Complainant could not have contemplated. Accordingly, the Panel directed LEADR to notify the parties that the Panel would only admit that paragraph of the Complainant's supplementary submission, and would determine subsequently whether to receive anything by way of rejoinder. The Respondent on Saturday 15 May 2010 lodged a supplementary Response which LEADR forwarded to the Panel on Monday 17 May 2010. The Panel has dealt with that submission as more particularly set out in section 6 below.

All other procedural requirements appear to have been satisfied.

4 Factual Background

The following facts, taken from the Complaint, are uncontested.

The Complainant is a well-known retired Australian international cricketer, coach and captain of the Rajasthan Royals cricket team in India, specialist coach and ambassador for Cricket Australia and has also been a television and newspaper commentator and columnist. He has a well-known reputation for being a proficient bowler and previously held the record for the highest number of wickets taken in test cricket. He has won numerous awards and accolades, including being named as one of only five Wisden's Cricketers of the Twentieth Century, in Australia's Cricket Team of the 20th Century, BBC Sports Personality of the Year in 2005, and Victoria's Greatest Ever Sportsman in 2002.

The Complainant is also well known for his non-sporting activities and product endorsements. In 2004 he established The Shane Warne Foundation which raises funds to help seriously ill and underprivileged children in Australia.

The Complainant together with members of his family is a director of Flipper Underground Pty Ltd, a corporate vehicle that owns the Australian trademarks WARNEY and WARNIE.

5 Parties' Contentions

Complainant

The Complainant makes 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 Complainant submits that he has been well known throughout his cricket career, and subsequently, by a nickname that can be rendered as "warnie" or "warney" and that for the past 15 years those words have been synonymous with him and more recently also with the products and services endorsed by Flipper Underground Pty Ltd with his consent.

- Members of the Australian Cricket Community, cricket fans, television industry, media and advertising organisations and the public at large readily associate the names Warnie and Warney with the Complainant.
- The Disputed Domain Names incorporate the Complainant’s nicknames and are confusingly similar to them.
- The likelihood of confusion is increased by the content of the website to which the Disputed Domain Name resolves because it includes photographs of the Complainant playing cricket, products featuring his likeness, slogans such as “WARNEY FOR P.M.”, a statement that “donations go toward the Shane Warne Foundation (Charity for sick children)”, a reference to “VB WARNIE DOLLS” (which alludes to one of the Complainant’s well known sponsorship arrangements with the brewer of VB beer) and a statement that “Shane Warne, one of Australia’s most prominent and successful cricket players, seems to have taken up new business ventures”.
- The Complainant also claims common law trademark status for his nicknames and essentially says that they are trademarks for his ‘celebrity’ services.

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

- The Respondent has not been and is not commonly known as *Shane Warne* or *Warney* or *Warnie* or any other remotely similar name or nickname and neither the Complainant nor Flipper Underground Pty Ltd has granted the Respondent any right to use those names or marks.
- There is no evidence of the Respondent’s bona fide use of the Complainant’s names or likeness on the websites to which each Disputed Domain Name resolves.
- The words “Warnie” and “Warney” are invented words and have no dictionary meaning and can only have been selected for the primary reason of conveying an association with the Complainant or his family, businesses, services, causes or products.
- The Respondent’s actions are disruptive to the legitimate business and activities of the Complainant and, of more concern, to the charitable causes to which the Complainant lends his name and which, contrary to the claims on the Respondent’s websites, do NOT receive anything from the Respondent’s sale of products and services.

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

- Invoking paragraph 4(b)(iv) of the auDRP, the Complainant says that the Respondent has intentionally attempted to attract for commercial gain Internet users to the sites to which the Disputed Domain Names resolve by creating a likelihood of confusion with the Complainant’s name or mark as to the source, sponsorship, affiliation or endorsement of that site or location or of a product or service on that website or location. It has done this by use of the Complainant’s name, likeness and nicknames, and by reference to the eponymous charitable Foundation that he established;

- That the Respondent's actions are for commercial gain can be assumed from the fact that orders can be placed on the websites to which the Disputed Domain Names resolve for A\$29.95 shirts bearing slogans such as "WARNEY FOR P.M.";
- The Complainant also notes that the abovementioned slogan suggests that he has political aspirations, which is denied;
- The terms of the sarcastic disclaimer on the Respondent's websites are especially highlighted as evidence of bad faith, it being in these terms:

The goods on offer are made available by Shane Warne fans, and are not sponsored, affiliated, endorsed, licensed, created, designed or hand-made by Shane Warne himself (or Flipper Underground Pty Ltd, The Shane Warne Foundation, Fosters, VB Warnie Dolls, Barrack Obama or Mother Theresa

- The Complainant highlights the false claims on the Respondent's websites that donations from the purchase of merchandise go towards The Shane Warne Foundation and submits that the Respondent's conduct could divert much needed donations away from the Complainant's charity and is arguably fraudulent conduct.
- The Respondent has deliberately ignored the Complainant's letter of demand including requests for transfer of the Disputed Domain Name and demands that it cease to use the Complainant's intellectual property.

Respondent's Response

The Response formally denies that any of the grounds set out in paragraph 4 of the auDRP are satisfied.

It also says:

- a) The Complainant commenced his career in Melbourne in 1990 representing the Victoria Cricket Team;
- b) The Complainant has developed a number of nicknames "possibly" including "Warnie" and "Warney" and numerous others. However, the Complainant has always used "Warne" rather than any nickname on his jersey during televised cricket matches;
- c) Other famous cricketers are known by different nicknames;
- d) The words "Warnie" and "Warney" are not "protected or registered" trademarks;
- e) Despite formal trademark applications therefor, Flipper Underground was met by two adverse Examiner's Report in respect of the two foregoing trademarks as a consequence of which "it is quite obvious that these words cannot be trade marked by Flipper Underground Pty Ltd under Australian law";
- f) The two claimed trademarks were the subject of prior use;
- g) Flipper Underground does not market under the WARNIE or WARNEY names and "there is not one instance where Flipper Underground has marketed or promoted the

brand of “Warney” in any way. As a consequence, the Complainant has included false material in the Complaint, in breach of the auDRP;

- h) The Respondent registered the Disputed Domain Names on 1 November 2007 and 4 January 2008 respectively;
- i) In November 2007 the Respondent ordered the printing of 30 T-shirts bearing the slogan “WARNEY FOR PM”;
- j) Since that date “I have comically worn the T-shirt on occasions since I am also referred to as “Warney” by my friends”;
- k) Only two out of the 30 T-shirts have been sold, the first in Australia on 24 December 2007 and the second in the UK on 17 January 2008;
- l) The Respondent has “adequately met the requirements of eligibility for the domain names as it is an Australian Registered Company and sells a product linked with the word the domain refers to”;
- m) Paragraph 4(b)(iv) of the auDRP cannot apply because the “only links from this website is to the domain’s email address, to the Warney/Warnie website itself, and to 888 Poker ...”.
- n) The Complainant’s submissions that the Respondent is passing itself off as being formally associated with the Complainant “should be seen as ridiculous, as it assumes that the audience is of substantially low intelligence”.
- o) The Complainant’s personal assistant regards the “Warney for PM” shirts as funny, was “notified” of the T-shirts in October 2007 in a communication by which the Respondent’s Mr John Smith* foreshadowed wearing the T-shirt so marked and indicted an intention to donate \$1 from the proceeds of each shirt sold to The Shane Warne Foundation;
- p) On 30 October 2007 Mr John Smith* sent an email to the Complainant’s personal assistant to the effect of “I just want to know that it won’t be upsetting anyone. ‘Warney for PM’ is the slogan, I just wanted peace of mind knowing this was OK, and wanted to respectfully ask rather than get into trouble for something I thought would be positive”;
- q) The Complainant’s personal assistant responded in these terms:

“Ha! Thanks Mr Smith*, appreciate you asking. I haven’t actually passed it by anyone. I’m sure there would be no problem. After all, it’s a free world and as long as you don’t use anyone’s intellectual property or images that belong to anyone else you can do what you want. We appreciate your support”;
- r) The Respondent asserts that the foregoing is formal permission from the Complainant to use the word “WARNEY” in connection with the sale of t-shirts. The only reason that no proceeds have been donated to The Shane Warne Foundation is that only two shirts have been sold. Mr John Smith* claims now to be ready willing and able to pay the promised \$2;
- s) “WARNEY” and “WARNIE” are not the Complainant’s names, trademarks or service marks; nor does the Complainant have rights to these words;

- t) The Respondent also relies on paragraph 4(c)(i) based on the foregoing facts;
- u) Finally Mr John Smith* asserts that his nickname is “Warney” and that he has been known by that nickname since at least age 6, three years before he became a fan of the Complainant.

6 Supplementary submissions

As indicated above, the Complainant filed a supplementary submission by way of Answer to the Response. This comprised a four-page document with about 10 pages of annexures. The Panel ruled that only paragraph 14 of this supplementary response read together with the Examiner’s Report in Annexure A would be considered. Having observed subsequently that there are two successive paragraphs numbered 14, the Panel notes that only the first paragraph so numbered was the material that the Panel agreed to take into account in conjunction with the Examiner’s Report. The material in question was responsive to that part of the Response that asserted that the Australian Trademarks Office had indicated that neither the Complainant nor Flipper Underground were entitled to “WARNIE” or “WARNEY” as trademarks.

In accordance with permission given to the Respondent by the Panel, Mr John Smith* on Saturday 15 May 2010 filed a rejoinder to the Complainant’s supplementary submission. This document contained little new material and the bulk of it was a verbatim repetition of large slabs of the Response. Nevertheless it did indicate that the Respondent has filed an opposition to Flipper Underground’s application for the WARNEY and WARNIE trademarks on the grounds of Mr John Smith*’s childhood nickname, and the Panel has determined that this information should be considered.

7 Reverse Domain Name Hijacking

The Respondent also asserts in the Response that “Flipper Underground is attempting to strip this domain out of the hands of the rightful owner by means of legal intimidation and bullying, as is evident in their letters directly to me”. The Panel interprets that language as an allegation of Reverse Domain Name Hijacking under the auDRP.

8 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.

The Complaint canvases much material that is of little assistance to the Panel. First, since Flipper Underground is not a party to this proceeding, its activities and trademarks are not

strictly relevant, unless the Panel treats that entity as an alter ego of the Complainant. As it has chosen not to be a joint Complainant the Panel declines to accord it that status.

To establish his standing the Complainant had only to show that the Disputed Domain Names were identical or confusingly similar to a name, trademark or service mark in which he had rights. Apart from the Respondent's express concession that the Complainant is known by such a nickname, the evidence in support of the contention that the Complaint is known as "Warney" or "Warnie" is compelling. Even apart from the Panel's view that the Complainant's nickname derives from the Australian proclivity for converting to two syllables many one syllable names, "Warne-y" is equally likely to be derived from the cricketing world's famous chant of "Lill-ee" as the nickname of a famous predecessor bowler to the Complainant. Thus it is easy for the Panel to accept that the Complainant is frequently called "Warne-y" which can be rendered in the phonetically equivalent forms "WARNEY" and "WARNIE". If that were not enough, the original adverse Examiner's Reports issued against the trademark applications for WARNEY and WARNIE were based upon the view of the Australian Trademarks Office that they were likely to be taken by the Australian public to refer to the Complainant and that accordingly they could not be registered without his consent. That consent having been provided, the trademarks proceeded to acceptance and, but for the Opposition apparently being prosecuted by the Respondent, it is likely that the marks would by now have formally been granted to Flipper Underground Pty Ltd. Whether that registration would deprive the Complainant of the corresponding common law trademarks that he claims is a potential problem for the Complainant as the Panel inclines to the view that it might, since the consent given by the Complainant in practical terms allows Flipper Underground Pty Ltd to appropriate the goodwill in those marks that formerly belonged to the Complainant.

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 is very well known as "Warne-y" or "Warney" or "Warnie" or any other phonetically equivalent spelling.

Accordingly, the status of trademark applications by Flipper Underground Pty Ltd is unnecessary to consider but the Panel would probably not have granted standing to the Complainant had he been required to prove that he held a relevant interest in trademarks that he had allowed Flipper Underground to register in its own name and affix to products.

The Complainant, having established that he has rights in the name "Warne-y", then needs to demonstrate that the Disputed Domain Names are identical or confusingly similar to that name. It is well established both as a matter of auDRP jurisprudence as well as UDRP jurisprudence that the test under the first limb involves comparing the Complainant's name with the Disputed Domain Names. The content of the website, if any, to which a Disputed Domain Name resolves, and the conduct of a respondent, are not otherwise relevant to this issue. This is because the initial interest confusion that underpins the UDRP and its derivatives, seeks to provide redress where a domain name has been chosen to leave Internet users confused about whether a particular domain name is associated with a well known person, firm, product or service. Whilst the content of the websites and other facets of the Respondent's conduct are relevant under the second and third limbs of the auDRP, they have no place in submissions under the first limb and should not be made.

Ignoring the ccTLD and 2LD components of the Disputed Domain Names as one does unless they are themselves part of the alleged confusion, the Panel finds that the Disputed

Domain Names are phonetically identical to the Complainant's name "Warne-y" and, whether rendered as "Warney" or "Warnie", are on any view confusingly similar to his name.

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

Rights or Legitimate Interests in respect of the Disputed Domain Name

The evidence shows that the Respondent was not incorporated until 30 August 2006. On the Respondent's own admission that is long after the Complainant and his nickname became famous, if not a household word in Australia and other cricket-playing nations. The Panel cannot accord to the Respondent any rights deriving from Mr John Smith* alleged nickname any more than it is prepared to accord rights to the Complainant based on trademarks held by Flipper Underground Pty Ltd.

The Respondent makes much of the email from the Complainant's personal assistant and claims that it conferred on it the necessary rights to the Disputed Domain Names. The Panel rejects that assertion on multiple bases. First, the emails sought permission for Mr John Smith* to wear T-shirts bearing the WARNEY FOR PM slogan, and he offered to donate a dollar for each shirt sold as a consequence. At no time did he seek, either for himself or for the Respondent, permission to operate websites of the kind about which the Complainant is aggrieved. Nor did he seek permission to use the likeness of the Complainant, nor to use his name in other ways including in the cheeky disclaimer.

Indeed, given the overwhelming fame if not notoriety of the Complainant over the last five years, the Panel has to regard the Respondent's submissions about its right to use the Complainant's nicknames as made tongue in cheek if not simply disingenuous. There is nothing in the language of the October 2007 email that could have led the Respondent to hold bona fide the view that it had been granted permission to register the Disputed Domain Names or establish the websites to which they resolve. Unwise though the qualified expression of permission may have been with the benefit of hindsight, qualified it was nonetheless with a caution against using the Complainant's intellectual property or likeness.

In the Panel's view the evidence establishes categorically that the Respondent has not a shred of right or legitimate interest in using the Complainant's name as part of the Disputed Domain Names nor indeed in any use of that name on its websites.

The second limb of the auDRP is clearly made out.

Registered or subsequently used in bad faith

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

The evidence is clear, despite the language of the so-called disclaimer recited above, that the Respondent represents on its websites that it is authorised by or otherwise affiliated with the Complainant or The Shane Warne Foundation. It is equally clear that the Respondent is not so authorised and that it has made no donation to the Foundation. This is misleading and deceptive conduct, and it matters not whether the Respondent has sold one or one million shirts. It is flagrantly cybersquatting on the Complainant's name, falsely claiming an affiliation in order to obtain a commercial advantage, and likely also damaging or at least diverting funds away from the Complainant's charitable foundation.

The Panel is of the view that the Disputed Domain Names were both registered and continue to be used in bad faith by the Respondent, and a finding of either of those forms of conduct would have been sufficient for the Complainant to succeed on this ground of the auDRP.

The Complainant has strongly made out paragraph 4(a)(iii) of the auDRP.

Reverse Domain Name Hijacking

The Panel having found the Complaint made out, there is no scope for a finding against the Complainant in relation to Reverse Domain Name Hijacking. Read literally, the Respondent in fact makes the allegation of “legal intimidation and bullying” against Flipper Underground Pty Ltd, which is not even a party to this proceeding. But given the Respondent’s misleading and deceptive conduct it is otherwise impossible for the Panel to make an adverse finding against the Complainant under the auDRP.

For the Respondent to make the allegation seems to the Panel to be corroborative of the Respondent’s lack of good faith rather than the reverse.

8 Decision

The evidence strongly supports the grounds on which the Complainant relies. Accordingly, the Complaint must be upheld and the Panel therefore orders that <warney.com.au> and <warnie.com.au> be transferred to the Complainant.

Dated this 26th day of May 2010

P Argy

Philip N Argy

Sole Panellist