

Domain Names: *www.taboola.com.au*

Name of Complainants: *Taboola.com Ltd*

Name of Respondent: *MM & ZF Pty Ltd*

Provider: *Resolution Institute*

Single Member Panellist: *Dennis Liner*

1. The Parties

- 1.1 The Complainant in this proceeding is Taboola.com Ltd (“the Complainant”).
- 1.2 The Respondent in this proceeding is MM & ZF Pty Ltd 69 611 551 690 (“the Respondent”).

2. The Domain Name, Registrar and Provider

- 2.1 The Domain Name subject to this proceeding is **taboola.com.au** (“the Domain Name”).
- 2.2 The Registrar of the Domain Name is Synergy Wholesale Pty Ltd (“the Registrar”).
- 2.3 The provider in this Proceeding is Resolution Institute of [Suite 602, Level 6, Tower B, Zenith Centre, 821-843 Pacific Highway, Chatswood NSW 2067](#) (“the Provider”)

3 Procedural Matters

- 3.1 This proceeding relates to the complaint submitted by the Complainants in accordance with:
 - (i) the .au Dispute Resolution Policy no.2016-01 published 15 April 2016 (“auDRP”) which includes Schedule A (the Policy) and Schedule B (the Rules);and
 - (ii) the Provider’s supplemental rules for the au Domain Name Dispute Policy.
- 3.2 (i) The Provider was supplied with an ADR Domain Name Dispute Complaint Application Form and Complaint dated 21 April 2021 by way of an email and received

by the Provider on 22 April 2021 (“the Complaint”). The email with the Complaint attached supporting documentation is referred to below.

(ii) On 23 April 2021 the Provider emailed the Respondent a copy of the Complaint and written notification of the Complaint lodged against it and advised that a Response to the Complaint would be due Thursday 13 May 2021. On 13 May 2021 the Provider emailed the parties and confirmed that no Response had been received and advised that a single panellist had been appointed.

(iii) The Provider has not received a Response.

(vi) I find that the making of the Complaint, together with the supporting documentation referred to below comprise all the relevant matters submitted to the Panellist which the Panellist takes into consideration in making this Determination. I have perused the documents and I am satisfied that the service of the documents and the time for service of the documents complies with the Rules.

3.3 The documents supplied by the Complainants were as follow:

Domain Dispute Name Complainant by way of email to which the documents set out below were attached:

- i) Resolution Institute Domain Name Dispute Complaint Application Form dated 21 April 2021 with Complaint attached.
- ii) Annexure 1: Copy of ASIC search of the Respondent.
- iii) Annexure 2: Copy of search results from WHOIS database.
- iv) Annexure 3: Copy email in respect to the commencement of the Domain Name.
- v) Annexure 4: Copy Trade Mark No. 1709455 for “TABOOLA” registered 24 July 2015 (“the Trade Mark”).
- vi) Annexure 5: Copy screenshot capture of landing page of taboola.com.au.

3.4 The Respondent has not filed any Response or reply nor provided any documents

Factual background and submissions

FACTS ALLEGED BY THE CLAIMANT AND SUBMISSIONS

4.1 The Complainant is the owner of the Trade Mark described on 3.3 (v) above and the Domain Name is identical to the Complainant’s name and to this Trade Mark.

4.2. The Complainant has traded under the name of Taboola.com Ltd and has been using the Trade Mark “TABOOLA” since February 2007.

- 4.3. The Respondent was registered with ASIC on 29 March 2019 and the Domain Name was registered on 14 May 2019, both being some years after the Complainant was using the name “Taboola” and after the Trade Mark had been registered.
- 4.4. An internet search of the Domain Name resolves to an interface that has a login screen which does not mention the Complainant’s name, or anything related to Taboola. The name “Fonik” which is stated on the screen does not seem to be associated with any business and it appears inactive.
- 4.5. The Respondent had no rights or legitimate interests in respect of the Domain Name for the following reasons:
- (i) the Respondent is not commonly known by the name “TABOOLA” as this name is commonly known as the name of the Complainant and its affiliates, is known in respect to the goods and services in the relevant classes of the Australian Trade Mark register and not known to be used by any other parties;
 - (ii) the name does not reflect any distinctive feature of the Respondent’s business, the Respondent owns no goodwill in the Complainant’s name, has no registered rights in the Trade Mark, the Complainant has not given any rights to the Respondent in respect to the Trade Mark and the Respondent cannot acquire any rights thereto;
 - (iii) upon logging in to the Domain Name there is no evidence that it is being used to offer goods and services;
 - (iv) the Domain Name is not a logical domain name used by the Respondent for a “Fonik” log in, but the Domain Name is the logical domain name of the Complainant in respect to its business in Australia.
- 4.6. The Respondent registered the Domain Name in bad faith as:
- (i) the Respondent’s registration of the Domain Name confuses the ownership and sponsorship of the Domain Name and the whether the Complainant is affiliated with the Respondent, as users may enter the Domain Name site without realising that it was not the Complainant’s site.
 - (ii) it is inconceivable that the Respondent registered the Domain Name without actual and/or constructive knowledge of the Complainant’s rights in the Trade Mark as the Respondent registered the Domain Name after the Complainant registered the Trade Mark in Australia, the Domain Name is identical to the Trade Mark, the international use of the name overseas since 2007 and in Australia since 2015 and the fame and success of the Complainant

FACTS ALLEGED BY THE RESPONDENT AND SUBMISSIONS

- 5.1 The Respondent has not alleged any facts or submissions in response to the Application.

6 Jurisdiction

6.1 Paragraph 2.1 of the auDRP states:

“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.”

6.2 The Domain Name, being “com.au”, is an open 2LD within the scope of the aforementioned paragraph. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP

6.3 In registering the Domain Name the Respondent became subject to the Policy and the Rules in respect to any dispute in regard to the Domain Name, and in registering the Domain Name under the .au process, it has agreed to be so bound. Accordingly, the panel finds that pursuant to the Policy and the Rules it has jurisdiction to determine the Complaint in respect to the Domain Name.

7 Basis of Decision

7.1 Paragraph 15(a) of the Rules state:

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

7.2 Paragraph 4(a) of the Policy provides that a person is entitled to complain about the registration or use 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.

It is noted that **all three** components of Paragraph 4(a) are required to be proven for any Complaint to be upheld.

- **Domain Name is identical and confusingly similar to names or Trade Marks in which the Complainant has rights.**

The Complainant contends that the Domain Name is identical to the Trade Mark of the Complainant.

The Respondent does not contest this.

The Panel finds that upon considering the submissions of the Complainant and upon viewing Annexure 4 the Domain Name is identical or confusingly similar to the business name in which the Complainant has rights. Accordingly, I find that Paragraph 4(a) (i) is satisfied.

- **Respondent has no rights or legitimate interests in respect of the Domain Name**

The Respondent takes no issue or contests the contents of paragraph 4.1 to 4.5 inclusive hereof.

Pursuant to Schedule A of auDRP the Respondent is required to demonstrate its rights or legitimate interests in respect to the Domain Name by inter alia, any of the following:

- *before any notice to the respondent of the subject matter of the dispute, the respondent's bona fide use of, or demonstrable preparations to use, the domain name or a domain name corresponding to the domain name in connection with an offering of goods or services(not being the offering of domain names that it has acquired for the purpose of selling, renting or otherwise transferring); or*
- *the respondent (as an individual, business, or other organisation) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or*
- *the respondent is 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.*

Upon evaluating all the evidence provided to me and considering the facts and submissions as set out above, I find that the Respondent has not demonstrated any of these matters. Accordingly, I find that paragraph 4(a)(ii) is satisfied.

- **The Domain Name was registered or was subsequently used in bad faith**

The Complainant has made detailed submissions in respect to this matter as contained in paragraph 4.6 hereof and the Respondent does not take issue or contests the contents thereof.

Pursuant to Schedule A of auDPR the following circumstances, inter alia, shall be evidence of the registration and use of a domain name in bad faith:

- (i) *circumstances indicating that the domain name has been registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for a profit; or*
- (ii) *the registration of the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or*
- (iii) *registering the domain name primarily for the purpose of disrupting the business activities of another person; or*
- (iv) *using the domain name to intentionally attempt 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.*

The Complainant relies upon the contention that paragraphs (ii), (iii) and (iv) apply. The Respondent does not contest this. Furthermore, it would seem that the Respondent either expressly or impliedly warranted to the Registrar at the time of registering the DomainName that It had a right to use the Domain Name. The Policy considers bad faith to be if any representations or warranties as to eligibility or third party rights given upon application are false in any manner. Upon this basis and upon the submissions of the Complainant and evidence supplied I find that evidence bad faith substantiated. I therefore find that paragraph 4 (a)(iii) is satisfied.

8. Decision.

- 8.1 As I have found that as all elements of 4(a) have been proven, the Complainant is substantiated.
- 8.2 Accordingly, for the above reasons, I direct that the Domain Name be transferred to the Complainant.

Dated 24 May 2021

Dennis Liner.

Panellist