



## ADMINISTRATIVE PANEL DECISION

**Tony & Monika Rahme**

v

**Paul & Sharyn White**

**LEADR Case No.**

**Domain Names:** **greenerydesign.com.au**  
**Name of Complainants:** **Tony & Monika Rahme**  
**Name of Respondents:** **Paul & Sharyn White**  
**Provider:** **LEADR**  
**Panel:** **Anthony P. Alder**

### 1. THE PARTIES

- 1.1 The Complainants are **Tony & Monika Rahme** (“TMR”).  
The Respondents are **Paul & Sharyn White** (“PSW”).

### 2. THE DOMAIN NAMES AND PROVIDER

- 2.1 The current dispute is regarding the domain name greenerydesign.com.au (“the Domain Name”) currently recorded in the name of the Respondents.
- 2.2 The provider in relation to this proceeding is LEADR (“Provider”).

### 3. PRELIMINARY MATTERS

- 3.1 Schedule A of the *.au Dispute Resolution Policy* (“auDRP”) applies to disputes which meet the requirements set out in Paragraph 4(a) of Schedule A of the auDRP. This subparagraph 4(a) requires that any party holding a domain name licence “...*submit to a mandatory administrative proceeding in the event that a third party* (a “Complainant”) *asserts to the applicable Provider, in compliance with the Rules of Procedure that:*

- (i) [their] domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
  - (ii) [they] have no rights or legitimate interests in respect of the domain name; and
  - (iii) [their] domain name has been registered or subsequently used in bad faith.
- In an administrative proceeding, the complainant bears the onus of proof.”*

#### **4. PROCEDURAL HISTORY**

- 4.1 The Procedural History in this matter is set out in Annexure A.
- 4.2 LEADR has appointed this Panellist as the sole panellist in the matter. The Panellist has had no prior knowledge of or association with either party and has no conflict of interest.
- 4.3 All procedural requirements appear to have been satisfied. The Panel has been properly constituted.
- 4.4 Paragraph 15(a) of the auDRP Rules states:  
*“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy [the auDRP Policy], these Rules and any rules and principles of law that it deems applicable”.*

#### **5. FACTUAL BACKGROUND**

- 5.1 During the 1990's, Greenery Designs was a chain of franchises operating in South East Queensland selling and distributing artificial plants. During this time, the business was operated by Mr Peter Fair and included: a business named Greenery Designs, which operated as a retailing division and included at least several franchisees; and a wholesaling business named Greenery Imports.
- 5.2 The Respondents entered into a “preferred agency agreement” in about 1997 to 1998 which licensed the use of the name 'Greenery Designs' to them. The original executed agreement between Mr Peter Fair and the Respondents was lost or destroyed in a flood in 2005. However, Mr Peter Fair submitted his standard version of the agreement and stated, in an affidavit, that the agreement with the Respondents was substantially identical to the submitted agreement except for the parties.
- 5.3 The Respondents began using the business name SHARYN'S GREENERY DESIGN in or about December 1998. The business name was registered in Queensland on 18 May 1998.

- 5.4 In 2000, the Respondents terminated said agreement with Mr Peter Fair and were required to cease using the licensed name “Greenery Designs” within 6 months of the termination of contract. The Respondents subsequently changed their primary operating name to SGD Importers in compliance with said agreement. However they continued trading under the name Sharyn's Greenery Design.
- 5.5 Mr Peter Fair sold the businesses named Greenery Designs and Greenery Imports to unnamed successor who then subsequently sold the businesses and rights pertaining to the said businesses to TMR.
- 5.6 The Domain Name was registered on 24 February 2000 and was subsequently amended to record the current Respondent's names on 30 June 2009.
- 5.7 The Complainant has obtained: Trade Mark Registration 1245340 for GREENERY DESIGNS – THE ARTIFICIAL PLANT SPECIALISTS and LOGO applied for on 10 June 2008; the domain name registration GREENERYDESIGN.COM.AU; and the Queensland Business Name BN4774248 GREENERY DESIGNS registered on 25 January 1993.
- 5.8 Both the Complainants and Respondents operate their businesses in South East Queensland and there has been multiple documented instances of confusion because of the similarity of names and domain names.
- 5.9 Both the Complainants and Respondents sell and distribute artificial plants in the market for several years.
- 5.10 The domain name, trade marks and names relating to ARTIFICIAL PLANT SPECIALISISTS do not form part of this decision and has been excluded from consideration.

## **7. DISCUSSION AND FINDINGS**

### **Elements of a successful complaint**

- 7.1 According to Paragraph 4(a) of the auDRP Policy, 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, trademark 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.*

7.2 It is to be noted that the three elements of a complaint under Paragraph 4(a) of the auDRP Policy are cumulative; all of them must be proved if the complaint is to be upheld.

7.3 In these administrative proceedings, the Complainant bears the onus of proof regarding each of the separate components required by Paragraph 4(a) of the auDRP Policy.

**Is the Domain Name identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights?**

7.4 The Panel must determine whether, on the basis of the facts set out in Paragraph 4 above, the Complainants have rights in a relevant name, trade mark or service mark.

7.5 The auDRP Policy states:

*“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;*

*(b) The complainant's personal name.”*

7.6 The Domain Name is confusingly similar to the business name GREENERY DESIGNS being used by the Complainants; and at least a prominent proportion of the Trade Mark Registration 1245340.

7.7 The Complainants have the legitimate rights to use the name GREENERY DESIGNS accumulated from the heritage of use from Mr Peter Fair dating back to at least 1993 based on the use of the business name.

7.8 On the balance of material presented to the Panel, the Panel determined that there is the real potential, and the actuality of confusion of identity in this proceeding.

7.9 The Panel notes that TMR registered trade mark rights relate to the unique combination of the words GREENERY DESIGNS – ARTIFICIAL PLANT SPECIALISTS & logo and not simply the term GREENERY DESIGNS.

7.10 The Complainants in these proceedings bears the onus of proving the requirements and ownership under auDRP. Accordingly, the Panel determines that the Complainant has satisfied the requirement of Paragraph 4(a)(i) of the auDRP Policy.

7.11 Please note that the Panel considers the terms GREENERY DESIGN and GREENERY DESIGNS to be substantially identical and confusingly similar.

**Does the Respondent have any rights or legitimate interests in respect of the Domain Name?**

- 7.12 Paragraph 4(c) of the auDRP Policy sets out particular circumstances (without limitation), which can demonstrate a Respondent's "*rights or legitimate interests to the domain name for purposes of Paragraph 4(a) (ii).*"
- 7.13 The Respondents has not demonstrated their activities fall within the scope of the specified activities enumerated in Paragraph 4(c) of the auDA Policy for providing a basis for bona fide use of the domain name.
- 7.14 The Respondents have shown that they have used SHARYN'S GREENERY DESIGN since December 1998. They have submitted little evidence to refute the assertions set out in the statutory declaration of Mr. Peter Fair and is not convincing. The Panel accepts the Complainants submissions that the Respondents entered into a preferred agency agreement with Mr Peter Fair and that this lead to commencement of the Respondents usage of "Sharyn's Greenery Design".
- 7.15 The Respondents were well aware of the confusion between their business activities and the activities of Mr Peter Fair and/or the Complainants. The Respondents acknowledge Mr Peter Fair in their evidence (Attachment PSW-6).
- 7.16 The standard preferred agency agreement includes provisions relating to the preferred agent ceasing to use the trade mark (i.e. GREENERY DESIGNS) and that they must not register the trade mark as a business name. The agreement also sets out terms of preferred usage of the trade mark by the preferred agents. The Respondents according to the agreement had no legitimate right to apply for the business name including GREENERY DESIGN, and had no right to register the domain name without authorisation.
- 7.17 Accordingly, the Panel finds that the Respondents do not have a legitimate interest to the domain name, and so Paragraph 4(a)(ii) of the auDRP Policy has been satisfied by the Complainant.

**Has the Domain Name been registered or subsequently used in bad faith?**

- 7.18 Paragraph 4(b) of the auDRP Policy sets out circumstances of "*evidence of the registration and use of a domain name in bad faith*". This Paragraph contains four sets of example circumstances, any one of which, if established, can constitute evidence of

registration in bad faith. It is important to note also that it is a non-exhaustive list of circumstances such that, for example, the Panel is not necessarily constrained from a finding of bad faith should it arise (also by example) from not only any one or other of them, but from a combination of them, or indeed, upon the basis of other reliable material before the Panel inclusive of the illustrated list.

- 7.19 The Panel determination of whether “bad faith” occurred in this case is focused on several key issues: the demand from the Respondent's to transfer the domain name for \$15000, which is well in excess of the costs of registration or maintaining the domain name; and that the Domain Name currently resolves to <http://www.sgpimporters.com.au/index.php>, which is the website of the Respondents main business venture.
- 7.20 The Panel notes the considerable confusion caused by the registration of the Domain Name in misdirecting web traffic. The Respondents seem to have acted in a manner to increase the confusion.
- 7.21 The Panel is satisfied that there is sufficient evidence for a finding with respect to Paragraph 4(b)(i) of the auDRP Policy. In the Panel’s view, the onus of proof of this requirement rests with the Complainant and the Complainant has failed to establish the requirements of Paragraph 4(a)(iv) of the auDRP Policy.

## **9. DECISION**

- 9.1 The Panel concludes for the reasons stated that:
- (a) the Domain Name is confusingly similar to business name, and partially the trade mark of TMR. The Complainants have demonstrated that they have legitimate rights to GREENERY DESIGNS.
  - (b) the Respondents do not seem to have a legitimate right in the domain name; and,
  - (c) the Complainants have shown that the Respondent acted in bad faith by registering the Domain Names and their subsequent actions.
- 9.2 For the reasons outlined, the Complainant has satisfied the elements of Paragraph 4(a) of the auDRP Policy.

**10. RELIEF**

**Transfer of the Domain Name**

10.1 The Panel orders that the Domain Name be transferred to the Complainant.

Dated this 25<sup>th</sup> day of August 2009

**Anthony P. Alder**

Sole Panellist

## Annexure A

### Procedural History

[www.greenerydesign.com.au]

1. The complaint was submitted for decision in accordance with the (auDRP) Policy and Rules, which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplementary Rules (LEADR is the Provider).
2. The complete application was received from the Complainant by LEADR on 22-Jul-09
3. On the 22-Jul-09 LEADR faxed to the Respondent a dispute notification letter.
4. On 22-Jul-2009 LEADR contacted by the Respondent via phone and confirmed that the application had been received by post.
5. A copy of the application and a copy of the dispute notification letter were also posted to the registrar **PlanetDomain** on 22-Jul-09.
6. LEADR advised auDA of the complaint on 22-Jul-09 via e-mail.
7. The response was due on 11-Aug-09. A response was received by that date.
8. On 11-Aug-09 the provider approached the Panellist. The panellist confirmed his availability, informed LEADR that they had no conflict issues with the parties and accepted the matter on 11-Aug-09
9. The Panellist was informed on 12-Aug-09 that the package was being sent for Adjudication.