

ADMINISTRATIVE PANEL DECISION

IAMA Case No. 3658

Disputed Domain Name: thepointkirribilli.com.au
Name of Complainant: E.F.G. Nominees Pty Limited [ACN 092 156 717]
Name of Respondent: Lenland Property Development Pty Ltd. [ACN 143 463 816]
Provider: The Institute of Arbitrators & Mediators Australia [IAMA]
Panel: Philip N. Argy

1. THE PARTIES

1.1 The Complainant **E.F.G. Nominees Pty Limited** is represented by Fraser Old & Sohn, Patent and Trade Mark Attorneys of North Sydney, NSW, Australia.

1.2 The Respondent **Lenland Property Development Pty Ltd.** of Chatswood, NSW, Australia, has not participated in these proceedings.

2 **THE REGISTRAR** The Registrar is **TPP Internet** of Broadway, NSW, Australia.

2. PROCEDURAL HISTORY

The Complaint was filed with IAMA on 30 August 2012 pursuant to the .au Dispute Resolution Policy (the “Policy”), the Rules for .au Dispute Resolution Policy (the “Rules”), both as adopted by auDA on 13 August 2001 and amended on 1 March 2008, and “the WIPO [*sic*] Supplemental Rules for .au Dispute Resolution Policy. The Panel has interpreted the reference to “WIPO” as a clerical error and assumes that the reference was intended to be to IAMA’s Supplemental Rules with which there has in fact been compliance in relation to payment of fees and the like (“Supplemental Rules”).

The Complainant recites that it was served on the Respondent on 30 August 2012 by

being sent to an address in Chatswood, NSW that was obtained by conducting a company search on the Respondent. However the Complainant's attorneys very fairly and properly have included in the record a copy of the envelope in which that communication was contained bearing a RETURN TO SENDER endorsement from Australia Post clearly indicating that the envelope never reached the Respondent. Furthermore, the Complaint recites that a copy of the Complaint was sent by email to the Respondent at the email address shown in the WhoIs record for the Disputed Domain Name, namely, "info@rareid.com.au". As will appear below, that is not an email address for any officer or employee of the Respondent.

The Panel has not been provided with any registrar verification that the Respondent is the registrant of the Disputed Domain Name. However, the WhoIs record is publicly available and the Panel is satisfied that the Respondent is the entity recorded as the current registrant of the Disputed Domain Name.

Under paragraph 2(f) of the Rules an email sent to the contact email address in the WhoIs record is a valid communication to the Respondent, subject to any contrary decision of the Panel. As will be apparent from the Factual Background below, that communication did not reach the Respondent. IAMA used the same email address to notify the Respondent of the Complaint on 5 September 2012. The Panel is satisfied that that communication also failed to reach the named Respondent.

In default of any Response being received from the Respondent, IAMA proceeded on 21 September 2012 to appoint Philip N Argy as the sole panellist in this matter. It is apparent from the record that the Respondent has never received notification of the Panel's appointment. The Rules require 20 days to elapse from the time that the Respondent is notified of the Complaint before a Panel can be appointed. Even if IAMA's 5 September notification had reached the Respondent, it is clear that 20 days had not elapsed. Nevertheless, as at 12 October 2012, no Response has been filed and the Panel deems the proceedings to have been properly commenced and its appointment valid, albeit from the later date of 25 September 2012.

4. Factual Background

From the written record furnished to the Panel the following uncontested facts can be recited.

The Complainant owns the Australian trade mark THE POINT which is registered in two classes relating to real estate services. A marketing campaign extending over several years was conducted on behalf of the Complainant to sell apartments in its refurbished 15-apartment building now known as THE POINT at 20 Alfred Street, Milsons Point, a suburb on the northern foreshore of Sydney Harbour immediately to the west of the Sydney Harbour Bridge. A photograph of the building shows that the building has a prominent exterior THE POINT sign which is illuminated at night. The Complainant's

sales campaign utilising the trade mark THE POINT has been successful and all but one of the apartments, the Penthouse on the two upper floors, have been sold.

In 2010 the Complainant's property won an award from the Australian Institute of Architects for the Residential Development of the Year. Also in 2010 one of the apartments in the building won an award from Master Builders Australia Limited for the Residential Unit of the Year. These awards for innovative building design expanded the building's already widespread reputation in the real estate community.

Either the Neutral Bay or Northbridge branch (the evidence is equivocal on this) of a real estate agent, Belle Property, had approached the Complainant and requested that Belle Property act for the Complainant in the Complainant's marketing campaign. This did not eventuate. However, the Mosman branch of Belle Property subsequently undertook real estate sales advertising activity for a different apartment building called The Point, at 106 Kirribilli Avenue, Kirribilli, a suburb on the northern foreshore of Sydney Harbour immediately to the east of the Sydney Harbour Bridge, utilising the Disputed Domain Name in the advertisements.

Kirribilli and Milson's Point share the postcode 2061.

The Complainant's attorneys wrote to Sandoval Investments Pty Ltd, the owners of the Kirribilli building, complaining about their use of the Complainant's THE POINT trademark. That solicited a response from that building owner's solicitor asserting that the use of the suburb name, Kirribilli, was sufficient to distinguish their building from the Complainant's building, and advising the Complainant that their client would ensure that the suburb name, Kirribilli, would always be included in any reference to their client's building.

The Complaint in these proceedings was filed not long thereafter.

On 26 September 2012, subsequent to the Panel's appointment, IAMA received a letter from a firm of solicitors acting for Rare Identity Pty Ltd. It is important to set out the salient parts of that letter to contextualise the approach the Panel has decided upon for this case:

We act on behalf of Rare Identity Pty Ltd ("Rare") and refer to the above complaint and administrative proceedings.

Rare is an advertising and marketing agency specialising in the promotion of real estate. Midway through this year, Rare was contracted by Belle Property Mosman ("Belle"), who was acting on behalf of Sandoval Investments Pty Limited, to undertake marketing on a real estate development called The Point at Kirribilli. This name was chosen by the director of Sandoval Investments Pty Limited.

In June 2012, Belle instructed Rare to organise the registration of the domain name of www.thepointkirribilli.com.au and to register that name in the name of Belle. Unfortunately, due to an error made by an employee of Rare, the domain name was registered under the name of Lenland Property Development Pty Ltd ("Lenland"). Lenland is a client of Rare who is unconnected to The Point at Kirribilli or Sandoval Investments Pty Limited and is only listed as the registrant of the domain name due to the error in registration.

We are writing to advise that Lenland has no interest in the domain name of www.thepointkirribilli.com and, although it is the listed registrant, it is not the proper respondent to the current administrative proceedings. Rare have notified Belle of the administrative proceedings and attempted to transfer the domain name to Belle after becoming aware of the proceedings but Belle have indicated that they have no interest in being the registrant for the domain name. We note that a transfer of the name cannot take place after the commencement of these proceedings in any case. Belle has also indicated that it is unwilling to be involved in the proceedings.

There is no evidence that the forgoing correspondence has been furnished to the Complainant's attorneys.

5. Parties' Contentions

A. Complainant

The Complaint is based on all three elements of paragraph 4(a) of the Policy, namely, that the Disputed Domain Name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, and that the Disputed Domain Name was registered or has subsequently been used in bad faith.

In relation to the first element the Complainant asserts that the Disputed Domain Name is confusingly similar to its THE POINT registered trade mark.

In relation to the second element it asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been authorised to use the Complainant's trade mark.

And in relation to the third element it asserts that the Disputed Domain Name was registered and is being used in bad faith because the Respondent would or should have been aware of the Complainant's advertising campaign for its Milson's Point property.

B. Respondent

No Response has been received. However, the Panel has relied upon the letter from the solicitors for Rare Identity Pty Ltd ("Rare") set out above in finding that the Respondent, although named as registrant of the Disputed Domain Name, achieved that status without its authority, knowledge or intent. Its name was mistakenly used by Rare, a service provider to Belle Property, when registering the domain name and it is therefore the Respondent to these proceedings in name only. It has and has had nothing whatsoever to do with the subject matter of the dispute.

6. Discussion and Findings

The Panel has to determine whether on the available material it is satisfied that each of the three elements of the Policy has been shown to exist.

In addition to the Policy, auDA has a published policy on the handling of complaints about the eligibility of a registrant to hold their domain name licence under the policy rules for the open second level domains ("2LDs"), including "com.au". The *Complaints (Registrant Eligibility) Policy* deals with registrants that do not exist or whose registration particulars are incorrect. It does not deal with a registrant whose particulars are accurate but who is not the intended or an eligible registrant. Furthermore, where a complainant is not on notice that a registrant is not the intended registrant, it is hardly in a position to take action on that basis.

auDA also has a published policy called the *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs*. This key policy contains the eligibility rules that must be met before a domain name can be registered in the open 2LDs. Relevantly, paragraph 2 of Schedule C provides:

2. Domain names in the com.au 2LD must be:
 - a) an exact match, abbreviation or acronym of the registrant's name or trademark; or
 - b) otherwise closely and substantially connected to the registrant.

It is quite plain from the letter from Rare's solicitor that the Respondent is not eligible to

hold the Disputed Domain Name. The Disputed Domain Name bears no resemblance to the Respondent's corporate name or style, no resemblance to any trade mark which it might own, and apparently has no connection whatsoever to the registrant.

Against this background the Panel must consider the three elements of the Policy in turn before deciding on what remedy, if any, should be ordered.

A. Identical or Confusingly Similar

Ignoring the “.com.au” Country Code top and second levels of the Disputed Domain Name, the omission of the spaces between the words “The”, “Point” and “Kirribilli”, and the lack of capitalisation, as one does in approaching the question under the first limb of the Policy, the residual question is whether “thepointkirribilli.com.au” is deceptively similar to “THE POINT”, being a trade mark in which the Complainant has rights. It is plainly not identical, but does the inclusion of the suburb name of “Kirribilli” make it less likely than not that persons would confuse the Disputed Domain Name with the Complainant's trade mark?

On balance the Panel has come to the view that the Disputed Domain Name is indeed similar to the Complainant's trade mark THE POINT and that the addition of “Kirribilli” is not sufficient to prevent it from being confusingly so. This is because people familiar with the area of Sydney in question may regard Milson's Point and Kirribilli as conjoined suburbs having a common postcode, so that the use of one suburb rather than the other is insufficient to dispel any confusion. And for people having no knowledge of Sydney, the suffixed “kirribilli” segment of the Disputed Domain Name is insufficient to displace the primary signification of “the point”.

The first limb of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

The Complainant has not authorised the Respondent to use the Disputed Domain Name. The Panel can infer from Rare's solicitor's letter that the Respondent was oblivious to the registration of the Disputed Domain Name and would not assert any rights or legitimate interests in the Disputed Domain Name. Certainly it has not in fact asserted any.

Accordingly, the Panel finds the second element of the Policy made out.

C. Registered or Subsequently Used in Bad Faith

As Rare's solicitor's letter also makes clear, the Respondent had nothing to do with the registration of the Disputed Domain Name and is not the user of the Disputed Domain Name. Self-evidently the Panel could not reach any finding that the Respondent had registered or subsequently used the Disputed Domain Name in bad faith. However, the

Policy does not require such a finding for the third element to be made good. All that is required is a finding that the Disputed Domain Name was registered or was subsequently used in bad faith without the need for a finding that the bad faith conduct was that of the Respondent.

Clause 2 of the Policy contains a warranty that “the statements that you made in your domain name application are complete and accurate, including those as to your eligibility for a domain name in the open 2LD”. To the extent that the person who completed the application for the Disputed Domain Name recorded as applicant the name of a person who was not eligible under paragraph 2 of Schedule C to the *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs*, this warranty was falsely given. That person – apparently a person employed by Rare - also provided email contact details that were not email contacts for anyone at the Respondent. The email contacts given in the WhoIs record include the “rareid.com.au” domain, which has no connection with the Respondent.

In the circumstances, the Panel finds that the Disputed Domain Name was registered in bad faith by the person at Rare who completed the application form. It is therefore unnecessary for the Panel to consider whether the Disputed Domain Name is also being used in bad faith and it declines to do so.

6. Remedy

Paragraph 4(i) of the Policy prescribes only two remedies that the Panel can order, namely, the cancellation of the Disputed Domain Name or its transfer to the Complainant (provided that the Complainant is otherwise eligible to hold that domain name).

The Complaint requests the transfer of the Disputed Domain Name to the Complainant. However, if the Panel were to accede to that request in the light of its above findings in relation to the first limb of the Policy, it would cause continuing confusion in the minds of Internet users since the Complainant is not connected with the apartment building called The Point at Kirribilli. Accordingly, the Panel proposes instead to order the cancellation of the Disputed Domain Name.

In addition to the warranty as to eligibility to hold the domain name referred to above, clause 2 of the Policy contains three further warranties, namely, that “(b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations”. The Policy goes on to provide that it is the responsibility of the applicant for registration “to determine whether your domain name registration infringes or violates someone else's rights”.

As a result of these proceedings Rare, Belle Property and Sandoval Investments Pty Ltd are all aware of the Complainant's registered trade mark if they were not previously, and

are aware of the rights asserted by the Complainant in relation to that mark. They are therefore aware that the inclusion of “thepoint” in a domain name pointing to a website that is concerned with any of the services in respect of which THE POINT is registered as a trade mark will probably infringe the Complainant’s trade mark. They are also aware that it is probable that promoting The Point at Kirribilli runs the risk of misleading consumers into believing that the building being referred to is the Complainant’s building at Milson’s Point.

In the circumstances it seems to the Panel that none of those entities, nor the Complainant, could in good faith give the warranty required to be given by clause 2(d) of the Policy if they were to seek to re-register the Disputed Domain Name following its cancellation. The Panel otherwise expresses no view on the consequences of there being two apartment buildings in close proximity called “The Point”.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <thepointkirribilli.com.au> be cancelled. The Panel directs IAMA to furnish a copy of this decision to the solicitors for each of Rare and Sandoval Investments Pty Ltd and to use its best efforts to bring the decision to the attention of Belle Property Australasia.



Philip N. Argy
Sole Panellist

Dated: 12 October, 2012