



ADMINISTRATIVE PANEL DECISION

Uptick Pty Ltd
v.
Robert James Technology Ventures Pty Ltd

auDRP_20_15
<uptick.com.au>

1 The Parties

The Complainant is Uptick Pty Ltd of Abbotsford, Victoria. It is represented in the proceedings by Aidan Lister, a director of the Complainant.

The Respondent is Robert James Technology Ventures Pty Ltd [ACN 122 633 765], a company formerly of Wallsend NSW but deregistered on 2 April 2010. It is unrepresented and filed no Response to the Complaint.

2 The Disputed Domain Name and Registrar

The Disputed Domain Name is <uptick.com.au>. The registrar of the Disputed Domain Name is Netregistry Wholesale 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 and re-issued on 15 April 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”).

A Domain Name Dispute Complaint Form was originally filed with Resolution Institute (RI) on 7 November 2020 naming the Respondent as “Rob Ferguson”. Later that day RI advised the Complainant that the Complaint did not comply with paragraph 3(b) of the Rules, setting out a copy of those requirements. At 9:06 am on 9 November 2020 the Complainant filed “an updated form that ticks off all of the elements listed in your email”. That document also named the Respondent as Rob Ferguson. Having determined that the amended Complaint was also deficient RI invited the Complainant to submit a “rectified

Complaint” with evidence in support of its contentions. A so-called Rectified Complaint still naming Rob Ferguson as the Respondent was filed on 10 November 2020 and apparently deemed compliant by RI. This was forwarded to the Registrar the same day with a request that the registration particulars be confirmed and the Disputed Domain Name be locked. On 12 November 2020 RI received an email from Melbourne IT confirming that “we [Netregistry Wholesale Pty Ltd] are the registrar” and also expressly confirming that “Rob Ferguson is the registrant”. Melbourne IT subsequently advised RI that it had been informed by registry operator Afilias that the Disputed Domain Name had been server locked. auDA and Mr Ferguson were also notified by RI of the Complaint on 12 November 2020.

Under Rule 5(a) a Response was due 20 calendar days after the proceeding commenced. The Rules make no allowance for weekends or public holidays. Under Rule 4(c) the proceeding is taken to have commenced on the date on which RI 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) – in this case, 12 November 2020. Accordingly, the due date for a Response was 2 December 2020.

The email sent to Mr Ferguson by RI erroneously advised that the proceedings were taken to have commenced on “Saturday, 0 January 1900” and that the last date for a Response was also “Saturday, 0 January 1900”. It would have been obvious to any recipient that those dates were incorrect, and clarification could have been sought. The Rules are publicly available on line and the relevant times can easily be calculated. The Panel would have extended the time for a Response to be filed if there was any evidence of confusion. In any event, no Response has been received up to the time of writing these reasons.

RI approached the Panel on 2 December 2020 and, following the Panel’s Declaration of Independence and Statement of Impartiality, the parties were notified of the Panel’s appointment later that day.

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

4 Factual Background

According to Australian Securities and Investment Commission public records the Respondent company having Australian Company Number 122 633 765 was deregistered on 2 April 2010. According to the online Australian Business Register the Australian Business Number 89122633765 was cancelled on and from 16 December 2014¹. In lay terms, the recorded registrant of the Disputed Domain Name has not existed for nearly 11 years. The Registrar should have discovered this before renewing the Disputed Domain Name.

The following additional facts, taken from the Complaint, remain unchallenged:

The Complainant owns the Australian registered trademark UPTICK in classes 9 (which includes computer software), 35 (which includes database management), 37 (which includes provision of online information) and 42 (which includes cloud computing solutions). It was registered for a standard initial term of 10 years from 2 October 2017.

¹ <https://www.abr.business.gov.au/ABN/View?abn=89122633765>

In the month leading up to the filing of the original Complaint Mr Lister twice wrote to Mr Ferguson enquiring about acquiring the Disputed Domain Name and on both occasions Mr Ferguson responded by stating that he was “happy to consider serious offers for any of our domains”.

Up until the second contact with Mr Ferguson by Mr Lister the Disputed Domain Name did not resolve to any website but thereafter was redirected to the website of an organisation called Van Orton whose products appear to include an online trading application called Uptick.

There is no evidence before the Panel of when the Disputed Domain Name was created. This information should have been obtained from auDA before the Complaint was filed.

5 Correct respondent

The WhoIs information accompanying each version of the Complaint clearly showed the registrant to be Robert James Technology Ventures Pty Ltd with Mr Ferguson named as the Registrant Contact as well as the Technical Contact. Given the deregistered status of the Registrant the Panel has determined that it is proper to proceed to determine the Complaint with the correct registrant named as Respondent. Nothing could be gained by requiring the Complainant to serve a copy of the Complaint on the non-existent registrant, especially when the only known means of contact is by email to Mr Ferguson, who in fact was notified of the Complaint on 12 November 2020.

6 Parties’ Contentions

Complainant

The Complainant asks for registration of the Disputed Domain Name to be transferred to it on the basis that:

- (a) The Disputed Domain Name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Disputed Domain Name has been registered or subsequently used in bad faith.

In relation to the first limb of the Policy the Complainant relies on its Australian registered trademark for UPTICK .

In relation to the second limb of the Policy the Complainant notes that the Disputed Domain Name has not been used for at least 4 years until early November 2020 at which time it resolved “to the owner’s personal website”. In support of that proposition the Complainant provided five links to the Wayback Machine² all of which resulted in an error message despite the header indicating that there had been 28 snapshots captured between 28 February 2016 and 25 March 2019.

In relation to the third limb of the Policy the Complainant relies on the same submissions and also provided evidence of written approaches it made to the Respondent enquiring

² www.archive.org

about purchasing the Disputed Domain Name with Mr Ferguson's replies in the terms set out under Factual Background above.

The Complainant also contends that the Respondent is holding the Disputed Domain Name "purely for the purpose of selling, renting or otherwise transferring the domain name registration to another person for valuable consideration in excess of [its] documented out-of-pocket costs directly related to the domain name", thus invoking paragraph 4(b)(i) of the Policy.

Respondent's Response

On 3 December 2020 RI forwarded to the Panel an email that had been sent to it on 24 November 2020 from the same person at Melbourne IT that had sent the "confirmatory" response on 12 November. That email extracted what it described as an email that had been received from Mr Ferguson but did not disclose the date on which it had been sent. The full text of that email (as extracted from Melbourne IT's email) was as follows:

"Hi [*name of Melbourne IT addressee redacted by Panel*],

Uptick's Intellectual Property is currently owned by Van Orton Trading Pty Ltd (ABN: 87 634 715 352).

Van Orton Trading Pty Ltd provides products and services using the Trading Name: Uptick Technology Solutions.

Please find attached the ASIC Record of Registration of Business Name for your reference.

Please let me know if you require any additional information, etc.

KInd regards

Rob Ferguson

m: [*telephone number redacted by Panel*]

w: <https://van-orton.com.au>"

Accompanying the email was a Record of Registration for Business Name for "Uptick Technology Solutions" dated 17 November 2020. The business name holder is recorded as Van Orton Trading Pty Ltd.

No Response has been received from Robert James Technology Ventures Pty Ltd (the registrant of the Disputed Domain Name), nor from any person on its behalf.

7 Discussion and Findings

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

- (i) the Disputed Domain Name is identical or confusingly similar to a name, trade mark or service mark in which it 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 Panel has to decide the case based on the evidence before it, and the Complainant must prove all of the elements of the Policy.

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

The uncontested evidence shows that the Complainant is the registered owner of the Australian trademark UPTICK. Ignoring the 2LD designators “.com.au”, as is appropriate in these cases, the Panel formally finds that the Disputed Domain Name is identical to the registered trademark in which the Complainant self-evidently has rights.

No Right or Legitimate Interest in respect of the Disputed Domain Name

In addition to the submissions contained in the Complaint, which the Panel accepts, it is beyond doubt that, as a company deregistered on 2 April 2010, the Respondent cannot possibly have had any rights or legitimate interests in respect of the Disputed Domain Name at the time of its last renewal, nor subsequently. The Uptick Technology Solutions business name registered by Van Orton Trading Pty Ltd five days after Mr Ferguson had received notice of the Complaint would support a domain name registration by that entity, but that is irrelevant to this proceeding. There is no evidence before the Panel that Van Orton Trading Pty Ltd is a successor in business to the registrant of the Disputed Domain Name and the Panel is unable to make any use of the undated communication from Mr Ferguson to Melbourne IT other than to note that he shares a name is the named Registrant Contact and Technical Contact for the Disputed Domain Name.

There has been no explanation for the Respondent’s failure to file a Response and the Panel infers that, having regard to its deregistration in 2010, whoever has been renewing the Disputed Domain Name since then has sought to create confusion in the hope that the underlying facts might not become known to the Panel. There is also no evidence that there has been a transfer of the Disputed Domain Name from the registrant to any other person, nor evidence of any sale of business from which the Panel might be able to discern some plausible interest.

For the record, there is no evidence before the Panel that could result in the named registrant having any right or legitimate interest in respect of the Disputed Domain Name and the Panel formally finds that it has none.

Registered or subsequently used in bad faith

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

The absence of a Response makes it difficult for the Panel to draw any inference favourable to the Respondent. Given that the named registrant of the Disputed Domain Name has been a company deregistered almost 11 years ago, all renewals of the domain name subsequent to the date of its deregistration have been invalid and in breach of auDA’s relevant policies. To the extent to which the applicant for renewal certified the registrant’s continuing eligibility to renew the Disputed Domain Name, that was plainly a false (if not fraudulent) representation.

Furthermore, the Disputed Domain Name appears to be in use to promote a service squarely within the class of services for which the Complainant has a registered trademark for UPTICK. The Complainant would be entitled to restrain whoever is in fact making use of the Disputed Domain Name to point to a webpage promoting products unlawfully using UPTICK as a trademark. For what it's worth, the 17 November 2020 registration by Van Orton Trading Pty Ltd of the business name Uptick Technology Solutions confers no rights to use the Complainant's UPTICK trademark. The Panel infers that the business name was registered with a view to creating eligibility on the part of Van Orton Trading Pty Ltd to hold the Disputed Domain Name should it become available through a drop catch service or otherwise. The server lock put in place by Afilias on 12 November 2020 has preserved the *status quo* pending the Panel's decision.

Given that there is no evidence before the Panel of when the Disputed Domain Name was first registered the Panel does not know if the Complainant's registered trademark pre-dated or post-dated that date. The Wayback Machine capture dates suggest that it pre-dated the Complainant's trade mark registration. Nevertheless, the evidence is compelling that the Disputed Domain Name is being used in bad faith, with the registration remaining in the name of the non-existent Respondent. That is sufficient for the Panel to find that third limb of the Policy has been made out.

8 Eligibility to hold the Disputed Domain Name

The Complainant has made out to the Panel's comfortable satisfaction all of the three grounds on which it needed to succeed. However, according to paragraph 6.1(b) of the chapeau to the Policy, the Registrar also needs to be satisfied before actioning a transfer order that the Complainant is eligible to hold the transferred domain name. The Complaint does not address this important requirement. In the Panel's view the Complainant is so eligible as the registered proprietor of the UPTICK trademark in Australia.

9 Order

For the foregoing reasons the Panel orders pursuant to Paragraphs 4(i) of the Policy and 15 of the Rules, that the domain name <uptick.com.au> be transferred to the Complainant and that the Registry lock on that domain name be removed to enable that transfer to be effected.

The Panel feels it necessary given the background to warn the Registrar not to process any transfer of the Disputed Domain Name other than to the Complainant. The Registrar also needs to be more diligent in performing its duties under the auDRP – it certainly should NOT be confusing the registrant with the registrant contact. In other jurisdictions the “registrant contact name” is known as the “admin contact”. The Panel encourages Afilias and auDA to revert to that practice.

Dated this 13th day of December 2020

A stylized signature in blue ink, appearing to read 'P Argy'.

Philip N Argy
Panellist