



ADMINISTRATIVE PANEL DECISION

MW Toolbox Manufacturing (Vic) Pty Ltd

v

Edward Enayah

auDRP_21_08

<toolboxcenter.com.au>

1 The Parties

The Complainant is MW Toolbox Manufacturing (Vic) Pty Ltd of Clayton, Victoria. It is represented in the proceedings by Mr Jeremy Hunter of Williams Winter, Solicitors, in Melbourne, Victoria.

The Respondent is Mr Edward Enayah of Prestons, NSW. He is self-represented.

2 The Disputed Domain Name and Registrar

The Disputed Domain Name is <toolboxcenter.com.au>. The registrar of the Disputed Domain Name is Web Address Registration 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 filed with Resolution Institute (**RI**) on 6 May 2021. This was forwarded to the Registrar on 13 May with a request that the registration particulars be confirmed, and the Disputed Domain Name be locked. On the same day RI received an email from the Registrar confirming the accuracy of the named registrant and contact particulars and advising that the Disputed Domain Name had been server locked. auDA and Mr Enayah were also notified of the Complaint on the same day.

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, 13 May 2021. Accordingly, the last date for filing a Response was Thursday 2 June 2021. That afternoon RI received an email from Mr Enayah in response to RI’s email noting that, absent a Response to the Complaint, the matter was proceeding to Panel appointment. Mr Enayah’s email simply stated:

I am away on my honeymoon I will return friday to address your email

Then, in a second email, later the same afternoon, Mr Enayah said:

I'm still not sure what this is all about, what is the problem with MW toolboxes, what do they want exactly? They have an issue with my domain www.toolboxcenter.com.au

We are a toolbox center [*sic*] that provide [*sic*] products for toolboxes and Utes. What's there [*sic*] problem.

RI advised Mr Enayah that in the circumstances he could request an extension of time to file his Response.

Following non-receipt of a formal Response, RI approached the Panel and, following the Panel’s Declaration of Independence and Statement of Impartiality, the parties were notified of the Panel’s appointment on 2 June 2021. Neither RI nor the Panel has received any communication from Mr Enayah since his 2 June emails referred to above. The Panel is mindful that restrictive Emergency Orders have been in place in Melbourne but would have expected some communication if Mr Enayah needed an extension of time to prepare a Response whether for that reason or by reason of just having returned from his honeymoon.

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

4 Factual Background

The Complainant is a manufacturer of “ute toolboxes”, canopies, vehicle-mounted tents as well as camping and other trailers and related products.

According to the evidence provided by the Complainant, on 19 November 2003 the domain name www.toolboxcentre.com.au (the **Centre Domain Name**) was first registered. It presently resolves to a website on which is prominently depicted the following logo (the **Trade Mark**):



The Disputed Domain Name was first registered on 30 March 2015.

On 6 May 2021 the Complainant became the registered proprietor of the business name “Toolbox Centre” (the **Business Name**).

5 Parties’ Contentions

Complainant

The Complainant asserts only that:

- a) the Disputed Domain Name is identical or confusingly similar to the Business Name and the (unregistered) Trade Mark; and
- b) the Disputed Domain Name “has been registered or subsequently used in bad faith”.

In support of the first of those grounds the Complainant submits:

1. The Disputed Domain Name is identical to the Business Name with the exception of the misspelling of the word “centre” which has been slightly modified to “center”;
2. the Disputed Domain Name is regarded as a misspelling in accordance with section 4.2 of the auDA Prohibition on Misspellings Policy as it is the same as the Centre Domain Name with a transposed letter.
3. The Disputed Domain Name also contains substantially identical or deceptively similar words to the Trade Mark with the exception of the misspelling of the word “centre”.

In support of the second ground the Complainant submits:

4. The circumstances indicate that the Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business activities of the Complainant. Specifically, it says that the Centre Domain Name was first registered on 19 November 2003 and the Complainant’s business has operated since about 1999.
5. The Disputed Domain Name was first registered on 30 March 2015. The Respondent operates a competing business trading under the name “Tools In A Box” selling the same goods as those of the Complainant. The Disputed Domain Name redirects to a third domain name: <toolsinabox.com.au> (the **Respondent’s Domain Name**).
6. By using the Disputed Domain Name the circumstances indicate that the Respondent has intentionally attempted to attract for commercial gain Internet users to its website, by creating a likelihood of confusion with both the Business Name and the Centre Domain Name or the Trade Mark as to the source, sponsorship, affiliation, or endorsement of that website or location of a product or service on that website or location. Whilst not cited, the Panel assumes that by this submission the Complainant is intending to invoke paragraph 4(b)(iv) of the Policy.
7. The Complainant’s business has a well-established reputation in its industry. The Respondent is in breach of the common law principles of passing off as his use of the Disputed Domain Name is a misrepresentation to consumers that his business is endorsed by, affiliated [with] or sponsored by the Complainant’s business. The

Complainant receives regular reports from customers and suppliers who are mistaken that the Respondent's business is affiliated with the Complainant's business.

The Complainant seeks the remedy of transfer of the Disputed Domain Name to itself, or cancellation of the Disputed Domain Name.

6 Respondent's Response

No formal Response has been submitted. However, the Panel does have the Respondent's emails of 2 June 2021 quoted in section 2 above.

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 Panel has to decide the case based on the available evidence, and the Complainant must prove all of the elements of the Policy at least on the balance of probabilities.

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

The Complainant became the registered owner of the Business Name on the day that the Complaint was lodged.

Under this limb of the Policy the exercise is essentially one of comparing character strings and no account is taken of the content of any website nor of the dates on which the rights relied upon by the Complainant accrued. Also, the "www" and the ".com.au" are ignored for the purposes of this comparison unless they are demonstrably relevant.

If the Australian and the American spellings of the word Centre are treated as the same it may be possible to regard the Disputed Domain Name as identical to the Centre Domain Name. However, despite the prominence of the Centre Domain Name in the logo depicted above, the Panel is not prepared to find that the Disputed Domain Name is identical or confusingly similar to the Trade Mark. This is because of the greater prominence of both "MW" and the telephone number, as well as the representation of Australia.

However, there is no evidence that the Complainant has any rights in the Trade Mark or the Centre Domain Name. A simple check of the WhoIs record shows that the Complainant is not (and apparently never has been) the registrant of the Centre Domain Name:

Domain Name: TOOLBOXCENTRE.COM.AU
Registry Domain ID: D40740000002297510-AU
Registrar WHOIS Server: whois.auda.org.au
Registrar URL:
Last Modified: 2019-10-19T00:10:48Z
Registrar Name: Netregistry Pty Ltd
Registrar Abuse Contact Email:
Registrar Abuse Contact Phone:
Reseller Name:
Status: serverRenewProhibited <https://afilias.com.au/get-au/whois-status-codes#serverRenewProhibited>
Status Reason: Not Currently Eligible For Renewal
Registrant Contact ID: TPP64138-R
Registrant Contact Name: John Zhang
Registrant Contact Email: Johnzhang@toolboxcentre.com.au
Tech Contact ID: TPP64139-C
Tech Contact Name: David Xu
Tech Contact Email: xuminxu@hotmail.com
Name Server: NS3.MWTOOLBOXES.COM.AU
Name Server IP: 103.21.128.132
Name Server: NS4.MWTOOLBOXES.COM.AU
Name Server IP: 103.21.128.133
DNSSEC: unsigned
Registrant: M W Sheet Metal PL
Registrant ID: ABN 42071608814
Eligibility Type: Registered Business

>>> Last update of WHOIS database: 2021-06-13T11:11:54Z <<<

According to the Australian Business Register, M W Sheet Metal PL is a trading name of MW Sheet Metal Pty Ltd, as to which see the Panel’s additional comments below. Furthermore, the website to which the Centre Domain Name resolves includes the claim “© MW Toolbox Trailer Manufacturing”. No such entity appears on the Australian Business Register although there are many which include those words in that order which the Panel infers may have some corporate relationship with the Complainant. In any event, the evidence available to the Panel not only does not support the Complainant’s claim to have rights in the Centre Business Name and the Trade Mark, it is all to the contrary.

Accordingly, the Panel can only find formally that the Disputed Domain Name is confusingly similar to the Business Name in which the Complainant has the barest of rights based solely on the registration which it acquired on the day the Complaint was filed¹. This is because the words “toolboxcenter” in the Disputed Domain Name are the same as the Business Name save for the removal of spaces between the words and the use of the American spelling of “centre”.

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

The Complainant makes no submission in relation to the second limb of the Policy. Nor does it present any evidence from which the Panel could make a finding in its favour on this limb of the Policy. If forwarding of the Disputed Domain Name to the Respondent’s Domain Name was intended to support a submission under this limb of the Policy it is not apparent to the Panel how such a submission can be made, especially when the Complaint does not even cite this limb of the Policy as a ground on which the Complaint is brought, as required by paragraph 3(b)(ix) of the Rules.

¹ See footnote 1 to paragraph 4(a)(i) of the Policy

To the extent to which the Complainant relies upon the Prohibition On Misspellings Policy the Panel notes that a registered business name is expressly excluded from the definition of “entity name” in paragraph 2.1(a) of that policy. In any event the Panel draws the Complainant’s attention to paragraph 3.4 of that policy.

A more fruitful avenue of enquiry for the Complainant and its advisors might be auDA’s new Licensing Rules which came into force on 12 April 2021 (for domain names first registered or renewed after that date) but it would not be appropriate for the Panel to say anything further in that regard.

Of course the words TOOLBOX and CENTRE are ordinary English words. To the extent to which the Respondent is selling goods and services in respect of which those words might be apposite, as appears to be the case from his second email of 2 June 2021, it is all but impossible for the Panel to find in favour of the Complainant on this limb of the Policy.

Registered or subsequently used in bad faith

According to the publicly available elements of the ASIC register the Complainant was incorporated as “MW MANUFACTURING (VIC) PTY LTD” on 18 December 2017 but adopted its current name, with the addition of TOOLBOX, about a month later on 23 January 2018.

Self-evidently the registrant of the Centre Domain Name at the time of its first registration cannot have been the Complainant, which was not incorporated for another 14 years. And, as indicated above, it is not the current registrant either. According to the Wayback Machine² the Centre Domain Name in late 2004 resolved to a website purporting to be operated by an entity styled MW Sheet Metal Pty Ltd. According to the Australian Business Register that entity owned the business name MW TOOL BOX from 10 July 2008 until it was cancelled on 10 October 2011. With a scintilla of evidence the Panel may have been able to infer if not find some corporate relationship between that early user of the Centre Domain Name and the Complainant, but none has been provided. It is not for the Panel to make out a case where the Complainant has failed to do so. The identity of the initial registrant of the Centre Domain Name cannot be determined from the evidence available to the Panel, although the Panel suspects it was the current registrant, MW Sheet Metal PL.

The Complainant has also provided no evidence which would enable the Panel to determine whether and, if so, when, it ever used the Trade Mark although something similar to the logo also appears on the 2004 and subsequent renditions of the original website referred to above.

The Panel is most concerned that the Complainant either intentionally or inadvertently sought to create the impression that the Respondent registered the Disputed Domain Name in 2015 in circumstances where the Complainant had been using the Business Name, the Centre Domain Name and the Trade Mark for some 12 years. That is simply false.

The Wayback Machine has captured a 2 July 2005 snapshot of the original website referred to above containing the following photograph:

² www.archive.org



That plainly evidences use of the words MW TOOL BOX on business premises at that time. However, there is no evidence to link that usage with the Complainant which, as noted above, was not even incorporated until November 2017 - two years after the initial registration of the Disputed Domain Name.

There is no submission from the Complainant that, vis-à-vis the operator of the business depicted in the photograph or operating the original website, the Respondent registered the Disputed Domain Name primarily for the purpose of disrupting the business activities of that person, which might arguably fall within paragraph 4(b)(iii) of the Policy. Even if there were such a submission there is no evidence that the Respondent was the initial registrant of the Disputed Domain Name and no evidence of what use was made of the Disputed Domain Name at that time.

Whatever suspicion the Panel might have about what the Respondent did and when, or for what purpose, the evidence available to the Panel falls way short of what would be required to make any findings in favour of the Complainant under this limb of the Policy.

The Panel finds that there is no evidence to support any finding of bad faith registration or subsequent use of the Disputed Domain Name on the part of the Respondent.

8 Order

The Complainant has failed to prove two out of the three limbs of the Policy which it is required to prove under paragraph 4(a) of the Policy. Accordingly the Panel orders, pursuant to paragraphs 4(i) of the Policy and 15(a) of the Rules, that the Complaint be dismissed and that the Registry lock on the Disputed Domain Name be removed.

Dated this 13th day of June 2021

P Argy

Philip N Argy
Panellist