

**Domain name:** justbikes.com.au  
**Name of Complainant:** Just Magazines Pty Ltd  
**Name of Respondent:** Australian Just Bikes of the Northern Rivers  
**Provider:** LEADR  
**Panel:** N J Hickey

## **1 The Parties**

- 1.1 The complainant in this Proceeding is Just Magazines Pty Ltd (the “**Complainant**”).
- 1.2 The respondent to this proceeding is Australian Just Bikes of the Northern Rivers (the “**Respondent**”).

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

- 2.1 The domain name subject to this proceeding is “justbikes.com.au” (the “**Domain Name**”).
- 2.2 The registrar of the Domain Name is Distribute.IT (the “**Registrar**”).
- 2.3 The provider in this proceeding is LEADR of Level 9, 15-17 Young Street, Sydney, NSW, 2000, Australia (the “**Provider**”).

## **3 Procedural Matters**

- 3.1 This proceeding relates to the Complaint submitted by the Complainant in accordance with:
- (a) the .au Dispute Resolution Policy No. 2008-01 (the “**auDRP**”) published on 1 March 2008 which includes: Schedule A (“**auDRP Policy**”) and Schedule B (“**auDRP Rules**”); and
  - (b) the Provider’s Supplemental Rules to Rules for au Domain Name Dispute Policy.
- 3.2 The Provider supplied the Panel with a document entitled “Procedural History”. According to the Procedural History, the Complaint was lodged with the Provider on 7 October 2008.
- 3.3 The Provider mailed a copy of the Complaint and a Domain Name Dispute Notification to the Respondent via express post on 8 October 2008. The Respondent indicated receipt of the Complaint by email on 14 October 2008.
- 3.4 The Response was due on 28 October 2008. A Response has not been received.
- 3.5 A copy of the Complaint and Domain Name Dispute Notification were posted to the Registrar on 8 October 2008. The Registrar confirmed that the website was locked on 8 October 2008.
- 3.6 The Panel was appointed on 3 November 2008.

#### 4 Factual Background and Submissions

4.1 The Panel proceeds on the basis that the factual allegations set out in the Complaint and Procedural History are true.

##### *Facts Alleged by the Complainant*

4.2 The Complainant began publishing its *Just Motor Bikes* magazine in 1989. The magazine primarily lists advertisements for the sale of motorcycles. It had an audited circulation in Australia of around 36,000 monthly sales in 2006-2007, making it the magazine with the largest circulation in the Australian motorcycle market.

4.3 The Complainant claims that the magazine was often referred to as *Just Bikes* and provided examples of such references from editions of the magazine published in 1994 and 1995.

4.4 The name of the magazine was changed to *Just Bikes* in 2007.

4.5 The Complainant owns three relevant trade marks. These are:

- the word and device mark 948416, for JUST MOTOR BIKES AUSTRALIAN BIKE MARKET PLACE MAGAZINE (priority date 23 March 2003);
- the word mark 1081637, for JUST BIKES (priority date 19 October 2005); and
- the word mark 1081636, for JUST MOTOR BIKES (priority date 19 October 2005).

4.6 The Complainant has also applied for the device mark 1175025, for the stylised words JUST BIKES (priority date 8 May 2007).

4.7 An ASIC company search of the respondent reveals there is no registration for “Australian Just Bikes of the Northern Rivers”. A search of the business names register reveals that Visteller Pty Ltd registered “Australian Just Bikes of the Northern Rivers” as a business name on 22 May 2000. The registration expired on 5 August 2003.

4.8 The Domain Name “justbikes.com.au” was created on 25 May 2000.

4.9 The “justbikes.com.au” website was in operation in 2000 and 2001. The Complainant contends that the website was used to redirect users to a business called the Australian Motorcycle Market. Although there does not seem to have been a link on the website to an Australian Motorcycle Market website, the welcome page was entitled “Welcome to Australian Motorcycle Market” and invited users to “Email us and let us know what you want from motorcyclemarket.com.au. By clicking the words “Email us”, a user was redirected to an email message addressed to “webmaster@motorcyclemarket.com.au”.

### *Complainant's Contentions*

4.10 The Complainant makes the following principal contentions:

- (a) The disputed Domain Name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights because:
  - (i) the Domain Name is identical to its magazine's name, JUST BIKES in which it has a registered trade mark in addition to its common law trade mark rights; and
  - (ii) it is confusingly similar to the trade mark JUST MOTOR BIKES in which the Complainant also has both common law and registered trade marks.
- (b) The Respondent has no rights or legitimate interests in respect of the Domain Name:
  - (i) the names "Australian Just Bikes of the Northern Rivers" and Visteller Pty Ltd are not listed in whitepages.com.au and a Google search for the these names gave no results;
  - (ii) there are no trade mark registrations or applications in the name of Visteller Pty Ltd or for the words "Australian Just Bikes of the Northern Rivers";
  - (iii) there has never been any business operating under the name "Australian Just Bikes of the Northern Rivers" and there is therefore no goodwill associated with the name;
  - (iv) the website has not been used since around 2001;
  - (v) the Complainant relies on the facts supporting its allegation of bad faith in support of its submission that any interest in the domain name was not a legitimate one; and
  - (vi) having established a prima facie case that the Respondent has no rights or legitimate interests in the domain name, the evidentiary burden shifts to the Respondent.
- (c) The domain name was registered or is being used in bad faith:
  - (i) the name Australian Just Bikes of the Northern Rivers was registered in bad faith for the purpose of securing the Domain Name and to redirect customers to a competing business associated with the Respondent conducted on the motorcyclemarket.com.au website; and
  - (ii) in the alternative, the Complainant submits that ownership of the business name "Australian Just Bikes of the Northern Rivers" did not give the Respondent any rights in the words "Just Bikes" alone.

## ***Respondent's Response***

4.11 The Respondent did not submit a Response.

## **5 Basis of decision**

5.1 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.”*

## **6 Jurisdiction**

6.1 Paragraph 2.1 of the auDRP states:

*“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 Names are an open 2LD within the meaning of this provision. They were registered with the Registrar on 25 May 2000. They are therefore subject to the mandatory administrative proceeding prescribed by the auDRP.

## **7 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 All three elements of a complaint under paragraph 4(a) of the auDRP Policy must be proved if a complaint is to be upheld.

## **8 Discussion**

*The Domain Name is Identical or Confusingly Similar to a Name or Trade Mark in which the Complainant has Rights*

8.1 Note 1 to 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.”*

- 8.2 At the date of the complaint, the Complainant has rights in the marks JUST BIKES and JUST MOTOR BIKES, which is the relevant time at which the Complainant must establish rights. See *The Crown in Right of the State of Tasmania trading as “Tourism Tasmania” v James Gordon Craven* WIPO Case No DAU2003-0001.
- 8.3 The Panel has compared the Domain Name with the name of the Complainant’s magazine *Just Bikes* and finds it to be relevantly identical. Clearly, the complainant has rights in its registered trade mark, which has the words “Just Bikes”.
- 8.4 Accordingly it is not necessary to deal with the Complainant’s claim with regard to JUST MOTOR BIKES. However, it will be briefly discussed. The test of “confusing similarity” is restricted to comparison of the domain name to the trade mark itself, independent of the content of the site or other marketing factors considered in trade mark cases. See, *The Crown in Right of the State of Tasmania trading as “Tourism Tasmania” v James Gordon Craven* WIPO Case No DAU2003-0001. The name JUST MOTOR BIKES consists purely of generic terms, as does JUST BIKES. There is no distinctive element incorporated in the Domain Name. Cf. *Arthur Guinness Son & Co (Dublin) Limited v Dejan Macesic* WIPO Case No D2000-1698; *Ansell Healthcare Products Inc v Australian Therapeutics Supplies Pty Ltd* D2001-0110. The term ‘Motor Bike’ also potentially has a different plain meaning from ‘Bikes’ (in that the latter could refer to a push bike). The Panel considers that there is therefore no confusing similarity between the Domain Name and the name JUST MOTOR BIKES.

*Respondent has no Rights or Legitimate Interest in Respect of the Domain Name*

- 8.5 The registration of a business name, without more, does not confer rights upon the registrant. There is no evidence of what business Visteller Pty Ltd engages in or that any rights have been acquired through use of the name “Australian Just Bikes of the Northern Rivers”. In fact, there is no evidence that the name has been used, either on the justbikes.com.au website or elsewhere.
- 8.6 Accordingly, the Complainant has established a prima facie case that the Respondent has no rights or legitimate interest in the Domain Name. Although the Complainant has the onus of showing that the Respondent has no rights or legitimate interest in the domain name, once a prima facie case is established, the evidentiary burden shifts to the Respondent. See *Advanced Book Exchange Inc. v Argyle Emporium* WIPO Case No DAU2003-0004.

- 8.7 The Panel finds that in the absence of any answer to the claims of the Complainant and in light of no evidence being led by the respondent, that on the facts put by the Complainant the Respondent has no right or legitimate interest in respect of the Domain Name.

*Domain Name was Registered or Subsequently Used in Bad Faith*

- 8.8 The Complainant alleges that the Respondent has acted in bad faith within the meaning of paragraph 4(b)(iv) of the Policy, which provides that a Respondent will have acted in bad faith 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 website or location or of a product or service on that website or location.*

- 8.9 The Complainant's magazine has the largest circulation in the Australian motorcycle market. The material placed on the justbikes.com.au website by the Respondent suggests that the Respondent is in the same market and is a direct competitor of the Complainant. Consequently, the prospect is very low that the Respondent was not aware of the Complainant's reputation in the name *Just Bikes*, which is identical to the Domain Name.
- 8.10 As the registration of the Domain Name occurred prior to the registration of the Complainant's trade marks, the Respondent cannot be said to have acted in bad faith with respect to the registered marks. However, the Panel accepts that the Complainant's *Just Motor Bikes* magazine was commonly known as *Just Bikes*.
- 8.11 Although users were not automatically redirected to another website, the references on the site to Australian Motorcycle Market and motorcyclemarket.com.au were sufficient to constitute an intentional attempt to attract users to the motorcyclemarket.com.au website.
- 8.12 In the absence of evidence to the contrary, this is sufficient to establish that the Domain Name was registered and used in bad faith. See *Croatia Airlines d.d. Modern Empire Internet Ltd* WIPO Case No D2003-0455.
- 8.13 It was not argued that the Domain Name was registered to prevent the Complainant registering the Domain Name or for the primary purpose of disrupting the Complainant's business. However, the *Just Motor Bikes* magazine had a substantial reputation as *Just Bikes*, so it was obvious that establishing a rival motorcycle sales forum with the domain name justbikes.com.au would impede the Complainant from registering the logical domain name for an online counterpart to its magazine and thereby disrupt the Complainant's business.

**9 Decision**

- 9.1 The Complainant has satisfied all of the requirements for the Complaint to be upheld and has requested that the Domain Name be transferred to it.
- 9.2 Accordingly, the Panel orders that “justbikes.com.au” be transferred to the Complainant.

Dated this 21<sup>st</sup> day of November 2008.

**Natalie J Hickey**

Sole Panelist