

## ADMINISTRATIVE PANEL DECISION

### IAMA Case No. 3665

**Disputed Domain Name:** [privaterealestate.com.au](http://privaterealestate.com.au)  
**Name of Complainant:** Private Real Estate Pty Limited [ACN 154 253 924]  
**Name of Respondent:** Chris Papas  
**Provider:** The Institute of Arbitrators & Mediators Australia [IAMA]  
**Panel:** Philip N. Argy

#### 1. THE PARTIES

1.1 The Complainant, **Private Real Estate Pty Limited**, is represented by Ms Lisa Frances of Abbott Solutions, Mt Lawley, Western Australia.

1.2 The Respondent, Chris Papas, trading as **Australian Private Real Estate**, of Victoria, is self-represented.

2 **THE REGISTRAR** The Registrar is **Melbourne IT** of Melbourne, Victoria, Australia.

#### 2. PROCEDURAL HISTORY

The Complaint was filed with IAMA on 26 November 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 IAMA Supplemental Rules for .au Dispute Resolution Policy (“Supplemental Rules”).

Pursuant to paragraph 3(b)(xii) of the Rules, the Complaint recites that it was not served on the Respondent before filing. 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. IAMA used the WhoIs contact email address to notify the Respondent of the Complaint on 3 December 2012, thus starting the 20 day period within which a Response had to be filed. The Panel has no evidence of whether that email was delivered or read.

In default of any Response being received from the Respondent, IAMA proceeded on 20 December 2012 to email the Respondent reminding him that a Response was due by

23 December 2012 and that, absent a Response, a panel would be appointed and the matter would proceed to determination. IAMA appointed Philip N Argy as the sole panellist in this matter on 2 January 2013 and the Panel has furnished the appropriate Declaration of Impartiality.

On 15 January 2013, just as the Panel was completing its deliberations, IAMA received a telephone call from the Respondent claiming that he had not received any of the communications from IAMA nor any copy of the Complaint. In the Case Manager's absence on vacation, the CEO of IAMA requested the Panel to exercise discretion under paragraph 10(b) of the Rules to grant the Respondent an extension of time of a further 20 days and undertook to have a copy of the Complaint delivered to him at a street address he specified. At that point it became apparent that the street address that had been provided to IAMA during the Registrar verification was incorrect. Whilst the Panel was sceptical about a request coming at the 11<sup>th</sup> hour, and despite there being no explanation of why the Respondent would not have received emails sent to the email address specified in the WhoIs record for the Disputed Domain Name, the Panel did grant the Respondent an additional 20 days within which to file the Response on the basis that Christmas/New Year is a time when many people are legitimately unable to give attention to business matters and it is very normal practice under both the Policy and the UDRP for requests for an extension of time to be granted at that time of year.

On 5 February 2013, the day before the Response was due, the IAMA Case Manager advised the Panel that the Respondent had called seeking a further extension of time but giving no reasons for the request. The Panel directed IAMA to advise the Respondent that no further extension of time would be granted absent demonstrably exceptional circumstances. On 7 February 2013 the Respondent lodged a substantive Response and this was furnished to the Panel on 8 February. The Panel extended by a commensurate period the time within which this decision had to be rendered.

All other administrative requirements appear to have been satisfied.

## **4. Factual Background**

The following recitation of facts taken from the Complaint and Response appears to be non-contentious.

On or about 18 November 2002 the Respondent registered with the Dept of Fair Trading in Victoria the business name AUSTRALIAN PRIVATE REALESTATE in respect of his online real estate business. That business name registration lapsed on 18 November 2011 following the respondent's failure to renew it. The Disputed Domain Name was also registered on 18 November 2002 and was last renewed on 1 November 2012.

The Complainant was incorporated on 14 November 2011 and it is now the registered proprietor of Australian trademark 1462008 for PRIVATE REAL ESTATE which

includes the device of a house and buildings. That trademark was granted on 9 July 2012 retrospective to the date of application, namely, 9 December 2011.

## 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 now-registered trademark PRIVATE REALESTATE.

In relation to the second element it asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the business name in respect of which it was granted was cancelled on 18 November 2011.

And in relation to the third element it asserts that the Disputed Domain Name was renewed on 1 November 2012 in bad faith because the registration includes a non-existent Australian Business Number. The Complainant also alleges that on 18 September 2012 Ms Frances spoke to the Respondent to enquire whether he was interested in transferring the Disputed Domain Name to her. She alleges that he preferred not to sell but indicated that he had already received a previous offer for \$15,000 and that the Complainant would need to offer more to acquire the Disputed Domain Name.

### *B. Respondent*

The Respondent has explained that he did not receive notice of renewal of the business name in 2011 and that that is the only reason it was not renewed before 18 November 2011. Once he became aware that the business name registration had lapsed he sought to renew it with the Department of Fair Trading but by then the new national business names registration regime had come into force in Australia and he had to ascertain and give effect to the application processes under that new regime. As a consequence, the business name AUSTRALIAN PRIVATE REALESTATE is once again registered in the name of the Respondent but there was a gap between 18 November 2011 and 25 January 2013 during which there was no formal registration in place. Importantly for present purposes the Respondent says he never ceased to use the business name and that there was no loss of continuity of the business he conducted under that name.

In relation to the alleged non-existent Australian Business Number the Respondent points to a practice by which business names registered prior to the commencement of the national register did not require an ABN.

The Respondent also denies the substance of the 18 September 2012 telephone conversation as related by the Complainant.

## 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 made out, the onus being on the Complainant.

### *A. Identical or Confusingly Similar*

In relation to the first element of the Policy it is beyond argument that the Disputed Domain Name is identical to the word elements of the Complainant's PRIVATE REAL ESTATE trademark. On that basis it is easy for the Panel to conclude that it is confusingly similar to that trademark. In any event, the Disputed Domain Name is also confusingly similar to the Complainant's name. It is not relevant under this limb of the Policy that the Disputed Domain Name was first registered long before the Complainant's incorporation and before its trademark application was lodged.

### *B. Rights or Legitimate Interests*

In relation to the second limb of the Policy the Panel has to determine whether the Respondent has any rights or legitimate interests in respect of the Disputed Domain Name. The Respondent claims that, by reason of his business name registration for AUSTRALIAN PRIVATE REALESTATE, he has a legitimate interest in respect of the Disputed Domain Name. Whilst the Complainant could be forgiven for not knowing the reason for the Respondent's failure to renew his business name, having received the Respondent's explanation the Panel is bound to accept it when there is no reason to do otherwise. The Policy does not provide for the sophistication of cross examination of witnesses nor other testing of evidence except to the extent that matters can be discerned from publicly available information or are otherwise apparent on the record provided to the Panel. The public record shows that AUSTRALIAN PRIVATE REALESTATE is a business name the registered proprietor of which is one Chris Papasteriopoulos *aka* Chris Papas. It is current to 17 February 2016 and has been allocated Australian Business Number 54 240 235 505. In the circumstances the Panel has no option but to find that the Respondent's registered business name AUSTRALIAN PRIVATE REALESTATE does ground his claim to having a legitimate interest in respect of the Disputed Domain Name.

In addition to the Policy, 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.

On the basis of the evidence before the Panel the Respondent is eligible to register the Disputed Domain Name based on his current business name registration.

Although the Disputed Domain Name does not resolve to any website and there is nothing before the Panel to indicate whether the Disputed Domain Name is being used as an email domain, the Respondent claims that he is planning to operate his business as soon as finances allow. An eleven year gestation period does strike the Panel as rather an extended timeframe but, as noted above, the Panel's doubts about the Respondent's claims cannot be substituted for plain evidence that he has filed purporting to show substantive preparations to use and actual use of the business name since it was first registered.

As at the date of this decision, which is the time at which the second limb test is applied, the Respondent appears to have a legitimate interest in respect of the Disputed Domain Name. Accordingly, the Panel finds that the Complainant has not made out the second element of the Policy.

### *C. Registered or Subsequently Used in Bad Faith*

Under this limb of the Policy the Complainant's submission is that the Respondent "unlawfully renewed the Disputed Domain Name with a non-existent Australian Business Number". The Panel infers from the recitation of the telephone conversation with the Respondent that the Complainant also relies on paragraph 4(b)(i) of the Policy and presumably argues that the Respondent registered the Disputed Domain Name in order to obtain a price for it in excess of his documented out of pocket costs directly related to the Disputed Domain Name. The nine year currency of the business name AUSTRALIAN PRIVATE REALESTATE by the Respondent up to November 2011 must preclude a finding that the Disputed Domain Name was registered in bad faith. Given that the Complainant was incorporated and its trademark sought long after the Disputed Domain Name was first registered, it is equally impossible for the Panel to find bad faith registration on the part of the Respondent.

However, unlike the UDRP, the third limb of the auDRP permits a complainant to succeed if it can demonstrate to the satisfaction of a panel that a domain name registered in good faith was subsequently used in bad faith. So the question still to be considered is whether at any time subsequent to its initial registration the Disputed Domain Name has been used in bad faith.

Paragraph 2 of the Policy provides for the following representation to be made by each applicant for a domain name in the .au space:

By applying to register a domain name, **or by asking us to maintain or renew a domain name registration**, you hereby represent and warrant to us that (a) 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; [*emphasis added*]

Clearly by force of that provision the Respondent has represented and warranted to Melbourne IT that at the time he sought to renew his registration of the Disputed Domain Name on 1 November 2012 he remained eligible for the Disputed Domain Name based on his use of the business name AUSTRALIAN PRIVATE REALESTATE. Although the evidence shows that there was a gap between 11 November 2011 and 16 February 2013 during which the registration of that business name had lapsed, the Respondent contends that this was an artefact of his failure to receive a renewal notice rather than any cessation of the business. Having regard to the Respondent's request for an extension of time on 15 January 2013, the Panel is concerned that the Respondent waited until 24 January 2013 to apply afresh for his business name but, he having done so, the evidentiary position is clear: the Respondent is presently eligible to hold and renew the Disputed Domain Name as a consequence of his current business name registration for AUSTRALIAN PRIVATE REALESTATE.

Under the auDRP, of course, a finding of bad faith use subsequent to a good faith registration is grounds for finding in a complainant's favour under the third limb of the Policy. This Panel has consistently expressed the view that a knowing breach of the paragraph 2 warranty at time of renewal should be regarded as a bad faith use of a domain name.

The question that remains is whether a technical breach of the warranty given to the Registrar on 1 November 2012 is also sufficient to constitute "use" in bad faith. The Panel has come to the view, consistent with the view taken by panels under the UDRP, that given the Respondent's bona fide belief in the currency of his business name (even if he was mistaken and probably ought to have known that it had expired) a finding that the renewal constituted a bad faith use of the Disputed Domain Name is precluded.

Accordingly, the third limb of the Policy is not made out.

## 6. Decision

For all the foregoing reasons, in accordance with paragraph 15 of the Rules, the Panel orders that the Complaint be dismissed.

The logo for Philip N. Argy, featuring a stylized blue 'P' followed by the name 'Argy' in a blue, cursive-style font.

Philip N. Argy  
Sole Panellist  
Dated: 18 February 2013