

# ADMINISTRATIVE PANEL DECISION

LEADR Case No: auDA 02/09

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**Domain Name:** www.earthmove.com.au  
**Name of Complainant:** Informa Australia Pty Limited  
**Name of Respondent:** Reed Business Information Pty Limited  
**Provider:** LEADR  
**Panel:** John A. McGruther

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## 1. THE PARTIES

- 1.1 The Complainant is **Informa Australia Pty Limited** ('I').
- 1.2 The Respondent is **Reed Business Information Pty Limited** ('R').

## 2. THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 2.1 The Domain Name at issue is **www.earthmove.com.au** ('the Disputed Domain Name').
- 2.2 The trade mark, name or service mark upon which Complaint is based is EARTHMOVER trade and service mark and earthmover.com.au Domain Name.
- 2.3 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 4a of Schedule A of the auDRP. This subparagraph 4a 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, trade mark 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’ to this determination.

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

4.4 Certain written and related material has been submitted to the Panel as provided by the parties to the Provider. The observations in this determination arise singularly from the material so submitted and the submissions made. I have read all of the materials. There is no need that I traverse all of it in the reasons here given, but all of it has been noted and analysed.

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”.*

4.6 The Registrar of the Disputed Domain Name is TPP Internet of Manly New South Wales (‘Registrar’). The Disputed Domain Name was created on 7 August 2008. The Policy applies to the Disputed Domain Name.

#### **5. FACTUAL BACKGROUND: The Complainant’s (I’s) Case**

5.1 In submissions made with its Complaint, I as Complainant essentially raised some of the following matters, namely that:

- (a) I is a leading event organiser and specialist magazine publisher including of the magazine *The Earthmover and Civil Contractor* ('magazine').
- (b) The magazine originated in 1963 and historically remains the official journal of the now Australian Earthmovers & Civil Contractors Federation ('CCF'), the representative body of civil engineering contractors in Australia.
- (c) Over the best part of forty-five (45) years since 1963 the magazine has been known and widely referred to within the civil engineering industry as 'EARTHMOVER'.
- (d) There is an online edition of the magazine on the Internet on I's Domain Name 'earthmover.com.au ('Earthmover Domain Name'), which online edition has been uninterruptedly published since 1998.
- (e) That over the stated forty-five (45) year period, I has acquired a valuable reputation, in Australia and overseas, in the name 'Earthmover' when used in publishing information and expertise to the Australian civil construction industry.
- (f) R is the registrant of the Disputed Domain Name created by R on 7 August 2008, some forty-four (44) years after first publication by I of the magazine and ten (10) years after the online Earthmover Domain Name was first used and created by I.
- (g) That R does not have any rights in the Disputed Domain Name.
- (h) The parties are known to each other as competitors, including as publishers and information providers using online marketing in promotion, such that R's use for commercial advantage of a domain name so closely resembling the trade and service mark of I is colourable and misleading.

## **6. FACTUAL BACKGROUND: The Respondent's (R's) Case**

6.1 Within its submissions, the Respondent (R) essentially put:

- (a) That R is one of Australia's largest 'B2B' publishers and information providers including as a subsidiary of 'Reed Elsevier'.
- (b) That R's 'business aim' is to 'be the main source of information-driven services.. to its target customers..', including through the Internet and electronic commerce.
- (c) That R has been in Australia since 1955 and has a valuable reputation in the Australian publishing marketplace for business or industry information.
- (d) That the R business includes publishing a wide range of business or industry information including via e-newsletters, online industry portals and the like across a range of industries (noted as including on the singular R website a 'Manufacturing & Engineering' category there described as 'Earth Moving').
- (e) That the various domain names published by R on its websites reflect the subject matter of the website.
- (f) That R '..is constantly looking to increase its coverage.. to reach more customers and fill gaps in the market where business information relating to that industry is lacking'.
- (g) That R has a 'strategy' on a new publication launch of choosing a title identifying to the reader what the publication is about.
- (h) That R's 'Earth Moving' publication is accessible from the Disputed Domain Name ('earthmove.com.au') distributed only in e-newsletter and electronic form.
- (i) That R's '..plan for an earthmoving publication were first developed in around March 2008..', employing a journalist in July 2008 to research earthmoving articles.
- (j) That the Disputed Domain Name was registered by R on 7 August 2008, with first website launch publication in October 2008.

## **7. DISCUSSION AND FINDINGS**

## **Elements of a successful complaint**

- 7.1 According to Paragraph 4a 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, trade mark 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 4a of the auDRP Policy are cumulative; all of them must be proved if the Complaint is to be upheld.

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

7.3 The Panel must determine whether the Complainant has rights in a relevant name, trade mark or service mark.

7.4 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."*

7.5 The auDRP Policy does not provide guidance as to the intended meaning of "identical" or "confusingly similar". However, "essential or virtual identity" is sufficient. (*BlueChip Info Tech Pty Limited v Roslyn Jan and another* [LEADR case 06/03]).

7.6 Although it may appear that there is no exactitude as to what is contemplated in the term "confusing", the test of "confusing similarity" could have reliable precedent in the trade mark infringement case application of the expression, where the concept of "deception" contemplates consumers who may be deceived or "caused to wonder" about the source or origin of goods or services. (As, for

example, noted in *Camper Trailers WA Pty Ltd v Off Road Equipment Pty Ltd* [LEADR 06/04]).

- 7.7 The Panel makes the following observations in no priority order.
- 7.8 Broadly, the submitted chronology of I as Complainant, on the papers before the Panellist, is accepted substantively as to a very active commercial use and exposure, over a long period, including within Australia, of the Earthmover Domain Name and of the EARTHMOVER trade and service mark, consistent with a range of trade name applications.
- 7.9 Although R has some contended variations to some of the antecedent history and chronology, the Panel accepts the substance of the history largely as I as Complainant presents it on the papers. Some of that history has been referred to earlier, but these supplementary observations are immediately made as to the acceptance substantively by the Panel of the following antecedent history and presentation (and in no priority order):
- (a) I's magazine originated in 1963 and I continues to publish it as a joint venture with CCF.
  - (b) It is a leading monthly publication in the Australian civil construction industry (all sectors including Governmental), with each print run of the order of or exceeding Australian distribution of 6500 units.
  - (c) That I has invested not insignificant resources (in various ways) in developing readership over a long period.
  - (d) That the EARTHMOVER trade and service mark has been consistently and uninterruptedly used by I throughout the fuller history of magazine publication and public exposure.
  - (e) That relative to the Earthmover Domain Name, that the consistent and long-standing publication descriptive under the banner of 'EARTHMOVER' by I since I's original Domain Name registration of it in 1998, has been the uninterrupted website descriptive for the online magazine format since.

- (f) The consistency of I's magazine publication (newsletter format) since 1963, and of the online format as described since 1998 prima facie establishes a significant longevity of reputation, more especially so when that utility by I is in the development of a reputation within the singular and discrete engineering / manufacturing / civil construction sectors of industry.
- (g) That such reputation is not limited to Australia but has international implication through the Earthmover Domain Name ('www.earthmover.com.au') which, singularly as the online publication source, has been actively visited by enquirers as to that site since 1998.

7.10 Additional to the above Panel observations, the Panellist specifically notes (and again, in no priority order):

- (a) The only difference between the Earthmover Domain Name and the Disputed Domain Name is the letter 'r' at the end.
- (b) The Disputed Domain Name was first created by R on 7 August 2008, by which time I had been actively operating its business, including specifically within these discrete industry sectors, and singularly addressing the online version of such publication, for ten (10) years, and by reference to the EARTHMOVER trade and service mark, since 1963.
- (c) Against some of the above background alone, the Panel concludes that the recent 'creation' by R of the Disputed Domain Name induces a real risk of loss of custom, reputational damage, and market and customer confusion resultantly.
- (d) In this latter respect, I has pointed to:
  - (i) The website promotion by R of competing goods using the Disputed Domain Name since August-November 2008 has had the factual consequence of customer confusion and diversion of business from I.
  - (ii) I's awareness of this was almost immediate in that, in or around November 2008, one of I's advertising representatives inadvertently accessed the R site.

(iii) That several magazine subscribers, since about October 2008, had made contact with I requesting email address access to the Disputed Domain Name site, some referring to the confusion occasioned by the similarity between the Disputed Domain Name and the Earthmover Domain Name.

(e) That, since operational commencement, and historic development of reputational name value, I has resultantly achieved significant magazine product sales with ongoing similar forecast.

7.11 The Panel notes all of the submitted content of R under this heading. Similarly, it is not necessary to traverse all of it, but the following observations are made.

7.12 R contends various arguments by reference to the assertion of I not having any registered trade mark rights including in the magazine. Firstly, R invites that an adverse inference be drawn from an argued rejection of an historic previous trade mark application (class 16) by I for the title of the magazine, suggesting that it was 'possible' that such historic previous trade mark application's rejection was because the magazine title was 'descriptive'. R suggests that because such 'failed trade mark attempt' was not disclosed in this Complaint, an adverse inference should be drawn against I as Complainant. The Panel does not agree for a number of reasons, but the following observations will suffice.

7.13 The argument lacks any reliable verification, and is at the level, respectfully, of conjecture or surmise. Further, even if the earlier trade mark application rejection referred to were, in reality, based on a 'descriptive' rejection, and such rejection perforce of trade mark statutory or regulatory processes, such is not the standard or test under this heading. What is, however, pertinent, in the view and determination of the Panel, is that I does have a trade or service mark and name in both the Earthmover Domain Name and in its trade and service mark and name EARTHMOVER, and which definitionally reconcile with Paragraph 4a(i) of the auDRP Policy recited earlier.

7.14 The Panel, respectfully, does not accept the definitional contention of R that Paragraph 4a(i) and Note 1 of the Policy excludes I's Earthmover Domain Name and its trade and service mark or name EARTHMOVER from examination here. That is not so. Paragraph 4a(i), including Note 1 to the Policy, does not exclude a legal trading name or a service mark or name, in which a Complainant contends rights, from examination. That is exactly the presentation here. Namely, as to one part of it, the I Complaint specifically is that there is a confusing similarity between the Disputed Domain Name and the service mark or name and as to the Earthmover Domain Name in which the Complainant contends rights.

7.15 In various ways, relative to contended 'unregistered trade mark rights' of the Complainant in the magazine or in 'EARTHMOVER', the Panel notes the arguments advanced by R within the commentary following.

7.16 The Panel concurs with the principle that I has the onus of establishing the Complaint under this heading. Distilling the primary contentions of R here, they included:

(a) Where the domain name in issue consists of a 'generic term', a Complainant (R argues) would need to provide 'strong evidence' that an 'unregistered mark' had become a 'distinctive identifier' of association of the Complainant with the relevant goods. As a principle, the Panel does not disagree (including by reference to *Australian Trade Commission v Matthew Reader*, WIPO Case D2002-0786).

(b) A number of comments are pertinent here however. Firstly, the onus does not extend to a Complainant needing to establish any consumer association of a word (say, here, 'earthmover') singularly with the Complainant's business or reputation. Indeed, as R's submission here appears inherently to acknowledge, any name or term used (and whether 'generic' or otherwise) which 'primarily' has an association with a Complainant's business is enough, prima facie, to give rise to confusing similarity under this heading.

7.17 To this extent, and generally, the Panel, respectfully, does not concur with various R contentions put to the effect that the 'only evidence' as

to trade mark or trade name 'reputation' of I are the period and frequency of magazine publication, or as to the 'number of hits' on I's website, and that, under this heading, I puts only 'limited information'. That is not the presentation which the Panel reliably discerns emerging from the papers here.

7.18 The Panel notes the argument (described in various ways by R) contending against the magazine being commonly known under a singular descriptive of 'EARTHMOVER'. The Panel does not concur for these reasons:

- (a) The Panel accepts that the magazine has, in all of its formats, a longevity of industry publication and exposure and, resultantly, a long-standing acquired reputation vesting in I.
- (b) What is demonstrably clear, including from examples of magazine covers (for instance) noted, is that the dominant and emphatic title references historically in all of such magazine presentations since 1963 inarguably is the word 'EARTHMOVER/S'.
- (c) To the contention of R that a mere assertion is, in this regard, insufficient 'to prove trade mark rights.', respectfully, misconceives the Complaint. I does not found any element of its Complaint with reference to 'trade mark rights', whether by reference to any registered or unregistered position of a '**trade mark**' (emphasis of the Panel) as such. The Complaint under this heading is as to the Disputed Domain Name being identical with or confusingly similar to a name or service mark in which I as Complainant argues rights.
- (d) Broadly, the Panel is satisfied, including on the requisite onus, that there is a position of conviction to the I Complaint, under this heading, to the extent that its customers have long recognised its association, particularly in this discrete industry usage, as to 'EARTHMOVER', as to the magazine and otherwise. The Panel does not concur, on fullest examination with the R contentions that such reputation has thus far only been 'short term'.

7.19 R asserts (in various ways) as to some general commonality of usage of the Disputed Domain Name to, in effect, argue that I cannot now assert a ‘monopoly’ or, by extension of the R argument, any special reputation in the Earthmover Domain Name or I’s EARTHMOVER trade and service name. Here, the Panel makes the additional observations following.

7.20 The Panel does not concur that this is a like or analogous presentation to that in *Tooling Australia Inc v Austool Ltd (in Liquidation)* (IAMA Case 3045). Further, some of the R contentions are, respectfully, not the relevant test under this heading including the following:

- (a) Whether ‘Earthmoving’ has some argued ‘substantial third party use’ is not the relevant test here.
- (b) Equally not the test here is whether or not Australian businesses use the term ‘earth movers’ or the like expressions, or whether words of that ilk are common, everyday words.
- (c) Equally not the test is whether the ‘general public’ has some recognition of ‘Earthmoving’ as a distinct industry in Australia.
- (d) The Panel does not agree, necessarily, that ‘Earthmoving’ (to any extent relevant here) is not a term capable of being distinctive of the Complainant’s historic industry involvement.

7.21 For completeness, the Panel makes these further commentaries. Where the difference between a Domain Name in issue and the name or mark or Domain Name in which a Complainant asserts rights, is quite discrete, such as a differential (as here) of only one (1) letter (here, the letter ‘r’ only), such creates the higher risk and potential for misleading or confusing similarity, under this heading. Many cases of similar presentation attest to this, illustratively only including *Oxygen Media LLC v Primary Source* (WIPO Case D2000-0362), *Microsoft Corporation v Charlie Brown* (WIPO Case D2001-0362) and *Pfizer, Inc v Seocho and Snezko* (WIPO Case D2001-1199), amongst other.

7.22 Further, arguments as to ‘deceptive similarity’ put singularly by reference to the law of registered trade marks is not necessarily central to issues under this heading. The issue under UDRP is not whether there is confusion as to the origin of goods, but rather

whether the Disputed Domain Name is ‘confusingly similar’ to the trade or service name or mark of the Complainant. In this regard, it is the effect of that similarity in all the circumstances which is decidedly pertinent, described by Windeyer J in terms: ‘*The likelihood of deception must be judged not by the degree of similarity alone, but by the effect of that similarity in all the circumstances.*’ (*Shell Co of Australia v Esso Standard Oil (Australia) Ltd* (1963) 109CLR407).

7.23 For these reasons, on the balance of material before the Panel, there is in its determination, the real potential for, and the actuality of, identity confusion in the terms which meet the foundation for the Complaint of I under this heading and where I, in the determination of the Panel, has established the requisite onus.

7.24 Accordingly, the Panel determines that the Complainant has satisfied the requirement of “*confusingly similar*” in Paragraph 4a(i) of the auDRP Policy.

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

7.25 This is the second element for establishment within a Complaint under the UDRP. It involves deliberation upon the issue as to, whether or not, a Respondent has, in the circumstances of the presentation, no rights or legitimate interests in the Disputed Domain Name (as contended here). This is relative to considerations pursuant to Paragraph 4a(ii) of auDRP Policy.

7.26 Firstly, it is imperative to note, including here, that ‘rights or legitimate interests in respect of the Domain name’ are not established merely by a Registrar’s determination that the Respondent satisfied any relevant registration criteria for the Disputed Domain Name at the time of its Respondent registration (and refer Note 2 of the Policy). There is accordingly no basis for any argument singularly put by reference to registration, or necessarily, as to later use since registration, on that basis.

7.27 The relevant burden of proof is to the extent that the Complainant need only make out a prima facie case that the Respondent has no legitimate interest, whereupon that burden then shifts to the Respondent to produce evidence of any relevant interest in the name

in issue, as to satisfy the Panel (*Document Technologies, Inc v International Elec Communications Inc* (WIPO Case D2000-0270)).

7.28 The UDRP does not attempt to define forensically what is meant by a right or legitimate interest in a Domain Name. Paragraph 4c of UDRP lists three (3) (and importantly, non-exclusive) examples of what may comprise any contended 'right or legitimate interest', namely:

- (a) Use, or demonstrable preparations to use, the Domain Name in connection with a bona fide offering of goods or services;
- (b) The Respondent being commonly known by that Domain Name; or,
- (c) Making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers.

7.29 It is not necessary for the Panel to traverse in fullness the respective submissions content of the parties under this heading. The following observations are made on the material before the Panel, and in no priority order.

7.30 To the extent of any relevant history asserted by either side, the Panel accepts the following:

- (a) That I has uninterruptedly published since 1963 its magazine under the prominent entitlement of 'EARTHMOVER' (as previously discussed).
- (b) That, since 1998, I has additionally registered (and used for the online format / edition of its magazine) the Earthmover Domain Name.
- (c) I asserts, and it is not contested, that it carefully selected its 1998 Earthmover Domain Name registration title as to accurately inform consumers about the source of goods and services.
- (d) That, contrasted to that, the Respondent had extended parts of its business activities to 'the earthmoving industry' for approx

twenty (20) years with some longer standing clients operating in that industry, and with some publications reporting on it.

(e) That R received first notice of this Complaint around 18 November 2008.

7.31 The Panel observes that the potential for confusion as to source of the Disputed Domain Name is a relevant and appropriate consideration in analysis of any claim for legitimacy of interest under this heading. Some of the Panel's commentary following is in that context, additional to other commentary made.

7.32 R asserts that I has not demonstrated rights in a name or description, argued as a 'generic term', of 'earthmover'. Respectfully, this is not the relevant test or benchmark here, which does not go to any basis or otherwise as to a Complainant's rights, but rather more accurately is as to whether or not R as the Respondent has any rights or legitimate interests in the specific Disputed Domain Name, here put in contest and the subject of this specific Complaint.

7.33 The Panel has already indicated the principles as to the relative evidentiary burdens, but here immediately notes, and determines, that I as Complainant has made out a prima facie case that R, as registrant of the Disputed Domain Name, has no legitimate interest in it (including for observations which further follow). It is for R then, to satisfy the Panel, the onus resting upon R, that it has a relevant interest in that name.

7.34 As already stated, the mere fact of the Disputed Domain Name registration by R as Respondent does not connote a legitimacy of interest or right in it. Equally, by reference to matters recited within Paragraph 4c of UDRP (abbreviated references above), mere assertions of preparations to use the Disputed Domain Name, without further reliable evidence from a Respondent, is insufficient to establish that a Respondent has undertaken any relevant demonstrable preparations to use the name in terms of Paragraph 4c for example.

7.35 In particular, and specifically pertinent to this presentation in the view of the Panel, an offering of goods or services is not bona fide if use of the Disputed Domain Name is likely to cause consumer

confusion including, such as and by one illustration only, that it may infringe a Complainant's trade name rights or acquired reputation (*Universal City Studios Inc v GAB Enterprises* (WIPO Case D2000-0416)).

7.36 The Panel has already made several, including detailed, references to pertinent antecedent history of I as to a long-standing usage (accepted by the Panel) to the EARTHMOVER trade and service name (since 1963), and to the Earthmover Domain Name (since 1998). The Panel concurs with that element of I's submissions that its Earthmover Domain Name is the natural Domain Name and designation for it given its long history and reputation, including in the antecedent (since 1963) EARTHMOVER trade and service mark or name. To this extent, the Panel on balance, agrees that this Respondent R, in its position (with further brief comments on this following) would not be acting reasonably or bona fide to choose to register the Disputed Domain Name. Here, the Panel regards it as especially noteworthy that:

- (a) R, relying on the evidence, was, or should have been, aware or reasonably aware of the long-standing reputational interest possessed by I in its EARTHMOVER trade and service mark and in the Earthmover Domain Name, the latter already in existence for some ten (10) or eleven (11) years prior to R's initiative to acquire registration of the Disputed Domain Name.
- (b) In the latter context, it is pertinent that R was a competitor, fully aware of I's profile and presence in the market, in particular with reference to the civil construction industry.
- (c) I has pointed to, and it is not disputed, that it has confronted recorded consumer confusion consequent upon R's Disputed Domain Name registration and with concurrent immediacy from and since the time of such registration.
- (d) As previously stated, confusion as to source is a relevant consideration under this heading.
- (e) Also, as previously stated (*Universal City Studios*), an offering of goods or services is not bona fide if use of the Disputed Domain

Name is likely to cause consumer confusion to the extent to which I now complains (and which the Panel accepts).

7.37 The Panel has noted R's contentions in asserting that I's rights as Complainant are relative only to a 'generic' term. Equally, as previously stated, this is the wrong test applicable here. In any event, the Panel, in the circumstances of this presentation, does not accept that what is in issue here is simply or singularly a 'generic term', such as 'Earthmover'. R made a number of submissions much in the same context of this (such as, for example, by references to certain case histories as to 'generic' citations, that a Complainant 'cannot monopolise a generic term' as to prevent 'other traders from making bona fide use of it', and by reference (in part) also to dictionary definitions and the like). The case citations with reference to 'generic or descriptive' names are not, in their presentations, akin to the presentation before this Panel. Secondly, one cannot excise a word singularly, such as 'earthmover', from a Complaint as to remove it from its analysis in proper context, under this heading, which applies equally to dictionary definitional analogies. Thirdly, the Panel does not, for the sake of this argument, accept that the Disputed Domain Name inclusive of the word 'earthmove' is, properly analysed, 'generic', and certainly not 'generic' in the circumstances of this presentation.

7.38 Nor is the relevant question one of 'monopoly', whether as to a 'generic' term or otherwise. The question is as to whether R has a right or legitimate interest, in the circumstances of the Complaint and presentation made, in respect of the Disputed Domain Name.

7.39 Whilst it is noted that R submits that it extended its business activities to the 'earthmoving industry' over the last approx twenty (20) years, its published 'earthmoving' content has had a different history, and as to magazine publication, different entitlement to that of I, the latter having its clear and longstanding identification. For instance, R's magazine has had a different title to that of I, R's magazine title being more prominently under the heading of 'Construction Contractor' (by way of illustration). Nor is it singularly to the point whether R, in its antecedent activities, has previously used such terms as 'earthmoving' and 'earth move' prior to its choosing to initiate the Disputed Domain Name registration. Here, on the papers before it, the Panel notes that, prior to the 2008 Disputed

Domain Name registration by R, it had not initiated itself any prior formal Domain Name registration approach or any similar trade mark registration initiative. In other words, R was operating in its sector of activity and in part only in matters of the 'earthmoving industry', but under different descriptives and profile, to its longer-standing competitor, I.

7.40 The Panel notes that R urges that it was 'not aware' of I's website magazine publication or of I's Domain Name registration 'earthmover.com.au' prior to receiving notice of this dispute. Respectfully, the Panel is not satisfied on this element of matters under this heading in particular. The contention does not appear to reconcile entirely with the relatively concurrent engagement (for example) by R of a journalist to research 'articles relating to earthmoving' from around March 2008. The contention further does not appear to entirely reconcile with much of the antecedent history of the parties within the same industry as, for instance, would reasonably command some particularity and forensics in any such pre-registration research to be undertaken by an intending registrant, in the circumstances, acting carefully or reasonably.

7.41 The submission of R that, under the Policy, the making of a bona fide offering of goods and services from the website, prior to notice of the dispute, is sufficient in itself to demonstrate a legitimate interest in their Disputed Domain Name is not the correct position. The emphasis is on the fact of establishing that any such use or offering is in fact bona fide.

7.42 On the balance of reliable material before it, the Panel has noted the full antecedent history as submitted by both parties. In this regard, additional to earlier observations, the Panel, for completeness, further notes:

(a) R only commenced to 'offer' goods or services via the Disputed Domain Name since October 2008. At that point, and previously, R had a specific, and at the least a general, including competitive, awareness of I in the same marketplace, in the same industry, and in specific similar publication work of long-standing of I under I's EARTHMOVER trade and service mark and under its Earthmover Domain Name.

- (b) The Panel does not accept the R submissions that any rights, contested as vesting in R, by reference to website registration, was 'planned' to be a bona fide website use to publish information under a generic value of the word 'earthmoving', and thus to register the Disputed Domain Name, against the interests of I (as earlier described).
- (c) The Panel is further not convinced that the history reliably demonstrates that R had previously been 'commonly known' by the Disputed Domain Name, including by reference to Paragraph 4c(ii) of the Policy.
- (d) The Panel is not convinced, on the material before it, that there was absent any intent of R for commercial gain as to the diversion of consumers away from I, including by reference to Paragraph 4c(iii) of the Policy.

7.43 Accordingly, the Panel is not of the view that R has discharged the onus as to establishing, in the circumstances of this presentation, a right or legitimate interest in respect of the Disputed Domain Name in issue here.

7.44 Accordingly, the Panel finds that the Respondent has no right or legitimate interest in the Disputed Domain Name. Paragraph 4a(ii) of the auDRP Policy has been satisfied by the Complainant.

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

8.1 The Panel has noted and studied the full context and content of all requisite material under this heading.

8.2 Paragraph 4b 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 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.

- 8.3 This Complaint contention resides under Paragraph 4a(iii) of auDRP Policy.
- 8.4 The Panel deals with Paragraph 4b(iv) firstly, that is, that evidence of bad faith can be: *“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 marks as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location”*. The Panel emphasises that this is not the singular or exclusive reference as to analysis of pertinent matters under this Policy heading.
- 8.5 R (in various ways) denies ‘bad faith’ contentions by reference to a denial of any intent to make any commercial gain or by creating confusion.
- 8.6 Confusion, including as to source, is an appropriate consideration in connection with analysis under this heading, discussed further following.
- 8.7 Distilled, some of R’s argument here includes:
  - (a) It had no awareness of the ‘earthmover.com.au’ Domain Name of I, nor that I had an online magazine publication at that location.
  - (b) That the search printouts (‘K’ annexure of Complaint) are not interpreted by R to verify constant usage by I since 1998.
  - (c) That R chose the Disputed Domain Name for ‘its generic value’ without intent to trade off I’s business.
  - (d) That R strove (various references made) to ‘use generic dictionary words’ to avoid infringements.
  - (e) That R had a ‘first preference’ to register other Domain Names reflecting the ‘Earthmoving’ title.

- (f) That there is no similarity in layout or 'look and feel' between the respective websites such that there is no intent to create confusion.
- (g) That I has 'no rights in the 'EARTHMOVER' name or trade mark (registered or unregistered)'.
- (h) Denies choice of the Disputed Domain Name to attract commercial gain away from I.

8.8 In these respects, and noting equivalent and contrary contentions of I as Complainant, the Panel makes the following observations and findings, and in no selective order.

8.9 On the material before it, the Panel does not accept the contentions of R (inherent within its Response paragraphs 4.1 and 4.8) that it was 'not aware' of the antecedent 1998 Earthmover Domain Name registration, or magazine publication from that location. The following is noteworthy in the view of the Panel:

- (a) The parties have been competitors, and with a proximity of relationship and knowledge of respective activities, within the discrete industry of civil construction over a long period.
- (b) Howsoever Annexure 'K' of the Complaint can be interpreted, as to regularity of website magazine publication over the ten (10) years since 1998, whether that website was updated monthly or not, is not critical to the integrity of the Complaint of I here made. That Annexure alone (but certainly not exclusively) is illustrative, at the least, of a series of chronological publications by I on that website.
- (c) R's contention (Response Paragraph 4.8, for example) that its 'first preference' was to register 'earthmoving.com.au' and 'earthmoving.com', as to reflect the contended generic expression 'Earthmoving' does not reconcile with the contended lack of R awareness that I owned the Earthmover Domain Name by a prior 1998 registration, ten (10) or eleven (11) years earlier. Here, the Panel notes the statement made by R: *'However as both of these domains were not available, the*

*Respondent registered "earthmove.com.au"...'. This reflection on domain 'availability' can only arise after research, search or inquiry. Such would reasonably connote, particularly with the proximity of competitiveness and mutual knowledge of the parties of each other in the industry, a forensic identification of potential conflict or confusion, as distinct from the registrant, R, proceeding to register the Disputed Domain Name against the antecedent registered Earthmover Domain name of I and of its EARTHMOVER trade and service name identities.*

- (d) The Panel does not accept R's urgings that I 'had no rights' in the EARTHMOVER name or mark.
- (e) The various 'strategies' contended as adopted or implemented by R, whether as a contended 'market leader' in this publishing field, or otherwise, do not go squarely to the issue as to the creation of a likelihood of confusion in the terms attendant upon Paragraph 4a(iii), illustrated within the non-exclusive evidentiary indications inherent within Paragraph 4b of the Policy.

8.10 To this extent, the Panel again notes:

- (a) The Disputed Domain Name registered by R is so closely proximate to I's Earthmover Domain Name, diversified only by the one (1) letter 'r', as to be highly examinable against R's contention that it was both unaware of I's prior registered interests, and (in essence) sought no commercial advantage, or diversion of customers away from I, by so initiating the disputed registration.
- (b) R's contentions are, in the view of the Panel, the more highly examinable upon consideration as to the proximity of knowledge of the parties as competitors, within the discrete industry areas referred to, over a long period such that, in the view of the Panel, it is not reasonably plausible, in the circumstances of this presentation, to accept that there was no such intent or no relevant confusion occasioned by R taking that registration step.

8.11 There is no material before the Panel indicative of any initiative of R towards a clear website disclaimer as to attempt to diffuse or remove any potential confusion (*AGDEST v Blogger Pty Ltd*, IAMA-3058 (2007)).

8.12 In the Panel's view and determination, these considerations, and all matters taken together, reliably establish that the registration by R of the Disputed Domain Name 'intentionally attempted to attract, for commercial gain, Internet users to a website or other online location by creating a likelihood of confusion'.

8.13 Further, for completeness, the Panel concludes that the Respondent's use of the Disputed Domain Name was in bad faith, in that it likely confused and diverted customers, including as to an affiliation or source which did not exist, such that bad faith registration, in the view of the Panel, may consequently be inferred (*Houghton Mifflin Co v The Weathermen Inc* (WIPO Case D 2001-0211)).

8.14 For the reasons outlined, the Panel determines that I as Complainant has satisfied the requirements of Paragraph 4a(iii) of the auDRP Policy as to Disputed Domain Name registration in bad faith.

## **9. DECISION**

9.1 The Panel concludes for the reasons stated:

- (a) That the Disputed Domain Name is confusingly similar to a name, trade mark, or service mark in which the Complainant I has rights;
- (b) That the Respondent R has no rights or legitimate interest in the Disputed Domain Name; and,
- (c) That the Respondent R registered and used the Disputed Domain Name in bad faith.

9.2 For the reasons outlined, the Complainant has satisfied the elements of Paragraph 4a of the auDRP Policy.

## **10. RELIEF**

## **Transfer of the Domain Name**

10.1 The Panel orders that the Disputed Domain Name 'www.earthmove.com.au' be transferred to the Complainant I.

10.2 The Panel notes that the Complainant I is eligible to hold the Disputed Domain Name under Schedule A, Paragraph 4a(i) of the auDA Policy as the owner of a 'name, trademark or service mark' in which the Complainant I has rights.

Dated this 9<sup>th</sup> day of April 2009

**JOHN A. McGRUTHER**  
**Sole Panellist**

Annexure 'A'

**Procedural History**

**[earthmove.com.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 **10 March 2009**.
3. On **25 March 2009** LEADR contacted the Respondent via phone and confirmed that the application had been received after 13 March 2009, by express post.
4. On **13 March 2009** 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 **TPP Internet** on **13 March 2009**. The Registrar confirmed that the website was locked on **23 March 2009**.
6. LEADR advised auDA of the complaint on **13 March 2009** via e-mail.
7. On **25 March 2009** 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 on 25 March 2009.
8. The response was due on **2 April 2009**. A response was received by that date.
9. The Panellist was informed on **3 April 2009** that the package was being sent for Adjudication.