



ABN 69 008 651 232

## ADMINISTRATIVE PANEL DECISION

**Disputed Domain Names:** <premierfire.com.au> and <premierfire.net.au>  
**Name of Complainants:** Premier Fire Protection Services (NSW) Pty Ltd and Premier Fire Services (NSW) Pty Ltd  
**Name of Respondent:** Nixon Safety Pty Ltd  
**Provider:** LEADR  
**Panel:** ME Dixon

### 1. THE PARTIES

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- 1.1 The Complainants are:
- 1.1.1 Premier Fire Protection Services (NSW) Pty Ltd; and
  - 1.1.2 Premier Fire Services (NSW) Pty Ltd,
- both represented by Axis Legal.
- 1.2 The Respondent is Nixon Safety Pty Ltd, represented by Mr Blair Nixon.

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

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- 2.1 The disputed domain names are <premierfire.com.au> and <premierfire.net.au> (**Disputed Domain Names**).
- 2.2 The registrar of the Disputed Domain Names is Net Registry of 97 Rose Street, Chippendale NSW 2008 (**Registrar**).
- 2.3 The provider in relation to this proceeding is LEADR (**Provider**).

### 3. PROCEDURAL HISTORY

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- 3.1 This proceeding concerns a complaint (**Complaint**) submitted in accordance with:

- 3.1.1 the .au Dispute Resolution Policy No. 2002/22 (**auDRP**), which was approved by .au Domain Administrator Ltd (**auDA**) in 2001 and which commenced operation on 1 August 2002, including:
    - 3.1.1.1 Schedule A (**auDRP Policy**); and
    - 3.1.1.2 Schedule B (**auDRP Rules**);
  - 3.1.2 the Provider's Supplemental Rules to Rules for au Domain Name Dispute Resolution Policy (**LEADR Rules**).
- 3.2 The Provider has supplied the Panel with a document entitled "Procedural History – www.premierfire.com.au and www.premierfire.net.au". This document provides that:
- 3.2.1 the Complaint was received by the Provider on 3 July 2005.
  - 3.2.2 On 8 July 2005 the Respondent received email notification of the Complaint. On the same day the Provider express posted to the Respondent a dispute notification letter and a copy of the Complaint and emailed a copy of the dispute notification letter to the Complainant's authorised agent.
  - 3.2.3 On 8 July 2005 a copy of the application and a copy of the dispute notification letter was also express posted to the Registrar.
  - 3.2.4 On 8 July 2005 the Provider advised auDA of the Complaint via email.
  - 3.2.5 On 8 July 2005 the Registrar was advised by email to lock the websites <premierfire.com.au> and <premierfire.net.au>.
  - 3.2.6 On 12 July 2005 the Registrar, by return email, advised the Provider that they had sent a request to have the Disputed Domain Names locked and envisaged this would occur by close of business that same day.
  - 3.2.7 On 13 July 2005 the Provider approached the Panel. The Panel conducted a conflict search on the parties. The Panel confirmed its availability and informed the Provider that it had no conflict issues with the parties and accepted the matter on 18 July 2005.
  - 3.2.8 On 20 July, as a courtesy reminder, the Provider telephoned the Respondent and advised when the response was due.
  - 3.2.9 On 29 July 2005 the Provider again telephoned the Respondent and left a further reminder as to when the response was due.
  - 3.2.10 On 30 July 2005 the Respondent's response was received via email.

3.2.11 All procedural requirements appear to have been satisfied.

#### 4. FACTUAL BACKGROUND

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4.1 In the Complaint the Complainants assert that:

4.1.1 Premier Fire Protection Pty Ltd was incorporated as a company on 1 July 1987 (**First PF Company**) and was wound up in 1995;

4.1.2 Premier Fire Protection (NSW) Pty Ltd (**Second PF Company**) acquired the assets and continued the First Company's operations until 1999;

4.1.3 the Complainants acquired the assets of the Second PF Company in 1999 and have split the fire protection services and installation business operationally and financially.

The Panel notes that the Complainants have not provided the Panel with full ASIC searches or other supporting evidence verifying these assertions. Further, given the lack of supporting evidence, the Panel is unable to ascertain the relationship between the First PF Company, the Second PF Company and the Complainants.

4.2 In the Complaint the Complainants also assert:

4.2.1 Mr Gordon Salley, a director of the First PF Company, arranged for the registration of the domain name <premfire.com.au> with Ozemail on August 26 1987;

4.2.2 the Complainants registered the domain name <premfire.com> in 2002;

4.2.3 the Complainants recently registered the domain name <premfire.net.au>;

4.2.4 the Complainants sought to register the domain name <premierfire.com.au> but found that the Disputed Domain Names had been registered by the Respondent on 9 June 2004;

4.2.5 the Respondent was incorporated in February 2004;

4.2.6 the Disputed Domain Names resolve to the website of one of the Complainant's competitors, Austwide Protection Services Pty Ltd (**Austwide**).

The Complainants provided no evidence to the Panel of the registration of any domain name. Further, the Complaint fails to identify which of the Complainants is said to be the owner of any domain name or indeed of any other rights in the words "PREMIER FIRE". The Complainants provide some evidence of use of the words "PREMIER FIRE".

- 4.3 In its submissions, the Respondent asserts that it was incorporated in February 2004 but it has similarly failed to provide the Panel with any supporting evidence.

## 5. PARTIES' CONTENTIONS

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### 5.1 Complainants

The Complainants contend that:

- 5.1.1 they have rights in the trademark "PREMIER FIRE" (**Trade Mark**);
- 5.1.2 the Disputed Domain Names are identical or confusingly similar to the Trade Mark or a name to which the Complainants have rights;
- 5.1.3 the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- 5.1.4 the Disputed Domain Names have been registered or subsequently used by the Respondent in bad faith.

### 5.2 Respondent

The Respondent contends that:

- 5.2.1 it was the first to register the Disputed Domain Names and therefore common law trade mark rights do not apply;
- 5.2.2 the words "PREMIER FIRE" are not capable of constituting a trade mark;
- 5.2.3 the Disputed Domain Names are not confusingly similar to the Complainant's names; and
- 5.2.4 a future marketing plan has been formulated that will include the words "PREMIER FIRE".

## 6. DISCUSSION AND FINDINGS

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

- (i) the Disputed Domain Names are 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 Names; and

- (iii) the Disputed Domain Names were registered or subsequently used in bad faith.

## 6.1 Identical or Confusingly Similar

Note 1 to paragraph 4(a)(i) of the auDRP provides that:

*"For the purposes of this policy, auDA has determined that a "name ... in which the complainant has rights" refers to:*

- a) **the complainant's company**, business or other legal or trading name, as registered with the relevant Australian government authority; or*
- b) the complainant's personal name."*

[emphasis added]

The Complainants incorporate the words "PREMIER FIRE" in their company names, namely:

- o Premier Fire Protection Services (NSW) Pty Ltd; and
- o Premier Fire Services (NSW) Pty Ltd (collectively the **Company Names**).

The Company Names are therefore "names" for the purpose of paragraph 4(a)(i) of the auDRP Policy.

The Complainants rely on the decision in *Premier Group Inc v Usearch Inc, eResolution AF-0250* for the proposition that the "addition of the generic suffices '.com.au' or '.net.au' does not distinguish" the Disputed Domain Names from the Trade Mark. Although this decision was decided under the ICANN Uniform Domain Name Dispute Resolution (**UDRP**) the principle has been cited and approved in other determinations under the auDRP in respect of open second level domains (**2LDs**), e.g. *GlobalCenter Pty Ltd v Global Domain Hosting Pty Ltd*, WIPO Case No. DAU2002-0001 (March 5, 2003) by a single panellist 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. The Panel therefore adopts these principles for comparing domain names containing ".com.au" or ".net.au" elements, with a name or mark. It is noted that the Complainants assert that the Complainants are commonly known as "PREMIER FIRE", an abbreviation of the Complainants' full names.

The question is whether the words "PREMIER FIRE" are identical or confusingly similar to the Company Names.

It is clear that the words "PREMIER FIRE" (featuring in both Disputed Domain Names) are not identical to the company name "Premier Fire Protection Services (NSW) Pty Ltd" given that the words "Protection Services (NSW)" do not feature in the Disputed Domain Name.

Similarly, the words "PREMIER HRE" are not identical to the company name "Premier Fire Services (NSW) Pty Ltd" given that the words "Services (NSW)" do not feature in the Disputed Domain Name.

The Respondent asserts that the term "PREMIER FIRE" does not "constitute a similar or confusing domain" and cites the decision, without any reason for citing this authority, in *BlueChip InfoTech Pty Limited v Roslyn Jan and Blue Chip Software Development Pty Ltd* LEADR – Case No. 06/03 (23 December 2003) (**BlueChip Case**). In this case the domain name <bluechip.com.au> was held not to be confusingly similar to the complainant's name, "BlueChip InfoTech Pty Ltd". The respondent in that case contended that the words "Blue Chip" were common terms and had made submissions and attached evidence that the term "Blue Chip", both by itself and with other words, are widely used in corporate/business names and trade marks. Furthermore, the common descriptiveness of the words "Blue Chip" made the words "Info Tech" an essential feature of the name. The Panel notes that the Respondent provided no such evidence in this case.

The Panel considers that another important factor in the BlueChip Case was that the disputed domain name was registered by the respondent six years *before* the Complainant chose to change its name to incorporate the words "Blue Chip". This case can therefore be distinguished on its facts.

It is the Panel's view that the words "PREMIER FIRE" are confusingly similar to the company name, "Premier Fire Services (NSW) Pty Ltd". The words "Services" and "NSW" are common additions to company names and do not distinguish the company name from others.

Notwithstanding the addition of the word "protection", the Panel is of the view that the Disputed Domain Names are confusingly similar to the company name, "Premier Fire Protection Services (NSW) Pty Ltd".

The Panel finds that the Complainants both have rights in their own names and that the Disputed Domain Names are confusingly similar to these names.

In view of this finding it is not necessary for the Panel to consider whether the Complainants have common law trade mark rights in the word "PREMIER FIRE".

## 6.2 No Rights or Legitimate Interest

Paragraph 4(c) of the auDRP Policy sets out how the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Names.

Paragraph 4(c)(i) of the auDRP Policy provides the following:

*"before any notice to you of the subject matter of the dispute, your 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 you have acquired for the purpose of selling, renting or otherwise transferring)..."*

[emphasis added]

According to the Business Name Extract provided by the Complainant, Blair Nixon registered the business name "Australia's Premier Fire Systems" (BN98136625) (**Business Name**) on 29 April 2005.

The *previous day* the Complainants' representative wrote to both the Respondent and Austwide by registered mail and brought the subject matter of the dispute to their attention (**Notification Letter**). The Respondent therefore cannot rely on the Business Name as evidence of legitimate use of the words "PREMIER FIRE". The Panel considers that the apparent registration of the Business Name after the receipt of the Notification Letter (which is not denied by the Respondent) suggests that the Respondent knew that it had no rights or legitimate interests in the words "PREMIER FIRE" and only took such action in an attempt to justify its activities. In any event, according to the Business Name Extract, it is Mr Nixon in his personal capacity and not the Respondent that is permitted to carry on a business under the Business Name.

In its Response to the Complaint, the Respondent suggests that it has "rights or legitimate interests" in the Disputed Domain Names because it invested heavily in the development of the new websites and therefore is "in a position to protect" its investment. The Respondent goes on to state that it has:

*"...formulated a future marketing plan that intrinsically involve[d] not only the website but also direct marketing of a new service along with the new business logos and name "Australia's Premier Fire Systems" and products."*

The Panel cannot accept these arguments.

The Panel notes that apart from a line at the bottom of each web page, the Respondent does not use the words "PREMIER FIRE " in its websites. The Respondent has provided no other evidence of its use of the words "PREMIER FIRE". To that end, the response to the Notification Letter (which is from Austwide Group and not the Respondent) expressly states:

*"[t]here is no use of the name "PREMIER FIRE" on my website".*

The Respondent contends that the status of being first in time as registrant of the Disputed Domain Names is determinative of all issues. The Panel notes that Note 2 appearing in relation to 4(c) of the auDRP is instructive for this purpose and states that such rights or legitimate interests:

*"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."*

On the basis that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the auDRP Policy, and the Respondent has not produced conclusive evidence to the contrary, the Panel determines that the Respondent has no right or legitimate interest in the Disputed Domain Names.

### **6.3 Registered or Subsequently Used in Bad Faith**

The Complainants argue that bad faith registration and use is evidenced by the circumstances of Paragraph 4(b) (ii), (iii) and (iv) of the auDRP Policy which states:

- "(ii) you have 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) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or*
- (iv) by using the domain name, you have 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. "*

Part of the Complainants' evidence of the Respondent's bad faith is that by typing the Disputed Domain Name an internet user is diverted to a competitor's website. The Complainant provided printouts of the Disputed Domain Name websites as evidence of this.

It is the Panel's view that the use of the Disputed Domain Names to direct users to the competitor's web pages, being a party other than the Respondent, is evidence of the Respondent's use of the Disputed Domain Names in bad faith. There is little doubt that commercial gain could result from such use of the Disputed Domain Names. Whilst the Respondent denies the Complainants' allegations and asserts that the use of the Disputed Domain Names is consistent with the implementation of the "broader strategy" of, amongst others, "Australia's Premier Fire Systems", the Respondent has provided no evidence to the Panel for consideration. The Panel notes that the Respondent's "broader strategy" and proposed use of the words "PREMIER FIRE" do not actually include the Respondent *per se*. The Panel finds that the Disputed Domain Names have been used by the Respondent in bad faith, falling within the activities described under paragraph 4(b)(iv) of the auDRP Policy.

Unlike the UDRP, under the auDRP the Complainant must only prove that the Disputed Domain Names were registered *or* subsequently used in bad faith. Having decided that the Disputed Domain Names were "used" in bad faith, it is not necessary for the Panel to decide whether they were registered in bad faith.

## **7. DECISION**

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The Complainants have satisfied the elements of paragraph 4(a) of the auDRP Policy.

## **8. RELIEF**

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The Complainants have sought a direction that the Disputed Domain Names be transferred to "either or both of the Complainants". It is unclear to the Panel how the Disputed Domain Names could be transferred to "both of the Complainants". Based on the submissions and the evidence before it, the Panel is also unable to decide to which one of the Complainants the Disputed Domain Names should be transferred. The Panel is therefore unable to order the transfer of the Disputed Domain Names to the Complainants. However, the Complainants have requested in the alternative, that the Disputed Domain Names be cancelled.

As such and for the foregoing reasons and in accordance with paragraphs 4(i) of the auDRP Policy and 15 of the auDRP Rules, the Panel directs that the registration of the Disputed Domain Names be cancelled.

Dated this 17<sup>th</sup> day of August 2005.

**Michelle Dixon**  
Sole Panelist