



## ADMINISTRATIVE PANEL DECISION

**Grayson's International Pty Ltd**

**v**

**BW Harrison & FR Harrison**

**auDRP\_20\_06**

**<waleafscreeener.com.au>**

### **1. The Parties**

The Complainant is Grayson's International Pty Ltd., of Box Hill North, Victoria, Australia, represented internally.

The Respondent is BW Harrison & FR Harrison, of Bassendean, Western Australia.

### **2. The Disputed Domain Name and Registrar**

The disputed domain name is <**waleafscreeener.com.au**> ("the Domain Name"). The Registrar of the Domain Name is Web Address Registration Pty Ltd.

### **3. Procedural History**

This is an administrative proceeding pursuant to the 2016-01.au Dispute Resolution Policy published by auDA on April 15, 2016 ("auDRP" or "Policy"); the auDA Rules for .au Dispute Resolution Policy ("Rules") and the Resolution Institute Supplemental Rules for .au Domain Name Dispute Resolution Policy ("RI Supplemental Rules").

The Complaint was received by Resolution Institute ("RI") via email on Tuesday 23 June 2020 and acknowledged next day, when a copy of the Complaint was emailed to the Registrar with a request to confirm the Registrant's details and lock the Domain Name pending the final decision of these proceedings. That day the Registrar confirmed via email details of the Respondent and advised that the Domain Name had been locked. RI advised auDA of the Complaint on Thursday 25 June 2020 via email. That day, RI emailed the Respondent with the Notification of the Complaint lodged in respect of the Domain Name and emailed a copy to the Complainant and the Registrar. The due date for the Response was Wednesday 15 July 2020. No Response was submitted. On Thursday 16 July 2020, the Provider approached the Panelist, who confirmed his availability, informed RI that he had no conflict issues with the Parties and accepted the matter. On Thursday 16 July 2020 the Case file and relevant correspondence were forwarded to the Panelist and the Parties were notified of the Panelist's appointment.

#### **4. Factual Background**

The Complainant, Grayson's International Pty Ltd, is the owner by assignment of Australian registered trademarks in relation to gutter protection materials Nos. 831484 LEAFSCREENER and design (figurative), registered on July 7, 2002 and 849621 LEAFSCREENER (word), registered on May 19, 2003.

The name in which the Domain Name was registered, BW Harrison & FR Harrison ("the Respondent"), was the Australian Business Name ("ABN") of a family partnership whose registered trading name from July 1, 2002 was WA LEAFSCREENER GUTTER PROTECTION (Complaint, Schedule 2). The ABN BW Harrison & FR Harrison was cancelled from July 1 2012 (ibid). Bradley W Harrison and Fiona R Harrison divorced and Fiona Harrison took over the WA Leafscreeener business as part of the divorce settlement in about April 2015 (Complaint, Schedule 5).

A company with the name Australian Leafscreeener (W.A.) Pty Ltd was incorporated in New South Wales on October 3, 1996. Its name was changed to Australian Leafscreeener Sales Pty Ltd on September 4, 2000 and to Australian Leafscreeener Pty Ltd on November 19, 2001. The company was deregistered on June 15, 2016. Bradley Harrison was a director from the date of incorporation until August 30, 2000 (Complaint Schedule 3).

It is unclear from the Whois information when the Domain Name <waleafscreeener.com.au> was created. The Registrant Contact Name is Fiona Harrison. An Internet visit by the Panelist shows that the Domain Name currently resolves to an active website offering gutter protection services. The "About Us" page says: "WA Leafscreeener is a family run business having experience in Western Australia since 1994". The website copyright notice is dated 2012.

In response to a cease and desist letter from the Complainant, the solicitor acting on behalf of "WA LEAFSCREENER" wrote to the Complainant on June 5, 2020:

"My client has been operating as AUSTRALAN LEAFSCREENER (WA) PT LTD since 1996 to 2002, and then renamed it as AUSTRALIAN LEAFSCREENER PTY LTD until 2012. At that time the affairs of that corporate entity were restructured and she commenced trading as WA LEAFSCREENER. Accordingly, my client has continuously used the trade mark LEAFSCREENER since before the filing dates of your Trade marks."

#### **5. Parties' Contentions**

##### **Complainant**

The Complainant says the brand LEAFSCREENER was created by the owners of Polymesh Australasia Group Pty Ltd, which supplied gutter protection materials to consumers and businesses across Australia. The LEAFSCREENER brand has been used extensively since the early 1990s. The trademarks were both applied for in the year 2000 and were assigned to the Complainant on May 4, 2020.

The partnership BW Harrison & FR Harrison was deregistered in 2012 and therefore has no legitimate right to hold the Domain Name. As a deregistered entity, it is not capable of conducting business. The company AUSTRALIAN LEAFSCREENER PTY LTD has also been deregistered and ASIC records show that Fiona Harrison was never a director or secretary of that company.

Fiona Harrison is nevertheless continuing to renew the Domain Name. Bradley Harrison has stated that she is acting without his consent.

The Respondent has never been given permission to use the trademarks. The Domain Name is almost identical to the LEAFSCREENER word mark. The Respondent must have had knowledge of the LEAFSCREENER trademarks when it acquired the Domain Name. Despite becoming deregistered in 2012 it continued to hold and renew the Domain Name illegitimately. This itself is an act of bad faith. The LEAFSCREENER trademark is a coined and distinctive mark with no dictionary meaning and the fact that the Respondent chose to acquire and keep the Domain Name, which is almost identical to the trademark is a further indication of bad faith.

The Complainant seeks the transfer to it of the Domain Name.

## **Respondent**

The Respondent did not submit any Response.

## **6. Discussion and Findings**

The Panel has jurisdiction to determine this dispute pursuant to Paragraph 2.1 of the auDRP:

“All domain name licences issued or renewed in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP. At the time of publication, the open 2LDs are as.au, com.au, id.au, net.au and org.au.”

Further, RI is an approved Provider under Paragraph 3 of the auDRP and the Panel has been duly appointed by RI.

Paragraph 15(a) of the Rules instructs the Panel as to the principles it is to use in determining this dispute:

“A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the auDRP requires the Complainant to prove each of the following three elements:

- (i) the Domain Name is identical or confusingly similar to a name (Note 1), 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 Domain Name (Note 2); and
- (iii) the Domain Name has been registered *or* subsequently used in bad faith.

### **Note 1**

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.

**Note 2**

For the purposes of this policy, auDA has determined that “rights or legitimate interests in respect of the domain name” are not established merely by a registrar’s determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration.

**Identity or confusing similarity**

The Complainant has shown that it has rights in the registered LEAFSCREENER figurative and word marks, Nos. 831484 and 849621, registered respectively on July 7, 2002 and May 19, 2003.

The Domain Name is virtually identical and thus confusingly similar to the word mark since it adds the letters “WA” by way of prefix and the inconsequential 2LD suffix “com.au” which may be ignored.

The Complainant has established this element.

**Legitimacy**

Paragraph 4c of the auDRP provides:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the subject matter of the dispute, your bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that you have acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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, trademark or service mark at issue.

Under the auDA auDRP Overview 1.0, paragraph 2.1:

“A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. The complainant will usually make out a prima facie case by establishing that none of the paragraph 4(c) circumstances are present. Once such a prima facie case is made, the burden of production shifts to the respondent, requiring it to provide evidence or plausible assertions demonstrating rights or legitimate interests in the domain name. If the respondent fails to provide such evidence or assertions, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy ... If the respondent does provide some evidence or plausible assertions of rights or legitimate interests in the domain name, the panel then weighs all the evidence – with the burden of proof always remaining on the complainant”.

The relevant time at which a respondent's rights or legitimate interests in a disputed domain name need to be shown under the auDRP is the time of the filing of the Complaint.

The evidence provided by the Complainant that the ABN BW Harrison & FR Harrison was cancelled in 2012, is sufficient to constitute a prima facie case of absence of rights or legitimate interests on the part of the Respondent. In the absence of any Response, the Panelist concludes that the Respondent has no rights or legitimate interests in respect of the Domain Name.

The Complainant has established this element.

### **Bad faith**

As to registration, it is unclear when the Domain Name was registered. However, this is likely to have been some time during the currency of the ABN, which adopted the trading name WA LEAFSCREENER GUTTER PROTECTION on July 1, 2002. As mentioned, the Complainant's figurative mark was registered on July 7, 2002 and its word mark was registered on May 19, 2003. The Complainant says both marks were applied for in 2000, that the LEAFSCREENER brand has been used extensively since the early 1990s and that the Respondent must have been aware of the LEAFSCREENER marks when it acquired the Domain Name.

However, the Complainant has produced no evidence that the LEAFSCREENER brand, through use, had become distinctive of any of the Complainant's predecessors prior to the applications in 2000 to register either of the marks, nor that after their registration in 2002 and 2003, either mark had become so well known that, whenever the Domain Name was registered, the Respondent must have been aware of those marks or either of them.

It follows that the Complainant has failed to establish that the Respondent registered the Domain Name in bad faith.

As to use, the Domain Name has been used in connection with a gutter protection business in Western Australia. For bad faith to be shown, there must be present some intent on the part of the registrant to take advantage of a complainant's name or mark. There is no evidence of any such intent on the part of the Respondent, nor of Fiona Harrison, who took over the business as part of the divorce settlement.

The Complainant contends that the renewal of the Domain Name registration by Fiona Harrison following cancellation of the registration of the ABN constitutes bad faith.

In *Private Real Estate Pty Limited v Chris Papas* (IAMA Case No. 3665), Panelist Argy noted:

“Paragraph 2 of the Policy provides for the following representation to be made by each applicant for a domain name in the .au space:

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) the statements that you made in your domain name application are complete and accurate, including those as to your eligibility for a domain name in the open 2LD; [*emphasis added*].

... This Panel has consistently expressed the view that a knowing breach of the paragraph 2 warranty at time of renewal should be regarded as a bad faith use of a domain name.”

In the present case there is no evidence from which it may be inferred that Fiona Harrison knowingly breached the paragraph 2 warranty when she renewed the Domain Name following cancellation of the ABN BW Harrison & FR Harrison.

Accordingly, the Panelist is not persuaded that the Domain Name has been used in bad faith.

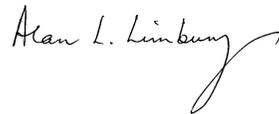
The Complainant has failed to establish this element.

The Panelist notes that this decision does not preclude the Complainant from invoking the auDA 2004-01 - Complaints (Registrant Eligibility) Policy, which sets out the appropriate process to determine the Complainant's contention that the Respondent is ineligible to hold its licence for the Domain Name pursuant to the auDA 2012-04 Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs Sch C, para 2.

## **7. Decision**

The Complainant having failed to establish all three elements required to entitle it to relief, the Panel orders that the Domain Name **<waleafscreeener.com.au>** remain with the Respondent.

Dated this 18<sup>th</sup> day of July, 2020.

A handwritten signature in black ink, reading "Alan L. Limbury". The signature is written in a cursive style with a long, sweeping tail on the final letter.

Alan L. Limbury, Panelist