



ADMINISTRATIVE PANEL DECISION

Yaffa Publishing Group Pty Ltd v. Jackaroo Solutions Pty Ltd

LEADR-auDRP 10_05
<australianflying.com.au>

1 The Parties

The Complainant is **Yaffa Publishing Group Pty Ltd** of Surry Hills, New South Wales. It was represented in the proceedings by its General Manager, Ms Tracy Yaffa.

The Respondent is **Jackaroo Solutions Pty Ltd**, a company with its registered office in Greensborough, Victoria. It was represented in the proceedings by Mr James Guy of Guy & Hinton of Melbourne, Victoria.

2 The Disputed Domain Name and Registrar

The Disputed Domain Name is <australianflying.com.au>. The registrar of the Disputed Domain is Net Registry.

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 15 February 2010. On 16 February 2010 LEADR forwarded a copy of the Complaint to both NetRegistry and to the Respondent, and advised auDA of the Complaint. NetRegistry confirmed to LEADR on 18 February 2010 that it had received a copy of the Complaint and that the Disputed Domain Name has been locked.

The Response was due 20 calendar days after the Respondent was first notified of the Complaint. Pursuant to Rule 3(b)(xii) the Complainant acknowledged that it did NOT serve a copy of the Complaint on the Respondent. It therefore appears that the only notice to the Respondent was by both email and Express Post despatched by LEADR on 16 February 2010 from Sydney NSW to the Respondent’s registered office in Greensborough Victoria. [The Panel determined that the Complaint would have been delivered by Express Post to the Respondent’s registered office on or before 18 February 2010. Under Rule 5(a) the Response was therefore due by 11 March 2010.]

On 3 March 2010 the Respondent’s representative notified LEADR that he had only just received instructions from the Respondent and sought a seven day extension of time

within which to file the Response. LEADR advised the Respondent's representative on 4 March 2010 that it had granted an extension of time until close of business on 12 March 2010 for the Response to be filed. At 2:17pm on 12 March 2010 the Respondent's representative requested a further extension of time until 15 March 2010 for a Response to be filed. This request was refused by LEADR. The Response was filed at 5.15pm on 12 March 2010 which the Panel regards as 15 minutes after what would normally be regarded as "close of business". Nevertheless the Complainant suffers no detriment from the Response being 15 minutes late and the Panel therefore accepts the Response as if it had been filed within time.

The Panel was appointed on 16 March 2010 having advised LEADR that there was no conflict of interest with either of the parties.

All other procedural requirements appear to have been satisfied.

4 Factual Background

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

The Disputed Domain Name was registered in January 2008.

The Complainant has published *Australian Flying* magazine since 1963 and it has a circulation of a little over 7,900, making it Australia's largest circulation flying magazine. The Complainant has also held a business name registration for "Australian Flying" for at least 18 years.

The Complainant has been using <<http://www.yaffa.com.au/cmag/fly.html>> for its magazine site but wished to launch a dedicated website using the Disputed Domain Name "in March 2010".

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 has common law trademark rights in "Australian Flying" based on its more than 46 years' continuous use as the title of its magazine which enjoys wide circulation amongst the general aviation community and beyond
- *Australian Flying* is a household name among aviation enthusiasts and is one of Australia's leading aviation brands

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

- The Respondent has not been and is not commonly known as *Australian Flying*
- There is no evidence of the Respondent's bona fide use of the term *Australian Flying* on the website to which the Disputed Domain Name resolves

- The Respondent is not making a legitimate non commercial or fair use of the Disputed Domain Name and it is clear that the Respondent registered the Disputed Domain Name either to a) attract *Australian Flying* traffic to its own site and/or b) is squatting on the address in the hope that there will be a policy change that will allow reselling of domain names
- The use of the Disputed Domain Name is entirely unnecessary to the success of the <recreationalflying> website and its associated activities
- The Respondent's actions are disruptive to the legitimate business and activities of the Complainant.

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

- The Respondent registered the Disputed Domain Name for the purpose of confusing readers of the Complainant's *Australian Flying* magazine and "directing traffic for its own gain".
- The Respondent approached the Complainant on 7 February 2008, shortly after the Disputed Domain Name was registered, and offered the Complainant "a link to its soon to be developed site". Whilst there is evidence of the Complainant's internal consideration of the Respondent's approach, the evidence does not include a copy of any written response at that time, being limited to an internal email dated 12 February within the Complainant's organisation that purports to record the outcome of a telephone conversation with Mr Doug Nancarrow of the Complainant in which the Respondent "keeps threatening to run with the competition". Mr Nancarrow's email records that the Complainant's Mr Dave Clutterbuck was to speak with the Respondent's Mr Ian Baker. In terms of an outcome the Complaint simply records that, in late February 2008:

"we advised that we did not wish to point our *Australian Flying* readers to his resource and that it did not fit the company view on online publishing. In addition management viewed the Respondent's efforts as an attempt to pass-off connection [sic] with the well established brand. In November 2009 ...[Mr] Nancarrow contacted the Respondent with a view to settle [sic] the domain issue amicably. There was no resolution."

- The Complainant goes on to argue that the use of the *Australian Flying* name by the Respondent is entirely unnecessary to the success of the recreationalflying website and its associated activities.
- The Respondent's actions are disruptive to the legitimate business and activities of the Complainant, "which is also indicative of bad faith as described within paragraph 4(b)(iii) of the" auDRP.
- "We are very concerned at the confusion the [Disputed Domain Name] will cause to our brand. The magazine's website is ready to launch. We require the Respondent to relinquish ownership of the [Disputed Domain Name] and allow transfer of ownership to [the Complainant]".

Respondent's Response

The Response begins by denying that *Australian Flying* could be a common law trademark that distinguishes the Complainant's goods from those in the Australian aviation industry.

The Response cites the Honourable Neil Brown QC's decision in *WOW Audio Visual Superstores v Comonoz* [DAU2007-0003] with its review of the principles relating to common law trademark claims.

The Respondent then submits:

- The term *Australian Flying* is apt to describe the subject matter of the Complainant's magazine and other like goods and services in the aviation industry. "As such, the Complainant's use of the term *Australian Flying* is utterly descriptive".
- The Complainant has not submitted any evidence of secondary meaning having been acquired in the term *Australian Flying* which could ground its claim for common law trade mark rights
- Under Australia law, use of a descriptive mark confers a lower level of protection than highly distinctive marks
- The Complainant did not have any trade mark or common law rights in a name corresponding to the Disputed Domain Name on the date that the Respondent registered it.

The Response annexes a statutory declaration made on 12 March 2010 by one Ian Baker. Mr Baker deposes that he is the sole director of "the Respondent in this auDRP proceedings case number DAU 2008-0021 and am duly authorised to make this statutory declaration for the Respondent". The Panel assumes that this language is a remnant from the statutory declaration prepared by Mr Hinton for the respondent in the WIPO proceedings referred to. In the Panel's view it reflects poorly on Mr Baker that he signed his declaration with those words remaining uncorrected. The Panel wonders how much of the balance of the declaration reflects Mr Baker's position and how much it reflects the position of the respondent in the 2008 proceedings. Nevertheless, the Panel has not drawn any adverse inference from this apparent drafting oversight and has taken the declaration at face value.

When read with Mr Baker's declaration, the Response goes on to say:

- a) The Respondent was aware of the Complainant at the time it registered the Disputed Domain Name
- b) The Disputed Domain Name was chosen "due to its descriptive nature, and was designed to serve the general aviation public from Australia. It was to be a stand alone site. It operated for 18 months and during the rebuild it was set to redirect to the other site recreationalflying.com.au".
- c) Before receiving any notice of the subject matter of this dispute, the "Respondents' [sic] bona fide use of the domain names [sic] in connection with an offering of goods

or services pursuant to para 4(c)(i) of the [auDRP] can be taken as” a proven demonstration of its legitimate rights and interests.

- d) The Respondents have been using the Disputed Domain Name “in connection with its public service since registration. It is a legitimate use of the domain name to advertise the Respondent’s own website which is flying of all types of aircraft other than RA registered aircraft throughout Australia”.
- e) Mr Baker was unaware that the title to the Complainant’s magazine “could have any right to prevent him from registering the” Disputed Domain Name.
- f) The Complainant acquiesced in the Respondent’s use of the Disputed Domain Name and, having endorsed the activities of the Respondent by sponsoring and judging competitions on its website site, it now seeks to deny that such support has existed.

In relation to registration or use in bad faith the Respondent repeats its arguments that *Australian Flying* is a generic term and submits that this precludes a finding of registration in bad faith relying, for example, on <internet.com.au> *WIPO Case number DAU2003-0005*.

The Respondent submits that the Panel cannot possibly infer that the Disputed Domain Name was registered in bad faith or subsequently used in bad faith as the Respondent had rights and legitimate interests in it and used it as part of a legitimate use to promote flying in Australia.

Mr Baker’s statutory declaration also adds that:

- (a) The <recreationalflying.com.au> site (the “RA Site”) is run on a totally non-commercial basis, subsidised by his pilot supplies business and otherwise funded by he and his wife personally.
- (b) The website to which the Disputed Domain Name is intended to be directed, which is under development, will be a general aviation ‘spin off’ from the RA Site, apparently to avoid clashes between recreational aviation enthusiasts and general aviation enthusiasts.
- (c) The monthly photo competition on the RA Site was sponsored by the Complainant and judged by Shelley Ross, who was then the editor of *Australian Flying* from August 2006 to July 2008. After Ms Ross stepped down from that role the photo competition ceased until the sponsorship and judging was taken up by a competitor magazine to *Australian Flying*, called *Aviator*.
- (d) “I am not a commercial concern, I have no malicious intent against the magazine and the name and I do not compete with them in any way but rather simply have a descriptive and most suited name to all no [sic] recreational types of flying in Australia”.

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.

The Complaint is poorly constructed and relatively bald in its submissions. Little attempt is made to cite which portions of the evidence support which submission. For the most part it seems to assume that the Panel will find amongst the annexed evidence enough to make good the Complaint. This is not an approach the Panel would like to encourage. A complainant needs to put a bit more effort into its complaint if it is not to risk getting a panel offside. A panellist should not have to wade through the evidence to find the salient bits to support the Complaint, despite the language of paragraph 15(a) of the Rules!

Identical or Confusingly Similar to a trademark in which the Complainant has rights

The Complainant has published *Australian Flying* magazine since 1963. It is the highest circulation magazine in its target demographic. The Complainant also has owned the registered business name *Australian Flying* for some 18 years.

The Respondent's contention that the Complainant cannot have acquired common law trademark rights in *Australian Flying* is both incorrect and unnecessary. Both the Response and Mr Baker's email exchanges with the Complainant often use the term *Australian Flying* to signify the Complainant's magazine of that name, although Mr Baker also uses it to describe the non-recreational or general segment of the aviation market.

The Panel has no difficulty finding that the name of a broad circulation magazine in continuous use for 46 years confers common law trade mark rights in that name on the publisher in respect of that publication. These rights do not equate to the exclusive rights conferred on the owner of a registered trade mark but exclusivity is not a requirement of the auDRP's first limb. On any objective view *Australian Flying* is a trade mark signifying the publication which bears that name and in which the Complainant has rights. The fact that those words may also have a descriptive use goes only to the strength of those rights rather than to whether they have acquired *any* secondary meaning.

Independently of its common law trademark rights, *Australian Flying* is also a business name registered by the Complainant. That gives it an alternative basis for making good its case under paragraph 4(a) of the auDRP.

Ignoring the ccTLD and 2LD components of the Disputed Domain Name as one does unless they are themselves part of the alleged confusion, the Panel finds that the Disputed Domain Name is identical to *Australian Flying* which is both a trade mark and a name in which the Complainant has rights.

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

Rights or Legitimate Interests in respect of the Disputed Domain Name

The Respondent contends that once the words “Australian Flying” are capable of a descriptive use, it must have a legitimate interest in using them in that way. In the Panel’s view that is not correct. To use the word “flying” capitalised as “Flying” is not a descriptive use in normal prose. It is perfectly clear to the Panel that the Respondent has not used the words “Australian flying” to describe the general aviation segment of the Australian market, or to distinguish it from Australian swimming or any other activity. Indeed in the Panel’s view the capitalised words in their ordinary English meaning are not synonymous with Australian [general] aviation, which is essentially what the Respondent asserts.

Since on the Respondent’s own case the legitimacy of or right to use the words “Australian Flying” are premised on their being ordinary descriptive words, the Panel’s rejection of that proposition is sufficient for the Complainant to succeed under this limb of the auDRP. However, it is clear from the Respondent’s own material that since at least August 2006, but likely long before then, it was very well aware of *Australian Flying* magazine and indeed had dealings with that publication’s editor. It is hard for the Panel to accept as other than disingenuous subsequent adoption by the Respondent of the phrase “Australian Flying” which, in any event, seems to the Panel to be a forced usage wherever it is used by the Respondent to refer other than to the Complainant’s magazine.

In the Panel’s view the Respondent does not have any legitimate right or interest in the Disputed Domain Name for a non-commercial general aviation discussion forum site, for any general aviation website, or for use as an email domain in connection with any aviation-related activity.

The Respondent’s reliance on paragraph 4(c)(i) of the auDRP cannot succeed. Use of the term “Australian Flying” in respect of the RA Site was not a bona fide use of the Disputed Domain Name in connection with an offering of goods or services, for the reasons that follow in relation to the third limb.

The second limb of the auDRP is 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.

At the time the Disputed Domain Name was registered in January 2008 the Respondent had been dealing with the editor of *Australian Flying* for some two years and was perfectly well aware of what those words signified both to the aviation market in Australia and, just as importantly, to the viewers of the RA Site’s photo competition. Whilst the Complainant’s continued dealing with the Respondent after it registered the Disputed Domain Name may have been a little naive, and its subsequent handling of the issue somewhat ham-fisted, it is drawing way too long a bow for that to be described by the Respondent as acquiescence in its use of the Complainant’s *Australian Flying* trade mark as a domain name or as the title of the home page of the site to which the Disputed Domain Name originally resolved.

The Panel is prepared to accept at face value Mr Baker’s declaration that the Respondent’s use of the term *Australian Flying* did not reflect any malicious intent on his

part but that is not sufficient to overcome the Panel's finding that on the objective facts the Respondent registered the Disputed Domain Name with full knowledge of the Complainant's *Australian Flying* magazine, its readership and the confusion that would ensue.

Mr Baker's assertion that the Respondent is developing a general aviation analogue of its RA Site may also be accepted at face value, but that does not mean that use of the Disputed Domain Name to point to such a site is a bona fide use.

In his email dated 7 February 2008 to the Complainant Mr Baker says "As you know, I own the domain name www.australianflying.com.au which has always pointed to [the RA Site] I would like to offer you and the readers of the Australian Magazine a connection I have placed a box on the left side of the forum to show an example of the connection that the Australian Flying website and your magazine can have together ... I am hoping that ... we can work together to provide the same valuable resources and promotional advantages to the Australian Flying readership as [the RA Site] does to the [Recreational Aviation Association]". The use of that language less than a month after registration of the Disputed Domain Name is both telling and disingenuous in the Panel's view.

In the Panel's view the Respondent registered the Disputed Domain Name in bad faith. Whilst unnecessary to decide, in the Panel's view the Respondent is also still using the Disputed Domain Name in bad faith even if it is developing a general aviation website for future use with the Disputed Domain Name..

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

8 Decision

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

Dated this 31st day of March 2010

 **Philip N Argy**

Philip N Argy

Sole Panellist