



ADMINISTRATIVE PANEL DECISION

Domain Name Dispute: itnetworksaustralia.com.au

between

IT Networks Pty Limited

Complainant

And

Andrew Warren

Respondent

Resolution Institute reference: auDRP_21_04

PRELIMINARY

1 The Parties

- 1.1 The Complainant is IT Networks Pty Limited (ACN 084 804 473), of 5/20 Enterprise Drive, Bundoora Victoria 3083.
- 1.2 The Respondent is Mr. Andrew Warren, of 15 De Havilland Avenue, Strathmore Heights Victoria 3041.

2 Domain Name and Registrar

- 2.1 The domain name in dispute is *itnetworksaustralia.com.au*, currently registered by the Respondent.
- 2.2 According to the Complaint:
 - the domain name was created on 31 May 2015;
 - the Registrar of the domain name is presently Wild West Domains LLC, whose address is stated on-line as Suite 226, 14455 North Hayden Road Scottsdale, Arizona 85260 USA.

3 Dispute Resolution Provider and Panel

- 3.1 On or about 8 February 2021, the Complainant submitted its Complaint to the Resolution Institute ('RI') for resolution under the Rules of the .au Dispute Resolution Policy ('auDRP'). RI is an independent auDA-approved Provider of dispute resolution services. The Complainant elected to have the dispute determined by a Panel comprising a single member, as provided under paragraph 3(b)(iv) of Schedule B of the Policy.
- 3.2 In its Complaint, the Complainant sought the following remedies with regard to the domain name *itnetworksaustralia.com.au* ('the Dispute'):
- *The domain name password and/or Authcode and/or Authinfo and/or EPP Code (be) provided to me.*
 - *The domain name (be) transferred to my company 'IT Networks'.*
 - *The domain name be registered under my control and company 'IT Networks'.*
- 3.3 By email dated 5 March 2021, RI appointed me, **Robert William Hunt**, as the Panel to determine the Dispute.
- 3.4 On 5 March 2021, I accepted appointment as the Panel to determine the Dispute.

4 Grounds on which the Complaint is Made

- 4.1 In paragraph (ix) of the Complaint, the grounds on which the Complaint is made are stated as follows:
- *Andrew Warren has registered the domain name *itnetworksaustralia.com.au* which has no relation to his actual business name 'Damm Computers' this (is) misleading and deceptive conduct due to similarities with our domain name *itnetworks.com.au**
 - *Customer confusion due to name similarities. We often have suppliers and end users contact the wrong companies due to the name similarities.*
 - *Mr. Andrew Warren **does not hold** the registered business name 'IT Networks Australia' which is required under auDA policy Schedule C.*
 - *I Mr. Kim Pham, Director of IT Networks and ITN Holdings **hold** the registered business name 'IT Networks Australia' [ABN 82 644 552 687] [refer Annexure 4]*
 - *I Mr. Kim Pham, Director of IT Networks and ITN Holdings **hold** the registered business name 'IT Networks' [ABN 27 084 804 604 473] [refer Annexure 6, pages 8-9]*
 - *Mr. Andrew Warren has had the business name IT Networks Australia **cancelled** by the Australian Securities and Investment Commission (ASIC) due to similarities to our business name.*
 - *Mr. Andrew Warren has provided an undertaking to **not** use the domain name *itnetworksaustralia.com.au* in any commercial capacity [refer to Annexure 1, Section 12.]'*

4.2 In paragraph (xi) of the Complaint, the Complainant also states:

'I have had other legal proceedings with the 'Victorian Business Commission' that have been settled. Judgement was that Mr. Andrew Warren ceases to use itnetworksaustralia.com.au in any commercial manner by June 2020. Please refer to

- *Annexure 2a which shows commercial use of domain name itnetworksaustralia.com.au offering 'Domain name Registration services'.*
- *Annexure 2b (which shows) commercial use of domain name itnetworksaustralia.com.au offering 'Web Hosting' services.'*

4.3 Annexure 6 to the Complaint is a written Declaration by Mr. Jim Kay dated 12 September 2019, said to be made under the *Trade Marks Act 1995 (Cth)* and Regulation 21.6 of the *Trade Marks Regulations 1995 (Cth)*.

5 Conduct of the Procedure

5.1 Paragraph 5 of Schedule B to the auDRP requires any Response by the Respondent no later than 20 days after the date of commencement of the administrative proceeding (sub-para (a)). The Provider (RI) may in exceptional circumstances extend the time for a Response (sub-para (d)). No Response was filed by the Respondent and no request was made for extension. In those circumstances, sub-para (e) of paragraph 5 applies, namely *'... in the absence of exceptional circumstances, the Panel shall decide the dispute based on the complaint'*. There being no submission or evidence of any such *'exceptional circumstances'*, I am bound to determine the dispute based on the Complaint.

5.2 I have read and considered all of the material referred to in paragraphs 4.1, 4.2 and 4.3 above in reaching my Determination of this Dispute.

5.3 Paragraph 15(a) in Schedule B to the auDRP provides that the Panel shall *'decide a complaint on the basis of the statements and documents submitted and in accordance with this Policy and any rules and principles of law that it deems applicable'*.

5.4 Paragraph 4(a) in Schedule A to the auDRP provides that a person or entity is entitled to complain about the registration of a domain name where:

- (i) the domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and
- (ii) the respondent to the complaint has no rights or legitimate interests in respect of the domain name; and
- (iii) the respondent's domain name has been registered or subsequently used in bad faith.

That paragraph further provides that, in any such proceeding, the complainant bears the onus of proof.

- 5.5 At the outset, it is necessary to consider whether the sub-paragraphs of paragraph 4(a) in Schedule A of the auDRP are to be read conjunctively or disjunctively. If they are to be read disjunctively, a complainant would only need to prove one of sub-paragraphs (i), (ii) or (iii) whereas, if they are to be read conjunctively, a complainant would need to prove each of sub-paragraphs (i), (ii) and (iii).
- 5.6 Applying settled principles of construction of documents, I am satisfied that sub-paragraphs (i), (ii) and (iii) are to be read conjunctively, more particularly because it would seem contrary to the Policy if a complainant could succeed if it only established that the domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights. I note that this interpretation of paragraph 4(a) in Schedule A of the auDRP is consistent with other published decisions under the auDRP, and is also consistent with decisions published by the WIPO Arbitration and Mediation Centre in respect of disputes under similar rules in the *ICANN Uniform Domain Name Dispute Resolution Policy* (see, for example, *Document Technologies Inc. v. International Electronic Communications Inc.* (Case no. D2000-0370)).
- 5.7 A consistent approach is desirable so that parties using the auDRP can have a high level of confidence that the auDRP will be interpreted in a particular way regardless of the identity of the Panel appointed in a particular dispute.
- 5.8 The remedies which a complainant may seek under the auDRP are set out in paragraph 6.1 thereof, as follows:

'A Complainant may seek to have the domain name licence:

- a) cancelled, in which case the domain name will become available for registration in the normal way; or*
- b) transferred to themselves, but only if the registrar determines that they are eligible to hold the domain name under the relevant policy rules.'*

DETERMINATION

- 6.1 (a) For the reasons set out in more detail in paragraphs 7.1 to 10.3 below,
- (b) having read and considered the submissions and evidentiary material provided by the Complainant, referred to in paragraphs 4.1 to 4.3 above,
- (c) drawing the *Jones v Dunkel* inference adverse to the Respondent from the absence of any contrary submissions and or evidentiary material filed by the Respondent, and
- (d) applying the auDRP and relevant rules and principles of law,

I find that the Complainant is entitled to relief in accordance with the terms of paragraph 6.1 of the .au Dispute Resolution Policy.

- 6.2 The so-called *Rule in Jones v Dunkel* (1959) 101 CLR 298 is that the unexplained failure of a party to call evidence available to it in relation to its case gives rise to an inference that any such evidence would not have assisted its case.

7 Whether the domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant

- 7.1 Decisions published by the WIPO Arbitration and Mediation Centre in respect of disputes under similar rules in the *ICANN Uniform Domain Name Dispute Resolution Policy*, from which the auDRP is derived, have consistently held that, when comparing domain names with marks and other names, the global top level domain elements of a domain name, such as .com or .net have no distinguishing capability and may be disregarded when considering whether a domain name is identical or confusingly similar to a name or mark. These determinations have been cited and approved in a number of other determinations under the auDRP in respect of open second level domains (2LDs), including *GlobalCentre v Global Domain Hosting Pty Ltd* (WIPO Case no. DAU2001-2 - 5 March 2003) and *The State of Tasmania trading as 'Tourism Tasmania' v Craven* WIPO Case no. DAU 2003-0001 - 16 April 2003. Consistent with the principles referred to in paragraph 5.7 above, the Panel adopts those principles for comparing domain names which contain an .com.au element.

- 7.2 The question for consideration under paragraph 4(a)(i) in Schedule A of auDRP is therefore whether '*itnetworksaustralia*' is identical or confusingly similar to '*a name, trademark or service mark in which the complainant has rights*'. As noted in footnote 1 to Schedule A of the auDRP, for the purpose of the 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.'*

- 7.3 The auDRP does not provide guidance as to the intended meaning of '*identical*' or '*confusingly similar*'. However, previous cases have found that '*identical*' can be established by '*essential or virtual identity*' (see *BlueChip Infortech Pty Ltd v. Roslyn Jan and Blue Chip Software Development Pty Ltd* - LEADR case no.06/03). The test of what is '*confusingly similar*' should properly be interpreted in the same manner as the test of '*deceptive similarity*' in trade mark cases, where the concept of '*deception*' contemplates consumers who may be deceived or '*caused to wonder*' about the source or origin of goods or services (see *Camper Trailers WA Pty Ltd. v Off Road Equipment Pty Ltd* - LEADR Case no. 06/04).

- 7.4 Applying the principles referred to in paragraph 7.1 and 7.3 above to the evidence and submissions referred to in paragraphs 4.1 to 4.3 above, the Panel finds that:

- (a) the domain name *itnetworks.com.au* is a '*name*' in which the Complainant has rights;

- (b) the registered business names '*IT Networks*' and '*IT Networks Australia*' are '*names*' in which the Complainant has rights;
- (c) the Respondent has no rights in the registered business name '*IT Networks Australia*' following cancellation by ASIC;
- (d) as stated in paragraph (ix) of the Complaint, '*(w)e often have suppliers and end users contact the wrong companies due to the name similarities*', which the Panel has no difficulty accepting as likely.
- (e) the Complainant has satisfied the requirements of paragraph 4(a)(i) in Schedule A of auDRP, that the domain name *itnetworksaustralia.com.au* is deceptively similar to the Complainant's domain name of *itnetworks.com.au*, and its registered company and business names of IT Networks.

8 Whether the Respondent to the Complaint has any rights or legitimate interests in respect of the domain name

8.1 Paragraph 4(c) in Schedule A of the auDRP sets out, without limitation, various circumstances which may demonstrate a respondent's rights to and legitimate interests in the disputed domain name, as follows:

- (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 and 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.'*

8.2 According to established legal principles, the Respondent bears the evidentiary onus of establishing that it has rights or legitimate interests in respect of the domain name *itnetworksaustralia.com.au*.

8.3 As noted in paragraph 5.1 above no submissions or evidence has been filed by the Respondent, such that the Panel is bound to determine the dispute based on the Complaint. Pursuant to the so-called '*Rule in Jones v Dunkel*', the Panel should properly infer from the failure of the Respondent to call any evidence on these issues where it bears the evidentiary onus that any such evidence would not have assisted its case.

8.4 Applying the principles referred to in paragraph 8.1 to 8.3 above to the evidence and submissions referred to in paragraphs 4.1 to 4.3 above:

- (a) as noted in paragraph 7.4(c) above, the Respondent has no rights in the registered business name *'IT Networks Australia'* following cancellation by ASIC;
- (b) the Respondent has not established that it has any rights or legitimate interests in the domain name *itnetworksaustralia.com.au*, in accordance with sub-paragraphs (i), (ii) or (iii) of paragraph 4(c) in Schedule A of the auDRP, or otherwise;
- (c) the Panel finds that the Respondent has no rights or legitimate interests in respect of the domain name *itnetworksaustralia.com.au*.

9 Whether the Respondent's domain name has been registered or subsequently used in bad faith

9.1 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 and use of a domain name in bad faith'*, which includes:

- '(iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or*
- (iv) by using the domain name, you have 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;'*

9.2 As noted in paragraph 4.2 above, in paragraph (xi) of the Complaint, the Complainant states:

'I have had other legal proceedings with the 'Victorian Business Commission' that have been settled. Judgement was that Mr. Andrew Warren ceases to use itnetworksaustralia.com.au in any commercial manner by June 2020. Please refer to

- Annexure 2a which shows commercial use of domain name itnetworksaustralia.com.au offering 'Domain name Registration services'.*
- Annexure 2b (which shows) commercial use of domain name itnetworksaustralia.com.au offering 'Web Hosting' services.'*

9.3 Annexure 1 to the Complaint is a copy of Terms of Settlement in the Victorian Small Business Commission dated 14 January 2020, which includes:

'12. ITNA will procure that Andrew Warren, by no later than 30 June 2020 does the following:

- (a) deregisters the registered business name IT Networks Australia;*
- (b) ceases commercially using the domain name "itnetworksaustralia.com.au".'*

9.4 The Respondent has filed no evidence or submissions to the contrary such that, applying the principles referred to in paragraphs 5.1 and 5.3 above, and drawing the *Jones v Dunkel*

inference that any evidence available to the Respondent would not assist his case, the Panel accepts Annexures 2a and 2b to the Complaint as evidence of continuing use of the domain name *itnetworksaustralia.com.au* in breach of paragraph 12(b) of the Terms of Settlement.

- 9.5 Annexure 6 to the Complaint is a written Declaration by Mr. Jim Kay dated 12 September 2019, said to be made under the *Trade Marks Act 1995 (Cth)* and Regulation 21.6 of the *Trade Marks Regulations 1995 (Cth)*. That declaration establishes that the Complainant has traded under the name IT Networks since 1995, with an annual turnover between 2014 and 2018 of between \$585,000 and \$994,000, and a projected annual turnover for 2019 of \$1 million. It is apparent that the Complainant has been a major, respected player in the IT field for a considerable period of time, as would reasonably have been known to the Respondent at the time of registration of *itnetworksaustralia.com.au* (30 May 2015).
- 9.6 Having regard to the matters referred to in paragraphs 9.2 to 9.5 above, the Panel accepts that the conduct of the Respondent in registering or using the domain name *itnetworksaustralia.com.au* was:
- conduct within the description of sub-paragraph (iv) of paragraph 4(b) of Schedule A to the auDRP;
 - in bad faith, in breach of sub-paragraph (iii) of paragraph 4 in Schedule A to the auDRP.

DECISION

- 10.1 As indicated in paragraphs 6.1 to 9.6 above, the Panel finds that the Complainant has established each of the three elements required under sub-paragraphs (i), (ii) and (iii) of paragraph 4 in Schedule A to the auDRP, such that it is entitled to relief in accordance with the terms of paragraph 6.1 of the .au Dispute Resolution Policy.
- 10.2 The Complainant appears to satisfy the eligibility requirements for registration of the domain name *itnetworksaustralia.com.au* which are set out in the auDA '*Domain Name Eligibility Allocation Rules for Open 2 LDs (2012-04)*' and '*Guidelines for Accredited Registrars on Interpretation of Policy Rules for Open 2LDs (2005-02)*' .
- 10.3 Accordingly, the domain name *itnetworksaustralia.com.au* should be transferred to the Complainant.

Robert Hunt

Sole Panelist

15 March 2021

