

ADMINISTRATIVE PANEL DECISION

Migration Solutions Pty Ltd v Han Chung Lee Trading As Australasia Migration Solutions

LEADR Case No. 02/06

1. THE PARTIES

- 1.1. The Complainant in this administrative proceeding is Migration Solutions Pty Ltd (ACN 086 722 607) of Level 1, Market Plaza, 61-63 Grote Street, Adelaide, South Australia, 5000.
- 1.2. The Respondent is Han Chung Lee trading as Australasia Migrations Solutions of PO Box 1197, North Adelaide, South Australia, 5095.

2. THE DOMAIN NAMES AND REGISTRAR

- 2.1. The Disputed Domain Name is migrationsolutions.com.au.
- 2.2. The Registrar of the Disputed Domain Name is NetRegistry.

3. PROCEDURAL HISTORY

- 3.1. The Panel is advised that the procedural history of this dispute is as follows:
 - (a) The complaint was submitted for decision in accordance with the Policy (auDRP) which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplemental Rules (LEADR is the Provider).
 - (b) On 15 February 2006, a complaint for the domain name migrationsolutions.com.au was received by LEADR.
 - (c) On 15 February 2006, LEADR notified the Registrar, NetRegistry, of the complaint and requested the Disputed Domain Name be locked by email.
 - (d) On 15 February 2006, LEADR posted a Notification Letter and copy of the Complaint to the Respondent by post.
 - (e) On 7 March 2006, LEADR received a response from the Respondent.
 - (f) On 9 March 2006 the Complaint and the Response was received by the Panelist.

4. FACTUAL BACKGROUND

- 4.1. The following factual background is based on the information in the documents provided to the Panel by the Complainant and Respondent.
- 4.2. The Complainant became incorporated as a company, Funke Pty Ltd, on 16 March 1999.
- 4.3. On 17 September 2003 the Complainant changed its name to Migration Solutions Pty Ltd. Since that date the Complainant has been carrying on the business of a migration consultancy service using that name.
- 4.4. The Respondent registered the Business Name Australasia Migrations Solutions on 10 October 2003 with the South Australian Business Registry for a migration consultancy business.
- 4.5. On 16 December 2003 the Respondent registered the Disputed Domain Name with NetRegistry.
- 4.6. On 1 July 2004 the Complainant lodged Australian trade mark application number 1009106 for a device containing a stylised map of Australia and the words "Migration Solutions" for services in class 42. The registration was granted on 14 June 2005, taking effect from 1 July 2004. It is not clear from the material submitted by the Complainant which class 42 services were specified on the trade mark registration, but that is not relevant for the purposes of determining this dispute.
- 4.7. Some time between 16 December 2003 and 17 February 2005 the Respondent launched a website using the Disputed Domain Name to advertise his migration consultancy business. The material submitted by the parties does not state when the website was launched. The Respondent also uses the Disputed Domain Name for email purposes.
- 4.8. On 17 February 2005 at 5.37pm Mr Mark Glazbrook of the Complainant contacted the Respondent by email regarding the Disputed Domain Name. Mr Glazbrook's email included a statement that some of his customers were confused by the Respondent's use of the Disputed Domain Name, and as a result they were inadvertently accessing the Respondent's website in the belief that it was the website of the Complainant.
- 4.9. In February 2005 and December 2005 the parties engaged in negotiations by email during which Mr Glazbrook requested that the Respondent transfer the Disputed Domain Name to the Complainant. There was some discussion about the amount of

monetary compensation that the Complainant was prepared to pay to the Respondent but no agreement was reached.

4.10. In December 2005 the Respondent removed his website from the internet. The Respondent states that the reason for this removal was to investigate and rectify attacks on his website that had occurred regularly during 2005. The Complaint states that as at 15 February 2006 the Respondent's website had not been reinstated. The Respondent has given no indication of when the website is likely to return online but has stated that it will only be "temporarily" offline.

5. THE PARTIES' CONTENTIONS

The Complainant

5.1. The Complainant makes the following contentions:

- (a) The Disputed Domain Name is identical to the Complainant's name and trademark;
- (b) The Respondent has no rights or legitimate interests in the Disputed Domain Name;
- (c) The Respondent's registration of the Disputed Domain Name has misled consumers and wrongly diverted business to the Respondent's website;
- (d) The Respondent's Disputed Domain Name has been registered or subsequently used in bad faith; and
- (e) The Respondent has breached the Registrar's terms and conditions for domain name licensing, including representations, undertakings and warranties made by the Respondent that:
 - i) all information provided is true and correct; and
 - ii) the registration of the Disputed Domain Name will not infringe upon or otherwise violate the rights of any third party.
- (f) The Complainant meets auDA's Domain Name Eligibility and Allocation Rules for .com.au domain names ("Eligibility Rules") and can demonstrate its entitlement to the Disputed Domain Name as follows:
 - i) The Complainant is an Australian registered company trading under the registered company name Migration Solutions Pty Ltd;
 - ii) The Disputed Domain Name exactly matches the Complainant's company name; and

- iii) The Disputed Domain Name exactly matches the Complainant's Australian trade mark.

5.2. The Complainant seeks the following relief:

- (a) revocation of the Respondent's licence in respect of the Disputed Domain Name; and
- (b) transfer of the licence in the Disputed Domain Name to the Complainant.

The Respondent

5.3. In response, the Respondent makes the following contentions:

- (a) The Complainant has no better right to the Disputed Domain Name than the Respondent does, and domain name licences are allocated on a "first come, first served" basis.
- (b) The Respondent is eligible to use the Disputed Domain Name as it "exactly matches" his registered business name within the meaning of the auDA Eligibility & Allocation Rules.
- (c) The alleged diversion of customers from the Complainant's website to the Respondent's website is not significant and is due to the Complainant failing to provide correct email and contact details to its customers.
- (d) The Respondent took his website offline in December 2005 to either investigate or prevent alleged attacks on his business email address and website. It is not clear from the Response whether the Respondent's website has been reinstated, or when this is likely to occur.
- (e) The Respondent has not acted in bad faith. He states that the Complainant made the first approach regarding monetary consideration for the transfer of the Disputed Domain Name, not the Respondent.

6. DISCUSSION AND FINDINGS

6.1. The Disputed Domain Name was registered by the Respondent after 1 August 2002, and therefore the Respondent is subject to the auDRP.

6.2. Paragraph 15(a) of the auDRP Rules ("the Rules") provides that the Panel shall "*decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable*".

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

- i. *the [Disputed 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] has no rights or legitimate interests in respect of the [Disputed Domain Name]; and*
- iii. *the [Disputed Domain Name] has been registered or subsequently used in bad faith.*

6.4. Note 1 to paragraph 4(a)(i) provides that auDA has determined that a “*name...in which the complainant has rights*” refers to the Complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority, or the Complainant’s personal name.

Identical or confusingly similar (paragraph 4(a)(i))

6.5. The first question to be determined in this dispute is whether the Disputed Domain Name is identical or confusingly similar to the Complainant’s company name or its trade mark.

6.6. According to note 1 to Paragraph 4(a) of the Rules, the Complainant’s company name constitutes a “*name...in which the Complainant has rights*” for the purposes of paragraph 4(a)(i).

6.7. Determinations under the UDRP (Uniform Dispute Resolution Policy), from which the auDRP is derived, have held that when comparing domain names with marks or names, the global top level domain (gTLD) element of a domain name, such as .com, has 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 are cited and approved in other determinations under the auDRP in respect of open second level domains (2LDs) such as .com.au, including *GlobalCenter Pty Ltd v Global Domain Hosting Pty Ltd*, WIPO Case No. DAU2002-0001 (March 5, 2003) by a single panelist and *The Crown in Right of the State of Tasmania trading as “Tourism Tasmania” v Craven*, WIPO Case No. DAU2003-0001 (April 16, 2003) by a 3-member panel. This Panelist therefore also adopts those principles for comparing domain names containing a .com.au element, with a name or mark.

6.8. The Disputed Domain Name, migrationsolutions.com.au, was registered on 16 December 2003, approximately 3 months after the Complainant had changed its registered company name to Migration Solutions Pty Ltd.

- 6.9. Disregarding the .com.au element, the Disputed Domain Name is clearly identical to the Complainant's name and the requirements of paragraph 4(a)(i) are satisfied.
- 6.10. Given that the Complainant's trade mark contains the words "Migration Solutions" in conjunction with a stylised map of Australia, it is likely that the Disputed Domain Name is also identical or confusingly similar to the Complainant's trade mark. However, there is no need to determine this issue given the above conclusion regarding the Complainant's company name.

No rights or legitimate interests in the Disputed Domain Name (paragraph 4(a)(ii))

- 6.11. The Complainant asserts that the Respondent has no rights or legitimate interests in the Disputed Domain Name as the Disputed Domain Name does not, word-for-word, match the registered business name of the Respondent.
- 6.12. Paragraph 4(c) of the Rules provides that the Respondent will establish that it had rights or a legitimate interest in the Disputed Domain Name for the purpose of paragraph 4(a)(ii), if any of the following circumstances can be proven:
- (i) *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 name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that [the Respondent] has acquired for the purpose of selling, renting or otherwise transferring); or*
 - (ii) *[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*
 - (iii) *[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.*

Prior use - Paragraph 4(c)(i))

- 6.13. According to the Business Name Search provided by the Complainant, the Respondent has, since or around 10 October 2003, operated a migration consultancy business under the business name Australasia Migration Solutions. There appears to be no dispute between the parties regarding this point.

- 6.14. For the purposes of paragraph 4(c)(i), the Complainant appears to have first notified the Respondent of the subject matter of this dispute on or around 17 February 2005, when Mr Glazbrook emailed the Respondent suggesting that they meet to discuss the similarities between the Disputed Domain Name and the Complainant's name.
- 6.15. The Respondent has not submitted any evidence regarding the date that he commenced use of the Disputed Domain Name in connection with his migration consultancy services. However, it is clear from the text of the emails passing between Mr Glazbrook and the Respondent from 17 February 2005 onwards that the Respondent had been using the Disputed Domain Name to operate his website and email since at least 2004.
- 6.16. Given that there is no dispute about the use by the Respondent of the Disputed Domain Name for migration consultancy services prior to 17 February 2005, paragraph 4(c)(i) appears to have been satisfied.
- 6.17. Both parties go further, however, and make reference to the term in paragraph 4(c)(i) of "*a name corresponding to the domain name in connection with an offering of goods and services*".
- 6.18. The Complainant submits that the Respondent's registered business name, Australasia Migration Solutions, is not a name that corresponds to the Disputed Domain Name.
- 6.19. The Panelist disagrees with the Complainant's submissions on this point. Guidance on the meaning of the term "*corresponding to the domain name*" can be obtained from the Eligibility Rules. Clause 2 of the auDA Eligibility and Allocation Rules for com.au domain names provides as follows:
- "2. *Domain names in the com.au 2LD must:*
- (a) *exactly match, acronym or abbreviation of the registrant's company or trading name, organization or association name or trade mark; or*
 - (b) *be otherwise closely and substantially connected to the registrant.*"
- 6.20. Paragraph 7.1 of the Guidelines for Accredited Registrars on the Interpretation of Policy Rules for Open 2LDs (2003-07), which was in force at the time of the registration of the Disputed Domain Name, provides that:
- "An 'exact match' is where the requested domain name matches one, some or all of the words comprising the name used by the registrant to establish their eligibility. The words must be used in the same order as they appear in the name."*

- 6.21. Policy 2003-07 has since been superceded but paragraph 7.1 of Policy 2005-02, which is currently in effect, remains exactly the same.
- 6.22. As the words “Migration Solutions” form part of the Respondent’s business name which was used to establish the Respondent’s eligibility for the Disputed Domain Name and the words appear in the same order as they do in the registered business name, the Disputed Domain Name does “exactly match” the Respondent’s business name.
- 6.23. It follows that if the Disputed Domain Name “exactly matches” the Respondent’s business name for the purposes of domain name registration, the requirement in paragraph 4(c)(i) that the names correspond with each other, will also be satisfied.
- 6.24. Further, the Complainant has provided no evidence to show that the Respondent’s use of the Disputed Domain Name or his registered business name has not been a *bona fide* use.
- 6.25. In the circumstances, the Panelist is satisfied that the Respondent has satisfied the requirements of paragraph 4(c)(i) and negated the Complainant’s assertions that the Respondent has no right or legitimate interest in the Dispute Domain Name.
- 6.26. As the circumstances in paragraph 4(c)(i) have been established, there is no need for the Panelist to consider whether paragraphs 4(c)(ii) or (iii) apply.

Bad faith registration and/or use (paragraph 4(a)(iii))

- 6.27. The Complainant alleges that the Respondent has registered or used the Disputed Domain Name in bad faith.
- 6.28. Paragraph 4(b) of the Rules sets out a non-exhaustive list of grounds for establishing bad faith registration or use as follows:
- (i) *circumstances indicating that [the Respondent] has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of [the Respondent’s] documented out-of-pocket costs directly related to the domain name; or*
 - (ii) *[the Respondent] has registered 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) *[the Respondent] has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or*
- (iv) *by using the domain name, [the Respondent] has 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.*

6.29. The Complainant relies upon all sub-sections of paragraph 4(b) in support of its contention that the registration of the Disputed Domain Name by the Respondent was in bad faith.

Primary purpose of selling, renting or transferring - Paragraph 4(b)(i)

6.30. The Complainant argues that the Respondent registered the Disputed Domain Name for the primary purpose of selling or transferring it to the Complainant for valuable consideration in excess of his out of pocket costs.

6.31. The evidence provided by the Complainant and Respondent in relation to this issue does not establish this point. There is no evidence that the primary purpose of the registration was to offer the Disputed Domain Name for sale to the Complainant. There are several factors pointing to this conclusion:

- (a) The Respondent appears to have used the Disputed Domain Name for a legitimate business website since some time in late 2003 or early 2004. The Complainant does not dispute this point.
- (b) The Respondent alleges that in the course of establishing his business, he has developed his website at considerable cost. Although there is no evidence provided of the actual costs outlaid, the Complainant does not dispute this point.
- (c) The emails between the parties, when viewed in context, demonstrate that the first approach regarding the proposed sale of the Disputed Domain Name was made by the Complainant to the Respondent on 17 February 2005, 14 months since the date of registration, *not* by the Respondent (as the Complainant asserts).
- (d) Following several email exchanges between the parties between 17 February 2005 and 26 February 2005, the matter appears to have been left dormant for a period of almost 10 months, until 16 December 2005 when the Complainant again raised the issue in an email to the Respondent. If the

Complainant's assertions regarding the Respondent's bad faith were correct, it is to be expected that the Respondent would have continued to pursue the Complainant regarding negotiations for the proposed sale.

- (e) The Respondent's emails dated 16 December 2005 repeatedly invite the Complainant to lodge a complaint with auDA. This is unusual conduct for the Respondent if, as the Complainant alleges, he did not intend to retain the domain name registration.

Intention to prevent others from legitimately registering name - Paragraph 4(b)(ii)

- 6.32. The Complainant contends that the Respondent registered the Disputed Domain Name in order to prevent the Complainant from registering a domain name that corresponded with its own company name or trade mark.
- 6.33. The evidence submitted by the parties does not prove this contention. The Complainant has provided no correspondence or other documentation that evidences the Respondent's intentions at the time of registering the Disputed Domain Name.
- 6.34. Indeed, it appears from the documentation submitted in support of this application that although the parties have been aware of each other's presence since or around 1999 there was little or no discussion about the Disputed Domain Name or its similarity to the Complainant's name, until February 2005.
- 6.35. Further, the Complainant did not lodge an application for trade mark registration until 1 July 2004, 6½ months after the Respondent registered the Disputed Domain Name. Without further evidence regarding the Complainant's use of that trade mark (or any other mark containing the words 'Migration Solutions') at the time of the Disputed Domain Name registration it is difficult to see how the Complainant can make out a claim under paragraph 4(b)(ii) in respect of its trade mark.
- 6.36. The Complainant has not established that paragraph 4(b)(ii) has been satisfied.

Disruption of business activities - Paragraph 4(b)(iii)

- 6.37. The Complainant contends that the Respondent registered the Disputed Domain Name for the primary purpose of disrupting the business or activities of the Complainant.

6.38. As stated above, the Complainant has provided no evidence of the Respondent's intentions at the time of registration of the Disputed Domain Name.

6.39. Further, the Complainant does not provide any indication of the extent to which any business disruption may have occurred. The Respondent's evidence suggests that the level of business disruption may be in the range of 10 to 13 misdirected emails per year. The Respondent notes, and the Complainant does not deny, that the Respondent has referred the misdirected emails to the Complainant. This seems an unlikely course of action for the Respondent to take if he was deliberately seeking to disrupt the Complainant's business.

6.40. On the evidence provided, it cannot be concluded that the ground set out in paragraph 4(b)(iii) has been established.

Intention to create likelihood of confusion regarding source - Paragraph 4(b)(iv)

6.41. The Complainant contends that the Respondent registered the Disputed Domain Name with the intention of causing a likelihood of confusion with the Complainant's name or mark.

6.42. Although it is conceded that the Disputed Domain Name and the Complainant's registered company name and trade mark are sufficiently similar that confusion as to source may result (particularly given that both parties provide migration consultancy services), the Panelist has not been provided with any evidence that the Respondent registered the Disputed Domain Name with the intention of causing that confusion.

6.43. The evidence clearly establishes that the Respondent was entitled to register the Disputed Domain Name, as it formed part of his registered business name and fell within the meaning of "exactly matches" under paragraph 7.1 of auDA Policy 2003-07, in force at the time of registration.

6.44. Further, no evidence has been provided to suggest that the Respondent has done anything other than use the Disputed Domain Name for the purpose of a legitimate business in migration consultancy services.

6.45. On the evidence provided, it cannot be concluded that the ground set out in paragraph 4(b)(iv) has been established.

6.46. The Complainant has not satisfied any of the requirements of clause 4(b). Further, it has provided no evidence of bad faith other than the grounds stated in paragraph 4(b).

6.47. Accordingly, the Complainant has not demonstrated under paragraph 4(a)(iii) that the Respondent's registration or use of the Disputed Domain Name was in bad faith.

6.48. For the reasons stated above, the Complainant has not proven its case under paragraph 4(a) of the auDRP.

Breach of representations and warranties

6.49. Clause 2 of Part A of the NetRegistry Terms and Conditions of Registration ("the Conditions") provides that the Respondent (as registrant of the Disputed Domain Name):

"...represent[s] that, to the best of [his] knowledge and belief, neither the registration of the SLD name nor the manner in which it is directly or indirectly used infringes the legal rights of a third party and that the Domain Name is not being registered for any unlawful purpose".

6.50. Further, clause 2 of Part B of the Conditions provides that:

"By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that:

(a) the statements that you made in your Registration Agreement are complete and accurate; and

(b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party;

...

It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

6.51. These representations and warranties mirror the terms of clause 2 of the auDRP.

6.52. The Complainant alleges that the Respondent has breached the warranties by failing to perform searches for, or alternatively take notice of, the Complainant's existing company name registration at the time of registering the Disputed Domain Name.

6.53. Registration of a company name under the *Corporations Act 2001 (Cth)* does not confer any proprietary rights in that name upon the registrant, aside from the right under section 147 of that Act to prevent any other person from registering the same company name under the Act, or the same business name on the national business

names register. Accordingly, the Respondent cannot be said to have infringed any of the Complainant's rights in respect of the company name.

- 6.54. The Complainant has not clearly articulated which of its rights (other than the rights under the auDRP, as dealt with above) the Respondent has allegedly violated. Further, the documentation submitted by the Complainant in this dispute does not establish that the Respondent has in fact violated any of the rights of the Complainant, or that the Respondent failed to attend to the proper searches before registering the Disputed Domain Name.
- 6.55. The Panelist further notes that he has no jurisdiction to determine issues outside the scope of the auDRP, such as whether the Respondent has engaged in trade mark infringement, passing off or misleading & deceptive conduct under the *Trade Practices Act 1974 (Cth)*, which the Complainant appears to be alluding to.
- 6.56. The only basis upon which the Panelist could be satisfied that the rights of the Complainant (other than those conferred under the auDRP) had been violated, would be if the Complainant produced a Court order to that effect.
- 6.57. For the reasons outlined above, the Complainant has not proven that the Respondent has breached its representations and warranties under paragraph 2 of the Conditions or, alternatively, the auDRP.

Retention of the Disputed Domain Name

- 6.58. The Panel therefore determines that the Respondent's licence in respect of the Disputed Domain Name, should be retained by the Respondent.

7. DECISION

- 7.1. The Complainant has failed to satisfy the elements of paragraph 4(a) of the auDRP. Accordingly, the Complaint is denied.
- 7.2. The Panel directs that the Respondent is entitled to retain its registration of the Disputed Domain Name, `migrationsolutions.com.au`.

Dated: 23 March 2006

Steven Jerrard
Sole Panelist