



auDRP09/08

Domain Name: **domuslift.com.au**

Name of Complainant: **Easy Living Home Elevators Pty Ltd**

Name of Respondent: **Lift Shop Pty Ltd**

Provider: **LEADR**

Panel: **Gregory Burton**

EASY LIVING HOME ELEVATORS PTY LTD & LIFT SHOP PTY LTD

Determination re: www.domuslift.com.au

1. I received the complaint, response and procedural history on 29 December 2008, having been asked to accept, and having accepted, appointment on 22 December 2008.

2. The complainant relies upon the following matters in support of its application to have the domain name transferred to its ownership (I have interpolated some comment and qualification in the course of stating the matters relied upon):

2.1 The complainant has since 2000 supplied and serviced an Italian brand of primarily residential elevators containing the core word Domus, with the primary product supplied having the brand name DomusLift (sometimes the words are separated, sometimes not, sometimes the L is capitalised, sometimes not). The other products supplied and serviced have the brand names Domus XL Lift and Super Domus Lift.

2.2 The Italian manufacturer of those products has stated that the complainant has been its sole distributor since 2000 of the products, and uses the word exclusive in relation to that distribution but with no date for exclusivity.

2.3 The manufacturer also has stated that the complainant is its authorised maintainer and repairer of the products and that the respondent is not authorised to maintain and repair those products. (There is no evidence that the manufacturer and the complainant have sought to prevent the respondent from maintaining and repairing those products, if there was any basis to be able to do so. However, one can infer that unauthorised repair and maintenance would be advanced as a reason for voiding any manufacturer's and supplier's warranties.)

2.4 The manufacturer has stated that it has authorised the complainant to act on its behalf and is “happy for the trade mark and domain rights to rest with [the complainant]”.

2.5 The complainant on 10 June, 12 August and 11 June 2008 respectively applied, with the apparent consent and support of the manufacturer, to register in Australia in the relevant categories of lift supply and service the trade marks “DomusLift”, “DOMUS” and “SuperDomus”. The first of those marks is identical in text content to the domain name; the other two in my view would be seen as confusingly similar or deceptive if sought to be registered by someone else in the same categories. The first and third of those marks were accepted on 10 September 2008 with a sealing date of 9 April 2009 and were advertised on 9 October 2008. At date of search (14 Oct 08) the second mark had been accepted and was awaiting advertisement. (Although the opposition period has not yet expired, there is no evidence before me of any opposition to registration and the opposition period is closing.)

2.6 The manufacturer is the registered owner in the EU as at 10 April 2006 (applied for 17 May 2005) of the trade mark “DOMUSLIFT” which is identical in text content to the first mark applied for in Australia and to name of the primary product supplied and serviced by the complainant in Australia.

2.7 The manufacturer’s website, which has at the top of its product list the primary product DomusLift supplied and serviced in Australia by the complainant, links inquiries concerning Australia to the complainant’s website. (The website appears to have links to countries in Europe and Asia.)

2.8 The complainant expends approximately \$200,000.00 per annum on marketing the product range for which it has sole/exclusive distribution rights; the marketing appears to be by all media including the internet. The complainant claims a substantial local goodwill and reputation in and long-

standing local association with those products and their long-standing international reputation (over 40 years internationally). (I note the respondent's material includes a "case study" which is apparently authored in part by a person connected with the complainant in which sales in Australia of those products are said to have grown from nothing in 2000 to nearly 500 per annum in a newly created market. The trade literature provided by the complainant suggests an emerging market for the products since 2000.)

2.9 Some of the complainant's local marketing literature includes what appears to be a brochure produced by the manufacturer which contains the word "DOMUSLIFT" with a registered trade mark symbol and immediately below it the domain name "www.domuslift.com".

2.10 The respondent has stated that it seeks only to service the relevant products but supplies competing brands of residential elevator.

2.11 The respondent on 31 July 2008 said to the manufacturer that it "may be prepared to rent it [the domain name] to you because I still wish to help you and really I am only interested in servicing the lifts and do so. Perhaps you want to consider."

3. The respondent relies upon the following matters to maintain its domain name licence which it previously referred to as a property right but no longer does so (again, I have interpolated some comment and qualification in the course of stating the matters relied upon):

3.1 In July 2008 it successfully defended its eligibility to have the domain name registered, apparently on eligibility criterion Sch C para 2(b), namely, that the domain name was otherwise closely and substantially connected with the licensee.

3.2 It was registered (apparently in 2006 according to the complainant's material, the date in 2006 is not clear) before the complainant's local applications for a registered trade mark (but not before any common law

rights in the mark which the complainant may have acquired.). Those applications are still in opposition period.

3.3 The complainant's trade mark rights are irrelevant.

3.4 It is entitled to service one of the relevant Italian products if the owner wants that done.

3.5 It supplies and services in Australia a Chinese-manufactured residential elevator called the domus lift, which obtained trade mark registration on 7 July 2004. It supplies that product in Australia under the name "freedom lift".

3.6 The respondent is entitled to remain registered if it satisfies the eligibility criteria to obtain registration of the domain name.

3.7 The respondent obtained the registration of the domain name some two years before the offer to rent it, in circumstances where it supplied and serviced a Chinese product manufactured under that name and trade mark "domus lift", and the offer to rent the domain name was made in the course of protracted correspondence disputing entitlement to be registered. The sole purpose of obtaining registration was not within the criteria for bad faith.

4. There is no evidence of the scope of the Chinese trade mark registration. On its face it appears to be a registration in China with no direct effect in Australia.
5. There is no evidence from the respondent of the timing and degree of market penetration of the Chinese product in Australia and under what name that penetration has been and is effected except that the respondent does not supply it under the name domus lift but, rather, under the name freedom lift.
6. In that circumstance, the close and substantial connection with the respondent which enabled registration to be obtained and maintained appears

to be with the supply of the product and offer to service the product as opposed to the name under which the product is supplied by the respondent.

7. By contrast, the complainant has had a long-standing and substantial investment in and association with the supply and service of a product whose name (for the primary product in the range) is in text identical to the domain name and where the other products in that range have names confusingly similar to the domain name.
8. Whether or not the complainant can prevent private servicing arrangements between owners of the Italian product range it supplies and the respondent (even if such arrangements do void any warranty) seems to me to be irrelevant to the inquiry. The complainant is, on the evidence before me, the sole or exclusive supplier and the only *authorised* servicer of the relevant products with the name identical or confusingly similar to the domain name. It is the significance of that fact which is the relevant matter.
9. As the decision on eligibility to obtain registration itself stated, such a decision does not affect rights to challenge the use by that licensee (the respondent) of the domain name:

“We suggest you also make [the respondent] aware that just because we have found that their registration is not in breach of auDA policy rules, does not mean that their use of the domain name cannot be challenged under other avenues, such as the .au Dispute Resolution Policy (refer to <http://www.auda.org.au/audrp>) or other legal action.” (auDA to service provider email 28.vii.08 9.44am in respondent’s material; refer Note [2] to auDRP 2008-01 Sch A para 4(a)(ii))

10. The complainant’s material, and the absence of material from the respondent to demonstrate actual use by it (or anyone else) of domuslift (apart from offers of servicing arrangements) in the domain name demonstrates that “domuslift” has on a long-standing basis been closely associated in Australia with the

commercial activity of the complainant, with the apparent consent and support of the manufacturer of relevant product of that name or substantially similar name which has an international reputation and EU trade mark protection.

11. The domain name is identical in text with a .com domain name used by the European manufacturer in product literature which is distributed in Australia by the complainant. The domain name is identical in text with the name of the primary product in the range solely (and for a time exclusively) distributed in Australia by the complainant and confusingly similar to the names of other products in that range.
12. There is a strong inference from the features identified in the preceding paragraphs that the domain name would raise in the mind of a reasonable viewer that there was an association of the domain name with the complainant in a broad manner encompassing supply and authorised service and ancillary activities.
13. I find that the domain name is identical or confusingly similar to the complainant's common law trade mark or service mark in Australia and very shortly (in the apparent absence of opposition) will be identical or confusingly similar to the complainant's registered trade marks in Australia; refer auDRP Sch A para 4(a)(i).
14. I have previously noted that meeting the eligibility criteria to register a domain name does not of itself establish a right or legitimate interest in respect of the domain name: refer auDRP Sch A para 4(a)(ii) and Note [2].
15. The respondent has not sought to make a case of actual use of the domain name as part of its name or in connection with its business in Australia, other than servicing arrangements which are not authorised by the manufacturer or its sole distributor. The respondent does not supply the Chinese products under the domus lift name (leaving aside any question of entitlement to do so under trade mark law if it attempted to do so).

16. If the respondent had registered a domain name containing domuslift but limited to servicing it *may* have had a stronger claim of actual use prior to notice of the subject matter of the dispute: refer auDRP Sch A para 4(c)(i).
17. However, as previously stated, the domain name infers association with all aspects of supply and authorised service of a product range with the name domuslift or substantially similar name. I find that the respondent has no right or legitimate interest in respect of the domain name in its current broad and unqualified form. Questions concerning a narrower registration can be left for if and when they arise.
18. I am not satisfied that the evidence goes so far as to support a finding of primary purpose of the description within auDRP Sch A para 4(b)(i) or (iii). I am, on balance, not satisfied that the lesser test of purpose in para 4(b)(ii) has been made out, bearing in mind that the complainant bears the onus of proof.
19. However, I am satisfied that the evidence supports a finding that auDRP Sch A para 4(b)(iv) is made out and that accordingly the domain name has been registered and in particular subsequently used in bad faith under auDRP Sch A para 4(a)(iii). The use of the domain name in its current form gives legitimacy to the service arrangements offered by the respondent via that name by inferring an association or endorsement of such arrangements (contrary to the fact) by the supplier of the product sought to be serviced. The respondent's material refers to a history of disputation and vigorous competition between the parties which infers an intent to take advantage if it is within (even if close to) the letter of the law. If it is found to have strayed to the wrong side of that letter, that does not reduce the intent to engage in the act, merely a miscalculation on the consequence.
20. I find the complaint made out.
21. As to remedy, there has been an obvious history of vigorous competition and

dispute between the parties in relation to the domain name and generally. There is an absence of any offer of undertaking from the respondent not to seek to re-register the domain name if cancelled, either in its own name or in the name of an associate or with another registrar. The complainant is clearly eligible to hold the domain name (auDRP Sch A para 4(i)). In the circumstances, I consider the appropriate remedy is to require transfer of the domain name to the ownership of the complainant.

22. The respondent raised allegations in its response about the complainant. These are not part of the dispute I am asked to determine. In any event, I have no evidence in respect of the allegation about the alleged registration of a domain name and the source code allegation involves words which seem to me to appear quite legitimately used, in context and without further evidence.

Wentworth Chambers

8 January 2009

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Gregory Burton, SC

Determiner