



ACN 008 651 232

## ADMINISTRATIVE PANEL DECISION

### **The National Office for the Information Economy v. Verisign Australia Limited**

#### **LEADR Case No. 02/2003**

#### **1 The Parties**

The Complainant is The National Office for the Information Economy, an Executive Agency of the Australian Government's Department of Communications, Information Technology & the Arts, of GPO Box 390, Canberra, Australian Capital Territory, 2601.

The Respondent is Verisign Australia Limited of P.O. Box. 3092, South Melbourne, Victoria, 3205.

#### **2 The Domain Name and Registrar**

The Disputed Domain is <gatekeeper.com.au>. The registrar of the domain name is Planet Domain.

#### **3 Procedural History**

This is an administrative proceeding pursuant to the .au Dispute Resolution Policy adopted by auDA on 13 August 2001, which commenced operation on 1 August 2002 ("auDRP"); the auDA Rules for .au Dispute Resolution Policy ("Rules") and the LEADR Supplemental Rules to Rules for .au Domain Name Dispute Resolution Policy ("LEADR Supplemental Rules").

The Complaint was lodged with LEADR on 14 May 2003, and a copy sent to the Respondent on 20 May 2003 by post. The Respondent was advised that it had until 10 June 2003 to submit all materials it wished to have considered by the Panel. LEADR also notified auDA of the Complaint.

On 19 May 2003 the Registrar acknowledged receiving notice of the Complaint and confirmed that it had locked the Disputed Domains pending the determination of this proceeding.

The Respondent sent an e-mail Response on 5 June 2003 which was apparently not received by LEADR until 11 June 2003. No hard copy of the response has been received.

All other procedural requirements appear to have been satisfied.

## **4 Factual Background**

“*Gatekeeper: A Strategy for public key technology use in the Government*” (the “Strategy”) was developed by the Australian Government’s Office of Government Information Technology and released in May 1998.

The Strategy explained that the Gatekeeper Project was to provide a mechanism for the implementation of Public Key Infrastructure technology to enable other agencies, business and the public to transact business with Government agencies. Public Key Infrastructure technology is enabling technology that allows Government agencies to implement a secure online transaction capability. It is also used to authenticate subscribers to Government web pages and servers, and to ensure the integrity and confidentiality of information within the Government online environment. By means of the accreditation of Service Providers, Gatekeeper creates a trust hierarchy for the supply of digital certificates up to the “Highly Protected” level required by the Commonwealth Government.

There are currently eight Gatekeeper accredited organisations, both Government and private industry, either issuing or providing part of the digital certificate services that are a necessary part of the Gatekeeper scheme. The Respondent (previously eSign Australia Limited) was accredited as a Certification Authority and Registration Authority on 5 April 2001.

On 20 September 2002, the Respondent registered the Disputed Domain.

## **5 Parties’ Contentions**

### **5.1 Complainant**

The Complainant makes the following contentions.

Gatekeeper is an accreditation scheme that evaluates both commercial and Government Service Providers. These Gatekeeper accredited organisations can then market their specific services (ie provision of digital certificates) as compliant with the Gatekeeper standards.

As Gatekeeper is not a product or service that is provided by any particular Gatekeeper accredited Service Provider, the Complainant considers it inappropriate for the Respondent to retain ownership of the Disputed Domain. Relevantly ‘Gatekeeper’ is a certification mark licensed by the Complainant and denoting that a licensed service provider has met the rigorous standards required for participation in the Gatekeeper authentication framework

#### **5.1.1 The Gatekeeper Trade Mark**

The application (No. 841106) for ‘Gatekeeper’ was filed on 29 June 2000 and granted on 11 March 2003 for 10 years from the filing date.

One of the elements underpinning the Complainant’s case against the Respondent relates to timing. The Complainant lodged its application to register Gatekeeper as a trade mark on 29 June 2000, some nine months prior to the Respondent establishing its <http://gatekeeper.esign.com.au> website and over two years before the Respondent registered the Disputed Domain.

The timetable of relevant events with regard to the Gatekeeper accreditation of the Respondent and the actions of the Complainant and the Respondent with respect to trade marks and the Disputed Domain is set out in the following table:

Date	Event
March 1998	Office of Government Information Technology publishes <i>Gatekeeper: A Strategy for public key technology use in the Government</i> .
28 February 2000	<gatekeeper.gov.au> registered to Office of Government Online
3 April 2000	The Respondent (then eSign Australia Limited) achieves entry level Gatekeeper accreditation and is issued a Certificate of Accreditation pertaining to that fact.
29 June 2000	The Complainant lodges application 841106 with the Trade Marks Office to register the word “Gatekeeper” as a certification trade mark in relation to services in Class 42 of the Australian trademarks register.
5 April 2001	The Respondent (then eSign Australia Limited) achieves full-level Gatekeeper accreditation and is issued a Certificate of Accreditation pertaining to that fact.
9 April 2001	The Respondent (then eSign Australia Limited) establishes a web site ( <a href="http://gatekeeper.esign.com.au">http://gatekeeper.esign.com.au</a> ) to market its Gatekeeper accredited services.
11 July 2002	The Trade Mark Office advertises the acceptance of Trade Mark No. 841106 in relation to Class 42.
20 September 2002	The Respondent registers the Disputed Domain.
11 March 2003	Certificate of Registration of Trade Mark No 841106 issued

#### 5.1.2 Registration of the Disputed Domain

The Complainant considers that it has the sole right to the Disputed Domain on the basis that it:

- published the Strategy in 1998;
- registered Gatekeeper as a trade mark; and
- formally administers and manages the Gatekeeper accreditation scheme.

The Complainant asserts that by registering the Disputed Domain subsequent to its Gatekeeper accreditation, the Respondent is in breach of its Heads of Agreement with the Australian Government. This is not an issue on which this Panel can opine.

### 5.1.3 The parties' contentions prior to the Complaint

The Complainant corresponded with the Respondent before instituting the Complaint. Essentially the Complainant set out its views and the Respondent its views in terms not materially different from those that have become the parties' respective arguments in the Complaint and the Response.

There is little dispute about the similarity if not identity between the Disputed Domain and the Complainant's trademark. Accordingly, the two main areas of contention between the parties relate to the legitimacy of the Respondent's conduct and its bona fides.

The Respondent contends that the Complainant cannot genuinely assert that the Respondent has no legitimate interest in the Disputed Domain or that the Respondent has registered the Disputed Domain in bad faith because:

- the Respondent currently, and since registration of the Disputed Domain, is using the Disputed Domain to sell, issue and manage Gatekeeper digital certificates;
- there is a clear connection between the name of the site and the services the Respondent offers - namely the issuance of Gatekeeper certificates; and
- the content on the site is clearly the content of the Respondent and not that of the Complainant.

The Respondent contends that it has been a very active participant in the Government's Gatekeeper strategy since its inception in 1999 and was the first commercial organisation to achieve full Gatekeeper accreditation as both a Certification Authority and Registration Authority. The Respondent was also the first organisation to issue a Gatekeeper Australian Business Number - Digital Signature Certificates and has been at the forefront of the development of the Gatekeeper Type 3 Certificate - Broad Specification.

The Respondent further contends it has been active in policy formation and in attempting to drive acceptance of Gatekeeper in Government and business, with the establishment of its Canberra office being primarily to promote Gatekeeper and Gatekeeper certificates in the Government arena.

The Respondent claims that it has devoted considerable effort and resources to establish a suitable environment in which to provide highly secure services. The requirements of Gatekeeper, and the Defence Signals Directorate accreditation in particular, had a significant influence in the final form and costs of establishing the Respondent's \$6 million secure data centre in South Melbourne, Victoria.

The Respondent asserts that it used the Disputed Domain to advertise its Gatekeeper solutions. The Respondent claims that over the past three years it has spent substantial money and effort to vigorously push the adoption of Gatekeeper certificates of which it has managed to sell 1,000.

### 5.1.4 Complainant's contentions

The Complainant contends that the Respondent did not use the trade mark in relation to Gatekeeper services before the Complainant first used the mark "Gatekeeper" in 1998, which was when the Strategy was developed and implemented by the Office of

Government Online (which is now the Complainant). The term “Gatekeeper” achieved prominence in the Australia Public Key Infrastructure (“PKI”) market only with the release of the Gatekeeper strategy in 1998. The Complainant contends that had the strategy not been published there would have been no reason for the Respondent to register the Disputed Domain.

The Complainant also asserts that the Respondent’s registered business name does not include the word “Gatekeeper”. The services provided by the Respondent (at <<http://www.verisign.com.au/gatekeeper/>>) provided under the Respondent’s Gatekeeper accreditation are a small proportion of the Respondent’s total product base. The Complainant considers that this is further evidence that the ownership by the Respondent of the Disputed Domain is inappropriate. Further, the Complainant considers that the Respondent’s registration of the Disputed Domain is an infringement of the Complainant’s trade mark under s 120(1) of the *Trade Marks Act 1995*. The Complainant also considers that the Respondent’s registration of the Disputed Domain is misleading and deceptive (and therefore contrary to s 52 of the *Trade Practices Act 1974*) in that it suggests that the Respondent is responsible for the Gatekeeper accreditation scheme, whereas in fact it is one of seven accredited bodies under the scheme for which the Complainant is responsible.

The Complainant contends that the level and nature of the Respondent’s involvement in the digital certificate market is irrelevant to this debate. A number of private companies and Government agencies have also committed substantial resources to participate in the development of Gatekeeper policy, as well as to obtaining Gatekeeper accreditation.

The Complainant contends that the Respondent’s registration of the Disputed Domain provides the Respondent with an unfair competitive advantage relative to the other Gatekeeper accredited Service Providers.

The Complainant asserts that a number of Federal and State Government departments operate <.com.au> domains for the purpose of enhancing access to Government services. These sites promote programs, Government initiatives and grant funds for embryonic or growth markets. The Complainant considers the Disputed Domain to be an equivalent situation.

The Complainant requests LEADR to direct the transfer of the domain licence for the Disputed Domain from the Respondent to the Complainant. The Complainant strongly believes that this action will:

- prevent use of the Disputed Domain from creating an unfair competitive advantage for one accredited Service Provider in what is a competitive market;
- allow the Complainant to use the Disputed Domain to promote the Gatekeeper strategy for the benefit of all Gatekeeper accredited services; and
- raise public awareness of the benefits of using PKI-based solutions in their dealings with the Government and to reduce the degree of confusion about this complex IT security framework.

## 5.2 Respondent's Response

### 5.2.1 The Disputed Domain is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights.

The Respondent agrees that the Complainant has registered a trade mark in relation to class 42 for the following goods and/or services:

*Accreditation of Service Providers using Public Key Technology to provide secure transmission and receipt of online information and other online transactions.*

Further, the Respondent admits that the trade mark is registered from 29 June 2000 for 10 years.

### 5.2.2 The Respondent has no rights or legitimate interests in respect of the Disputed Domain.

The Respondent contends that it was the first organisation to seek to achieve or to obtain registration of the Disputed Domain on 3 October 2002 after meeting the eligibility requirements for the Disputed Domain. Unlike the domain <gatekeeper.gov.au>, which the Complainant has registered since 28 February 2000 but does not use, the Respondent does not believe that the Complainant ever attempted to register the Disputed Domain. The Respondent believes that prior to registration of the trade mark, the Complainant would not have been deemed eligible to register the Disputed Domain even if it had attempted to register the Disputed Domain.

In response to the Complainant's submission that other organisations could have registered the Disputed Domain but did not do so, the Respondent contends that in its opinion the only relevance of this statement is that there were other organisations which would also have had a legitimate right to obtain registration of the Disputed Domain. The Respondent contends that this does not prove that the Respondent has no right to the Disputed Domain.

The Respondent contends that although the Complainant has registered a trade mark in relation to the word "Gatekeeper" in class 42, the Respondent has a registered business name in "eSign Gatekeeper Services". The Respondent claims that both registration systems recognise a form of legal rights that an organisation may possess in a name.

The Respondent contends that the Complainant is a Government agency which runs a scheme to accredit both Government and commercial organisations and, since registration of the trade mark on 29 June 2000, granted them the ability to use the Gatekeeper certification trade mark. The Respondent is a commercial organisation that has obtained that accreditation since 3 April 2000 and has provided and continues to provide accredited goods and services. The Respondent contends that it is not disputed that the Respondent obtained accreditation before registration of the Complainant's trade mark.

The Respondent contends that its use of the mark predates the Complainant's attempts to register the mark in any form.

The Respondent agrees that its registration of the Disputed Domain occurred after the registration of the Complainant's trade mark. However, the Respondent contends that its use of the name is not inconsistent with the registration of that trade mark and, as a prior

user of the word “Gatekeeper” before registration was obtained, its use of the word “Gatekeeper” is specifically allowed under the Trade Marks Act

The Respondent asserts that the Strategy uses the term “Gatekeeper” in a number of ways suggesting that there is a “Project Gatekeeper”, a “Gatekeeper strategy” and a “Gatekeeper report”. In that publication, the Complainant made no attempt to claim the word “Gatekeeper” was a trade mark of the Complainant or that the Complainant had any other form of intellectual property rights in the Gatekeeper name. The Respondent contends that at the time of its original use of the name, the Complainant had not attempted to use the word Gatekeeper as a trade mark. The Respondent claims that all references to the word “Gatekeeper” in the document are inconsistent with the use for which the Complainant has subsequently registered the trade mark.

The Respondent contends that the Trade Marks Act provides that a continuous user of an unregistered trade mark may continue to use that trade mark notwithstanding a trade mark has been registered if the person was using the trade mark in relation to those goods and services before the date of registration of the trade mark.

The Respondent does not believe that it is infringing the Complainant’s trade mark in any way by its use of the word “Gatekeeper” or its registration of the Disputed Domain. The Respondent asserts that although the Complainant has certain rights in relation to class 42 and accreditation services, this is not the context in which the Respondent uses the name. The Respondent is a Gatekeeper accredited provider and correctly designates those goods and services for which the Respondent has obtained accreditation as Gatekeeper accredited goods and services.

The Respondent asserts that the revenue breakdown between the Respondent’s revenue from selling Gatekeeper goods and services and other services is not relevant, except to the extent that it proves that the Respondent is earning revenue by conducting business under the Gatekeeper name and the Disputed Domain.

The Respondent summarises its argument as follows:

- the Respondent is a registered owner of a business name similar to the trade mark of the Complainant;
- the Respondent has been lawfully using the name “Gatekeeper” before the Complainant attempted to register a trade mark in the name (and before the Complainant indicated it regarded “Gatekeeper” as its trade mark);
- the Respondent has achieved Gatekeeper accreditation and under the terms of the Certification Mark Rules is entitled to use the word “Gatekeeper” in conjunction with the goods and services it sells;
- the Complainant has only been granted a monopoly right over the word “Gatekeeper” in respect of class 42 (accreditation services) and the Respondent’s use of the Disputed Domain is not inconsistent with that;
- the Respondent has invested millions of dollars over a period of four years achieving and maintaining Gatekeeper accreditation; and
- the Respondent has invested considerable resources in developing, selling and marketing its services using the Disputed Domain.

### 5.2.3 The Disputed Domain has been registered or used in bad faith.

The Respondent contends that the registration of the Disputed Domain after the Complainant applied for the trade mark does not amount in itself to bad faith. What is required to prove is the intent of the person who registered the name and in particular a lack of good faith. The Respondent contends that the Complainant has proved none of the elements of bad faith as provided in section 4(b) of the auDRP. The Respondent submits that it is operating the Disputed Domain in good faith and takes various steps to make it clear that Gatekeeper is a Government initiative and the Respondent is an accredited provider of services. The Respondent does not believe that its website could be confused with that operated by the Complainant.

The Respondent contends that there are only two Gatekeeper accredited Service Providers actively issuing certificates in a competitive commercial environment: Telstra and the Respondent. The Respondent was the first commercial organisation to issue certificates to the mass market. The other accredited Service Providers are either large Government departments who provide services to their own customers (like the ATO and HeSA), large corporations who have yet to begin widespread commercialisation (such as the ANZ Bank) or providers of the technology that is used by all these Service Providers (such as SecureNet). In this competitive environment, the Respondent believes that its use of the Disputed Domain helps to reduce the competitive advantages enjoyed by its competitors.

The Respondent contends that the Complainant uses the website <noie.gov.au> to promote its Gatekeeper accreditation process. The entry page for Gatekeeper is <noie.gov.au/projects/confidence/securing/gatekeeper.htm>. The Complainant does not operate a separate website for Gatekeeper, even though it could use <gatekeeper.gov.au>, which it has already registered, for this purpose. The Respondent is of the view that there are alternatives for a Government agency running an accreditation scheme to use another domain name suffix rather than <.com.au> which generally designates a commercial Service Provider. The Respondent contends that its registration of the Disputed Domain is not stopping the Complainant advertising Gatekeeper; it is only stopping the Complainant advertising or operating the initiative at the Disputed Domain.

The Respondent believes this it has not registered the Disputed Domain in bad faith under section 4(b) of the auDRP Policy as before the notice of this dispute, the Respondent was using the Disputed Domain in connection with an offering of goods or services. Specifically, the Respondent's website was used in connection with the offering for sale of Gatekeeper accredited goods and services.

In short, the Respondent contends that the Complainant has failed to prove that:

- the Respondent has no rights or legitimate interests in respect of the Disputed Domain; or
- the Disputed Domain has been registered or used in bad faith.

## **6 Discussion and Findings**

Paragraph 15(a) of the auDRP Rules requires the Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the [auDRP, the auDRP Rules], and any rules and principles of law that it deems applicable.”

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

- (i) the Disputed Domain 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 ; and
- (iii) the Disputed Domain has been registered or subsequently used in bad faith.

The onus of proof is on the Complainant in relation to all three of these elements.

## **6.1 Identical or Confusingly Similar**

The Complainant is the registered proprietor of the word “Gatekeeper” as a certification mark under the *Trade Marks Act 1995*. The Disputed Domain comprises the word “gatekeeper” together with the second level domain “.com.au”. Administrative panels deciding cases brought under the UDRP (from which the auDRP is derived) have long held that the gTLD elements of a domain name have no distinguishing capability when the balance of a domain name is identical to a trade mark. Here the same principle is applicable and the Panel finds that the 2LD has no capability of relevantly distinguishing the Disputed Domain from the Complainant’s trade mark. The reason for these UDRP decisions, and for this Panel to adopt the same approach under auDRP, is simply that the gTLD/2LD elements of a domain name are fixed and define the universe within which identity/similarity are judged. In this case the Panel has no hesitation in finding the Disputed Domain identical to the Complainant’s registered trade mark.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the auDRP.

## **6.2 Rights or Legitimate Interests**

For the purposes of the auDRP, auDA has indicated that "rights or legitimate interests in respect of the domain name" are not established merely by a registrar's determination that the Respondent satisfied the relevant eligibility criteria for the domain name at the time of registration. This is important because the .com.au 2LD is not a completely ‘open slather’ domain’. Rather an applicant has to establish some textual nexus between the domain name applied for and a name or mark by which it or its products are known. In the present case the Respondent’s eligibility appears to have been founded on its registration of the NSW business name “eSign Gatekeeper Services”. Since a business name registration under Australian law confers no rights to use the name (it merely being a legal condition of trading under a name other than an entity’s real name) the fact of the Respondent’s business name registration is inconclusive in assessing the legitimacy of the Respondent’s use of one word from that name in its domain name. Indeed the Respondent’s selection of only one of the many words in its business name might give rise to an inference that its choice of domain name was motivated by other factors. Although paragraph 4(c) of the auDRP sets out grounds upon which the Respondent is able to demonstrate rights or a legitimate interest in respect of a domain name, they are not exhaustive.

The chronology of the development of the Gatekeeper scheme is relevant context in which to judge the Respondent’s conduct. In 1997 the Australian Government launched Project Gatekeeper, to enable it to make optimal use of Public Key Technologies (PKT)

for electronic transactions. On 28 February 2000 the Complainant registered gatekeeper.gov.au. It subsequently accredited various Service Providers to supply digital certificates which were compliant with Gatekeeper accreditation standards. On 3 April 2000 the Respondent achieved “entry level” Gatekeeper accreditation

It is apparent from an analysis of this timetable of events that the Complainant first began using the name Gatekeeper in the area of security of online transactions in October 1997, before the Strategy was even released.

As noted above, the Complainant formally administers and manages the “Gatekeeper” accreditation scheme for the supply of digital certificates for online transactions.

In its letter of 3 March 2003 and in its Response, whilst asserting that it had used the word ‘gatekeeper’ prior to release of the Strategy in 1998, the Respondent provided no evidence of this and the Panel views it as unlikely given that the word Gatekeeper was not promulgated prior to release of the Strategy. The Respondent also could not have lawfully used the term prior to its being accredited under the Gatekeeper scheme, which was not before 3 April 2000 at the very earliest. Thus, the Complainant was the first user of the term in any event.

The Respondent asserts that the Trade Marks Act allows a prior user of an identical trade mark to continue to use that mark despite the fact that someone has lodged a trade mark. Section 124 of the Act requires that, for the Respondent to have the benefit of this section, the use by the Respondent of the word Gatekeeper must pre-date **the earlier of the Complainant’s trade mark application filing date or the date on which it first used the mark.** Since the Complainant first used the Gatekeeper mark in 1997 (or, at the latest, from the date of release of the Strategy in 1998), the Respondent cannot have the benefit of this provision of the Trade Marks Act. It is, on the contrary, quite clear that the Respondent conceded the Complainant’s right to the Gatekeeper mark and deferred to the Complainant by investing in meeting the rigorous standards set by the Complainant before it could describe its digital certificate services as Gatekeeper certified. In those circumstances it seems rather disingenuous for the Respondent now to assert that it had rights or legitimate interests in respect of the Disputed Domain by dint of its business in supplying services so accredited by the Complainant. The Respondent at most had the right to describe its services as having been accredited by the Complainant, or as meeting the Gatekeeper standards set by the Complainant, but that is a far cry from having rights or legitimate interests “in respect of” gatekeeper.com.au. Perhaps an analogy is that of a franchisee seeking to register a domain name consisting of its franchisor’s trade mark. It is hard to see how the franchisee could claim to have a legitimate interest in taking that course when its rights are totally derived from and dependent upon the franchisor. Absent the franchisor’s permission to take that course, a franchisee would probably not prevail over a complaint by its franchisor. Here the position of the Respondent is even weaker, since it is not selling products under the Complainant’s brand name - merely under the Complainant’s certification scheme.

The Respondent also contends that the Complainant made no attempt to claim the word “Gatekeeper” or use the word “Gatekeeper” as a trade mark in the Strategy. The Panel does not see the relevance of this contention. The property in a mark arises from use or proposed use. In order to be registered, a mark must already be identified with the applicant through use or be intended for use when a product or service is launched (*Electrolux Ltd v Electrix Ltd* (1953) 71 RPC 23). The use claimed or proposed must be

bona fide commercial use (*Imperial Group Ltd v Philip Mom's & Co Ltd* [1980] 1 FSR 146). The Project which was launched by the Australian Government in 1998 was entitled "Gatekeeper". A steering committee and various working groups were established under the umbrella title of "Gatekeeper" and an implementation project and strategy for accreditation were established under the umbrella title of "Gatekeeper". Clearly, Gatekeeper was the name by which the Government's official scheme was known and it thereby acquired the trade mark rights in Gatekeeper which subsequently founded its application for the certification trade mark that it now owns. The Panel takes the view that the Complainant's common law rights in Gatekeeper extend beyond the accreditation services in respect of which the certification mark is registered.

The Respondent admits on its own website that Gatekeeper is the Australian Government's initiative. That website does not disclose that the Respondent is only one of many accredited issuers of digital certificates under the Gatekeeper scheme. Indeed, contrary to the Respondent's assertion, its website creates the impression that the Respondent is "the" supplier of digital certificates under the Gatekeeper framework, and its use of the Disputed Domain only re-inforces that impression.

The Panel is of the view that the Respondent has not demonstrated the existence of any of the grounds in paragraph 4(c) of the auDRP, nor provided other evidence to ground its claim to having any right or legitimate interest in respect of the Disputed Domain. Accordingly, the Complainant has made out paragraph 4(a)(ii) of the auDRP.

### **6.3 Registered and used in Bad faith**

Paragraph 4(a)(iii) of the auDRP requires the Complainant to demonstrate that the Disputed Domain was either registered or subsequently used in bad faith. Paragraph 4(b) of the auDRP sets out certain circumstances which, if proven, are to be taken to conclusively determine bad faith.

The Panel's strong impression is that the Respondent registered the Disputed Domain and re-directed it to <[verisign.com.au/gatekeeper](http://verisign.com.au/gatekeeper)> so that relevant consumers would believe that the Respondent was the sole supplier of digital certificates under the Complainant's scheme.

The Panel is satisfied that the Complainant has established that by using the Disputed Domain, the Respondent has intentionally attempted to attract, for commercial gain, Interest users to the Respondent's website <[verisign.com.au/gatekeeper](http://verisign.com.au/gatekeeper)>, by creating a likelihood of confusion with the Complainant's trade mark as to some sponsorship, affiliation and endorsement of that website. The Respondent, as a result of being granted accreditation by the Complainant, is **only** granted the right to state that it can supply Gatekeeper-compliant digital certificates. The Respondent is not granted the right to use the name Gatekeeper as a badge of origin or title, which its use in the Disputed Domain must have been calculated to achieve.

Even if one could charitably take the view that the Respondent's conduct was honestly misconceived rather than 'sharp' and disingenuous, the auDRP allows the circumstances which the Complainant has shown here to prevail to be taken as conclusive proof that paragraph 4(a)(iii) of the auDRP has been made out, and the Panel so finds.

**7 Decision**

The Complainant having made out all of the elements of paragraph 4(a) of the auDRP, the Panel directs that the Disputed Domain, <gatekeeper.com.au> be transferred by Planet Domain to the Complainant or, in the event that the Complainant is regarded as ineligible to take a transfer of the Disputed Domain, the Panel directs the cancellation of the Disputed Domain and recommends that “gatekeeper” be added to auDA’s Reserved List of words on the basis that it may not be the subject of a domain name licence without the prior consent of the Complainant.

Dated this 26th day of June 2003

Philip N Argy

Sole Panellist