



ABN 69 008 651 232

AUSTRALIAN RUGBY UNION LTD & WEEKS

Determination re: www.aru.com.au

1. I received the complaint on 9 September 2005. The respondent did not provide material.
2. There is no material to contradict the statements in the material provided by the complainant in respect of the complainant's registered trade marks "ARU" and the complainant's widespread use of and significant reputation in the name "ARU" in both Australia and overseas.
3. The complainant's material demonstrates that "ARU" is a registered trade mark in categories of commerce closely associated with the playing and promotion of the sport, rugby union, which is, and has for a considerable period of time (exceeding 50 years) been, organised, promoted and administered in Australia by the complainant. By registration of those marks the complainant has the exclusive right of use in Australia of "ARU" in selling or otherwise dealing in items in the commercial classes of registration.
4. The complainant's material indicates that "ARU" is a phrase, label, name, acronym or word which is closely identified in Australia and overseas with media commentary on the complainant and its organisation, promotion and administration of the sport for which the complainant is responsible.

5. The material provided by the complainant is in itself, and even more so in the absence of any challenge, sufficiently probative of the matters alleged concerning the association of the complainant with the configuration “ARU” in commercial and non-commercial usage of that term. It would be difficult to conclude otherwise than that (at least in Australia and probably in many countries overseas where rugby union is a strong sport), when one sees “ARU” in the media, or on clothing, sporting equipment, merchandise or services, or in marketing or educational material, one thinks of the complainant as the source of or otherwise responsible for the product or material.
6. In those circumstances the fact that the complainant has not itself sought to register the questioned domain name, and has registered other domain names using the word “rugby” or a name associated with the national rugby union team, does not diminish the connection or association of the complainant with “ARU” in commercial and non-commercial usages.
7. I find that the complainant has rights in “ARU” as a name and as a mark.
8. I have throughout this determination used “ARU” in capitals, and that is the form in which the configuration is a registered mark of the complainant and in which the complainant has demonstrated that it has Australian and overseas usage and reputation. I do not limit my reasons or findings to the configuration in the upper case; they apply equally to that configuration in the lower case. There is no material before me to suggest, and intrinsically I find it difficult to accept, that there would not be a clear association in a reasonable person’s mind with the complainant as the source of usage of “ARU” in the lower case, even if only as a misprint or as a coined or stylised usage of “ARU” in the upper case. There is no material before me to suggest that “ARU” in either upper or lower case has any descriptive or ordinary meaning independent of its status as an acronym for the complainant’s corporate name.

9. When used in the lower case “ARU” is identical to the questioned domain name. For the reasons in the preceding paragraph, when “ARU” is used in the upper case then the questioned domain name is confusingly similar to that usage, even before one reaches what I believe to be correct and, if it is correct, is conclusively compelling on the issue: that domain names are not case-sensitive.
10. Further, to the extent that the phrase “identical or confusingly similar” has a meaning as a combined phrase greater than its parts, I find that the foregoing reasoning strongly applies to bring “ARU” in either upper or lower case within that combined phrase.
11. There is no material before me which indicates that the respondent has any registered trade mark in respect of, asserts any common law trade mark in respect of, or apart from the questioned domain name itself asserts any right to use or association with or other intellectual property right in respect of “ARU”. The material is to the contrary.
12. The history of the website in the complainant’s material, which is not contradicted or sought to be qualified or explained by the respondent, exhibits the following features:
 - (A) a mixture of active and passive use, including semi-passive use as a portal to sites associated with the respondent;
 - (B) in relation to active use, material which is derivative from third parties and which, apart from a title page graphic, displays no usage of or association with the configuration “ARU” or any activity legitimately associated with that configuration;
 - (C) a continuity with a previously deregistered domain name owner;

- (D) an offer by that preceding domain name owner to the complainant of a point of contact for sale of the site;
 - (E) disclaimers of association with the complainant and other named persons with a potential interest in “ARU” (such as the Australian Railways Union) which were placed after first complaint to the preceding (and then registered) owner and which, in placement and presentation compared with references to associations with the complainant, are not materially significant.
13. There is a strong inference from the features identified in the preceding paragraph that questioned domain name, despite the formal attempt at disclaimer, would raise in the mind of a reasonable viewer that there was an association of the questioned domain name and its website with the complainant. A reasonable person seeking information about the complainant would be likely to use “ARU” as part of the search inquiry.
14. I have no material before me to enable me to determine if the disclaimer about the content of the Google AdSense banner being beyond the control of the respondent is correct or not apart from the comments on this issue in paragraphs 60 to 63 of the complaint, which is somewhat inconclusive because it appears that Google make the decision on which advertisers appear on the banner based on Google’s assessment of the content of the website . Even assuming the disclaimer to be correct, the features previously identified, together with the activity in relation to revival and alteration of the website and previous history of communication with the preceding owner and the current owner, lead me to the strong conclusion that the respondent has no rights or legitimate interest in respect of the questioned domain name.
15. The same material also leads me to the conclusion that the respondent has registered and subsequently used the questioned domain name in bad faith.

16. I am further reinforced in those conclusions by the material described in paragraphs 50 and 51, the material on financial gain to the respondent in paragraphs 60 to 64 of the complaint and, to a small degree, by the material in paragraphs 54 and 58 of the complaint, but do not need to rely upon that material (and in particular the material in paragraphs 54 and 58) to reach the conclusion which I have reached.
17. I find the complaint made out.
18. As to remedy, in the circumstances where deregistration of the preceding owner led to immediate re-registration with another registrar necessitating this complaint by a person interested in the preceding owner, and in the absence of any undertaking from the respondent not to engage further in such conduct and to procure its associates not to do so, the appropriate remedy to protect the complainant and its association with the questioned domain name is require transfer of the questioned domain name to the ownership of the complainant.

Wentworth Chambers

23 September 2005

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Gregory Burton, SC

Determiner