



ADMINISTRATIVE PANEL DECISION

Sitecore Australia Pty Ltd

v

WB Solutions Pty Ltd

LEADR Case No.

Domain Names: **sitecore.com.au & sitecore.net.au**
Name of Complainant: **Sitecore Australia Pty Ltd**
Name of Respondent: **WB Solutions Pty Ltd**
Provider: **LEADR**
Panel: **Anthony P. Alder**

1. THE PARTIES

- 1.1 The Complainant is **Sitecore Australia Pty Ltd** (“SAU”).
The Respondent is **WB Solutions Pty Ltd** (“WBS”).

2. THE DOMAIN NAMES AND PROVIDER

- 2.1 The current dispute is regarding the domain names **sitecore.com.au** and **sitecore.net.au** (“the Domain Names”).
2.2 The provider in relation to this proceeding is **LEADR** (“Provider”).

3. PRELIMINARY MATTERS

- 3.1 Schedule A of the *.au Dispute Resolution Policy* (“auDRP”) applies to disputes which meet the requirements set out in Paragraph 4(a) of Schedule A of the auDRP. This subparagraph 4(a) requires that any party holding a domain name licence “...*submit to a mandatory administrative proceeding in the event that a third party (a “Complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure that:*

- (i) [their] domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
- (ii) [they] have no rights or legitimate interests in respect of the domain name; and
- (iii) [their] domain name has been registered or subsequently used in bad faith.

In an administrative proceeding, the complainant bears the onus of proof.”

4. PROCEDURAL HISTORY

4.1 The Procedural History in this matter is set out in Annexure A.

4.2 LEADR has appointed this Panellist as the sole panellist in the matter. The Panellist has had no prior knowledge of or association with either party and has no conflict of interest.

4.3 The Panel additionally notes that the Procedural History does not include an additional email responses from the Complaint dated 14 January 2009 and the Respondent dated 30 December 2008. These email responses were both allowed and considered by the Panel and both serve in addition to the original submissions made by both parties. These additional responses were both allowed in the interests of procedural fairness.

4.4 All procedural requirements appear to have been satisfied. The Panel has been properly constituted.

4.5 Paragraph 15(a) of the auDRP Rules states:

“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy [the auDRP Policy], these Rules and any rules and principles of law that it deems applicable”.

5. FACTUAL BACKGROUND

5.1 A Danish Company, Sitescore A/S (‘SAS’) has been using the trade mark SITECORE since 2001 in Denmark.

5.2 Both Domain Names were registered on 3 November 2004 by WBS.

5.3 SAU was registered as an Australian company on 26 July 2007.

5.4 SAU is a wholly owned subsidiary of SAS.

5.5 SAS has a significant reputation in Europe and Denmark and is a well recognised brand in Europe.

5.6 SAS is not a named Complainant in this dispute.

5.7 WBS applied for Australian Trade Mark Application SITECORE on 14 May 2008 in respect of software, which is currently the subject of opposition proceedings, and a

second Australian Trade Mark Application SITECORE on 11 November 2008, which is currently pending.

- 5.8 SAS applied for Australian Trade Mark Applications for SITECORE and SITECORE LOGO on 25 November 2008 neither application has been registered.
- 5.9 WBS submitted detailed business plans detailing their intentions plans. These plans were initially drafted in May 2004 and were the subject of multiple revisions since that time.
- 5.10 No evidence was presented showing that the WBS or its directors knew of existence of either SAU nor SAS prior to registering the Domain Names.

7. DISCUSSION AND FINDINGS

Elements of a successful complaint

- 7.1 According to Paragraph 4(a) of the auDRP Policy, a person is entitled to complain about the registration or use of a domain name where:
 - (i) *The domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and*
 - (ii) *The respondent to the complaint has no rights or legitimate interests in respect of the domain name; and*
 - (iii) *The respondent's domain name has been registered or subsequently used in bad faith.*
- 7.2 It is to be noted that the three elements of a complaint under Paragraph 4(a) of the auDRP Policy are cumulative; all of them must be proved if the complaint is to be upheld.
- 7.3 In these administrative proceedings, the Complainant bears the onus of proof regarding each of the separate components required by Paragraph 4(a) of the auDRP Policy.

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

- 7.4 The Panel must determine whether, on the basis of the facts set out in Paragraph 4 above, the Complainant has rights in a relevant name, trade mark or service mark.
- 7.5 The auDRP Policy states:

“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;*

(b) *The complainant’s personal name.”*

- 7.6 The Complainant is allegedly using the trade mark SITECORE in Australia and their company name incorporates SITECORE.
- 7.7 The trade mark SITECORE is substantially identical and confusingly similar to the Domain Names.
- 7.8 On the balance of material presented to the Panel, the Panel determined that there is the real potential, and the actuality of, confusion of identity. However, SAU has not demonstrated that they are the rightful owners of the trademark, nor have conclusively demonstrated that they have used the trade mark or name in Australia, as per the understanding of Australian case law regarding “use of a trade mark” in the jurisdiction of Australia. Specifically, SAU has failed to demonstrate any kind of sales or revenues from their products in Australia and therefore failed to show that they had a reputation for their products in Australia.
- 7.9 Additionally, SAU failed to demonstrate the authority by which they claim ownership of the SITECORE trade mark. They stated in their Complaint, that SAS and SAU jointly own a common law trade mark in Australia for the name SITECORE and submitted no supporting documentation. Also, SAS is not a party to this Complaint and therefore by the Complaint’s own admission they are not entitled to the Domain Name.
- 7.10 Furthermore, SAS filed for Australian trade mark applications in its name, alone, without naming SAU. SAU is not recorded as a licensee and no information was provided to support a licensing relationship. Additionally, this Australian Trade Mark Application seems to contradict the earlier assertion of joint ownership.
- 7.11 The Complaint in these proceedings bears the onus of proving the requirements and ownership under auDRP. Accordingly, the Panel determines that the Complainant has not satisfied the requirement of Paragraph 4(a)(i) of the auDRP Policy.

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

- 7.12 Paragraph 4(c) of the auDRP Policy sets out particular circumstances (without limitation), which can demonstrate a Respondent’s “*rights or legitimate interests to the domain name for purposes of Paragraph 4(a) (ii).*”

- 7.13 The Respondent has demonstrated their activities fall within the scope of the specified activities enumerated in Paragraph 4(c) of the auDA Policy for providing a basis for bona fide intention to use of the domain name.
- 7.14 The Respondent has shown that they intended to use the word SITECORE in relation to their software and recruitment activities. This was demonstrated by way of business plans, timelines and screenshots of the proposed product submitted by the Respondent.
- 7.15 The Respondent's pending trade mark application filed before SAS's applications also supports the Respondent's intentions.
- 7.16 Accordingly, the Panel finds that the Respondent has legitimate interest and intention to use the domain name, and so Paragraph 4(a)(ii) of the auDRP Policy has not been satisfied by the Complainant.

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

- 7.17 Paragraph 4(b) of the auDRP Policy sets out circumstances of "*evidence of the registration and use of a domain name in bad faith*". This Paragraph contains four sets of example circumstances, any one of which, if established, can constitute evidence of registration in bad faith. It is important to note also that it is a non-exhaustive list of circumstances such that, for example, the Panel is not necessarily constrained from a finding of bad faith should it arise (also by example) from not only any one or other of them, but from a combination of them, or indeed, upon the basis of other reliable material before the Panel inclusive of the illustrated list.
- 7.18 The Panel determination of whether "bad faith" occurred in this case is focused on a verbal discussion on 8th May 2008 between Mr Henry Whittaker of WBS and Mr Philipp Heltewig of SAU. The Parties submitted contradictory versions of this discussion. The Complainant alleged that the Respondent requested payment for the domain name being "something in the vicinity of AU\$50,000 – AU\$100,000". The Respondent alleged that they informed the Complainant at this discussion that the Domain Names were not for sale. On due consideration, the Panel found that the Respondent's submissions were more persuasive as these submissions were collaborated by a third party, Mr Peter Gable, who overheard the conversation.
- 7.19 The Panel is not satisfied that there is sufficient evidence for a finding with respect to Paragraph 4(b)(i) of the auDRP Policy. In the Panel's view, the onus of proof of this

requirement rests with the Complainant and the Complainant has failed to establish the requirements of Paragraph 4(a)(iv) of the auDRP Policy.

8 DECISION

8.1 The Panel concludes for the reasons stated that:

- (a) the Domain Names are identical with and confusingly similar to a name, or trade mark of SAS and SAU. However, the Complainant has failed to demonstrate SAU is entitled to own the trade mark in Australia;
- (b) the Respondent seems to have legitimate interest in the domain name; and,
- (c) the Complainant has also failed to show that the Respondent acted in bad faith by registering the Domain Names.

8.2 For the reasons outlined, the Complainant has not satisfied the elements of Paragraph 4(a) of the auDRP Policy.

9. RELIEF

Transfer of the Domain Name

9.1 The Panel orders that the Domain Name remain in the name of the Respondent.

Dated this 20th day of January 2009

Anthony P. Alder

Sole Panellist

Annexure A

Procedural History

[sitecore.com.au ; sitecore.net.au]

1. The complaint was submitted for decision in accordance with the (auDRP) Policy and Rules, which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplementary Rules (LEADR is the Provider).
2. The complete application was received from the Complainant by LEADR on 1-Dec-08
3. On 10-Dec-08 LEADR contacted the Respondent via phone and confirmed that the application had been received after 3-Dec-08, by express post.
4. On 3-Dec-08 LEADR express posted to the Respondent a dispute notification letter and a copy of the application.
5. A copy of the application and a copy of the dispute notification letter were also posted to the registrar PlanetDomain on 3-Dec-08. The Registrar confirmed that the website was locked on 8-Dec-08.
6. LEADR advised auDA of the complaint on 3-Dec-08 via e-mail.
7. On 9-Jan-09 the provider approached the Panellist. The panellist confirmed his availability, informed LEADR that they had no conflict issues with the parties and accepted the matter
8. The response was due on 24-Dec-08. A response was received on 5-Jan-09 upon LEADR's reopening.
9. The Panellist was informed on 13-Jan-09 that the package was being sent for Adjudication.