



## ADMINISTRATIVE PANEL DECISION

Confo Pty Ltd v. Meridian Project Consulting Pty Ltd

Case No. LEADR-auDRP\_10\_20

<buildercpd.com.au>

### 1. THE PARTIES

The Complainant is Confo Pty Ltd, represented by its Director, Mr Charles Bannister.

The Respondent is Meridian Project Consulting Pty Ltd, represented by Pope and Spinks, Solicitors.

### 2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name <buildercpd.com.au> is registered with distribute.IT Pty Ltd.

### 3. PROCEDURAL HISTORY

This is an administrative proceeding pursuant to the .au Dispute Resolution Policy ("auDRP"), the Rules for .au Dispute Resolution Policy ("auDRP Rules"), and the LEADR Supplemental Rules for .au Domain Name Dispute Resolution Policy ("LEADR Supplemental Rules").

The Complaint was filed with LEADR on 2 December 2010. On 9 December 2010, LEADR notified the Complainant that the Complaint did not comply with all the requirements of the auDRP Rules, and that the Complainant had five days to rectify the deficiencies. On 10 December 2010, the Complainant transmitted by email to LEADR the revised Complaint. On 16 December 2010, LEADR transmitted by email to distribute.IT Pty Ltd a request for registrar verification in connection with the disputed domain name. On 17 December 2010, distribute.IT Pty Ltd transmitted by email to LEADR its verification response confirming that the Respondent is listed as the registrant and providing the contact details. LEADR verified that the amended Complaint satisfied the formal requirements of the auDRP, the auDRP Rules and LEADR Supplemental Rules, and on 23 December 2010 notified auDA and the Respondent of the Complaint. The proceedings commenced on 23 December 2010.

In accordance with the auDRP Rules, the due date for Response was 17 January 2011. On 10 January 2011, LEADR sent a reminder to the Respondent that a Complaint had been lodged and that the last day to submit a Response was 17 January 2011. On 19 January 2011, solicitors acting for the Respondent requested an extension to 25 January 2011 of the time by which it could submit a Response. On 21 January 2011, the Complainant provided further information about the activities of the Respondent, and requested that the matter proceed to be determined and that the Respondent's request to file a late Response be rejected as being out of time.

On 21 January 2011, LEADR appointed Andrew F. Christie as the sole panelist in this matter. On 21 January 2011, the Panel issued an Interim Determination, refusing the Respondent's request to extend the due date for filing a Response, on the ground that the Respondent had not provided any evidence or argument as to why, pursuant to paragraph 10(c) of the auDRP Rules, this was an "exceptional" case requiring extension of a time period fixed by the auDRP Rules. The Interim Determination did, however, permit the Respondent to file succinct observations on the matters raised in the Complaint by no later than 17:00 AEDT on 25 January 2011, to give effect to the requirement of paragraph 10(b) of the auDRP Rules that each party is given a fair opportunity to present its case.

On 24 January 2011, the Respondent submitted a further request for leave to file a late Response, arguing that the timing of the commencement of the Complaint, 23 December 2010, constituted an exceptional situation because it coincided with the traditional vacation time in Australia, thus hampering the Respondent's ability to instruct professional representation and obtain evidence. On 25 January 2011, the Complainant filed a submission arguing that the Respondent had failed to make out an exceptional case for extending the time for filing a Response. On 25 January 2011, the Panel issued a second Interim Determination, granting the Respondent leave to file a Response by no later than 17:00 AEDT on 27 January 2011. The Response was filed with LEADR on 27 January 2011.

On 1 February 2011, the Complainant filed an unsolicited reply to the Respondent's Response. On 4 February 2011, the Respondent filed an unsolicited reply to the Complainant's reply.

#### **4. FACTUAL BACKGROUND**

The Complainant provides continuing professional development ("CPD") courses for the building industry. It has been trading under the business name "Builders CPD" since on or around February 2008, when that business name was registered with the Office of Fair Trading in NSW. A wholly owned company of the Complainant is called "Builders CPD Pty Ltd." This Company is in partnership with TAFE NSW NSI and has trained in excess of 2,000 builders since 2008 throughout NSW. The Complainant has spent more than \$500,000 in the marketing of its face-to-face and online courses over the last three years. The Complainant owns the domain name <builderscpd.com.au>, and uses that domain name as the URL for its website.

The Respondent has been providing educational services to the building industry since 1998, when Mr John Makdessi, the Principal of the Respondent, published a Manual for Owner/Builders and Building Check List. Since 2006 the Respondent has been approved by the Office of Fair Trading to provide CPD courses in building procedure and methods to owner/builders. This led to the Respondent setting up a website using the domain name <cpdforbuildersonline.com.au>. At a time not specified, the

Respondent registered the disputed domain name <buildercpd.com.au>. In about October or November 2009 (according to the Respondent) or June 2010 (according to the Complainant), the Respondent adopted the disputed domain name as the URL for its website. After commencement of these proceedings, the Respondent adopted yet another domain name, <buildingcpd.com.au>, as the URL for its website, but continued to use the disputed domain name to point to that website.

## **5. PARTIES' CONTENTIONS**

### **A. Complainant**

The Complainant contends the disputed domain name is almost identical and confusingly similar to the Complainant's domain name <builderscpd.com.au>.

The Complainant contends that the Respondent has no rights in respect of the disputed domain name, because "buildercpd" is not the registered business name of the Respondent and the Respondent is not the owner of any registered trademark or of a company name similar to "buildercpd".

The Complainant contends that the Respondent has used the disputed domain name in bad faith, because it adopted the disputed domain name as the URL for its website so as to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's domain name. The Respondent is in competition with the Complainant and is trying to capitalize on the goodwill created by the Complainant through its years of effort in marketing and delivering its core services with the TAFE NSW. At the time it adopted the disputed domain name as the URL for its website, it also redesigned the website so that the "look and feel of its whole business [is] almost identical" to the Complainant's website. The Respondent's conduct following commencement of this proceeding, whereby it adopted yet another domain name, <buildingcpd.com.au>, as the URL for its website, demonstrates the Respondent's acknowledgement that the disputed domain name is too similar to the Complainant's business name and domain name.

### **B. Respondent**

The Respondent contends that the phrase "Builders CPD" is a natural and generic listing for services of this type. The core business of the websites operated by both the Complainant and the Respondent is to attract builders wishing to access continuing professional development courses. The Complainant should not be able to force the Respondent from this generic name and therefore obtain a competitive advantage. The Respondent adopted the disputed domain name on the advice of web designers who said that the original domain name, <cpdforbuildersonline.com.au>, was too long for a URL. In addition, the disputed domain name would make the Respondent's website more prominent in searches.

The Respondent contends that "[t]he 'right' to use a name is a matter of Trade Marks law", that "there is no nexus between having a registered business name and having a URL of similar type", and that "the 'rights' to a name do not arise from Business Name registration".

The Respondent rejects the Complainant's assertion that it changed its domain name to take advantage of the Complainant's goodwill. It contends that its provision of CPD services to the building industry was either prior to, or contemporaneous with, that of the Complainant and therefore not motivated by capitalising on any goodwill.

## 6. DISCUSSION AND FINDINGS

### A. Identical or Confusingly Similar

The Complainant's contention in respect of the requirement of paragraph 4(a)(i) of the auDRP is misconceived. The issue is not whether the disputed domain name is identical or confusingly similar to the Complainant's *domain name*, but whether it is identical or confusingly similar to a name in which the Complainant *has rights for the purposes of the auDRP*. As footnote 1 of the auDRP makes clear, a "name ... in which the complainant has rights" for the purposes of the auDRP includes a company name and a business name, but does not include a domain name.

The disputed domain name incorporates the whole of the Complainant's business name BUILDERS CPD as registered with the NSW Office of Fair Trading, minus the letter "s". Likewise, the disputed domain name incorporates the whole of the Complainant's company name BUILDERS CPD PTY LTD (once the "Pty Ltd" is ignored) as registered with the Australian Securities and Investments Commission, minus the letter "s". The subtraction of the letter "s" simply turns from the plural to the singular the word "builders" in the Complainant's business name and company name. It does not lessen the inevitable confusion of the disputed domain name with the Complainant's business and company names caused by the substantial similarity of the disputed domain name to those names. Accordingly, the Panel finds that the disputed domain name is confusingly similar to a name in which the Complainant has rights.

Thus, the Complainant has established the requirement of paragraph 4(a)(i) of the auDRP.

### B. Rights or Legitimate Interests

The Respondent's contention in respect of the requirement of paragraph 4(a)(ii) of the auDRP is misconceived. The issue is not whether the *Complainant* has any rights to the disputed domain name, but whether the *Respondent* has any rights or legitimate interests in the disputed domain name.

The Respondent has not asserted the existence of, let alone provided any evidence to prove, any of the circumstances specified in paragraph 4(c) of the auDRP as demonstrating rights or legitimate interests in a domain name. Probably the only plausible argument the Respondent could make on this issue is that, prior to notice of this dispute, it was making a *bona fide* use of the disputed domain name in connection of an offering of goods or services – this being a circumstance specified in paragraph 4(c)(i) of the auDRP as demonstrating rights or legitimate interests in a domain name. However, such an argument does not succeed. Although the Respondent has used the disputed domain name in connection with an offering of services, that use is not *bona fide*.

It is true that the disputed domain name is descriptive of the services provided by the Respondent. However, that fact alone does not mean that the Respondent's use of the disputed domain name was *bona fide*. The Latin phrase *bona fide* means "in good faith". To determine whether a use of a domain name is in good faith requires a consideration of the motivation of the entity undertaking it. That, in turn, requires an evaluation of the facts and evidence contained in the case record.

The record in this case supports the conclusion that the motivation of the Respondent in adopting the disputed domain name, in place of its previous domain name, as the URL for its website was to use a domain name that was very similar to the business name of a competitor, and thereby to benefit from the reputation that the competitor had developed in that name. The following facts, in particular, support this conclusion. First, the Respondent has not asserted that at any relevant time it was unaware of the Complainant's business. Thus, it may be concluded that at all material times the Respondent was aware that the Complainant conducted its business under the business name BUILDERS CPD. Secondly, the Respondent has not disputed the Complainant's assertion that it changed the look of its website to one very similar to the Complainant's website at the time it adopted the disputed domain name as the new URL for its website. Thirdly, the disputed domain name is almost identical to the Complainant's business name. While it is understandable that the Respondent would wish to replace its original long domain name with a shorter one, it does not seem to be coincidental that the replacement chosen was almost identical to the Complainant's business name.

After close consideration of both parties' contentions and evidence, the conclusion that the Panel draws from the record in this case is that the Respondent was aware of the Complainant's business conducted under the name BUILDERS CPD when it adopted the disputed domain name as the URL for its website, and that the Respondent's motivation for adopting the disputed domain name as the URL for its website was to benefit from the reputation the Complainant had developed in the business name BUILDERS CPD. Seeking to benefit from another's reputation is not an action undertaken in good faith. It follows, therefore, that the Respondent's use of the disputed domain name was not a *bona fide* use for the purposes of paragraph 4(c)(i) of the auDRP.

The Respondent has not asserted the existence of either of the other two circumstances specified in paragraph 4(c) of the auDRP, and there is nothing in the record that would support the existence of either circumstance.

The Complainant has made out a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name, and the Respondent has failed to rebut that case. Accordingly, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name.

Thus, the Complainant has established the requirement of paragraph 4(a)(ii) of the auDRP.

### **C. Registered and Used in Bad Faith**

The Respondent has used the disputed domain name as the URL for its website offering CPD services for the building industry, which is an attempt to attract, for commercial gain, Internet users to its website. Given the Panel's findings that the disputed domain name is confusingly similar to the Complainant's name, and that the Respondent's motivation for adopting the disputed domain name was to benefit from the reputation in the Complainant's business name, it follows that this use of the disputed domain name is an intentional attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's name. Under paragraph 4(b)(iv) of the auDRP, this is evidence of use of the disputed domain name in bad faith. Accordingly, the Panel finds that the Respondent has used the disputed domain name in bad faith.

Thus, the Complainant has established the requirement of paragraph 4(a)(iii) of the auDRP.

#### **D. Complainant's Eligibility**

Given the business name and company name registrations held by the Complainant, the Complainant appears to satisfy the eligibility requirements for registration of the disputed domain name.

### **7. DECISION**

For all the foregoing reasons, in accordance with paragraph 4(i) of the auDRP and paragraph 15 of the auDRP Rules, the Panel orders that the disputed domain name, <buildercpd.com.au>, be transferred to the Complainant.

**Andrew F. Christie**

Sole Panelist

Dated: 12 February 2011