



## ADMINISTRATIVE PANEL DECISION

### Colmar Brunton Pty Ltd v. Alta Computer Systems Pty Ltd

LEADR-auDRP 10\_18  
<opinionspaid.com.au>

#### 1 The Parties

The Complainant is **Colmar Brunton Pty Ltd**, a company with its principal place of business at North Ryde, NSW. It was represented in the proceedings by Mr Alex Rhydderch of the law firm Colin Biggers & Paisley in Sydney.

The Respondent is **Alta Computer Systems Pty Ltd** trading as **Alta Research** with its principal place of business in Newtown, NSW. It was represented in the proceedings by its Director, Mr Terry Jackson, of the same address.

#### 2 The Disputed Domain Names and Registrar

The Disputed Domain Name is <opinionspaid.com.au>. The registrar of the Disputed Domain Name is Netregistry Pty Ltd.

#### 3 Procedural History

This is an administrative proceeding pursuant to the .au Dispute Resolution Policy originally adopted by auDA on 13 August 2001, and subsequently amended in March 2008 and May 2010 (“auDRP”); the auDA Rules for .au Dispute Resolution Policy (“Rules”) and the LEADR Supplemental Rules to Rules for .au Domain Name Dispute Resolution Policy (“LEADR Supplemental Rules”).

A LEADR Domain Name Dispute Complaint Form was filed with LEADR on or about 6 October 2010. On 15 October 2010 LEADR forwarded a copy of the Complaint to the Registrar and on 20 October received the Registrar’s confirmation of the registration particulars and confirmation that the Disputed Domain Name had been locked. A copy of the Complaint was sent to the Respondent on 22 October and auDA was advised of the Complaint on 15 October.

The Response was due 20 calendar days after the Respondent was first notified of the Complaint. Under Rule 5(a) the Response was therefore due by 11 November 2010.

On 10 November 2010 the Respondent lodged a Response which LEADR copied to the Complainant. The Respondent requested a three-member panel and nominated three individuals from LEADR’s list of panellists. One of those persons was unavailable for the bulk of the time within which the Panel was to prepare its decision and LEADR therefore substituted one panellist. Each member of the panel has provided the requisite

Statement of Impartiality and Independence. On 22 November 2010 the Complainant filed with LEADR a “further statement in answer for the purposes of rule 14 of the LEADR Supplemental Rules”. The Panel has taken into account the submissions made in that document on the basis that it was for the most part responsive to material in the Response which could not have been anticipated, such as the use of survey evidence.

The Panel was appointed on 2 December 2010 and received the Case file and Procedural History later that day.

All other procedural requirements appear to have been satisfied.

#### **4 Factual Background**

The Complainant is a large Australian-owned market research agency which has been in business for more than 20 years. The Respondent is an Australian-owned market research business which was formed 13 years ago.

The Complainant became the licensee of <opinionspaid.com> on 15 March 2000 and has used it ever since although, after December 2006, this was through its wholly-owned subsidiary, Your Source Pty Ltd. The Respondent became the licensee of the Disputed Domain Name on 15 August 2005 and has used it ever since through its Alta Research business.

The Complainant became the registered proprietor of Australian trade mark 1293565 for the word mark “OpinionsPaid” on 8 January 2010 (with effect from its lodgement date of 8 April 2009).

Both parties operate businesses that, amongst other activities, pay members of the public to give their opinions for market research purposes, primarily through participation in focus groups.

#### **5 Parties’ Contentions**

##### **Complainant**

The Complainant makes the following principal contentions:

##### **A. The Disputed Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights.**

The Complainant submits that the Disputed Domain Name is “confusingly similar if not identical” to its registered trade mark *OpinionsPaid* when the 2LD and ccTLD elements are ignored, as one does in making the required side by side comparison.

##### **B. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.**

- The Respondent has no registered trade mark, company name, business name registered or “business presence” in respect of the “opinionspaid brand” in Australia apart from the domain name.
- A search of the web pages in the Respondent's websites, [www.mrgroups.com.au](http://www.mrgroups.com.au), [www.opinionspaid.com.au](http://www.opinionspaid.com.au) and [www.altaresearch.com.au](http://www.altaresearch.com.au) reveal that there is no

reference to "opinionspaid" as part of the websites' content in connection with an offering of goods or services under that mark.

- The Complainant need do no more than show a *prima facie* case under this limb of the Policy, after which the onus shifts to the Respondent to demonstrate its rights or legitimate interests in respect of the Disputed Domain Name.

**C. The Disputed Domain Name was registered or is being used in bad faith.**

(a) The Complainant has developed a substantial reputation in the "opinionspaid" brand in respect of paid market research online recruitment since first developed in 2000.

(b) There are over 88,000 active members of the Complainant's website with over 2,500 online surveys conducted since the service was started in 2000.

(c) Both the Wayback Machine and Alexa reports show extensive use of the Complainant's <opinionspaid.com> domain name since the time of its registration in 2000, from which the Complainant submits that the Panel should infer relevant knowledge on the Respondent's part of the Complainant's mark both at the time of the registration of the Disputed Domain Name and subsequent to that time.

(d) There is a presumption that, if a trade mark is registered, then the domain name is distinctive of the services claimed.

(e) The registered trade mark for OpinionsPaid was granted to the Complainant without any endorsements in respect of, amongst other things, "surveys, opinion polling and market research".

(f) The Disputed Domain Name is likely to be used by internet users by directly typing it into their browser address field or by making searches for it under the presumption that they will be directed to a website associated with the OpinionsPaid "paid market survey service" conducted and promoted by the Complainant.

(g) On a Google search of "OpinionsPaid" or "opinionspaid.com.au" [sic], a search link for the Disputed Domain Name is found. On clicking on the search link, this then directs web traffic to an online survey page hosted by the Respondent, which offers some products and services" that are the same or similar to the Complainant's own offerings".

(h) A search of the Respondent's www.opinionspaid.com.au, www.mrgroups.com.au and www.altaresearch.com.au websites reveals no reference to "opinionspaid" as part of the websites' contents. The Complainant asks the Panel to conclude therefrom that the Respondent is not using the domain name in connection with an offering of goods or services but is merely directing traffic away from the Complainant's "OpinionsPaid" service.

(k) In the circumstances, the registration or use of the Disputed Domain Name by the Respondent "is an intentional attempt to attract for [sic] divert web traffic to the Respondent's other websites by creating the likelihood of confusion with the Complainant's Opinionspaid.com domain name and trading brand in which it has built up substantial goodwill".

## **Respondent's Response**

The Respondent explains by way of background that its business is the recruiting of participants for market research focus groups & face-to-face interviews. As such, it claims that it is essential that it attract a large number of people to register for its database of participants. The Respondent says that it currently has "over 66,000 names" on its database, being participants who are paid for their opinions when they attend focus groups.

The Response does not address the Complainant's submissions under the first limb of the Policy in terms, although it does deny the Complainant's reputation in the OpinionsPaid brand.

In relation to the Complainant's submissions under the second limb of the Policy the Respondent argues strongly that it has both rights and legitimate interests in the Disputed Domain Name. It first draws the Panel's attention to section 2.3 of auDA's Domain Name Eligibility and Allocation rules for open 2LDs, which states:

"There is no hierarchy of rights in the DNS. For example, a registered trade mark does not confer any better entitlement to a domain name than a registered business name. Domain name licences are allocated on a 'first come, first served' basis. Provided the relevant eligibility rules are satisfied, the first registrant to apply for a particular domain name will be permitted to license it."

It notes that it registered the Disputed Domain Name and began using it on 15 August 2005, "many years before" the Complainant's 2009 trade mark application. It claims therefore to meet the 'first come, first served' principle that underlies auDA's policy. The respondent claims to be one of Australia's largest independent market research recruiting companies, and to be greatly respected in the industry. It says that "we" (by which the Panel assumes is meant Mr Jackson rather than the corporate respondent) "hold the position of secretary of the NSW AMSRS committee". The AMSRS is the Australian Market & Social Research Society, which the Respondent says is "the" professional membership body for the industry. The Respondent (or Mr Jackson) is also a member of the NSW Qualitative Recruiters Group and chaired this group from 2005 to 2009. The Respondent notes that it is also ISO 20252 accredited.

In addition, the Respondent claims to "design, manufacture and support Australia's leading Market Research Recruitment software - Alta<sup>FX</sup>, with 150 users in Australia, New Zealand, Canada and the USA".

The Respondent goes on to submit that, since registration of the Disputed Domain Name in 2005, it has used it continuously in connection with its sole business--recruiting consumers to serve in focus groups and offer their opinions on products and services. The Respondent says that the "participants in these focus groups are paid for their opinions. Since 2000 we have recruited over 53,000 respondents, for over 8000 focus groups".

It also says that one of the primary challenges for market research recruiting companies is attracting qualified consumers to serve in focus groups. The Respondent claims to have spent "substantial time and money in building up a database of such consumers". The vast majority (> 98%) of contacts in its database have contacted the Respondent "based on Internet searches or have heard of us and contacted us directly through" the Disputed Domain Name. It says that "in the jargon of consumers, our business goes by a variety of names: focus groups, market research, consumer opinions, my opinions, opinions paid, cash for opinions, paid surveys, etc. Enabling consumers to locate us on the Internet is--

and has been since at least 2005--critical to the success of our business. As consumers age, move, or lose interest in being paid for their opinions, we are forced to constantly expand and replenish our database of consumers". The Disputed Domain Name is said to be an integral part of that.

In an unusual submission the Respondent asserts that the Complainant's business is "not associated with" the Disputed Domain Name. It bases this submission on a survey which it conducted using NSW and Victorian market research contacts, with over 1200 respondents. It says that the results show that "less than 4% of consumers associated 'opinions paid' with a business/site resembling the Complainant's name/mark. To consumers, opinions paid is a generic term for focus groups or market research; it is not linked to the Complainant in any way. In short, says the Respondent, it has used the Disputed Domain Name continuously for more than five years in connection with its sole business, the Disputed Domain Name has been critical in attracting consumers that enable its business to be viable, and the Complainant's efforts to force a transfer are nothing more than an attempt to take control of a domain name that the Respondent has spent years and tens of thousands of dollars promoting. The Panel notes that the Respondent stops short of accusing the Complainant of Reverse Domain Name Hijacking.

In response to the Complainant's submissions under the third limb of the Policy, the Respondent denies that it either registered or has subsequently used the Disputed Domain Name in bad faith. In particular, it says:

- i) The Disputed Domain Name resolves to a recruitment registration page, where visitors clearly see that they are registering for the Respondent's market research focus groups, and that they will be paid in cash for their opinions.
- ii) There is no confusion by consumers between the Complainant and the Respondent in light of the clearly defined and "Alta Research" branded registration site. The fact that the Respondent has owned and used the Disputed Domain Name for over five years has built up in the mind of consumers that it is related to the Respondent. Additionally, throughout that period the Complainant never previously raised any concern about the possibility of this confusion.
- iii) The Complainant's 'opinionspaid.com' website has almost no mention of the Complainant, and it displays a copyright claim by 'yoursource 2008'. Additionally, the CONTACT link at the site sends messages to <panel@yrsource.com>. Thus, the Respondent submits, the link between the <opinionspaid.com> website and the Complainant is obscure.
- iv) 'Opinions Paid' is a generic term widely used in this industry, relating to a consumer's reimbursement in the market research industry. It is not associated in any way in the average consumer's mind with the Complainant or its related companies. Referring again to the survey material mentioned above, the Respondent contends that more than 96% of the surveys' respondents found no connection between the OPINIONS PAID brand and the Complainant. Indeed, so the Respondent says, the Complainant seems to have decided, nine years after registering the top level domain--and electing not to seek a registration on the domain at issue here, that it wishes to undo that choice. The Complainant was well aware that the Respondent was investing in the Disputed Domain Name, and its choice to not seek a registration of that domain name before August 2005 cannot now be undone.

The Respondent further says that an Australian Google search of ‘opinions paid’ showed 532,000 results with reference to hundreds of other market research and related companies, “thus proving it to be a generic term and not a true ‘brand’”. The Respondent appeared third on the result list, under its NSW domain ‘sydneymarketresearch.com.au’ and fifth in the general search results.

The Respondent also notes that, according to the Complainant’s “About” web page, the “Opinionspaid site has been operating for 5 years (ie. 2006) , and not 2000 as stated in the” Complaint.

The Respondent also disputes the Wayback Machine and Alexa reports relied on by the Complainant.

## **6 Complainant’s further submission**

The Complainant’s further submission by way of answer to the Response comprised a two-page document with about nine pages of annexures. The Panel has taken into account the supplementary submissions by the Complainant, primarily in relation to the challenges made to the survey evidence adduced by the Respondent, which the Complainant could not reasonably have anticipated when drafting the Complaint. To the extent that the Complainant has had a ‘second bite at the cherry’ in relation to arguments already put in the Complaint, these have been ignored..

## **7 Discussion and Findings**

Paragraph 15(a) of the auDRP Rules requires the Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the auDRP, the Rules, and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the auDRP requires a Complainant to prove that:

- (i) the Disputed 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 has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered or subsequently used in bad faith.

The onus of proof is on the Complainant in relation to all three of these elements.

This kind of administrative proceeding is reserved for relatively clear cases of cybersquatting; extensive submissions and annexures are generally unhelpful. The Panel acknowledges that both the Complainant and the Respondent have for the most part addressed the relevant provisions of the auDRP in a succinct and helpful fashion.

### **Disputed Domain Name Identical or Confusingly Similar to Complainant’s Trade Mark**

The Panel has no hesitation in concluding that the Disputed Domain Name is identical to the Complainant’s registered trade mark *OpinionsPaid* when the capitalisation and 2LD and ccTLD elements are ignored, as one does unless they relevantly contribute in some way to the identity or confusion.

The Complainant has therefore made out the first limb of the auDRP.

### **Rights or Legitimate Interests in respect of the Disputed Domain Name**

The evidence shows that both parties operate businesses that involve cash payments being made to members of the public who give their opinions whilst participating in market research focus groups. Both parties use their respective websites as key components of the recruitment process by which databases of prospective focus group participants are drawn.

Whilst the Complainant correctly submits, based on a respected line of both auDRP and UDRP cases, that once it has made out a *prima facie* case, the onus of proof shifts to the Respondent to show the legitimacy of its rights or interests, the implicit assumption that it has made out a *prima facie* case in this proceeding is unsound. The Panel considers that the Respondent has a legitimate interest in the use of ordinary English words that convey that payment will be made for opinions given. Whilst the Panel does not accept that the Respondent has the right to infringe the Complainant's registered trade mark for "OpinionsPaid", it is not satisfied that the Disputed Domain Name is use "as a trade mark" of the Complainant's trade mark (which would be required to constitute infringement). Domain names cannot include spaces, and capitalisation is ignored when browsers parse domain names. Furthermore, on the Complainant's own evidence, there is no use of its trade mark in the website to which the Disputed Domain Name resolves. Under auDA's eligibility policy for domain names in the .com.au 2LD there is a close and substantial connection discernable between the paid opinions business activity of the Respondent and its choice of the Disputed Domain Name. The Respondent and Mr Jackson appear from the evidence to be held in high esteem by their industry peers and there is no basis for the Panel to reject the superficial legitimacy of the Respondent's interest in the Disputed Domain Name. In a court proceeding where evidence and witnesses' credit can be tested, the Complainant might be able to show that the Panel has been deceived, but based on the evidence before us, there is no basis for doubting the Respondent's asserted right and interest in respect of the Disputed Domain Name.

Whilst we are in no position to rule on the validity of the Complainant's trade mark registration, we reject the Complainant's submission that its registration in some way demonstrates a reputational underpinning which we are bound to recognise. In fact we are a little surprised that "OpinionsPaid" has been registered in respect of paid opinion recruitment services which at first blush it appears to connote if not denote. Certainly we are entitled to take into account, in assessing the legitimacy of the Respondent's interest in respect of the Disputed Domain Name, the possibility that the Respondent could succeed in resisting any action for infringement of the Complainant's trade mark by having it revoked on the grounds that it is not inherently adapted to distinguish the Complainant's services from the same services offered by other traders, being those in relation to which the Disputed Domain Name is used by the Respondent. The kind of exercise involved in applying provisions such as s. 41(5) or (6) of the Trade Marks Act 1995 is one that we are not equipped to conduct. Suffice it to say that our view that such an exercise could plausibly benefit the Respondent gives legitimacy to its having an interest in respect of the Disputed Domain Name.

There is a further reason for according the Respondent the benefit of the 'right or legitimate interest' doubt. Even if the Respondent might be expected to have known of the <opinionspaid.com> website at the time it registered the Disputed Domain Name in 2005, the fact is that the Complainant waited for almost four more years before filing for a trade mark for "OpinionsPaid" and then waited a further nine months after its trade mark

registration was granted before commencing this proceeding. There has been discussion in a number of recent UDRP cases about the role of *laches* and whether it creates substantive rights. Whilst this Panel agrees with what the learned panellist had to say in auDRP 11\_09 <sharp.com.au>, to the effect that a prolonged period of use of a domain name, unchallenged by an aware trade mark owner, accords the registrant increased legitimacy of right and interest in that domain name, we do not need to proceed on the basis of any substantive legal principles nor find that *laches* has been made out in this proceeding. It is sufficient that we take the view that under the second limb of the auDRP (and the UDRP for the same reason) the longer an aware trade mark owner takes to indicate to a prospective respondent that its conduct is not acceptable and is to be challenged, the greater the comfort level the putative respondent is likely to have in the continued use of its domain name. In Australia domain names have a licence period of only two years (although that is under review at the time of writing). So a domain name registrant who has registered and then renewed its domain name for a further period without complaint could be forgiven for believing that there was no objection to its conduct. That accords a degree of legitimate interest if not a right in respect of the registrant's domain name.

Here the evidence shows that the Respondent registered the Disputed Domain Name in August 2005, and the first it knew of the Complainant's concern appears to be the service of the Complaint in October 2010. This is a period of more than five years of apparently bona fide use in connection with the Respondent's market research focus group recruiting services. In those circumstances the Complainant has not made out a *prima face* case under limb 2 of the Policy. On the contrary, the Respondent has the benefit of paragraph 4(c)(i) of the Policy which deems it to have a right and legitimate interest because it had *bona fide* used the Disputed Domain Name before it had notice of the Complainant's challenge.

For the foregoing reasons the Panel finds that the Complainant has not made out the second limb of the Policy and the Complaint must be dismissed. However, the Panel proposes also to address the parties' submissions in relation to the third limb of the Policy.

### **Registered or subsequently used in bad faith**

Paragraph 4(a)(iii) of the auDRP requires the Complainant to demonstrate that the Disputed Domain Name was *either* registered *or* subsequently used in bad faith.

Where, as in this proceeding, the registration of a disputed domain name pre-dates the registration of the trade mark relied upon, a complainant has to place much more emphasis on the circumstances that prevailed up to and at the time of registration. Here the Complainant has elided the distinction between the circumstances that prevailed at the time the Disputed Domain Name was registered and the circumstances that now prevail, subsequent to its successful trade mark application. There is insufficient evidence or submissions before the Panel for us to be able to form any concluded view about the extent to which the Respondent ought to have been aware in August 2005 that the Complainant had or claimed to have a common law trade mark in the composite word "opinionspaid". As noted above, the Panel is prepared to assume that, by reason of their role in the market research industry the Respondent and/or Mr Jackson were aware in August 2005 of the website to which the <opinionspaid.com> domain name resolved. But that is a long way short of a finding that they had any appreciation that such use of "opinionspaid" conferred any common law trade mark rights on the Complainant and, on the view that we have taken, they might legitimately have taken the view that it conferred

no such rights. Accordingly, there is no basis in our view for any finding that the Respondent registered the Disputed Domain Name in bad faith.

Unlike the UDRP, the auDRP third limb can be made out by a finding that a disputed domain name was *either* registered *or* subsequently used in bad faith. Having failed to demonstrate bad faith registration of the Disputed Domain Name, the Complainant had the opportunity to persuade the panel that the Respondent subsequent to registration had used the Disputed Domain Name in bad faith. Partly because it did not distinguish between pre and post trade mark registration usage, it is difficult for the Complainant to discharge its onus of proof. The Respondent has an unbroken period of more than five years of use of the Disputed Domain Name which resolves to a website with a perfectly plausible nexus between that domain name and the Respondent's business activities. That precludes any reliance on paragraph 4(b) of the Policy. The Complainant has not put any other cogent submission to support its contentions.

Furthermore, given the Panel's view that the Respondent has a present legitimate interest in respect of the Disputed Domain Name, it would require a stronger showing by the Complainant to discharge its third limb onus. This it has conspicuously failed to do.

The Complainant has failed to make out ground 4(a)(iii) of the auDRP.

## 8 Decision

The Complainant having failed to make out the grounds of its Complaint, the Panel orders that the Complaint be dismissed.

Dated this 16<sup>th</sup> day of December 2010

*P Argy*

Philip N Argy

Presiding Panellist

*Scott Ellis*

Scott Ellis

Panellist



Sara Delpopolo

Panellist