



## ADMINISTRATIVE PANEL DECISION

**Ink King v. CamerasDirect.com.au Pty Ltd**

**LEADR Case No. auDRP 01/2005**

**Domain Name:** ink-king.net.au  
**Name of Complainant:** Ink King  
**Name of Respondent:** CamerasDirect.com.au Pty Ltd  
**Provider:** LEADR  
**Panel:** M J Sophocles

### **1. THE PARTIES**

- 1.1 The complainant is Ink King of 27 Fernleigh Crescent, Mooloolaba QLD 4557 (**'the Complainant'**). The Complainant is a business owned by Broko Investments Pty Limited (ABN 60 001 511 888).
- 1.2 The respondent is CamerasDirect.com.au Pty Ltd (ABN 18 104 991 620) of Labrador, QLD 4215 (**'the Respondent'**).

### **2. THE DOMAIN NAME, REGISTRAR AND PROVIDER**

- 2.1 The domain name in dispute is 'ink-king.net.au' (**'the Disputed Domain Name'**).
- 2.2 The registrar of the Disputed Domain Name is NetRegistry Pty Ltd (ABN 13 080 859 721) of 97 Rose Street, Chippendale, NSW 2008 (**'the Registrar'**).
- 2.3 The provider in relation to this administrative proceeding is LEADR (**'the Provider'**).

### **3. PROCEDURAL HISTORY**

- 3.1 The complaint was submitted for decision in accordance with the auDRP Policy (**'the Policy'**), the auDRP Rules (**'the Rules'**) and the Provider's Supplementary Rules.
- 3.2 The Complainant lodged the complaint with the Provider on 23 February 2005.

- 3.3 The Respondent was sent the complaint and a dispute notification letter on 25 February 2005 by post. The Respondent was informed that it had 20 days from the commencement of the administrative proceedings (on 3 March 2005) to submit all material it wished to have considered by the Panel.
- 3.4 The Respondent was also sent an e-mail by the Provider, at approximately 2.30pm on 25 February 2005, for completeness. That email stated that a complaint had been received by the Provider (a dispute notification letter was attached to the e-mail) and that the complaint was being posted to the Respondent that same day. The e-mail also stated that if the Respondent did not receive the complaint by post then it should contact the Provider to discuss alternative means of service. A copy of the notification letter was forwarded to the Complainant on 25 February 2005 and the Registrar was sent a copy of the notification letter and complaint that same day.
- 3.5 The Provider informed auDA of the complaint on 25 February 2005.
- 3.6 The Registrar was advised by the Provider to lock the website [www.ink-king.net.au](http://www.ink-king.net.au) on 25 February 2005.
- 3.7 On 2 March 2005, the Panel was approached by the Provider. On 4 March 2005, the Panel confirmed that there was no conflict of interest and accepted the appointment in respect of this dispute.
- 3.8 A response from Respondent was due by 22 March 2005. The Respondent did not submit a response. The Provider has received no correspondence from the Respondent throughout this process. The Provider has written to the Respondent on several occasions via e-mail to remind the Respondent of the due date for its response. To that end, the Provider sent e-mail reminders to the Respondent on 4 March 2005, 16 March 2005 and 22 March 2005.
- 3.9 The Panel was informed on 24 March 2005 that the dispute was being sent to the Panel for adjudication and that no response had been received from the Respondent.
- 3.10 As the Respondent has defaulted under paragraph 5(a) of the Rules, the Panel will proceed to a decision on the complaint in accordance with paragraph 14(a) of the Rules.

#### **4. FACTUAL BACKGROUND**

- 4.1 Given that the Respondent has failed to submit any response the following facts, taken from the complaint submitted by the Complainant, are uncontested.
- 4.2 The Complainant is a business owned by Broko Investments Pty Limited (ABN 60 001 511 888), a company incorporated on 16 September 1977 and having its principal place of business in Queensland ('**Broko Investments**').
- 4.3 Broko Investments owns two registered business names which are relevant to this administrative proceeding. The first is Ink King (BN17401689) which was registered with the Department of Equity and Fair Trading in Queensland on 27 September 2000. The second is Ink King Australia which was registered with the Department of Tourism, Racing and Fair Trading in Queensland on 3 October 2001.

- 4.4 The Complainant registered its domain name of 'ink-king.com.au' with Melbourne IT Ltd on 27 April 2001.
- 4.5 The Complainant is in the business of selling printer ink cartridges and refill kits and has operated in that business continuously since its business name of Ink King was registered in September 2000.
- 4.6 The Disputed Domain Name was registered by the Respondent on 15 June 2004.
- 4.7 The Respondent was incorporated on 5 June 2003 and, like the Complainant, has its principal place of business in Queensland.

## **5. PARTIES' CONTENTIONS**

### **A. The Complainant**

5.1 In summary, the Complainant contends that:

- (a) the Respondent has registered the Disputed Domain Name which is identical or confusingly similar to the registered business name of the Complainant; and
- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (c) the Domain Name has been registered or subsequently used in bad faith.

5.2 The Panel was assisted by a detailed complaint from the Complainant. In summary, the Complainant relies on the following matters in respect of paragraph 4(a)(i) of the Policy (which requires the Complainant to prove that the Disputed Domain Name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights):

- (a) the Disputed Domain Name is identical to the Complainant's registered business name of 'Ink King' and its prior registered domain name of 'ink-king.com.au', but for the Disputed Domain Name's use of the different suffix 'net.au';
- (b) the difference between 'net.au' and 'com.au' is not material for the purposes of determining whether a disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which a complainant has rights; and
- (c) the use of the Disputed Domain Name by the Respondent contravenes sections 52, 53(c) and 53(d) of the *Trade Practices Act 1974* (Cth).

5.3 In summary, the Complainant relies on the following matters in relation to paragraph 4(a)(ii) of the Policy (which requires the Complainant to establish that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name):

- (a) Broko Investments is the owner of the business names 'Ink King' and 'Ink King Australia';

- (b) there is no affiliation or association whatsoever between the Complainant and the Respondent;
- (c) the Respondent has not been given any licence or authority (whether verbal or written, express or implied) to use the 'Ink King' name;
- (d) the Respondent has never been commonly known as 'Ink King', nor does it hold any business names, trade marks or service marks in respect of the 'Ink King' name which are registered with any relevant Australian government authority; and
- (e) the Respondent therefore cannot show any rights or legitimate interests in respect of the Disputed Domain Name.

5.4 The Complainant also furnished some evidence that the Respondent has registered other domain names which are identical or confusingly similar to names, trade marks, or service marks in which parties other than the Respondent have rights and in respect of which the Respondent has no rights. For reasons given later in this decision, however, this contention is more appropriately directed to paragraph 4(a)(iii) of the Policy and it will be considered in relation to that provision.

5.5 In relation to paragraph 4(a)(iii) of the Policy (which requires the Complainant to establish that the Disputed Domain Name has been registered or subsequently used in bad faith), the following contentions of the Complainant are relevant:

- (a) the reputation of the Complainant, its registered business name of 'Ink King', the related business name of 'Ink King Australia' and the Complainant's prior registered domain name of 'ink-king.com.au' are sufficient to establish that the Respondent would have been aware of the Complainant and viewed the Complainant as a competitor;
- (b) the Respondent registered the Disputed Domain Name for commercial gain and with the intention of diverting Internet users to the web site and products of the Respondent (and away from the Complainant's web site and products) by creating a likelihood of confusion with the Complainant's registered business name of 'Ink King' and thereby misleading Internet users into believing that the Respondent's web site and/or products were sponsored by, affiliated with or endorsed by the Complainant (or that they were in fact dealing with the Complainant);
- (c) in the circumstances the Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant;
- (d) it would have been a simple matter for the Respondent to establish the existence of the Complainant's registered business name of 'Ink King' and the Respondent should not be entitled to assert that it did not know that the Disputed Domain Name might infringe the Complainant's rights;
- (e) the Respondent has engaged in a pattern of conduct involving the creation of domain names which are identical or confusingly similar to names, trade marks, or service marks in which parties other than the Respondent have rights and in respect of which the Respondent has no rights;

- (f) an applicant for registration of a domain name is taken to warrant that registration of the domain name will not infringe the rights of any third party. In this case, further evidence of the Respondent's bad faith may be found in the fact that the Respondent *'falsely represented'* that the Disputed Domain Name met certain criteria for registration set out at the Registrar's web site;
- (g) contrary to the *'Rules for Domain Name Registration'* set out at the Registrar's web site, the Respondent registered the Disputed Domain Name without having *'a solid relationship to the business it represents'*;
- (h) in the circumstances referred to above, the Respondent *'has blatantly abused the registration process'* and registered the Disputed Domain Name with the intention of:
  - (i) attracting Internet users to the Respondent's web site and products for commercial gain by creating the likelihood of confusion with the Complainant's registered business name;
  - (ii) giving Internet users a misleading impression of sponsorship, affiliation or endorsement of the Respondent's web site and products; and
  - (iii) misleading Internet users into thinking that they were in fact dealing with the Complainant.

## **B. The Respondent**

5.6 The Respondent, having failed to submit a response to the Provider, did not reply to any of the Complainant's contentions.

## **6. DISCUSSION AND FINDINGS**

6.1 Paragraph 2.1 of the Policy states, in part, that:

*'All domain name licences issued in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP. At the time of publication, the open 2LDs are asn.au, com.au, id.au, net.au and org.au.'*

6.2 The Disputed Domain Name is an open 2LD within the meaning of that provision. It was registered with the Registrar on 15 June 2004. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP.

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

6.3 In order to succeed, the Complainant will need to establish all of the matters set out in paragraph 4(a) of the Policy, namely 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.

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

6.4 Note [1] to the Policy states that, for the purposes of the Policy, auDA has determined that a '*name... in which the complainant has rights*' refers, inter alia, to:

*'the complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority'*.

6.5 In this case, the Complainant clearly has rights in the business name 'Ink King' which was registered with the Department of Equity and Fair Trading in Queensland on 27 September 2000.

6.6 The next question is whether the Disputed Domain Name is '*identical or confusingly similar to*' the Complainant's registered business name of 'Ink King'.

6.7 On the question of what is meant by '*identical or confusingly similar*', previous domain name dispute decisions have established that:

- (a) '*essential or virtual identity*' is sufficient: see *BlueChip InfoTech Pty Limited v Roslyn Jan and Blue Chip Software Development Pty Ltd*, LEADR Case No. 06/03 (26 December 2003); *Camper Trailers WA Pty Ltd v Off Road Equipment Pty Ltd*, LEADR Case No. 06/04 (12 November 2004); *Advanced Book Exchange Inc. v Argyle Emporium*, WIPO Case No. DAU2003-004 (13 November 2003); *The Crown in Right of the State of Tasmania trading as 'Tourism Tasmania' v Gordon James Craven*, WIPO Case No. DAU2003-0001 (16 April 2003); and *GlobalCenter Pty Ltd v Global Domain Hosting Pty Ltd*, WIPO Case No. DAU2002-0001 (5 March 2003); and
- (b) the global top level domain ('**gTLD**') components of domain names (such as '.com' and '.net') have no distinguishing capability and must therefore be ignored when considering whether a domain name is identical or confusingly similar to a name or mark: see *ESat Communications Pty Ltd v Kingford Promotions Pty Ltd*, LEADR Case No. 03/2003 (11 July 2003); *Camper Trailers WA Pty Ltd* (cited in paragraph 6.7(a) of this decision); *The National Office for the Information Economy v Verisign Australia Limited*, LEADR Case No. 02/2003 (26 June 2003); *MGM Home Entertainment & Ors v McIlroy Group Management Pty Ltd*, WIPO Case No. DAU2003-0006 (29 December 2003); *University of Melbourne v union melb*, WIPO Case No. DAU2004-0004 (3 December 2004); *Advanced Book Exchange Inc.* (cited in paragraph 6.7(a) of this decision); *Overture Services, Inc v Overture Search*, WIPO Case No. DAU2004-0002 (28 September 2004); *Supre Pty Ltd v Paul King*, WIPO Case No. DAU2004-0006 (22 December 2004); *BT Financial Group Pty Ltd v Basketball Times Pty Limited*, WIPO Case No. DAU2004-00001 (1 June 2004) and *GE Capital Finance Australia v Dental Financial Services Pty Ltd*, WIPO Case No. DAU2004-007 (7 January 2005).

- 6.8 The panel considers that, if one compares the Complainant's registered business name of 'Ink King' with the Disputed Domain Name of 'ink-king.net.au', they are essentially identical.
- 6.9 Given that the gTLD component of a disputed domain name (such as 'net.au') must be ignored when comparing a disputed domain name with other names or marks, the only difference between the Complainant's registered business name of 'Ink King' and the Disputed Domain Name is the hyphen which separates the words 'ink' and 'king' in the Disputed Domain Name.
- 6.10 The panel regards that difference as entirely insignificant as it merely reflects the fact that it is not possible to have a space between words in a domain name whereas it is possible for words in domain name to be separated by a hyphen.
- 6.11 For the reasons set out above, it is undeniable that the Disputed Domain Name is identical or confusingly similar to the Complainant's registered business name of 'Ink King'.
- 6.12 Accordingly, the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

- 6.13 A Complainant bears the onus of proving the absence of any rights or legitimate interests of the Respondent in a disputed domain name. However, once a complainant has asserted the absence of such rights or legitimate interests, it is incumbent on the respondent to put forward some evidence to rebut that assertion, because such information may be uniquely within the knowledge and control of the respondent: see the *GlobalCenter Pty Ltd* and *Tourism Tasmania* decisions (cited at paragraph 6.7(a) of this decision).
- 6.14 In the absence of any response from the Respondent, the Panel is entitled to infer that any evidence of the Respondent would not have been in its favour: see the *Supre Pty Ltd* decision (cited at paragraph 6.7(b) of this decision).
- 6.15 Paragraph 4(c) of the Policy sets out a non-exhaustive list of circumstances any of which, if established, will be taken to demonstrate a respondent's rights to or legitimate interests in a disputed domain name. The circumstances are as follows:
- (a) 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
  - (b) the fact that the respondent has been commonly known by the domain name (even if the respondent has acquired no trade mark or service mark rights); or
  - (c) the fact that 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, trade mark or service mark at issue.

- 6.16 As to the first of these matters, the evidence presented by the Complainant shows that the Respondent, before being notified of the subject matter of the dispute, was using the Disputed Domain Name in connection with an offering of goods or services.
- 6.17 The question, however, is whether that use of the Disputed Domain Name was *'bona fide'*. Based on the information provided by the Complainant, and in the absence of any response from the Respondent, the Panel is not satisfied that the Respondent's use of the Domain Name was bona fide. The reasons for this are as follows:
- (a) the Complainant and the Respondent have at all material times been competitors. Both are businesses based in Queensland which sell printer ink cartridges and refill kits. In these circumstances, the Respondent's use for commercial advantage of the Disputed Domain Name, which is virtually identical to the Complainant's registered business name of 'Ink King', is colourable: cf. *Camper Trailers WA Pty Ltd* (cited at paragraph 6.7(a) of this decision). In the absence of any contrary evidence from the Respondent, the Panel is entitled to infer from those circumstances that the Respondent knew of the Complainant's registered business name and online activities at the time when it registered the Disputed Domain Name;
  - (b) since 27 September 2000, the Complainant has been using the registered business name of 'Ink King'. Since 27 April 2001, the Complainant has also been using the domain name 'ink-net.com.au' which is virtually identical to the Disputed Domain Name subsequently registered by the Respondent in June 2004. By contrast, there is no evidence before the Panel to suggest that the Respondent has any business name, trade mark or service mark similar to the Disputed Domain Name. The Complainant has asserted that the Respondent *'cannot show any valid right or legitimate interest to the Ink King name'* and the Respondent, in failing to respond, has allowed that assertion to go unchallenged; and
  - (c) the Disputed Domain Name is not suggestive of the Respondent's business name of *CamerasDirect.com.au Pty Ltd* and there is no evidence before the Panel that the Disputed Domain Name is related to any other company, business or other legal or trading name associated with the Respondent and registered with any relevant Australian government authority.
- 6.18 Turning to paragraph 4(c)(ii) of the Policy, there is no evidence before the Panel that the Respondent has ever been commonly known by the Disputed Domain Name.
- 6.19 As to paragraph 4(c)(iii) of the Policy, there is no evidence before the Panel that the Respondent is making a legitimate non-commercial fair use of the Disputed Domain Name without intent for commercial gain to misleadingly divert consumers. Indeed, the only evidence before the Panel (that provided by the Complainant) points clearly towards the contrary conclusion which is identified later in this decision.
- 6.20 In summary, the evidence before the Panel discloses no basis on which it might be suggested that the Respondent has any rights or legitimate interests in the Disputed Domain Name.
- 6.21 For these reasons, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

- 6.22 Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances which, if established, shall constitute evidence of the registration and use of a domain name in bad faith. These circumstances are as follows:
- (a) circumstances indicating that the respondent has registered or 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
  - (b) where the respondent has registered the domain name in order to prevent the owner of a name, trade mark or service mark from reflecting that name or mark in a corresponding domain name; or
  - (c) where the respondent has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
  - (d) where, 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 web site or location or of a product or service on that web site or location.
- 6.23 In relation to paragraph 4(b)(i) of the Policy, there is no evidence before the Panel suggesting that the Respondent registered the Disputed Domain Name primarily for the purpose of selling, renting or otherwise transferring the registration of the Disputed Domain Name to another person.
- 6.24 As to paragraph 4(b)(ii) of the Policy, there is no evidence before the Panel suggesting that the Respondent registered the Disputed Domain Name to prevent the owner of a name, trade mark or service mark from reflecting that name or mark in a corresponding domain name.
- 6.25 In relation to paragraph 4(b)(iii) of the Policy the Complainant contended that *'the Respondent has used [the Disputed Domain Name] ... in bad faith, with the primary purpose of disrupting the business activities of the Complainant'*.
- 6.26 The Panel is not satisfied that the circumstances referred to in paragraph 4(b)(iii) of the Policy have been established. Although it was reasonably foreseeable by the Respondent that its registration of the Disputed Domain Name would disrupt the Complainant's business, there is insufficient evidence to establish that the Respondent registered the Disputed Domain Name primarily for that purpose.
- 6.27 For reasons given later in this decision, the Panel finds that the Respondent's registration of the Disputed Domain Name had as its primary purpose the achievement of commercial gain by the Respondent and not the disruption of the Complainant's business (although the latter may perhaps have been an incidental purpose for the Respondent's registration of the Disputed Domain Name.)
- 6.28 For these reasons, the Panel is not satisfied that the circumstances referred to in paragraph 4(b)(iii) of the Policy have been established in this case.

- 6.29 The Panel is satisfied that, by registering and using the Disputed Domain Name, the Respondent has intentionally attempted to attract Internet users to its web site for commercial gain by creating a likelihood of confusion with the Complainant's registered business name of 'Ink King' (as well as the Complainant's prior registered domain name of 'ink-king.com.au').
- 6.30 The Panel has reached this conclusion for the following reasons:
- (a) in the absence of any response by the Respondent, the Panel accepts the Complainant's contention that the reputation of the Complainant in its registered business name of 'Ink King' is sufficient to establish that the Respondent would have been aware of the Complainant and viewed the Complainant as a competitor;
  - (b) as noted in paragraph 6.17(a) of this decision, the Complainant and the Respondent are both businesses based in Queensland which sell printer ink cartridges and refill kits and, in these circumstances, the Respondent's use of the Disputed Domain Name, which is essentially identical to the Complainant's registered business name of 'Ink King', is colourable;
  - (c) indeed, it is telling to ask whether, had the Respondent and the Complainant not been competitors, the Respondent would have registered the Disputed Domain Name as opposed to some other domain name: cf. *Camper Trailers WA Pty Ltd* (cited at paragraph 6.7(a) of this decision). This is especially so when one considers that the word 'king' is not in any way descriptive of the relevant goods (printer ink cartridges and refill kits). This makes it inherently unlikely that the Respondent would, by a mere coincidence, have chosen a domain name identical to the Complainant's business name and used it in relation to similar goods: cf. *Overture Services* (cited at paragraph 6.7(b) of this decision);
  - (d) the Complainant put forward some evidence that the Respondent has registered other domain names which are identical or confusingly similar to names, trade marks or service marks in which parties other than the Respondent have rights and in respect of which the Respondent has no rights. In that regard, the Complainant relied on a decision of Jonathan Sumption QC (sitting a Deputy Judge of the English High Court in *Marks & Spencer Plc & Ors v One in a Million Ltd & Ors* [1998] FSR 265 (affd. sub nom *British Telecommunications Plc & Ors v One in a Million Ltd & Ors* [1999] 1 WLR 903). In that case, however, the evidence established that the defendant had registered numerous domain names comprising the names or trade marks of well known commercial enterprises without the consent of those enterprises and, in some cases, had offered to sell the domain names to those enterprises. In short, the *One in a Million* case was a clear case of 'cyber-squatting' and evidence of the nature and extent which existed in that case is not present here. Nevertheless, in the absence of any response by the Respondent to this contention (which was put fairly and squarely by the Complainant) the Panel considers that there is credible evidence to show that the Respondent has created other domain names which are identical or confusingly similar to names, trade marks or service marks in which parties other than the Respondent (including the Complainant or its related entities) have rights and in respect of which the Respondent has no rights;

- (e) upon examining the long list of other domain names registered by the Respondent (as detailed in the complaint), the overwhelming majority of them use the open 2LD 'com.au'. It is telling to note, however, that Respondent uncharacteristically used the open 2LD 'net.au' to register the Disputed Domain Name. It also happens to have used the open 2LD 'net.au' to register the domain name 'inkcartridges.net.au' which is identical or confusingly similar to 'inkcartridges.com.au' (another domain name owned Broko Investments). In the absence of any explanation from the Respondent, these circumstances entitle the Panel to infer that the Respondent chose to use the open 2LD 'net.au' to register the Disputed Domain Name because it knew that the domain name 'ink-king.com.au' had already been registered in connection with the Complainant's business. The Panel considers that it is appropriate to draw that inference in the circumstances of this case;
- (f) as a general matter, the Respondent failed to respond to the Complainant's contentions and paragraph 14(b) of the Rules provides that the Panel *'shall draw such inferences'* from the Respondent's failure to comply with the Rules *'as it considers appropriate'*. In this case the Complainant set out in detail the reasons for its contention that the Respondent's registration and use of the Disputed Domain Name were in bad faith. If the Respondent had been in a position to rebut the Complainant's contentions, it is reasonable to assume that it would have done so. The Respondent's failure to respond in any way to the Complainant's contentions justifies the drawing of inferences such as those referred to above which amply support the conclusion that the Respondent has registered and used the Disputed Domain Name in bad faith.

6.31 Taken together, these matters clearly establish that the Respondent's registration and subsequent use of the Disputed Domain Name have been in bad faith. The Panel is left in no doubt that the Respondent's purpose in registering the Disputed Domain Name was to attract Internet users to the Respondent's web site for commercial gain by creating a likelihood a confusion with the Complainant's registered business name of 'Ink King', thereby misleading Internet users into thinking that the Respondent's business had a commercial association with the business of the Complainant which did not in fact exist (or by misleading Internet users into thinking that they were in fact dealing with the Complainant).

### **Other contentions**

- 6.32 For the reasons given in paragraphs 6.29 and 6.30 of this decision, the Complainant has satisfied all of the elements of paragraph 4(a) of the Policy. That is sufficient to dispose of this matter but, in deference to the comprehensive nature of the complaint, the Panel will briefly address some additional contentions advanced by the Complainant.
- 6.33 First, the Complainant asserted that the Respondent was at least *'guilty of negligence'* because it *'ought to have known, or exercised reasonable care through the use of professional consultants or lawyers, not to infringe on the registered Ink King name'* and because *'A free search of the ASIC web site using either the words ink king or ink-king would have revealed the registered business names of the Complainant'*.
- 6.34 This amounts to a contention that the Respondent's registration and use of the Disputed Domain Name, combined with the Respondent's absence of rights in respect of the Disputed Domain Name and principles of *'constructive notice'*, should lead to a finding

of bad faith. Such an approach to the question of bad faith has been taken in previous domain name dispute decisions overseas: see, for example, *Kate Spade LLC v Darmstadter Designs*, WIPO Case No. D2001-1384 (3 January 2002); and *Cellular One Group v Paul Brien*, WIPO Case No. D2000-0028 (10 March 2000).

- 6.35 With the greatest respect, the Panel does not agree with the approach taken in those overseas decisions. It would enable a complainant, having satisfied paragraphs 4(a)(i) and 4(a)(ii) of the Policy, to argue that paragraph 4(a)(iii) had also been satisfied. The Panel's view is that such an approach to the question of bad faith would effectively render paragraph 4(a)(iii) of the Policy otiose.
- 6.36 Secondly, the Complainant contended that evidence of the Respondent's bad faith may be found in the fact that the Respondent '*falsely represented*' that the Disputed Domain Name met criteria for registration which were set out at the Registrar's web site. In that regard it should be noted that the matters referred to in paragraph 4(b) of the Policy are illustrative, but not exhaustive, of the circumstances which may be found to evidence registration or use of a domain name in bad faith.
- 6.37 The Panel accepts, as a general principle, that evidence of a respondent having provided false information in connection with the registration of a domain name may constitute evidence that the domain name was registered in bad faith: see *BT Financial Group Pty Ltd* (cited at paragraph 6.7(b) of this decision) and the decisions referred to therein.
- 6.38 The Panel also accepts, as a general principle, that evidence of other nefarious conduct by a respondent, such as taking deliberate steps to conceal its true identity or deliberately providing false contact details in breach of its registration agreement, may constitute evidence that a domain name was registered in bad faith: see *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. D2000-003 (18 February 2000). However, the inferences to be drawn from a respondent's conduct will of course depend on the specific facts of each case.
- 6.39 The difficulty with the Complainant's contention that the Respondent '*falsely represented*' certain matters to the Registrar is that there is no evidence before the Panel about the representations actually made by the Respondent. Although the complaint states that the Respondent completed a questionnaire on the Registrar's web site, no such completed questionnaire is before the Panel.
- 6.40 In the circumstances, there is no evidence before the Panel to establish that the Respondent '*falsely represented*' anything to the Registrar. The word '*false*' is generally taken to refer to a deliberate untruth and in this case there is no evidence before the Panel to establish that the Respondent made any deliberately untrue statements to the Registrar.
- 6.41 However, because the Panel is satisfied that the Respondent's registration and use of the Disputed Domain Name were in bad faith (for the reasons set out in paragraph 6.30 of this decision), it makes no difference that the Complainant has been unable to establish any additional evidence of bad faith.
- 6.42 Thirdly, the Panel makes no finding in relation to the Complainant's contention that the Respondent's use of the Disputed Domain Name contravenes sections 52, 53(c) and 53(d) of the *Trade Practices Act 1974* (Cth). The Panel is unable to determine such issues in the context of this administrative proceeding and says nothing more about them.

**7. RELIEF**

- 7.1 The Complainant has requested a transfer of the Dispute Domain Name to the Complainant.
- 7.2 Pursuant to paragraph 4(i) of the Rules, a complainant will only be entitled to the transfer of a disputed domain name if the complainant is otherwise eligible to hold that domain name.
- 7.3 Having regard to the Complainant's rights in respect of the registered business name 'Ink King', by which it has been known since September 2000, the Panel considers that the Complainant is clearly eligible to hold the Disputed Domain Name.
- 7.4 The Panel therefore considers that the Disputed Domain Name should be transferred to the Complainant.

**8. DECISION**

- 8.1 The Complainant has satisfied all of the elements of paragraph 4(a) of the Policy.
- 8.2 The Panel directs that the Disputed Domain Name be transferred to the Complainant.

Dated this 6th day of April 2005

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Michael J Sophocles

Sole Panellist