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A Critical and Comparative Review of auDRP and UDRP Domain Name Decisions

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Domain names are simplified internet addresses which provide a shorthand way to connect to webpages on the internet. The exponential increase in the use of the internet has led to a growing number of disputes relating to the registration and use of domain names. This has also led to the development of legal and quasi-legal rules relating to the management of domain names and domain name disputes. The Uniform Domain Name Dispute Resolution Policy (“UDRP”), which was implemented in 1999, provides the international legal framework for the resolution of domain name disputes concerning generic top-level domains (“gTLDs”), such as “.com”. National authorities provide corresponding policies for the resolution of domain name disputes concerning country code top-level domains (“ccTLDs”), such as “.au”. The relevant national policy governing .au domain name disputes is the .au Dispute Resolution Policy (“auDRP”), which came into force in 2002. Both the auDRP and UDRP have proven to be an effective mechanism for the quicker and cheaper resolution of domain name disputes. While there has been considerable academic discourse on the UDRP, there has been very little commentary written on the auDRP. The aim of this paper is to fill the gap in knowledge on the auDRP by providing a critical and comparative review of key decisions under both the international and Australian domain name policies.

Keywords domain names; auDRP; UDRP; elements under Paragraph 4(a)

Despite the internet’s omnipresence, online content is stored in the physical environment—in computer devices located all over the globe. These devices that are connected to the internet have a unique address, known as the Internet Protocol Address (“IP Address”), which is used to establish connections between them. Typically, IP Addresses take a numeric format (e.g. 203.2.218.214, which is the IP Address for the Australia Broadcasting Corporation’s website at <http://www.abc.net.au/>). Domain names are essentially a human friendly substitute for IP Addresses. Thus, the importance of domain names becomes visibly clear, as it would be extremely difficult for most humans to remember the IP Addresses for every single online location (or website) they wish to locate. When IP Addresses are converted to human friendly alphanumeric strings, such as “abc.net.au”, it becomes easier to remember (Armon, 2003, pp.101–102). However, the translation of IP Addresses to their alphanumeric format (or domain names) has given rise to legal disputes. This is because individuals derive rights and/or legitimate interests in respect of trademarks, as well as personal, corporate and business names, all of which could be represented in the form of domain names taking the same alphanumeric format. In short, the negative consequence of establishing domain names is the rise of cybersquatting (Badgley, 2001, pp.345–346).

In order to resolve domain name disputes, the Internet Corporation for Assigned Names and Numbers (“ICANN”), the international authority established for the administration of the internet, has adopted a dispute resolution policy known as the Uniform Domain Name Dispute Resolution Policy (“UDRP”). The UDRP applies to disputes concerning generic top-level domains (“gTLDs”),¹ and has been adapted in various jurisdictions for the resolution of domain name disputes involving country code

top-level domains (“ccTLDs”). In Australia, the relevant local policy for .au domain name disputes is the .au Dispute Resolution Policy (“auDRP”), which is administered by the .au Domain Administration Ltd (“auDA”) (Bender, 2007). The auDA is the policy and industry regulatory body for .au domain names. Among its functions, auDA accredits and licenses registrars to make domain name registrations, develops and administers policy, and represents .au domain names at ICANN.

Although the auDRP is derived from the UDRP, there are some notable points of divergence, which have consequentially resulted in panels constituted under the auDRP deviating from their UDRP counterparts in their approach to resolving similar disputes. This paper undertakes a critical and comparative analysis of these notable differences in the two policies and the key domain name decisions awarded by panels under the two policies.

To date, any attempt to compare UDRP and auDRP decisions has been limited to the auDRP Overview 1.0,² which is based on the corresponding overview of UDRP decisions formulated by the Arbitration and Mediation Center of the World Intellectual Property Organization (“WIPO”).³ Despite the auDRP Overview 1.0 being a “compendium of consensus views of panels on key legal and procedural issues under the auDRP”, it is arguably not exhaustive. This paper seeks to contribute to the discussion commenced by the auDRP Overview 1.0 by comparing panel decisions under a key provision of both policies: paragraph 4(a). It is under this provision that a complainant is required to establish three distinct elements (which are considered below) in order to be successful in domain name dispute resolution proceedings.

The First Element

There are no limitations to what domain names could comprise. When generic phrases such as “cars” or “computers” are used to form a domain name, such as “cars.com” or “computers.com”, there is unlikely to be any dispute. In contrast, when a domain name closely resembles a registered trademark⁴ (as well as a “name”, in the case of the auDRP), and someone other than the owner of the trademark (or bearer of a name) had registered that domain name, there is a greater likelihood that a dispute might spur. It is for this reason that both the policies incorporate a requirement that a domain name subject to a dispute must be identical or confusingly similar to a trademark (and/or name, in the case of the auDRP) in which the complainant has rights, if the complainant is to succeed.

Thus, in terms of paragraph 4(a)(i) of the UDRP, a domain name registrant must submit to a mandatory administrative proceeding if a complainant establishes *inter alia* that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. This is the first element that any complainant must satisfy. The corresponding provision in the auDRP replicates UDRP’s paragraph 4(a)(i) with a minor, yet significant, change. Under the auDRP, in addition to stating that a registered domain name is identical or confusingly similar to a trademark or service mark, complainants may also assert similarity to a “name” in which they have rights.⁵ The footnote attached to that provision provides the following clarification:

For the purposes of this policy, auDA has determined that a “name ... in which the complainant has rights” refers to: a) the complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority; or b) the complainant’s personal name.

In order to satisfy this element under both the policies, a complainant must establish two things—first, that the complainant has a “right” in respect of a trademark or service mark (or a name in the case of the auDRP) and second, that the domain name concerned is identical or confusingly similar to the trademark, service mark or name, as the case may be.

Establishing a Complainant's "Rights"

Rights in Respect of Registered Trademarks

Under the UDRP,⁶ as well as the auDRP,⁷ a complainant having a registered trademark easily satisfies the first element, although a mere application to register a trademark is not sufficient to confer any "rights" on a claimant.⁸ In the case of the UDRP, a complainant could establish rights in a trademark irrespective of where it is registered.⁹ Whereas, under the auDRP there has been some uncertainty whether rights arising from trademark registrations outside of Australia could satisfy this requirement, as there have been two strands of authority. Some panels have expressly opted for a more restrictive view in holding that only trademark registrations in Australia are capable of establishing rights for the purpose of the first element.¹⁰ Whereas, the more common view has been that even foreign trademark registrations would suffice.¹¹ The consensus view is reflected in the auDRP Overview 1.0—"The auDRP does not restrict a complainant's trademark rights to a trademark registered with the Australian trademark authority".¹² Notably, when this issue arose in *Marshmallow Skins v Piipiinoo*, the panel considered these two lines of authority and expressly decided to take the liberal approach in allowing foreign trademark registrations to supply the necessary rights for the purposes of this element under the auDRP. The panel observed that it "does not seek to insert a nationality requirement in the Policy, which does not exist in the text of the Policy".¹³ Although the panel was concerned that a literal interpretation of the policy would open floodgates allowing "complainant[s] with no connection to Australia to satisfy the first element of the Policy and thereby acquire a ".au" domain name",¹⁴ this concern was negated in view of the following:

- (1) It is unlikely that a complainant would expend legal resources preparing a complaint under the auDRP if it had no connection to, or interest in, Australia.¹⁵
- (2) The lack of a connection to Australia would be an obstacle in satisfying the other elements of the auDRP.¹⁶
- (3) The Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs (2012–04) require some connection to Australia, before a domain name is allowed registration. Thus, "[t]he Domain Name Eligibility and Allocation Policy Rules operate to prevent a complainant who relies solely on a foreign registered trade mark and has with (*sic*) no connection with Australia from taking possession of a domain name in the ".au" space that it is not entitled to, even if it obtained an order for transfer under the Policy".¹⁷

Rights in Respect of Unregistered Trademarks

Rights may also be established with regards to unregistered trademarks where such marks are inherently distinctive,¹⁸ as well as in circumstances where they are less distinctive but have acquired a "secondary meaning".¹⁹ However, there is a notable difference between the UDRP and auDRP in relation to unregistered marks—in that, under the latter, unregistered trademarks used only within Australia are considered for the purposes of establishing a complainant's rights in relation to a trademark.²⁰ The auDRP Overview 1.0 reflects this position: "evidence that [a complainant] has unregistered trademark rights outside of Australia is insufficient".²¹ Thus, in *We Buy Any Car v Highway Auto Mart*, the panel rejected the complaint on the basis that the complainant had never traded in Australia, despite it having established a reputation, and thereby common law trademark rights, in the United Kingdom.²² Taking into account the nature of business to which the domain name related in that dispute, the panel observed that "it seems [...] inherently unlikely that an Australian consumer would sell a motor vehicle in Australia through a United Kingdom based website and business that does not purport to offer services in Australia".²³ Yet, whether such a consideration should be part of the analysis in determining whether the first element of the auDRP is satisfied is questionable. This is so,

because all that is required is to determine whether the claimant has rights in a name or mark, and whether there is identity or confusing similarity. This was precisely the approach in *Marshmallow Skins v Piipiinoo* when the panel in that case allowed the complainant to rely on rights arising out of a foreign trademark registration. Moreover, if the consideration whether a claimant had a connection with Australia, e.g. by trading in Australia, was relevant under auDRP's first element, it is not logical to apply that consideration only in respect of unregistered trademarks. Thus, in terms of the current approach adopted by auDRP panels, if the facts of *We Buy Any Car v Highway Auto Mart* was slightly altered allowing reliance to be placed on a registered trademark in the United Kingdom, instead of a common law trademark, the outcome would have been the exact opposite under the first element. In effect, this approach discriminates between registered and unregistered marks. In fact, it is unfortunate that the panel in *We Buy Any Car v Highway Auto Mart* failed to refer to *PayBurst Financial Technologies v Virgin Blue Airlines*,²⁴ where the claimant's common law trademark rights in the United States was regarded as sufficient for the purposes of the first element.

In contrast, and in view of the global application of the UDRP,²⁵ a complainant may establish rights in an unregistered mark through use in any jurisdiction. However, since trademark rights are strictly territorial in nature,²⁶ whether a complainant enjoys rights in an unregistered mark would depend on whether such a category of rights is recognized in a particular jurisdiction under consideration. This may mean that complaints originating in some civil law countries, where trademark rights are acquired purely through a process of registration, may fail in view of the inability to establish "rights" in respect of an unregistered mark—an obstacle not prevalent in common law countries. UDRP panels have been sensitive to this disparity, seeking to give true meaning to the universality of the policy:

The word "Uniform" in the name of the UDRP is primarily a reference to uniformity across the gTLDs. At a minimum, implicit in the introduction and scope of the UDRP is its global application. The Panel takes the view that the Policy needs to be applied as uniformly as possible across the globe, particularly when dealing with a domain name in one of the gTLDs (which can be obtained and accessed around the world, irrespective of jurisdiction). *Were it otherwise, on an issue such as this complainants from many civil law jurisdictions would in certain scenarios be at a disadvantage when compared to their counterparts from common law jurisdictions and those civil law jurisdictions, such as Germany, which make special statutory provision for unregistered trade mark rights.*²⁷

Thus, for instance, UDRP panels have gone to the extent of recognizing common law "equivalent" rights in unregistered trademarks on the basis that in certain civil law countries, such as France, the remedy of unfair competition provides the equivalent common law remedy for passing off—thereby implicitly vesting a "right" to an unregistered mark.²⁸ The WIPO Overview 2.0 summarizes the position in the following terms: "For a number of reasons, including the nature of the Internet, the availability of trademark-like protection under passing off laws, and considerations of parity, unregistered rights can arise for the purposes of the UDRP even when the complainant is based in a civil law jurisdiction".²⁹

Rights in Respect of a Name

Complainants under the auDRP, in addition to establishing rights in relation to trademarks or service marks, may also seek to establish rights in respect of a "name".³⁰ This possibility allows claims to be brought in respect of a company, business or other legal or trading name registered with an Australian authority or a personal name, even in circumstances where no common law rights subsist³¹—thus, significantly expanding the scope of the auDRP *vis-à-vis* the UDRP.³²

Under the UDRP, although celebrities such as Tom Cruise,³³ Jim Carrey,³⁴ Jay Leno³⁵ and Beyoncé³⁶ were able to establish rights in their personal names, that was on the basis that the name was made use in actual trade attracting common law trademark rights. Whereas, when no evidence established the use of a personal name in connection with the sale of goods or services, UDRP panels have denied complaints on the basis that no rights were established to satisfy the first element.³⁷ In contrast, the wider scope of the auDRP, has allowed auDRP panels to recognize rights not just in relation to conventional names, but also in respect of nicknames, such as “Warnie” attaching to the world famous Australian cricketer, even without evidence that the complainant had engaged in actual trade in goods or services under a particular name.³⁸

Rights in respect of company and business names are dealt with in a similar manner to personal names, although at times rights in respect of a smaller part of a company or business name have also been recognized.³⁹ The possibility of establishing rights in relation to a complainant’s “other legal or trading name” has also resulted in unusual formats—such as phone words or smart numbers—being considered for the purposes of the first element. Thus, in *John Kolenda v 1300 Phonewords Pty Ltd*, a panel found that the complainant had rights in the phone word “1300homeloan”, even though it neither constituted the complainant’s company or business name, nor his personal name.⁴⁰ However, in later decisions, whether a phone word could really constitute a “name” has been doubted,⁴¹ although there is a possibility that phone words may attract registered or common law trademark rights. Thus, the position in relation to phone words or smart numbers is rather uncertain under the auDRP.⁴²

Establishing Identity or Confusing Similarity

Once a complainant establishes rights in respect of a trademark (or name in the case of the auDRP), the panel then must consider the extent to which that trademark (or name) is identical or confusingly similar to the domain name sought to be canceled or transferred through the administrative proceeding. The approach towards this aspect of the first element has been similar under both the UDRP and auDRP.⁴³

All domain names must be prefixed and suffixed by “www.” and the relevant domain (e.g. “.com”, “.com.au” etc), respectively, given the way in which domain names operate within the internet’s technological architecture. However, in assessing similarity, both UDRP and auDRP panels have ignored the technical prefix and suffix attached to a domain name.⁴⁴ The approach to the assessment of similarity was succinctly set out, in the context of the UDRP, in *Advance Magazine Publishers v. MSA*:

Panels have routinely held that the question under paragraph 4(a)(i) of the Policy is simply whether the alphanumeric string comprising the challenged domain name is identical to the Complainant’s mark or sufficiently approximates it, visually or phonetically, so that the domain name on its face is ‘confusingly similar’ to the mark.⁴⁵

Thus, in cases where the name or mark is identical to the disputed domain name (given that a domain name’s prefix and suffix are ignored in the analysis) the assessment should be fairly straightforward and the complainant’s burden of proof should be easily met. In *GlobalCenter v Global Domain Housing*, a panel constituted under the auDRP seeking to apply the stance under the UDRP observed that “[a]s is the case under the UDRP, essential or virtual identity is sufficient for the purposes of the Policy”.⁴⁶ The auDRP panel cited four UDRP decisions in support of this view: *The Stanley Works v Camp Creek*,⁴⁷ *Toyota v S&S Enterprises*,⁴⁸ *Nokia v Nokiagirls.com*⁴⁹ and *Blue Sky Software v Digital Sierra*.⁵⁰

However, surprisingly, except in *Toyota v S&S Enterprises*, the panels in the other three decisions made no reference to either essential or virtual identity. In fact, those cases were decided on the basis that either the complainant’s trademarks and the disputed domain names were a 100% match or confusingly similar (disregarding the relevant prefixes and suffixes of the domain names). It was only in *Toyota v S&S*

Enterprises that the panel concluded that “[e]ach of the domain names itoyota.com and itoyotas.com is virtually identical to the complainant’s registered trade mark TOYOTA”.⁵¹ Notably, the panel only referred to virtual identity and not essential identity in coming to its conclusion, although it did refer to a trademark infringement case where a court in the United States had held that “planned-parenthood.com” was essentially identical (the only addition being a hyphen) to the “Planned Parenthood” trademark.⁵² However, at a later point in the decision the panel observed:

Virtual or essential identity is sufficient for the purposes of paragraph 4(a)(i) of the Policy. The panel finds the complainant has established both sufficient identity and confusing similarity.⁵³

Thus, the UDRP panel’s overall treatment of the concepts of essential and virtual identity on the one hand and confusing similarity on the other hand is far from clear. It is not clear whether virtual identity and essential identity signify different standards of identity or in the alternative, whether they simply mean confusing similarity with a lower threshold of proof. Unfortunately, the WIPO Overview 2.0 does not provide any guidance in this regard.

Nevertheless, in view of *GlobalCenter v Global Domain Housing*, the concept of essential or virtual identity has seeped into the auDRP, although the panel in that instance ultimately held in favor of the complainant only on the basis that the complainant’s name “GLOBALCENTER” was confusingly similar to the disputed domain names “globalcenter.com.au” and “globalcenter.net.au”. *GlobalCenter v Global Domain Housing* is the second oldest auDRP decision and is the very first to introduce the concept of essential or virtual identity. Since then, however, auDRP panels have utilized this concept in subsequent decisions,⁵⁴ although panels have not provided any clarification as to what essential or virtual identity actually means. Panels have also been inconsistent as to when they apply the concept. For instance, although in *Tourism Tasmania v Gordon James Craven* the panel found “DISCOVER TASMANIA” to be essentially identical to “discover-tasmania.com.au” (the only addition being the hyphen),⁵⁵ in *Camper Trailers v Off Road Equipment* the panel found “Camper Trailers WA Pty Ltd” to be virtually identical to “campertrailerswa.com.au” (“Pty Ltd” of the company name being omitted from the domain name).⁵⁶ This may indicate that essential and virtual identity dictates different levels of identity. Yet, in typical typo-squatting disputes where the disputed domain name and the name or trademark in which the complainant established rights were the same apart from a single letter being added, omitted or replaced (e.g. “ARGILETS”/argilitz.com.au), panels have not referred to the concept of essential or virtual identity and have instead gone on to decide the dispute based on confusing similarity.⁵⁷ In contrast, most UDRP panels in corresponding typo-squatting disputes have sought to analyze the facts using the “virtual identity” standard,⁵⁸ although in some instances they have not done so.⁵⁹ Thus, although both UDRP and auDRP panels share the view that complaints alleging typo-squatting would normally satisfy the first element of either policy,⁶⁰ there is uncertainty as to whether the element could be satisfied on the basis of “virtual” or “essential” identity on the one hand, or “confusing similarity” on the other.

What the discussion hitherto illustrates is that to-date, just as under the UDRP, under the auDRP there is uncertainty as to where in the scale between “100% identity” and “confusing similarity” that “essential” or “virtual” identity lies. Any guidance in this regard in the auDRP Overview 1.0 is limited to the following statement: “The test for identity is that there is “essential or virtual identity” between the domain name and the trademark or name in which the complainant has rights”.⁶¹ This uncertainty is however not a cause for concern, because when a trademark or name is essentially or virtually identical to a disputed domain name, the threshold for confusing similarity is easily achieved.⁶²

In contrast to the assessment of essential or virtual identity, the assessment for confusing similarity is more uniform between the UDRP and auDRP policies. The assessment for confusing similarity has been set out by a UDRP panel as follows:

The issue is not whether confusion is likely in the trade mark sense (that is, confusion as to source based on the domain name and its use in connection with a website), but rather, whether the domain name, standing alone, is sufficiently similar to the trade mark to justify moving on to other elements of a claim for cybersquatting.⁶³

This approach to assessing “confusing similarity” has been followed by auDRP panels. For example, in *GlobalCenter v Global Domain Housing*, the panel observed (citing relevant UDRP decisions) that “[l]ikewise, the test of confusing similarity under the Policy is confined to a comparison of the disputed domain name and the name or trademark alone, independent of the other marketing and use factors usually considered in trademark infringement or unfair competition cases”.⁶⁴ Since then, auDRP panels have applied this “confusing similarity” test.⁶⁵ Thus, in making the comparison, whether the name/mark and the disputed domain name are descriptive,⁶⁶ the nature of the goods or services in relation to which the domain name is being used,⁶⁷ or the contents of the website to which the domain name resolves⁶⁸ are all irrelevant considerations. Similarly, where the trademarks in which rights are asserted contain design elements, both UDRP and auDRP panels have tended to ignore the design elements focusing on the textual elements alone.⁶⁹

There is also consistency between the approaches under the two policies in relation to the assessment of confusing similarity between a trademark (or name) and a disputed domain name which copies the trademark (or name) along with an added descriptive, generic or geographic element. The auDRP Overview 1.0 provides that the general position under the auDRP is the same to that of the UDRP,⁷⁰ the general consensus under the latter being that an added element is insufficient to avoid a finding of confusing similarity.⁷¹

In the UDRP’s context, this approach has been adopted by some panels even where the added generic term is of a negative or pejorative nature—e.g. by incorporating the word “sucks” after a famous trademark to form “[trademark]sucks.com”. Thus, in *Air France v MSA*, the panel found “airfrancesucks.com” to be confusingly similar to the “AIR FRANCE” mark:

The present Panel accepts that an ordinary user, familiar with the English language, is unlikely to expect that a domain name comprising the word “suck” or “sucks” appended to a familiar trademark would be operated by the trademark owner. However, that does not mean that the composite domain name can never be “confusingly similar” to the trademark at issue [...]. The Complainant has pointed out that not all users are familiar with English. In this case, the Complainant is a French business. It is conceivable that a user from France or some other country unfamiliar with English might assume that “suck” had a different meaning or was perhaps an acronym for a type of business (like “GmbH”, or “S.A.”, for example) and that others might even perceive the Domain Name as “Air Frances Uck”.⁷²

The finding of the panel in *Airfrance v MSA* is justified, since a majority of Air France customers were not native English speakers and would have found the addition of “sucks” relatively insignificant when it appeared next to the famous “Air France” mark. Yet when a famous trademark is suffixed by “sucks” in circumstances where a significant majority of the complainant’s customers are English speaking, it is reasonable to assume that the outcome would be different. Thus, in *Asda v. Mr Paul Kilgour*, ASDA being a popular supermarket chain in the United Kingdom, the panel concluded, “Internet users will be well aware that a domain name with a “-sucks” suffix does not have the approval of the relevant trade mark owner”.⁷³ However, UDRP panels have not been consistent in this regard. Thus, in *Wal-Mart v Richard MacLeod*, a dispute concerning the famous American supermarket chain “Wal-Mart”, the panel observed that “[n]o reasonable speaker of modern English would find it likely that Wal-Mart would identify itself using wal-martsucks.com”.⁷⁴ Despite coming to that finding, however, the panel concluded as follows:

...the Panel concludes that a domain name is “identical or confusingly similar” to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name. In other words, the issue under the first factor is not whether the domain name causes confusion as to source (a factor more appropriately considered in connection with the legitimacy of interest and bad faith factors), but instead whether the mark and domain name, when directly compared, have confusing similarity.⁷⁵

Thus, the position under the UDRP in relation to “sucks” cases has not been consistent, although a majority of panels have concluded that the addition of “sucks” to the end of a trademark is not sufficient to avoid a finding of confusing similarity.⁷⁶

To-date, a panel constituted under the auDRP has not had the opportunity to determine a “sucks” dispute. On this issue the auDRP Overview 1.0 states that the position is unknown.⁷⁷ Unfortunately, it is going to be difficult to predict a possible outcome of a “sucks” dispute. Although auDRP panels are unanimous in their views that the test for confusing similarity is a side-by-side comparison of the disputed domain name and the trademark or name concerned, confusion in relation to something cannot exist in the abstract. Thus, it is still necessary to address the question: in relation to what are internet users confused? In a 2004 decision, a panel having reiterated the side-by-side test for confusing similarity, observed:

In particular, it is not clear what is contemplated to be “confusing” in circumstances where similar domain names and other names are registered or used by different persons. It could be that the test of “confusing similarity” is to be applied in much the same way as the test of “deceptive similarity” in trade mark infringement cases, where the concept of “deception” contemplates consumers who may be deceived or “caused to wonder” about the source or origin of goods or services.⁷⁸

Some panels have suggested that confusion arises where a domain name is capable of being associated with the complainant. For example, in *Dorset Council v Mr Damian von Samorzewski*, the panel observed:

...so there is a possibility that an ordinary internet user could be confused into associating the disputed domains with the Complainant’s domain, and into believing that there is a real connection between the disputed domains and the Complainant’s activities.⁷⁹

Thus, auDRP panels in determining whether internet users are confused, when they come across a domain name that is similar to a trademark or name, have often considered whether an objective internet user would associate the domain name with the complainant. If this line of reasoning is adopted, it is likely that auDRP panels may differ from the majority UDRP decisions in determining corresponding “sucks” cases under the auDRP. This is because an average Australian internet user would not find that a domain name comprising a trademark and the word “sucks” (or any other equally negative or pejorative term) is in any way associated with the owner of that trademark. Absent such an association, it would be difficult to find confusing similarity.

The Second Element

Even though a complainant satisfies a panel that a third party’s registered domain name is identical or confusingly similar to the complainant’s trademark (or name), that does not necessarily mean that the domain name must be transferred to the complainant. This is because, just as in assessing a third party’s unauthorized use of a trademark in typical trademark infringement suits,⁸⁰ the use of a domain name is context specific.

Thus, in some contexts, the third party registrant of a domain name may have a right or legitimate interest in using that domain name despite its identity or similarity to a trademark or name. Therefore, both the UDRP and auDRP recognize the context specific nature of the use made of domain names by requiring a complainant to establish that the domain name subject to a dispute was registered by a third party who lacks the requisite rights or legitimate interests.⁸¹ This is the second element that a complainant must satisfy.

The Difficulty of Proving a Negative

The complainant bears the burden of proof under both the UDRP and auDRP. This is because under both the policies, it is a requirement that the complainant must prove the existence of each of the three elements upon which a transfer or cancelation of a domain name will be ordered.⁸² In the context of the second element, an early UDRP panel had recognised that this would require a complainant “to prove a negative, a difficult, if not impossible task”.⁸³ Paragraph 4(c) of both policies provides a non-exhaustive list of instances, which if found could demonstrate that a respondent had rights or legitimate interests in respect of a domain name. The language of paragraph 4(c) suggests that it is the respondent that must demonstrate the existence of rights or legitimate interests. In view of this contradiction, early UDRP panels were split in their approach as to the burden of proof under the second limb of paragraph 4(a). While some panels have held that the respondents have no burden whatsoever to establish any rights or legitimate interests, unless a complainant furnishes affirmative proof of the respondent’s lack of such rights or legitimate interests,⁸⁴ some others have held that, although the burden is on the complainant to establish a lack of rights or legitimate interests on the part of the respondent, that burden is a relatively light one.⁸⁵ On the other hand, a few UDRP panels have held that where the respondent had failed to demonstrate that at least one of the instances envisaged by paragraph 4(c) applies—which establishes rights or legitimate interests on the part of a respondent—that “can assist the Panel in deciding whether on consideration of all the evidence a Complainant has discharged the onus of proof”.⁸⁶ Despite this disagreement on the complainant’s burden of proof under the second element, a majority of UDRP panels have held that once a complainant had made out a *prima facie* (or credible) case that the respondent lacks any rights or legitimate interests in the disputed domain name, then the burden shifts to the respondent to refute that position.⁸⁷ The respondent’s rebuttal must be supported by concrete evidence, that is to say “more than mere personal assertions”.⁸⁸ This position is reflected in the WIPO Overview 2.0,⁸⁹ which is also mirrored in the auDRP Overview 1.0.⁹⁰

Panels under the auDRP have consistently followed the approach adopted by the majority of UDRP panels. Although not apparent in the first auDRP decision,⁹¹ from the second decision onwards, panels have in most instances applied the *prima facie* standard of proof in relation to the second element. To illustrate, in *GlobalCenter v Global Domain Housing*, the panel referred to the UDRP decision in *Do The Hustle v Tropic Web* in holding that:

These circumstances are sufficient to constitute a *prima facie* showing by the Complainant of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name.⁹²

This approach has been followed in later decisions,⁹³ although there have been a few instances where panels have deviated from this approach. Thus, for instance, in *Find Marketing v Troy Holland*,⁹⁴ *Private Real Estate v Chris Papas*,⁹⁵ *Dorset Council v Mr Damian von Samorzewski*⁹⁶ and *Andrea Chick v Countrynet Software*,⁹⁷ the panels determined the dispute under the second element without any reference to the complainant’s capacity to establish a *prima facie* case, instead relying on the respondent’s ability to establish rights or legitimate interests in respect of the disputed domain names. However, what was

common in all those instances was that the respondents were represented and had furnished material for the panel to consider in making a determination under the second limb. Thus, it may be posited that the *prima facie* standard in respect of the complainant's case under the second element becomes important in circumstances where the respondent remains legally unrepresented.

Establishing Rights or Legitimate Interests Under Paragraph 4(c)

As outlined above, both the UDRP and auDRP provide a non-exhaustive list of instances, which if established by a respondent, could demonstrate rights or legitimate interests in a domain name. These instances are:

- (1) Use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services, before any notice of the dispute.⁹⁸
- (2) The Respondent (as an individual, business or other organization) being commonly known by the domain name, even if no trademark mark rights have been acquired.
- (3) A legitimate non-commercial or fair use being made of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.⁹⁹

These specific defences (or safe harbors) are considered next.

Bona Fide Use of a Domain Name Before Notice

Although the second and third defences in paragraph 4(c) of both the UDRP and auDRP are identical, the scope of the first defence slightly differs. If a respondent sets up this defence, depending on the applicable policy, a panel must be conscious as to the timing of such *bona fide* use. Thus, while UDRP panels must ensure that the domain name was put to *bona fide* use prior to the respondent being notified of the "dispute", the defence under the auDRP only applies in circumstances where a respondent made *bona fide* use of the domain name prior to being notified of the "subject matter" of the dispute. Although this distinction between the UDRP and auDRP has not been highlighted in the auDRP Overview 1.0, auDRP panels have done so on numerous occasions. The panel in *Global Center v Global Domain Housing*¹⁰⁰ was one of the earliest to recognize this distinction, although it did not specify the consequence of it. However, later panels have sought to do this. Thus, for instance, in *Allianz Australia v Throne Ventures*, citing *Shanahan's Australian Law of Trade Marks and Passing Off* (4th ed, 2008), the panel observed as follows:

In order to rely on this [paragraph 4(c)(i) of the auDRP], the registrant needs to demonstrate its use or preparations to use the domain name prior to being aware of the subject matter of the dispute, rather than simply prior to notice of the dispute itself. This slight variation from the UDRP prevents a registrant from using or preparing to use the domain name after knowing that there may be a dispute but before dispute proceedings are commenced.¹⁰¹

Accordingly, under the auDRP, what becomes relevant is not the date of commencement of proceedings, but the date on which the respondent became aware of a dispute pertaining to the domain name.¹⁰² This means that any evidence of intended use of a disputed domain name for the *bona fide* sale of goods or services that is derived from material prepared *after* the respondent becomes aware of the subject matter of the dispute is irrelevant for the purposes of this defence under the auDRP.¹⁰³

Both UDRP and auDRP panels have considered numerous instances where the question as to whether a respondent's use of a domain name attracted sufficient good faith in order to justify the domain name registration to remain in favor of the respondent. Among them, decisions where panels have had to consider the legitimacy in the use of domain names by those who resell, distribute or repair the complainant's trademarked products are noteworthy and warrant discussion.

A person that resells, distributes or repairs genuine trademarked products should be permitted to use the relevant trademark to describe this activity. This is an accepted exception to trademark rights recognized under trademark law and is necessary to maintain fair competition. By the same logic, when a domain name incorporates a trademark, which resolves to a webpage owned by a person that resells, distributes or repairs the products bearing that trademark, such use ought to be permitted as well.

Under domain name law, this scenario comes squarely within the first defence of *bona fide* use. However, UDRP panels have set out strict criteria before this defence can be used by a domain name registrant (or respondent). In *Oki Data v ASD*¹⁰⁴ the Panel, having referred to previous UDRP decisions, formulated the following criteria that must be met by a respondent in order to establish *bona fide* use of a disputed domain name on the basis that it was an authorized reseller of, and a repair center for, the complainant's products:

- (1) The respondent must as a matter of fact be offering the goods or services at issue.¹⁰⁵
- (2) The respondent must use the website (to which the domain name resolves) to sell *only* the complainant's trademarked goods.¹⁰⁶
- (3) The site must accurately disclose the registrant's relationship with the trademark owner.¹⁰⁷
- (4) The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.¹⁰⁸

Subsequent UDRP panels have followed the criteria set out in *Oki Data v ASD*, often referring to them as the "Oki Data principles",¹⁰⁹ which now represents the criteria in determining whether resellers, distributors and suppliers of repair services qualify for the defence.¹¹⁰ The Oki Data principles have later been extended to circumstances where a respondent had no express or implied authority to use the complainant's trademark or deal with its products, but nevertheless was using the domain name to maintain a website in connection with the resale or repair of the complainant's products.¹¹¹

Following *Oki Data v ASD*, auDRP panels have embraced the Oki Data principles as a means of balancing the competing interests between the parties to domain name disputes. Accordingly, the auDRP Overview 1.0 reflects the position under the auDRP in the following terms: "The more recent decisions of auDRP panels have adopted the principles set out in the UDRP case *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D20010903".¹¹² The rationale for accepting the Oki Data principles in the auDRP's context was succinctly set out by the panel in *Clark Equipment v AllJap*:

The consensus of panelists' views on the fairest way of balancing the competing interests of the parties in such cases has been authoritatively dealt with in the Oki-Data decision, which in turn has been followed many times since.¹¹³

In terms of the scope of the Oki Data principles, it is noteworthy that auDRP panels have extended the applicability of these principles beyond the realm of resellers,¹¹⁴ distributors¹¹⁵ and repair service providers.¹¹⁶ Thus, in *Holden v Publishing Australia*,¹¹⁷ the panel was required to consider whether the principles applied to a respondent that acted "as an agent for car purchasers—that is, the Respondent negotiates with authorized car retailers to secure the sale of a car to the client of its car-buying service".¹¹⁸ It was quite clear that the respondent did not engage in the resale, distribution or repair of the complainant's branded vehicles. Applying the Oki Data principles to the respondent the panel observed:

Although these services are not "reselling" services, they are, in the Panel's opinion, sufficiently analogous to reselling services to make the principles established under the UDRP in respect of paragraph 4(c)(i) applicable to them. That is to say, the use of a domain name by a

buying agent can in certain circumstances be a *bona fide* offering of services under that domain name. Thus, the Panel considers that the Respondent will have demonstrated a legitimate right or interest in the disputed domain name if its use of the disputed domain name complies with the four requirements of *Oki Data* and is otherwise *bona fide*.¹¹⁹

The decision in *Holden v Publishing Australia* was followed in *BMW v Publishing Australia*,¹²⁰ where the Oki Data principles were applied to a buying agent. However, in *Google v. Q Interactive*,¹²¹ the respondent's attempt to argue that the Oki Data principles should apply to an entity that maintained an online store that sold apps compatible (interoperable) with the complainant's Android Operating System ("OS") was rejected. In this case, the respondent had registered the domain name—"androidappsstore.com.au"—which resolved to a website that exclusively sold apps that were compatible with the Android OS. The panel was required to decide whether the respondent's conduct came within the purview of paragraph 4(c)(i) of the auDRP and in particular the Oki Data principles. The panel observed that "[t]he Respondent is neither reselling or distributing goods or services supplied by the Complainant under the ANDROID trademark, nor providing services that are sufficiently analogous thereto". Moreover, the panel sought to distinguish the dispute before it from *Holden v Australia Publishing*. The panel's reasoning for its approach was explained in the following terms:

...the role of the Respondent in this case is not one of reselling or distributing goods or services bearing the Complainant's trademark; *rather, it is one of distributing goods or services (in this case, apps) that are interoperable with other goods or services (in this case, the Android platform) that bear the Complainant's trademark. In this Panel's view, the provision of a second product that interoperates with a first product is a scenario different from the reselling or distribution of a first product, and so the Oki Data principles are not the ones most appropriate to the circumstances of this case.*¹²²

This approach by the panel in *Google v Q Interactive* is not without issues. Holding that the Oki Data criteria did not apply to the respondent on the basis that it did not resell or distribute goods or services bearing the complainant's trademark cannot be justified in view of the third category of entities to which the Oki Data principles have been incessantly applied in the past: that is, to persons involved in repairing or servicing products bearing a complainant's trademark.¹²³ For instance, a panel constituted under the UDRP, commenting specifically on the second Oki Data criteria, observed, "the Panel sees no difference between selling products *or offering repair services for such products as far as this second element is concerned*".¹²⁴ Thus, the Oki Data principles are not restricted to resellers and distributors. Second, the panel's finding that the respondent's services were not sufficiently analogous to "reselling services" is questionable. While it is true that the operations of the respondents in *Holden v Publishing Australia* and *BMW v Publishing Australia* were sufficiently analogous to reselling services, in that they were providing assistance to those interested in purchasing vehicles bearing the complainants' trademarks, the same cannot be said about the provision of repair services. Arguably, if previous panels have applied the Oki Data principles to respondents providing repair services, it is difficult to explain why the said principles should not apply to the respondent in *Google v. Q Interactive*. Nevertheless, this approach is not a cause for concern as the panel in *Google v. Q Interactive* recognized that the "interoperability" scenario will be caught up under the descriptive fair use defence available under paragraph 4(c)(ii) of the policy.

In terms of the substance of the Oki Data principles, auDRP panels have generally followed their UDRP counterparts. In particular, the second (of the four) Oki Data principles—that the website to which the domain name resolves must be used only for the purpose of reselling or otherwise dealing with the complainant's trademarked products—has been applied strictly to the Australian context.¹²⁵ Notably,

panels have held that the second criteria would not be satisfied if the resolving website made any reference to other websites (e.g. through hyperlinks) that offer products that compete with the complainant's trademarked products,¹²⁶ further ensuring that a fair balance is reached between the competing parties. This, however, does not mean that for the second Oki Data criteria to be satisfied a respondent must only engage in the resale of, or otherwise deal with, the complainant's products alone, provided that the particular website to which the disputed domain name resolves is devoted entirely to promote the complainant's products.¹²⁷ Of course, in applying the second Oki Data criteria, a certain degree of restraint has been exercised by auDRP panels:

... it is not necessary that the disputed Domain Name be devoted entirely to the sale of the trade marked goods, provided that the sale of other goods or services is peripheral and provided that those goods or services were not competitive with the trade marked goods.¹²⁸

It should be noted that UDRP panels have supported this approach. For example, when a panel ignored a single hyperlink to another website offering a brand of products that were non-competing with the complainant's trademarked products in holding that the respondent satisfied the second Oki Data criteria, that reasoning was justified on the ground that the website to which the disputed domain name resolved was regarded "as one concerned overwhelmingly with (the complainant's) products".¹²⁹ This permitted the panel to regard the single hyperlink as *de minimis*. However, if the panel was faced with a situation where hyperlinks contained in the website to which a disputed domain name resolved were more than *de minimis*, the outcome may have been different, even if the products promoted in those other websites were non-competing.

Panels constituted under the auDRP have also expressed similar reservations in respect of the third Oki Data criteria:

This Panel is not convinced that the *Oki Data* criteria should be accepted *verbatim* as authoritative under the Policy, especially the requirement that there be disclosure of the registrant's relationship with the trademark owner. Here the active websites to which the domain names led did not falsely suggest that the registrant is the trademark owner nor that the website is the official website of the trademark owner. This Panel does not consider that, under these circumstances, any such disclosure is required in order to establish legitimacy.¹³⁰

Thus, although auDRP panels have fully recognized the need for the Oki Data principles in relation to the auDRP, they have applied them to the Australian context with caution ensuring that their application does not detract in any way from reaching a fair balance between the rights a complainant may have in relation to a trademark or name and the interests of a respondent to utilize a domain name for the *bona fide* offering of goods or services.

The Respondent Being Commonly Known by the Domain Name

The second defence (safe harbor) that a respondent could rely on reflects a common defence that is also made available under trademark law: that is, the own name defence.¹³¹ This allows a domain name to be registered by a person or entity that is commonly known by that domain name.

One of the key issues that this defence gives rise to is as to when a respondent could be regarded as being "commonly known" by the domain name. Thus, in circumstances where a domain name reflected the respondent's real name,¹³² stage name,¹³³ nickname¹³⁴ or corporate name,¹³⁵ UDRP panels have held that the respondent was commonly known by the domain name provided there was sufficient evidence to that effect through the *external* use of that name, prior to registering the disputed domain name.¹³⁶ In the case of a real name, establishing this defence should be straightforward since a real name is probably the name

by which a person is most commonly known. In relation to other types of names, including stage names, nicknames and corporate names, panels have been more cautious in evaluating the evidence in order to “guard against the opportunistic adoption of a name purely for the purpose of establishing rights or interest in a famous mark”.¹³⁷ Thus, in *Royal Bank of Canada v R.B.C. Bank*, the panel was unable to hold that the respondent was commonly known by the domain name, because the corporate name from which the domain name was derived was not put into any form of use after the corporate name was registered.¹³⁸ In *Sting v Urvan* the panel held that the respondent was not commonly known by the name “STING”, as the only use of that name was as a username for an online gaming platform.¹³⁹ The panel observed that the username, in fact, provided anonymity to the online gamer (respondent), rather than other online gamers being able to associate the username with the respondent.¹⁴⁰ These examples demonstrate that UDRP panels have focused on the nature and extent of the use of the respondent’s name in circumstances where the name relied upon is not a real name in order to determine whether it is reasonable to conclude that the respondent is commonly known by that name. Thus, a mere assertion that a respondent is commonly known by a particular name is insufficient to sustain this defence, in the absence of actual evidence of the name being externally used (as opposed to mere internal use).¹⁴¹ The standard of proof required to sustain this defence is a balance of probabilities.¹⁴²

Based on the manner in which this defence is framed, although it may be thought that panels should uphold the defence once respondents establish that they are commonly known by the domain name, there have been circumstances where the defence was denied. Thus, in *Kraft Foods v The Pez Kiosk*, the panel observed “[e]ven assuming that (‘SUGUS’) is indeed the familiar name by which many friends and collectors know [the respondent], it is noteworthy that the way in which ‘SUGUS’ is used most prominently on his website in no way points to this personal connection”.¹⁴³ In essence, the position under the UDRP is that even if the requirements under paragraph 4(c)(ii) of the Policy are met, the defence will fail if the domain name is used in a manner that takes unfair advantage of the reputation of the complainant’s name or trademark.

Unlike under the UDRP, there have been only a very few instances where auDRP panels have had the opportunity to consider the second defence under auDRP’s paragraph 4(c).¹⁴⁴ However, based on the few disputes decided under the auDRP, it may be posited that panels have followed the general approach under the UDRP in this regard. Thus, in the auDRP’s context, for panels to be satisfied that a respondent is commonly known by a disputed domain name, there must be substantial evidence¹⁴⁵ to that effect. Such evidence is to be derived from events or conduct prior to the domain name being registered. Following the approach adopted by UDRP panels, the panel in *Bernard v Bubenicek* observed that:

The common meaning of “rights or legitimate interests” does not, in the Panel’s view, admit a circumstance where a respondent becomes commonly known by a disputed domain name that it has registered with an intent to appropriate another’s trademark.¹⁴⁶

Ideally, evidence derived from “advertising, media recognition, or the extent of... sales under (a particular) name” may be capable of demonstrating that a respondent was commonly known by the name.¹⁴⁷ Such advertisements and media campaigns must, however, bear the name a respondent seeks to rely on—e.g. the sale and distribution of “Lullaby Concepts Baby Monitors” would not allow a respondent to claim that it was commonly known by the name “Lullaby Conceptions”, especially when the complainant’s name was “Lullaby Conceptions Pty Ltd”.¹⁴⁸ Thus, auDRP panels have often denied the defence where the name by which a respondent claims to be commonly known does not correspond with the disputed domain name. The decision in *Constable Care v The Big Bamboo*¹⁴⁹ is an apposite example. Here, the disputed domain name was “constablecare.com.au”. Although the respondent’s corporate name was not reflected in the domain name, it was in evidence that the respondent was the

proprietor of the registered business name “Constable Care’s Safety Books”. There was sufficient evidence that the respondent was commonly known by its business name “Constable Care’s Safety Books”. Thus, the panel had to decide whether the defence under paragraph 4(c)(ii) applied to the respondent. In this regard, the panel cited three UDRP decisions,¹⁵⁰ of which it preferred to adopt the approach in *John Hayes v Vaughan Enterprises* and *Kronopol v Lamwood*, where the UDRP panels had placed emphasis on the distinctive elements common to both the domain name and the name claimed to be commonly used to identify the respondent.

In addition, auDRP panels have also considered information in the WHOIS database (that establishes the registrant’s details of a given domain name) to determine whether or not the paragraph 4(c)(ii) defence could be sustained. Following their UDRP counterparts,¹⁵¹ auDRP panels have utilized WHOIS information to deny the defence to respondents. Thus, in *ALDI Stores v Peter Gerard Colless*,¹⁵² the disputed domain name was “aldionline.com.au”, whereas the WHOIS information indicated that the registrant was one Peter Gerard Colless. In the absence of any other evidence, the panel was satisfied that there was nothing to support the finding that the respondent might be commonly known by the disputed domain name.¹⁵³

At times, respondents have argued that they are commonly known by the abbreviation or acronym of a longer name. The approach adopted by auDRP panels in handling such claims has been consistent with the approach of their UDRP counterparts. Thus, in *The Institute of Arbitrators & Mediators Australia (IAMA) v Adjudicate Today Pty Limited*,¹⁵⁴ an auDRP panel left open the possibility for a respondent to be commonly known by an acronym provided there was substantial evidence to that effect. In this case, the disputed domain name was “iama.com.au” and the respondent argued that it was commonly known as “IAMA” the abbreviated form of its business registration. The panel denied the defence on the lack of sufficient evidence:

Apart from the appearance of the business name registered in New South Wales, “Investigation, Adjudication, Mediation Australia”, as a headline on the website to which the disputed domain name has resolved since June this year, none of the extracts from the websites put in evidence by the Respondent appear to make any use of either of the registered business names on which the Respondent relies or of the acronym IAMA¹⁵⁵

However, the auDRP panel in *MGM Home Entertainment and others v McIlroy Group Management Pty Ltd* decided in favor of the respondent on the basis that they had a legitimate interest in using the disputed domain name “mgm.com.au” as it was the abbreviation of its corporate name ‘McIlroy Group Management Pty Ltd’.¹⁵⁶ The panel came to this conclusion despite the respondent not filing a response, failing to use the disputed domain name in relation to any online content, and also requesting the domain name could be transferred for a fee of AUD 100,000. However, in view of subsequent auDRP decisions,¹⁵⁷ the approach in *MGM v McIlroy* cannot be taken to represent the correct view under paragraph 4(c)(ii) of the auDRP.

Legitimate Non-Commercial or Fair Use of the Domain Name

The third defence incorporated in to paragraph 4(c) of both the policies seeks to recognize “the importance of non-commercial considerations, in that it is aimed at balancing trade mark rights against other non-commercial rights and interests, including ‘fair use’ rights and rights to (or interests in) freedom of expression”.¹⁵⁸ In this regard, some of the most common, yet controversial, disputes that both UDRP and auDRP panels have had to deal with have involved criticism, information and fan websites.

In the context of the UDRP, a key question that panels have had to address is whether the use of a domain name that is identical or confusingly similar to a complainant’s trademark for the purpose of maintaining a criticism, information or fan website could be regarded as legitimate non-commercial or fair

use. UDRP panels have been divided in their approach. Thus, some panels have taken the view that free speech rights, including the right to criticize, does not extend to cases where the domain name directing users to the relevant content are identical or confusingly similar to a trademark.¹⁵⁹ In one UDRP decision the panel observed:

The Panel acknowledges that a person is entitled to express his views in a wide variety of different ways and to various audiences. . . Furthermore, the Panel acknowledges that a person may make use of a domain name for this purpose, provided that. . . *the domain name in question does not cause confusion or mislead the public.*¹⁶⁰

On the other hand, some other panels have taken a more liberal approach. Thus, in *Bridgestone v Myers*,¹⁶¹ the panel held that a respondent was making legitimate use of “bridgestone-firestone.net” for a criticism site in circumstances where the complainant had trademark rights for both “Bridgestone” and “Firestone”. The panel observed:

In this case, the Respondent’s principal purpose in using the domain name appears not to be for commercial gain, but rather to exercise his First Amendment right to criticize the Complainants. The use of the <trademark.net> domain name appears to be for the communicative purpose of identifying the companies, which are the subject of his complaints. He is not misleadingly diverting users to his website, as he has not utilized the <.com> domain and has posted adequate disclaimers as to the source of the website. It does not appear that his actions are intended to tarnish, or have tarnished, the Complainants’ marks.¹⁶²

Thus, where the domain name comprises a trademark in its entirety, the fact that the landing page is devoted to criticizing or providing information to consumers about the trademark at issue should suffice for the defence to be allowed. This approach has been followed in subsequent decisions.¹⁶³ The decision in *HJTA v McCauley* is important in this regard as it sought to draw a distinction between disputes where parties (or the panelists) were based in the United States, where free speech rights have greater protection, and disputes where parties (or panelists) were based in other countries guaranteeing a lesser extent of free speech rights.¹⁶⁴ Referring to prior UDRP decisions, the panel observed that “[i]ndeed, many of the cases in which trademark.TLD domain names have been transferred, despite claims that the sites were being used for legitimate criticism, involved non-US parties or panelists”.¹⁶⁵ The panel further observed that “[i]n cases involving US parties and/or panelists, on the other hand, a number of panels have ruled that the First Amendment does protect trademark.TLD domain names when they are used for legitimate criticism sites”.¹⁶⁶ This panel, analyzing the decisions where panels have transferred domain names to complainants (despite being used for criticism websites) even where the parties were based in the United States, observed that in these disputes “criticism was not the respondent’s primary motive”.¹⁶⁷ In summarizing the panel’s view as to what ought to be the position under the UDRP, the panel held:

the weight of authority suggests that a consensus is emerging that trademark. TLD domain names, when used for U.S.-based criticism sites, can constitute a legitimate interest, especially if there are [no] other indicia of bad faith.¹⁶⁸

Unlike in the case of the UDRP, there have been much fewer auDRP disputes in which respondents have made the argument that the disputed domain name was being used for a legitimate non-commercial purpose divorced from any commercial activity.¹⁶⁹ Yet, of these disputes, not one was decided in favor of a respondent on the basis that the domain name was being used for a legitimate non-commercial purpose. The auDRP Overview 1.0 states that the position under the auDRP is “unknown” and that:

Thus, it is not clear whether — and, if so, in what circumstances — a respondent will be found to have rights or legitimate interests in a domain name by virtue of a noncommercial or fair use of it.¹⁷⁰

The auDRP Overview 1.0 expresses similar sentiments in respect of criticism and fan websites as well.¹⁷¹ Therefore, it is difficult to determine as to which of the two UDRP approaches that auDRP panels are likely to follow in determining whether the use of a domain name in respect of a criticism, information or fan site amounts to legitimate non-commercial use. In *Google v Rytsk*, the panel acknowledged the divergence in the opinion expressed by UDRP panels in relation to this defence, although ultimately the panel did not have to decide the dispute on the basis of this defence.¹⁷² However, the panel shed some light as to what may be regarded as important in the Australian context in the following terms:

What is fundamental, however, to all such considerations is whether the Respondent is conducting a criticism site as a matter of fact. In other words, if a respondent wishes to rely on the criticism site and free speech grounds, he must prove on the balance of probabilities that on the facts of the individual case it really is a criticism site that is being conducted and also that it is being conducted in the pursuit of free speech and not as a guise for an essentially commercial or other improper purpose.¹⁷³

In *Google v Rytsk*,¹⁷⁴ the disputed domain name was “googlebay.com.au”, an instance where the complainant’s trademark was incorporated as part of the domain name. What if the respondent’s site was a genuine criticism site? Upon considering the panel’s language in this decision: “It is here that the Respondent’s case falls down. That is so because the Panel is not satisfied that the Respondent has established a genuine criticism site”, one might speculate that the panel may have decided in favor of the respondent had the site genuinely resolved to a criticism site. This raises the further question: what if the disputed domain name was “google.com.au”,¹⁷⁵ thus leading to <Trademark>.<Tld>?

Since UDRP panels themselves have drawn the distinction between disputes involving parties in the United States and others,¹⁷⁶ it might be reasonable to posit that auDRP panels are likely to adopt the narrower approach, where free speech rights do not extend to the use of a domain name that is identical or confusingly similar to a trademark or name. After all, the Australian Constitution does not expressly guarantee any free speech rights, unlike the First Amendment to the Constitution of the United States, although the High Court has inferred its existence in a limited capacity.¹⁷⁷ However, a perusal of the decisions thus far does not confirm this supposition with accuracy.

To illustrate, in *UEIP v Fincar*,¹⁷⁸ the disputed domain name was “unitedenergy.com.au”, whereas the complainant had rights in the “United Energy” trademark. Thus, the domain name fully incorporated a trademark. In relation to the respondent’s defence under paragraph 4(c)(iii) of the auDRP, the panel observed: “The website of the domain name, as it currently stands, offers extensive information with respect to energy related issues. It also provides links to other energy related sites. *If that were all that the website showed there may have been a showing of legitimate non-commercial or fair use of the domain name*”.¹⁷⁹ Thus, had the respondent not linked the website to other commercial sites, the paragraph 4(c)(iii) defence may have succeeded, despite the domain name being identical to the complainant’s mark. Similarly, in *SKYCITY v Trellian*, had the respondent actually filed a response, the panel would have dismissed the complaint because:

With even a very modest amount of effort the Respondent could have made out a legitimate interest in respect of the Disputed Domain Name by arguing in support of its right to operate a site warning of the dangers of gambling addiction and providing assistance to those adversely affected by an inability to control their gambling habits.¹⁸⁰

Notably, the complainant's business name in which it had rights and the disputed domain name were identical—"Adelaide Casino/adelaidecasino.com.au".

There are instances where panels have taken a different view. For example, in *DEST v Blogger*,¹⁸¹ the domain name "questacon.com.au", and "QUESTACON" being the name of an educational institute under the complainant, the respondent argued that the site to which the domain name resolved was *entirely* about Questacon, which made use of the domain name legitimate. However, the panel held: "Internet users familiar with the name Questacon would expect the disputed domain name to lead to a website operated by the complainant".¹⁸² Despite the respondent's site being a non-commercial information website, the panel denied the defence under paragraph 4(c)(iii) to the respondent.

Thus, it is unclear what approach auDRP panels will adopt in respect of a criticism, information or fan website that makes a non-commercial legitimate fair use of a domain name that is identical or confusingly similar to a name or trademark in which a complainant has rights. It seems that auDRP panels are as divided in their views as their UDRP counterparts.

The Third Element

Even though a complainant succeeds in establishing that a domain name, which is identical or confusingly similar to a trademark (or name in the auDRP's context), is being used by a third party having no rights or legitimate interests to do so, a complaint would only ultimately succeed if one final element were established. That is, the complainant must establish that the respondent also acted in bad faith—as required by paragraph 4(a)(iii) of both the UDRP and the auDRP.

Paragraph 4(b) of both policies provide a non-exhaustive list of circumstances,¹⁸³ which if found to exist is evidence of bad faith. The UDRP sets out these circumstances in the following terms:

- (1) Circumstances indicating that a domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration.
- (2) Registration of a domain name in order to prevent the owner of a trademark or service mark from reflecting that mark in a corresponding domain name, provided that the respondent had engaged in a pattern of such conduct.
- (3) The domain name was registered primarily for the purpose of disrupting the business of a competitor.
- (4) The use of the domain name, intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of your web site or location or of a product or service on your web site or location.¹⁸⁴

In contrast, the auDRP's corresponding provision is much broader. Accordingly, the circumstances indicating bad faith under the auDRP are as follows:

- (1) Circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting or otherwise transferring the domain name registration to another person for valuable consideration.
- (2) Registration of a domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name.
- (3) The domain name was registered primarily for the purpose of disrupting the business or activities of another person.

- (4) The use of the domain name intentionally attempted to attract, for commercial gain, Internet users to a web site or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation or endorsement of that web site or location or of a product or service on that web site or location.

Dealing with the scope of the auDRP, the panel in *Statoil v Creative Domain* observed:

...there are some significant differences between paragraphs 4(b) of the two Policies, with the auDRP being somewhat less restrictive in relation to sub-paragraphs 4(b)(i) (may be sale, etc to "another person" rather than just to the Complainant), 4(b)(ii) (no need to show a "pattern of such conduct") and 4(b)(iv) ("a website..." rather than "your [the Respondent's] website...").¹⁸⁵

In addition, although not mentioned by the panel in *Statoil v Creative Domain*, paragraph 4(b)(iii) of the auDRP is also broader as it has replaced the term "competitor" in the UDRP with "another person". Thus, paragraph 4(b) of the auDRP is more favorable to complainants than its UDRP counterpart.

However, upon an analysis of the various circumstances set out in paragraph 4(b) of both the policies, it may be reasonable to suggest that establishing bad faith on the part of a respondent is a superfluous exercise in circumstances where the complainant has demonstrated a lack of rights or legitimate interests on the part of the respondent in using the disputed domain name—for a lack of, at least, a legitimate interest should be sufficient to dispel good faith on the part of a respondent. However, upon a closer consideration of the manner in which the "bad faith" element has been framed and worded under paragraph 4(a)(iii) in the respective policies, it is not surprising that auDRP panels have diverged significantly from their UDRP counterparts in their analysis of the relationship between the "right and legitimate interests" and "bad faith" elements under the respective policies.

The "and"/"or" Issue

The third element as framed under the UDRP requires a complainant to establish that the disputed domain name "has been registered *and* is being used in bad faith".¹⁸⁶ Thus, the bad faith element in the UDRP imposes a conjunctive requirement. In contrast, under the auDRP the "and" has been replaced with "or"—thus, requiring a complainant to establish either bad faith registration of a domain name by the respondent or its bad faith use, but not both.

The conjunctive language incorporated into the UDRP's bad faith element resulted (and still does) in some problematic outcomes. For instance, when UDRP panels were initially faced with disputes involving domain names that were registered in bad faith, but were being passively held (i.e. without being used in relation to any active website), panels have had to overcome the difficulty imposed by the conjunctive requirement through innovative interpretation. Thus, in *Telstra Corporation v Nuclear Marshmallows*, in circumstances where the disputed domain name neither resolved to, nor was publicly advertized in relation to, any website or online location and where there was no evidence that the respondent had offered to transfer the domain name for valuable consideration, the panel observed:

The significance of the distinction is that the concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith.¹⁸⁷

Similarly, in *WWF v Bosman*,¹⁸⁸ even though the disputed domain name did not resolve to any active website, the respondent's post-registration conduct in offering to sell the domain name to the complainant

was regarded as sufficient to establish both bad faith registration and use for the purposes of UDRP's paragraph 4(a)(iii). The general position in respect of non-use is reflected in the WIPO Overview 2.0:

...panels have found that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.¹⁸⁹

If not for this expansive interpretation by UDRP panels, circumstances in which a respondent registered a domain name in bad faith, but made no use of it in relation to any online content, could have resulted in disputes being decided in favor of the respondent, despite the respondent's obvious bad faith.

In contrast, auDRP panels have avoided this problematic outcome in view of the disjunctive language found in the policy's paragraph 4(a)(iii). Thus, non-use of a domain name (passive holding) is immaterial if the domain name was registered in bad faith, as "the auDRP does not require a complainant to prove both that the disputed domain name has been registered and used in bad faith. Proof of either limb is enough to satisfy the requirements of Schedule A, paragraph 4(a)(iii)".¹⁹⁰ Nevertheless, auDRP panels have followed the approach adopted by their UDRP counterparts in holding that circumstances where the respondent offers to sell the domain name for valuable consideration is sufficient to indicate bad faith use.¹⁹¹

However, where the real problem lies is not with "non-use" situations, but rather with "subsequent" bad faith use situations. In view of the conjunctive language in the UDRP, there have been a significant number of instances where panels have had to deny complaints despite there being very clear evidence of bad faith use of the disputed domain names at the time the complaints were lodged. Thus, in *Telaxis Communications Corp v William E. Minkle*¹⁹² the respondent registered the disputed domain name at a time when the complainant had not obtained trademark rights in the phrase comprising the domain name. However, notwithstanding the acquisition of trademark rights on the part of the complainant, the respondent refused to transfer the domain name to the complainant despite several requests and instead directed the domain name to competing and pornographic sites. Clearly, the use to which the respondent put the domain name was in bad faith. Yet, the panel denied the complaint on the basis that the original registration of the domain name was not in bad faith and hence the conjunctive requirement resulted in the complaint being denied. Similarly, in *Miele v AACP*¹⁹³ the disputed domain name was registered when the respondent was an authorized distributor of the complainant's goods. Later, even after the distributorship agreement was revoked, the respondent having refused to transfer the domain name to the complainant, directed the domain name to the website of a non-profit organization. Despite evidence of bad faith use of the domain name, the panel denied the complaint as the original registration of the domain name was not in bad faith. The more recent decision of *Cosmetic Research Group v John Miller*,¹⁹⁴ which shared a factual similarity with *Miele v AACP*, was decided in the exact same manner. Similarly, in *Leipa Pack v Ulrich Brunhuber*¹⁹⁵ the domain name was registered with the complainant's consent when the respondent was a shareholder of the complainant company. Despite the *status quo* subsequently changing, the panel denied the complaint on the basis of the conjunctive language in UDRP's paragraph 4(a)(iii).

What the above decisions demonstrate is that despite there being clear evidence of bad faith use *at the time* a complaint being filed, if the domain name was originally registered in good faith, the complaint would be denied notwithstanding the obvious hardships caused to the complainant.¹⁹⁶ This is a direct consequence of the conjunctive language used in the UDRP.¹⁹⁷

Since the auDRP utilizes disjunctive language in its corresponding bad faith provision, the problematic outcome surrounding cases of "subsequent" bad faith use prevailing under the UDRP does not persist under the auDRP. The general position under the auDRP has been summarized in the auDRP Overview 1.0 in the following terms:

In any event, paragraph 4(a)(iii) of the auDRP requires that the domain name has been registered or subsequently used in bad faith for the third requirement to be satisfied. Unlike the equivalent provision in the UDRP, the word “and” is not used; thus, the issue of whether a complainant must establish both bad faith registration and bad faith use does not arise. As a result, registration – even one that is demonstrably in good faith – of the domain name prior to the complainant acquiring rights in its mark or name will not protect a respondent from a finding that the third requirement is satisfied where it is established that the respondent subsequently used the domain name in bad faith.¹⁹⁸

In *Sterling Marine v The Trustee of the Costa Family Trust*,¹⁹⁹ which had similar facts to the UDRP decisions *Miele v AACP* and *Leipa Pack v Ulrich Brunhuber*, the panel decided in favor of the complainant, although the initial registration of the disputed domain name was not in bad faith. A similar outcome was reached in *Cobb International v Cobb Australia*, in which case although the respondent was permitted to register and use a domain name bearing the complainant’s trademark and business name during the existence of a distributorship agreement, this entitlement ceased when the distributorship agreement was terminated. In these circumstances, the panel observed in relation to the registration of the domain name:

It is plain that the disputed domain name was registered and was being used in connection with the Distribution Agreement with the Complainant’s knowledge and consent. The registration of the disputed domain name, therefore, was not in bad faith.²⁰⁰

The panel then considered the situation after the distributorship was terminated:

The Panel considers that this passive retention of the disputed domain name to assist in negotiating a resolution of the commercial dispute between the parties qualifies in the totality of the circumstances as use in bad faith under the Policy.²⁰¹

Thus, what these decisions demonstrate is that unlike in the case of the UDRP, in circumstances where only subsequent bad faith use of a domain name is claimed, a complaint would succeed irrespective of whether the respondent registered the domain name in good faith.

The Relationship Between the “Bad Faith” and “Rights or Legitimate Interests” Elements

The conjunctive language in the UDRP’s bad faith element, and the disjunctive language in the auDRP’s corresponding provision, has impacted the relationship between the bad faith element and the rights and legitimate interests element in the respective policies. Neither the WIPO nor the auDRP Overviews consider this issue.

Both policies require that the complainant must establish all three elements in paragraph 4(a). The failure to establish even one element would result in the complaint being denied. Thus, in instances where a complainant fails to establish a lack of rights or legitimate interests to the domain name on the part of the respondent, panels have often denied the complaint on that basis alone, there being no necessity to consult the bad faith element under the policy.²⁰² In any case, where a respondent does have a legitimate interest in using a disputed domain name, it is unlikely that the domain name is being used in bad faith.

In circumstances where a complainant succeeds under the rights and legitimate interests element, the bearing that finding has on the panel’s finding under the bad faith limb depends on the policy applicable to the dispute. To illustrate this point, two similar disputes under both the policies may be compared: that is *Miele v AACP* (a dispute under the UDRP) and *Cobb International v Cobb Australia* (under the auDRP). In *Miele v AACP*, the panel denied the complaint on the basis that the initial registration of the disputed

domain name was not in bad faith.²⁰³ However, in respect of the rights and legitimate interests element, the panel observed:

The Panel finds that, as an authorized dealer of Miele vacuum cleaners, the Respondent initially had a legitimate interest in the domain name. The Panel notes that the Complainant has not alleged that the Respondent violated a dealership contract or agreement between them that limited the Respondent's ability to use the MIELE mark. In the absence of a dealership contract or agreement between the parties that limited the Respondent's interest in using the MIELE mark to bring attention to his authorized business selling Miele products, the Panel finds that the Respondent initially had a legitimate interest in the domain name.

However, to the extent Respondent had such an interest, it was an interest derived from his dealership relationship with Complainant. Once the Respondent lost its status as an authorized dealer, the derivation of its interest terminated and it lost that legitimate interest in the domain name.²⁰⁴

Thus, although *at the time of the dispute* the respondent clearly had no legitimate interests, let alone any rights, in using the domain name, the complaint was denied on the basis that the domain name was registered in good faith. In effect, a finding of a lack of rights or legitimate interests on the part of the respondent at the time of the dispute had no bearing whatsoever on the finding under the bad faith element and therefore the outcome of the decision.

On the other hand, in *Cobb International v Cobb Australia*, although the auDRP panel found that the domain name was initially registered in good faith, it found that there was subsequent bad faith use. In these circumstances, the panel observed the following with respect to rights and legitimate interests:

While Halcyon would appear to have been using the disputed domain name legitimately when the Distribution Agreement was on foot, it now says it has sold off all remaining stock on hand so, at present, it would not appear to have any rights or legitimate interests in the disputed domain name.²⁰⁵

Thus, a finding that a respondent had no rights or legitimate interests in using the domain name *at the time of the complaint was filed* would also lead to a finding that the domain name was being used in bad faith. Since, unlike in the case of the UDRP, the auDRP's bad faith element does not entail a conjunctive requirement, it may be posited that there is a distinct relationship between the bad faith and rights and legitimate interests elements of the auDRP. In that, in every case where a complainant had succeeded under the rights and legitimate interests element of the auDRP, the complainant would have also succeeded under the bad faith element.²⁰⁶ However, as illustrated above, this is not the same situation under the UDRP.

Conclusion

The key objective of this paper was to perform a comparative and critical analysis of the key UDRP and auDRP decisions that have been considered over the period of time since the two dispute resolution policies came into existence. Although the auDRP has been derived from the UDRP, incorporating similar principles, there are some notable instances of divergence. While the divergence in the approaches of auDRP panels from their UDRP counterparts may be primarily attributed to the difference in the phraseology adopted under the two policies, there are also instances where panels have diverged despite identical language being used.

First, the paper considered paragraph 4(a)(i) of both policies, which in the case of the UDRP requires a complainant to satisfy that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. The auDRP has broadened the scope for complainants by also allowing complainants to satisfy rights in respect of a name, in addition to a trademark or service mark. Decisions under the auDRP have given effect to this distinction. It was also noted that complainants under either policy may establish rights in registered trademarks irrespective of where they are registered. Despite the auDRP being applicable exclusively to Australian domain names (e.g. .com.au and .net.au), a majority of auDRP panels have allowed foreign trademark registrations to satisfy this criteria. However, in respect of unregistered trademarks, although UDRP panels have allowed complainants to set up rights through use of trademarks in any jurisdiction, auDRP panels have generally insisted that rights must emanate from within Australia. In effect, auDRP panels seem to discriminate between registered and unregistered marks. In respect of the establishment of identical or confusing similarity, it was noted that auDRP panels have tended to follow their UDRP counterparts, which has resulted in some of the uncertainties under the UDRP seeping into auDRP decisions.

Second, the paper considered paragraph 4(a)(ii) of both policies, which deals with rights or legitimate interests of the respondent in respect of a dispute domain name. It was noted that auDRP panels have consistently followed the approach under the UDRP in respect of the burden of proof and have recognized the difficulty in proving a negative. The common approach under both the auDRP and UDRP is to require the complainant to establish a *prima facie* case that the respondent lacks any rights or legitimate interests in the disputed domain name, upon which the burden shifts to the respondent. Paragraph 4(c) in both policies sets out a non-exhaustive list of defences, which if did exist would exhibit rights or legitimate interests on the part of respondents.

The first of those defences (paragraph 4(c)(i)) under the UDRP deals with instances where a respondent had made *bona fide* use of the domain name before notice of the dispute. The corresponding defence in the auDRP is worded differently, in that a respondent must establish *bona fide* use before notice of the subject matter of the dispute. This has resulted in panels constituted under both the policies analysing the timing of facts claimed by parties to a dispute in different ways, resulting in a greater burden for respondents under the auDRP. However, in applying this defence to entities that have registered and used a disputed domain name for the resale, distribution and repair of a complainant's trademarked products, auDRP panels have followed, albeit with some restraint, the "Okidata" principles that were laid down in *Okidata v ASD*, a decision under the UDRP.

It was also noted that auDRP panels have followed the approach adopted under the UDRP in respect of the second defence (paragraph 4(c)(ii)) dealing with instances where a respondent is commonly known by the disputed domain name. Perhaps the only odd decision under the auDRP is *MGM v McIlroy*, which seems to have ignored prior decisions under both the policies and therefore cannot be regarded as setting out the correct view.

The defence incorporated in paragraph 4(c)(iii) of both the policies refer to instances where a respondent demonstrates a legitimate non-commercial or fair use. This defence has been used to justify the use of domain names for criticism, information and fan websites on the basis of free speech doctrine. UDRP panels have been divided as to whether free speech rights extend to domain names themselves, especially where domain names are identical or confusingly similar to protected trademarks. Panels constituted under the auDRP have recognized this division, although since there have been only a few decisions where this defence has been considered, it is difficult to ascertain which line of UDRP decisions would be preferred in the Australian context.

Third, and lastly, the paper considered paragraph 4(a)(iii) of both policies, which deals with bad faith. On this issue reference was first made to paragraph 4(b) of both policies, which sets out a non-exhaustive list of instances that could demonstrate bad faith on the part of respondents. It was noted that there are

aspects of paragraph 4(b) of the auDRP which are broader than the corresponding paragraph in the UDRP, resulting in the auDRP being more favorable to complainants.

Paragraph 4(a)(iii) itself contains a key difference. While under the UDRP a complainant must satisfy that a respondent had both registered and used the disputed domain name in bad faith, under the auDRP it is sufficient to satisfy either bad faith registration or subsequent bad faith use of the domain name. This has resulted in auDRP panels deciding in favor of complainants in instances where domain names were being used in bad faith at the time of the complaints being filed, although respondents may have registered those domain names in good faith. In contrast, UDRP panels have generally denied complaints even if the disputed domain name was being used in bad faith at the time the complaint was filed in the event it was shown that the original registration of the domain name was in good faith. It was noted that this aspect of paragraph 4(a)(iii) in the auDRP significantly favors complainants, whereas the corresponding provision in the UDRP tends to lead to unjustifiable outcomes.

Both the UDRP and auDRP have now entered their second decade, and have proven to be successful dispute resolution mechanisms given that the vast majority of domain name disputes are not decided in the courts, but are settled under the respective policies. As domain name jurisprudence continues to grow internationally, it will be important to undertake further critical and comparative studies in this area in order to develop a sophisticated understanding of the subtle differences (and similarities) in domain name law(s).

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Notes

1. They are domain names ending with: .biz, .com, .info, .mobi, .name, .net, .org.
2. This is an informal overview of auDRP panel positions on key procedural and substantive issues published by auDA. See auDA Overview of Panel Views on Selected auDRP Questions First Edition (July 2014) ("auDRP Overview 1.0"), auDA: <<http://www.auda.org.au/assets/Policies/auDRP/auDRP-Overview/auDRP-Overview-2014b.pdf>> at 27 October 2015.
3. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), WIPO: <<http://www.wipo.int/amc/en/domains/search/overview/>> at 27 October 2015.
4. Service marks are essentially trademarks that are used in respect of services. The functions of service marks are precisely the same as trademarks, and therefore in this paper reference is only made to trademarks, unless the particular context requires otherwise.
5. auDRP, Schedule A, paragraph 4(a)(i) (hereinafter, a reference to paragraph 4 of the auDRP refers to the paragraph in Schedule A of the policy).
6. See e.g. *RapidShare AG and Christian Schmid v majeed randi*, WIPO Case No D2010-1089 (17 August 2010).
7. See e.g. *TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Limited*, WIPO Case No DAU2006-0003 (29.5.2006) ("*TrueLocal Inc. v News Ltd.*").
8. Under the UDRP, see e.g. *Aspen Grove, Inc. v Aspen Grove*, WIPO Case No. D2001-0798 (5 October 2001); *Spencer Douglass MGA v Absolute Bonding Corporation*, WIPO Case No D2001-0904 (5 September 2001). Under the auDRP, see e.g. *Marshmallow Skins, Inc. v Piipiinoo Australia Pty Limited* WIPO Case No

DAU2013-0015 (24 June 2013) (“*Marshmallow Skins v Piipinoo*”); *Avid Life Media Inc v Melody Carstairs*, WIPO Case No DAU2011-0001 (9 March 2011).

9. WIPO Overview 2.0, Question 1.1. See e.g. *Drugstore.com, Inc. v. Nurhul Chee/Robert Murry*, WIPO Case No D2008-0230 (9 May 2008):

...it is consensus view among Panelists that if a complainant owns a registered trademark it satisfies the threshold requirement of having trademark rights. A decision on whether the Complainant can also claim rights in the Common-Law Mark is not necessary, as the Complainant undisputedly owns the Registered Mark, and the strength of such mark is not relevant in this regard either.

10. See e.g. *Brilliance Publishing, Inc. v My Brilliance Pty Ltd/Ceinwen Schneider*, WIPO Case No. DAU2013-0007 (28 May 2013); *We Buy Any Car Limited v Highway Auto Mart and Jason Collings*, WIPO Case No. DAU2012-0004 (11 April 2012).
11. See e.g. *Rainbow Sandals, Inc. v. Malua Point Holdings Pty Limited, Anthony Brown/Malua Point Holdings Pty Limited a/k/a Malua Point Merchants*, WIPO Case No DAU2013-0014 (7 July 2013); *Smart Voucher Ltd T/A Ukash v Chowdhury, MD Abu Russel and Sydney Business & Technology Group Pty Ltd*, WIPO Case No. DAU2013-0006 (8 May 2013); *TeamViewer GmbH v Nigel Burke*, WIPO Case No. DAU2012-0027 (19 December 2012); *Hutchinson Wines v Amphora Wine Group Pty Ltd, William Howard*, WIPO Case No DAU2011-0008 (21 April 2011); *TrueLocal Inc. v News Ltd.* (n7).
12. auDRP Overview 1.0, Question 1.1A.
13. *Marshmallow Skins v Piipinoo* (n8).
14. Ibid.
15. Ibid.
16. Ibid.
17. Ibid. But see, *TrueLocal Inc. v News Ltd.* (n7), where the panel disagreed with the decision in *GE Capital Finance Australasia Pty Ltd v Dental Financial Services Pty Ltd*, WIPO Case No DAU2004-0007 (7 January 2005) (“*GE Capital v Dental Financial*”). In *GE Capital v Dental Financial*, the panel utilized the Domain Name Eligibility and Allocation Rules to hold that rights in relation to a trademark may even accrue where only an application for trademark registration has been submitted. However, in *TrueLocal Inc. v News Ltd.*, the panel held that “[h]owever the basis on which a domain name is granted to a respondent is not the same as the basis on which a complainant may assert its rights under the Policy”. Thus, if *TrueLocal Inc. v News Ltd.* is the right approach, then the third reasoning supplied by the panel in *Marshmallow Skins v Piipinoo* is doubtful.
18. See e.g. *La Mafafa, Inc. dba Cultura Profética v Domains Real Estate*, WIPO Case No D2009-0534 (1 July 2009) (panel found “CULTURA PROFÉTICA” inherently distinctive).
19. See e.g. *Spanton Media Group Pty Limited v. Lion Global Pty Limited*, WIPO Cases Nos DAU2007-0007 and DAU2007-0008 (2 January 2008) (panel found common law rights in respect of the words “BAR AWARDS”). Contrast, *Alpine Entertainment Group, Inc. v Walter Alvarez*, WIPO Case No D2006-1392 (22 January 2007) (panel found “Real Spankings” to be descriptive and there was no evidence of secondary meaning); *WOW Audio Visual Superstores Pty Ltd v. Comonoz Pty Ltd*, WIPO Case No DAU2007-0003 (24 July 2007) (panel found no common law trademark rights in the generic word “wow”).
20. See e.g. *GE Capital v Dental Financial* (n17); *We Buy Any Car Limited v Highway Auto Mart and Jason Collings*, WIPO Case No DAU2012-0004 (11 April 2012) (“*We Buy Any Car v Highway Auto Mart*”).
21. auDRP Overview 1.0, Question 1.1B.
22. *We Buy Any Car v Highway Auto Mart* (n20).
23. Ibid.

24. *PayBurst Financial Technologies and Gregory Fx Iannacci v Virgin Blue Airlines Pty Ltd*, WIPO Case No DAU2006-0001 (16 March 2006) (“*PayBurst Financial Technologies v Virgin Blue Airlines*”).
25. See, *SNC Jesta Fontainebleau v Po Ser*, WIPO Case No D2009-1394 (21 November 2009) (“*SNC Jesta v Po Ser*”).
26. See generally, H. W. Wertheimer, “The Principle of territoriality in trademark law of the common market countries” (1967)16 *International and Comparative Law Quarterly* 630.
27. *SNC Jesta v Po Ser* (n25) (emphasis added).
28. Ibid.
29. See, WIPO Overview 2.0, Question 1.7.
30. See, auDRP Overview 1.0, Question 1.6.
31. *Adjudicate Today Pty Limited v The Institute of Arbitrators and Mediators*, WIPO Case No DAU2012-0033 (13 March 2013).
32. Ibid:

The Policy therefore contemplates a potentially wider range of rights providing the foundation for a complaint than under the [UDRP].

33. *Tom Cruise v Network Operations Center/Alberta Hot Rods*, WIPO Case No D2006-0560 (5 July 2006).
34. *Jim Carrey v BWI Domains*, WIPO Case No D2009-0563 (16 June 2009).
35. *Jay Leno v Garrison Hintz*, WIPO Case No D2009-0569 (26 June 2009).
36. *Beyoncé Knowles v Sonny Ahuja*, WIPO Case No D2010-1431 (15 October 2010).
37. See e.g. *Vanisha Mittal v. info@setrillonario.com*, WIPO Case No D2010-0810 (8 August 2010); *Margaret C. Whitman v. Domains For Sale*, WIPO Case No D2008-1534 (1 December 2008).
38. *Shane Keith Warne v Sure Thing Services Pty Ltd*, LEADR Case No auDRP10/08 (26 May 2010). In this case, the panel recognized rights on the part of the claimant in respect of his nickname, despite “WARNEY” and “WARNIE” being granted trademark registration to Flipper Underground Pty Ltd, to which the complainant had given his consent. Once the complainant had authorized a third party to register a trademark corresponding to his nickname, the panel doubted whether he could continue to enjoy common law trademark rights to his nickname:

Whether that registration would deprive the Complainant of the corresponding common law trademarks that he claims is a potential problem for the Complainant as the Panel inclines to the view that it might, since the consent given by the Complainant in practical terms allows Flipper Underground Pty Ltd to appropriate the goodwill in those marks that formerly belonged to the Complainant.

Nevertheless, the panel recognized the complainant’s right to his nickname on the basis that “[u]nlike the UDRP, which requires a complainant to establish rights in trademarks, the auDRP offers an additional ground to a complainant that can establish rights in a name. In this case the Panel is entirely satisfied that the Complainant is very well known as “Warne-y” or “Warney” or “Warnie” or any other phonetically equivalent spelling”.

39. *KJ Aldridge Investments Pty Ltd v Aldridge Electrical Industries Pty Ltd*, LEADR Case No auDRP04/12 (25 May 2012). Here, although the complainant’s company name was “KJ Aldridge Investments Pty Ltd.”, the panel recognized the complainant’s rights in respect of “Aldridge” as forming the most distinctive part of the name.
40. WIPO Case No DAU2009-0001 (18 May 2009).
41. See e.g. *Multi-National Concepts Pty Ltd v 1300 Directory Pty Ltd*, WIPO Case No DAU2009-0002 (7 June 2009); *Inbound Telecommunications Pty Ltd, Phonename Marketing Australia Pty Ltd v. 1300 Directory*

Pty Ltd, Demetrio Padilla, WIPO Case No DAU2009-0018 (21 April 2010) (although in this case there was a dissent).

42. See, auDRP Overview 1.0, Question 1.1D.
43. See, auDRP Overview 1.0, Question 1.2.
44. See e.g. *Arthur Guinness Son & Co. (Dublin) Limited v Dejan Macesic*, WIPO Case No D2000-1698 (25 January 2001).
45. *Advance Magazine Publishers Inc. d/b/a Condé Nast Publications v MSA, Inc. and Moniker Privacy Services*, WIPO Case No D2010-2011 (7 February 2011) (“*Advance Magazine Publishers v. MSA*”).
46. *GlobalCenter Pty Ltd v Global Domain Hosting Pty Ltd*, WIPO Case No DAU2002-0001 (5 March 2003) (“*GlobalCenter v Global Domain Housing*”).
47. *The Stanley Works and Stanley Logistics, Inc. v Camp Creek Co., Inc.*, WIPO Case No D2000-0113 (13 April 2000) (“*The Stanley Works v Camp Creek*”).
48. *Toyota Jidosha Kabushiki Kaisha d/b/a Toyota Motor Corporation v S&S Enterprises Ltd.*, WIPO Case No. D2000-0802 (9 September 2000) (“*Toyota v S&S Enterprises*”).
49. *Nokia Corporation v Nokiagirls.com a.k.a IBCC*, WIPO Case No D2000-0102 (18 April 2000) (“*Nokia v Nokiagirls.com*”).
50. *Blue Sky Software Corp. v Digital Sierra Inc. and Abdullah Khan*, WIPO Case No D2000-0165 (27 April 2000) (“*Blue Sky Software v Digital Sierra*”).
51. *Toyota v S&S Enterprises* (n48).
52. *Planned Parenthood Federation of America, Inc. v Bucci*, 1997 U.S. Dist. LEXIS 3338, No. 97-0629 (S.D.N.Y. Mar. 24, 1997).
53. *Toyota v S&S Enterprises* (n48).
54. See e.g. *Sterling Marine Pty Ltd v The Trustee for The Costa Family Trust* Case No. LEADR-auDRP02/13 (23 April 2013); *Camper Trailers WA Pty Ltd v Off Road Equipment Pty Ltd*, LEADR Case No auDRP06/04 (12 November 2004) (“*Camper Trailers v Off Road Equipment*”); *BlueChip InfoTech Pty Limited v Roslyn Jan and Blue Chip Software Development Pty Ltd*, LEADR Case No auDRP06/03 (23 December 2003); *The Crown in Right of the State of Tasmania trading as “Tourism Tasmania” v Gordon James Craven*, WIPO Case No DAU2003-0001 (16 April 2003) (“*Tourism Tasmania v Gordon James Craven*”).
55. *Ibid.*
56. *Camper Trailers v Off Road Equipment* (n54).
57. See e.g. *Jean Heitz v Ghidella, Rosalia*, WIPO Case No DAU2011-0023 (18 October 2011), *Telstra Corporation Limited v Mikhail Doubinski and Yury Sharafutdinov trading as AAA Marketing World*, WIPO Case No DAU2006-0008 (5 October 2006); *Productreviews.com.au Pty Ltd v Job Search Business Systems Pty Ltd*, IAMA Case No 3763 (18 June 2013); *Macquarie Group Limited v McQuarie Group Pty Ltd / Roland Storti*, WIPO Case No DAU2012-0028 (8 March 2013); *Kelly’s Distributors Pty Ltd v Name of Respondent: Rybu Pty Ltd.*, LEADR Case No auDRP11/10 (29 June 2010) (panel noted that the domain name was “substantially identical and confusingly similar” to the complainant’s mark); *Tigerdirect Inc. v Jim Sun, Sun’s Sons Pty Ltd*, WIPO Case No DAU2010-0005 (5 May 2010); *Google Inc. v Jan Jelles*, WIPO Case No DAU2008-0012 (20 October 2008).
58. See e.g. *Wachovia Corporation v Peter Carrington*, WIPO Case No D2002-0775 (2 October 2002); *Humana Inc. v Cayman Trademark Trust*, WIPO Case No D2006-0073 (7 March 2006); *Edmunds.com, Inc. v Digi Real Estate Foundation*, WIPO Case No D2006-1043 (6 October 2006).
59. See e.g. *Express Scripts, Inc. v Whois Privacy Protection Service, Inc./Domaindeals, Domain Administrator*, WIPO Case No D2008-1302 (1 December 2008) (panel found “EXPRESS SCRIPTS” confusingly similar to “expressscripts.com” with no reference to essential or virtual identity); *Mejeriforeningen Danish Dairy Board v Cykon Technology Limited*, WIPO Case No D2010-0776 (14 July 2010) (panel found “LURPAK” confusingly similar to ‘lurpa.com’ with no reference to essential or virtual identity).

60. See, auDRP Overview 1.0, Question 1.10, which indicates that the general position is the same as under the UDRP.
61. See, auDRP Overview 1.0, Question 1.2.
62. This conclusion could be reached in view of the panel's approach in *GlobalCenter v Global Domain Housing*.
63. *Nikon, Inc. and Nikon Corporation v Technilab*, WIPO Case No D2000-1774 (26 February 2001).
64. *GlobalCenter v Global Domain Housing* (n46).
65. One of the most recent cases to do so is *Liposonix, Inc. v Robert Fam, Cosmedix Pty Ltd*, WIPO Case No DAU2015-0019 (15 July 2015) where the panel cited *Tourism Tasmania v Gordon James Craven* (n54) where it was observed:

...the test of confusing similarity under the Policy is confined to a comparison of the disputed domain name and the name or trademark alone, independent of the other marketing and use factors usually considered in trademark infringement or unfair competition cases.

66. See e.g. *Confo Pty Ltd v Meridian Project Consulting Pty Ltd*, LEADR Case No auDRP05/11 (16 May 2011); *Marketstorm Australia Pty Limited v ACN 140 859 892 Pty Ltd (t/a Recoup Debt Recovery)*, WIPO Case No DAU2011-0026 (28 December 2011); *Pelican Products, Inc. v Terri Curyer*, WIPO Case No DAU2011-0021 (26 October 2011); *ISaleADay L.L.C. and Benyamin Federman v LivinWireless, Simon Mochkin and Eli Feiglin*, WIPO Case No DAU2010-0016 (27 September 2010). However, some panels have found in favor of the respondent on the basis that the complainant's mark and the disputed domain name are highly descriptive and therefore one entity ought not to be allowed exclusive use of that term (see e.g. *Find Marketing Pty Ltd v Troy Holland and Taryn Green*, LEADR Case No auDRP09/11 (22 July 2011) ("*Find Marketing v Troy Holland*"); *Objective Ware Pty Ltd v Select Software Telecommunications Pty Ltd*, IAMA Case No 2757 (28 April 2005)). In fact, since this type of reasoning is irrelevant to the analysis under the first limb, a subsequent panel in *Leaders Computers Pty Ltd v Australian Flourish Pty Ltd*, LEADR Case No auDRP05/12 (13 June 2012), preferred not to follow the reasoning in *Find Marketing v Troy Holland*).
67. See e.g. *OASE Asia Pacific Ltd v Wifitech Ltd*, LEADR Case No auDRP13/11 (10 January 2012).
68. See e.g. *Clark Equipment Company v AllJap Machinery Pty Ltd*, WIPO Case No DAU2011-0042 (5 March 2012); *Telstra Corporation Limited v CQ Media Group Pty Ltd*, WIPO Case No DAU2008-0023 (3 March 2009); *Woolworths Limited v Cracka IP Pty Ltd*, WIPO Case No DAU2011-0028 (18 October 2011).
69. See e.g. *RUGGEDCOM, Inc. v James Krachenfels*, WIPO Case No D2009-0130 (7 April 2009). For an example from the auDRP context, see, *Cambridge Nutritional Foods Limited and Cambridge Manufacturing Company Limited v Cambridge Diet Pty Ltd*, WIPO Case No DAU2010-0021 (16 February 2011).
70. See, auDRP Overview 1.0, Question 1.9.
71. See, WIPO Overview 2.0, Question 1.9. See e.g. *Nintendo of America Inc. v Fernando Sascha Gutierrez*, WIPO Case No D2009-0434 (8 June 2009) (the panel found that the addition of the terms "download" and "unlimited" to the "WII" trademark in forming the disputed domain name resulted in a confusing similarity). In the auDRP's context, see e.g. *Clark Equipment Company v R & R Equipment Pty Ltd*, WIPO Case No DAU2012-0011 (4 June 2012) (the panel found that the addition of the term "sales" to the complainant's mark "BOBCAT" did not avoid a confusing similarity).
72. *Société Air France v MSA, Inc.*, WIPO Case No D2007-0143 (19 April 2007) ("*Air France v MSA*"). See also, *Société Air France v Virtual Dates, Inc.*, WIPO Case No D2005-0168 (24 May 2005).
73. *Asda Group Limited v Mr Paul Kilgour*, WIPO Case No D2002-0857 (11 November 2002) ("*Asda v Mr. Paul Kilgour*"). See also, *Joseph Dello Russo M.D. v Michelle Guillaumin*, WIPO Case No D2006-1627 (27 April 2007).
74. *Wal-Mart Stores, Inc. v Richard MacLeod d/b/a For Sale*, WIPO Case No D2000-0662 (19 September 2000) ("*Wal-Mart v Richard MacLeod*").

75. Ibid. See also, *Bakers Delight Holdings Ltd v Andrew Austin*, WIPO Case No D2008-0006 (25 February 2008); *Sermo, Inc. v CatalystMD, LLC*, WIPO Case No D2008-0647 (2 July 2008); *The Royal Bank of Scotland Group plc, National Westminster Bank plc A/K/A NatWest Bank v Personal and Pedro Lopez*, WIPO Case No D2003-0166 (9 May 2003); *Deutsche Telekom AG v AdImagination*, WIPO Case No DWS2006-0001 (4 January 2007).
76. See, *Chubb Security Australia PTY Limited v Mr. Shahim Tahmasebi*, WIPO Case No D2007-0769 (13 August 2007).
77. See, auDRP Overview 1.0, Question 1.3.
78. *Camper Trailers v Off Road Equipment* (n54).
79. LEADR Case No auDRP 15/04 (15 June 2015). See also, example *Messages on Hold Australia Pty Ltd v Media Group Pty Ltd*, LEADR Case No auDRP14/14 (5 January 2015); *Adultshop.com Pty Ltd v Josh Marsden, Importa Pty Ltd*, WIPO Case No. DAU2015-0002 (13 March 2015); *Tooling Australia Inc v Austool Ltd (In Liquidation)*, IAMA Case No 3045 (6 April 2007). A Similar view has been expressed by UDRP panels as well (see e.g. *America Online, Inc v Jonathan Investments Inc, and AOLNEWS.COM*, WIPO Case No. D2001-0918 (14 September 2001)).
80. See generally, Mark P. McKenna, “Trademark Use and The Problem of Source” (2009) *University of Illinois Law Review* 773.
81. See, UDRP and auDRP, paragraph 4(a)(ii).
82. See, paragraph 4(a) of both the UDRP and auDRP. The phraseology adopted in the opening sentence of paragraph 4(a) of both policies, which compels a respondent to submit to a mandatory administrative proceeding where a complainant establishes the three elements in paragraph 4(a)(i)-(iii), implies a general evidentiary burden on the part of complainants.
83. *Do The Hustle, LLC v Tropic Web*, WIPO Case No D2000-0624 (21 August 2000) (“*Do The Hustle v Tropic Web*”).
84. See e.g. *VeriSign Inc., v VeneSign C.A.*, WIPO Case No D2000-0303 (28 June 2000) (the panel found that the complainant had failed under the second limb, even though the respondent had failed to participate in the proceedings); *Beijing Pernot Ricard Winery Co. Ltd. v Capital Enterprises Group, Inc.*, eResolution Case No AF-0177 (18 June 2000) (the panel observed that “[a]lthough [Paragraph 4(c)] is couched in terms of the respondent ‘demonstrating’ its rights or legitimate interest, it is for the complainant to establish their absence”.); *Gassen Diamonds B.V. v Van Etten Bernardus Joacbus*, eResolution Case No AF-0149a; AF-0149b (25 May 2000) (the panel observed “[a]s far requirement under point (ii) above (illegitimacy) is concerned, Complainant did not submit any evidence that Respondent had no rights or legitimate interests in respect of the domain name”).
85. *Educational Testing Service v Netkorea Co.*, WIPO Case No D2000-0087 (4 April 2000) (the panel observed that “[i]t is relatively difficult for any complainant to prove beyond a shadow of a doubt that a respondent has no rights or legitimate interests in a domain name. By and large, such information is known to and within the control of the respondent. Accordingly, the burden on a complainant in respect of this element must, by necessity, be relatively light”). See also, *Europay International S.A. v Eurocard.com, Inc., EuroCard.org, and Chad Folkening*, WIPO Case No D2000-0173 (22 May 2000).
86. See, *Wal-Mart Stores, Inc. v Walmarket Canada*, WIPO Case No D2000-0150 (2 May 2000).
87. See e.g. *Do The Hustle, LLC v Tropic Web*, WIPO Case No D2000-0624 (21 August 2000) (“*Do The Hustle v Tropic Web*”); *Document Technologies, Inc. v International Electronic Communications, Inc.*, WIPO Case No. D2000-0270 (6 June 2000); *Inter-Continental Hotel Corporation v Khaled Ali Soussi*, WIPO Case No D2000-0252 (29 January 2001); *Neusiedler Aktiengesellschaft v Vinayak Kulkarni*, WIPO Case No D2000-1769 (5 February 2001).
88. See, *Do The Hustle v Tropic Web* (ibid).
89. See, WIPO Overview 2.0, Question 2.1.
90. See, auDRP Overview 1.0, Question 2.1.

91. *Australian Drivers Rights Association v Australian Dust Removalists Association*, IAMA Case No 2351 (3 January 2003).
92. This was the second decision to be awarded under the auDRP (see n46).
93. See *Minespec Services Pty Ltd v MINESPEC.COM, Cleanrite Australia Pty Ltd, Minespec Compliance Pty Ltd*, WIPO Case No DAU2012-0019 (6 August 2012) (“The Panel finds that the Complainant has made out a *prima facie* case, but that the Respondent has provided substantial evidence to rebut it. As such, the Complaint cannot succeed”). See also, e.g., *Banque Pictet & Cie SA v Alan Meltzer*, WIPO Case No DAU2015-0017 (18 June 2015); *Liposonix, Inc. v Robert Fam, Cosmedix Pty Ltd.*, WIPO Case No DAU2015-0019 (15 July 2015).
94. *Find Marketing Pty Ltd v Troy Holland and Taryn Green*, LEADR Case No auDRP 09/11 (22 July 2011) (“*Find Marketing v Troy Holland*”).
95. *Private Real Estate Pty Limited v Chris Papas*, IAMA Case No 3665 (18 February 2013) (“*Private Real Estate v Chris Papas*”).
96. See, n79.
97. *Andrea Chick v Countrynet Software Pty Ltd*, LEADR Case No auDRP05/15 (16 July 2015) (“*Andrea Chick v Countrynet Software*”).
98. Under the corresponding paragraph in the auDRP, the respondent’s use or preparations to use the domain name or name corresponding to the domain name in connection with the *bona fide* offering of goods or services must have been made before any notice of the “subject matter” of the dispute.
99. See, UDRP, paragraph 4(c)(i–iii). Note that the auDRP contains the identical provision with minor variations.
100. See, n36.
101. *Allianz Australia Insurance Limited and Allianz Australia Limited v Throne Ventures Pty Limited*, WIPO Case No DAU2010-0012 (20 July 2010) (“*Allianz Australia v Throne Ventures*”). UDRP panels have also given a fairly broad interpretation to the phrase “notice of a dispute”. See e.g. *R.T. Quaipe Engineering v Luton*, WIPO Case No D2000-1201 (14 November 2000) (“*R.T. Quaipe v Luton*”):

When the Policy refers to the “dispute”, that cannot mean solely the filing of a Complaint under the Policy. Otherwise it would create a disincentive for complainants to contact cybersquatters in an effort to resolve a dispute short of initiating a formal proceeding. Rather, the reference to “dispute” must be read more broadly to include any disagreement between the parties concerning the domain name or trademark at issue. . .

102. See, *United Parcel Service of America, Inc. v Wesley Bryant*, WIPO Case No DAU2009-0012 (11 February 2009) and *Blurb Inc. v Rethink IT Pty Ltd.*, WIPO Case No DAU2009-0008 (28 October 2009).
103. See e.g. *Tina Arena v Enigmatic Minds Pty Ltd*, LEADR Case No auDRP01/07 (17 March 2007), *Princess Yachts International Plc v Graham Stephens*, LEADR Case No auDRP08/07 (3 August 2007), *Zillow Inc. v Felix-Hoffman Anne-Simone*, WIPO Case No DAU2006-0015 (1 March 2007) (here the Panel held that the Respondent’s Australian trademark application relating to the word “ZILLOW”, which comprised the domain name, was made after the Respondent became aware of the dispute), *Premier Fire Protection Services (NSW) Pty Ltd and Premier Fire v Nixon Safety Pty Ltd*, LEADR Case No auDRP07/05 (17 August 2005) and *Overture Services, Inc. v Overture Search*, WIPO Case No. DAU2004-0002 (28 September 2004).
104. *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No D2001-0903 (6 November 2001) (“*Oki Data v ASD*”).
105. See e.g. *World Wrestling Federation Entertainment, Inc. v Ringside Collectibles*, WIPO Case No D2000-1306 (24 January 2001).
106. See e.g. *Nikon, Inc. v Technilab*, WIPO Case No D2000-1774 (26 February 2001); *Kanao v J.W. Roberts Co.*, WIPO Case No 0109 (25 July 2001). But in *Weber-Stephen Products Co. v Armitage Hardware*, WIPO Case No D2000-0187 (11 March 2000) and *Freni Brembo S.p.A. v Webs We Weave*, WIPO Case No D2000-1717 (19

March 2001), the panels have ignored the use of the respondent's website to sell competing products on the basis that those "instances appear to be minor".

107. See e.g. *Houghton Mifflin Co. v Weatherman, Inc.*, WIPO Case No D2001-0211 (25 April 2001); *Easy Heat, Inc. v Shelter Prods.*, WIPO Case No D2001-0344 (14 June 2001); *R.T. Quaipe v Luton* (n101).
108. See e.g. *Magnum Piering, Inc. v Mudjackers*, WIPO Case No D2000-1525 (29 January 2001).
109. See e.g. *Xtralis Technologies Limited v Secusense BV*, WIPO Case No DNL2014-0055 (26 February 2015).
110. See, WIPO Overview 2.0, Question 2.3.
111. *Philip Morris Incorporated v Alex Tsyarkin*, WIPO Case No D2002-0946 (13 February 2003). This approach has been followed in subsequent decisions including *LINBIT Information Technologies GmbH v Technical Support*, WIPO Case No D2014-1528 (14 October 2014).
112. See, auDRP Overview 1.0, Question 2.3.
113. *Clark Equipment Company v AllJap Machinery Pty Ltd* WIPO Case No DAU2011-0042 (5 March 2012) ("*Clark Equipment v AllJap*").
114. See e.g. *Pangaea Laboratories Ltd., Pacific Direct Intertrading Pty Ltd. v Astrix Pty Ltd.*, WIPO Case No DAU2015-0013 (3 June 2015); *Aastra Telecom Inc. v Spring Mountain Enterprises Pty Ltd.*, WIPO Case No DAU2008-0003 (9 April 2008).
115. See e.g. *Topfield Co. Ltd v Jai Kemp and Digital Products Group Pty Ltd, t/a Topfield Australia, formerly Paige Communications Pty Ltd*, WIPO Case No DAU2008-0002 (21 April 2008) ("*Topfield v Jai Kemp*"); *Terra Plana International Ltd. v The Summer House Australia Pty Ltd / Tanya Greenwood*, WIPO Case No DAU2012-0025 (22 November 2012).
116. See e.g. *GM Holden Ltd. v Bradley John Lawless*, WIPO Case No DAU2010-0010 (23 May 2010).
117. *GM Holden Ltd. v Publishing Australia Pty Ltd.*, WIPO Case No DAU2011-0002 (7 March 2011) ("*Holden v Publishing Australia*").
118. Ibid.
119. Ibid.
120. *Bayerische Motoren Werke Aktiengesellschaft v Publishing Australia Pty Ltd*, WIPO Case No DAU2011-0024 (24 November 2011) ("*BMW v Publishing Australia*").
121. *Google Inc. v Q Interactive Pty Ltd/Mr. Victor Quinteros*, WIPO Case No. DAU2012-0026 (14 January 2013) ("*Google v Q Interactive*").
122. Ibid (emphasis added).
123. See, n116.
124. *AB Electrolux v Nguyen van su Ong*, WIPO Case No D2012-1852 (18 December 2012) (emphasis added).
125. See e.g. *Clark Equipment Company v R & R Equipment Pty Ltd.*, WIPO Case No DAU2012-0011 (4 June 2012); *Veneziano Coffee Pty Ltd. v Rick Caspersen*, WIPO Case No DAU2012-0009 (22 May 2012); *Illycaffè S.p.A. v John Frisco & Associates Pty Ltd trading as Illycafe/CEW Pty Ltd.*, WIPO Case No DAU2015-0009 (23 April 2015).
126. See e.g. *Giorgio Armani S.p.A. v Essential Mall Pty Ltd.*, WIPO Case No DAU2011-0011 (13 May 2011); *Proxxon S.A. v Woodworking Machinery Specialists Pty Ltd.*, WIPO Case No DAU2009-0017 (19 February 2010).
127. See e.g. *Holden v Publishing Australia* (n117).
128. *Aston Martin Lagonda Limited v Frenbray Pty Ltd*, LEADR Case No auDRP09/06 (3 March 2006).
129. *ITT Manufacturing Enterprises, Inc., ITT Corporation v Douglas Nicoll, Differential Pressure Instruments, Inc.*, WIPO Case No D2008-0936 (7 November 2008).
130. *Topfield v Jai Kemp* (n115).
131. See e.g. *Trade Marks Act 1995* (Cth), s120 which allows third parties to use a registered trademark when the use amounts to a good faith use of a personal name or name of a business.
132. See e.g. *G.A. Modefine SA v A.R. Mani*, WIPO Case No D2001-0537 (20 July 2001).

133. See e.g. *A.S.T. Sportswear, Inc. v Steven R. Hyken*, WIPO Case No D2001-1324 (26 March 2002); *Toyota Motor Sales USA Inc. v J. Alexis Productions*, WIPO Case No D2003-0624 (16 October 2003).
134. See e.g. *Penguin Books Limited. v The Katz Family*, WIPO Case No D2000-0204 (20 May 2000).
135. See e.g. *I.K.B. Deutsche Industriebank AG v Bob Larkin*, WIPO Case No D2002-0420 (23 July 2002); *CITGO Petroleum Corporation v Mathew S. Tercsak*, WIPO Case No D2003-0003 (28 February 2003).
136. Thus, a respondent cannot rely on the registration and subsequent use of the disputed domain name to make avail of this defence. The respondent must have been commonly known by the name (which is reflected in the disputed domain name) before the domain name was registered. See e.g. *Yakka Pty Ltd v Mr. Paul Steinberg*, WIPO Case No D2004-0502 (3 September 2004); *Madonna Ciccone, p/k/a Madonna v Dan Parisi and "Madonna.com"*, WIPO Case No D2000-0847 (12 October 2000).
137. See, Lindsay (2007, p.319). This approach has been adopted under the auDRP as well. The auDRP Overview (at Question 2.7B) thus provides that:

The fact that a respondent has registered a business name or a company name does not, of itself, establish that the respondent has rights or legitimate interests in the domain name that corresponds to the business name or the company name.

138. WIPO Case No D2002-0672 (20 November 2002).
139. *Gordon Summer, p/k/a Sting v Michael Urvan*, WIPO Case No D2000-0596 (19 July 2000) ("*Sting v Urvan*").
140. Ibid.
141. See Lindsay *The Clorox Company v Marble Solutions*, WIPO Case No D2001-0923 (20 November 2001); *E. Remy Martin v Ramy Fahel*, WIPO Case No D2001-1026 (11 October 2001).
142. See, *Playboy Enterprises International, Inc. v Michael Ross*, WIPO Case No D2014-2077 (21 January 2015).
143. *Kraft Foods North America Inc. v The Pez Kiosk*, WIPO Case No D2001-1191 (8 November 2001) ("*Kraft Foods v The Pez Kiosk*").
144. Although the auDRP Overview 1.0 provides that "[i]t appears that no auDRP case has yet found that a respondent is 'commonly known' by a domain name" (see, response to Question 2.1B), there have been a few instances where panels have in fact considered this defence.
145. *Bernard Janes v L.J. Bubenicek & A. J. Main, A&L Technologies*, WIPO Case No DAU2010-0014 (6 September 2010) ("*Bernard v Bubenicek*").
146. Ibid, citing two UDRP cases (see, n136 and cases cited therein).
147. Ibid.
148. *Lullaby Conceptions Pty Ltd v Neverscope Pty Ltd*, IAMA Case No 3064 (5 July 2007).
149. *Constable Care Child Safety Foundation Inc. v The Big Bamboo Production Co. Pty Limited*, WIPO Case No DAU2013-0001 (8 March 2013) ("*Constable Care v The Big Bamboo*").
150. *Banco Espirito Santo S.A. v Bancovic*, WIPO Case No D2004-0890 (16 December 2004); *John Hayes v Vaughan Enterprises*, WIPO Case No D2004-0531 (27 August 2004) and *Kronopol Sp. z o.o v Lamwood Products (1990) Limited, Levana Schwartz*, WIPO Case No D2007-1596 ("*Kronopol v Lamwood*") (26 December 2007).
151. UDRP panels have consistently held that the mere appearance of the respondent's name in an entry relating to a disputed domain name in the WHOIS database does not without more entitle a respondent to claim that he/she is commonly known by that name. See e.g. *Paule Ka v Paula Korenek*, WIPO Case No D2003-0453 (24 July 2003); *The American Automobile Association Inc. v AAA-Vacationsunlimited*, WIPO Case No D2009-0373 (3 May 2009); *The American Automobile Association, Inc. v AAA Auto Find*, WIPO Case No D2012-2042 (21 December 2012). Similarly, some UDRP panels have denied the defence to respondents on the basis that the WHOIS information does not support a finding that the respondent was commonly known by the domain name. See e.g. *LK International AG v Fundacion Private Whois*, WIPO Case No D2013-0135 (4 March 2013).

152. WIPO Case No DAU2012-0032 (1 February 2013).
153. Ibid.
154. WIPO Case No DAU2012-0021 (13 September 2012) (“*IAMA v Adjudicate Today*”).
155. Ibid.
156. WIPO Case No DAU2003-0006 (29 December 2003) (“*MGM v McIlroy*”).
157. Such as *IAMA v Adjudicate Today* and *Bendigo Community Telco Ltd v IT Company Pty Ltd*, LEADR Case No auDRP14/04 (30 May 2014).
158. Lindsey (n137), 322.
159. See e.g. *Monty and Pat Roberts, Inc. v J. Bartell*, WIPO Case No D2000-0300 (13 June 2000); *Skattedirektoratet v Eivind Nag*, WIPO Case No D2000-1314 (18 December 2000); *Myer Stores Limited v Mr. David John Singh*, WIPO Case No D2001-0763 (10 July 2001).
160. *Anastasia International Inc. v Domains by Proxy Inc./rumen kadiev*, WIPO Case No D2009-1416 (18 January 2010) (emphasis added).
161. *Bridgestone Firestone, Inc., Bridgestone/Firestone Research, Inc., and Bridgestone Corporation v Jack Myers*, WIPO Case No D2000-0190 (6 July 2000) (“*Bridgestone v Myers*”).
162. Ibid (emphasis added).
163. See e.g. *TMP Worldwide Inc. v Jennifer L. Potter*, WIPO Case No D2000-0536 (5 August 2000).
164. *Howard Jarvis Taxpayers Association v Paul McCauley*, WIPO Case No D2004-0014 (22 April 2004) (“*HJTA v McCauley*”).
165. Ibid.
166. Ibid.
167. Ibid.
168. Ibid.
169. See e.g. *Arena Entertainment Pty Ltd v Alex Haddad*, LEADR Case No auDRP05/05 (27 June 2005); *Tina Arena v Enigmatic Minds Pty Ltd*, LEADR Case No auDRP01/07 (17 March 2007); *Australian Government Department of Education, Science and Technology v Blogger Pty Ltd*, IAMA Case No 3058 (2 June 2007) (“*DEST v Blogger*”); *Google Inc. v Dmitri Rytsk*, WIPO Case No DAU2007-0004 (8 August 2007) (“*Google v Rytsk*”); *UEIP Pty Ltd v Fincar Pty Ltd*, WIPO Case No DAU2007-0010 (13 December 2007) (“*UEIP v Fincar*”); *Google Inc. v Jan Jelles*, WIPO Case No DAU2008-0012 (20 October 2008); *SKYCITY Adelaide Pty Ltd v Trellian Pty Ltd*, IAMA Case No 3353 (24 October 2009).
170. auDRP Overview 1.0, Question 2.1C.
171. auDRP Overview 1.0, Questions 2.4 and 2.5.
172. *Google v Rytsk* (n169).
173. Ibid.
174. *Google v Rytsk* (n169).
175. This is merely for illustrative purposes. “Google.com.au” is registered by Google Inc.
176. See, n164–168 and accompanying text.
177. See, *Lange v Australian Broadcasting Corporation* (1997) 189 CLR 520.
178. *UEIP v Fincar* (n169).
179. Ibid (emphasis added).
180. *SKYCITY v Trellian* (n169).
181. *DEST v Blogger* (n169).
182. Ibid.
183. See e.g. *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No D2000-0003 (18 February 2000); *Jupiters Limited v Aaron Hall*, WIPO Case No D2000-0574 (3 August 2000) both of which are cases under the UDRP. These UDRP cases have been cited in the auDRP’s context in *Birchbox, Inc. v Nabil Sabet*, WIPO Case No DAU2012-0035 (18 February 2013).

184. UDRP, paragraph 4(b)(i–iv)
185. *Statoil ASA v Creative Domain Pty Ltd./Christine K. Hoyer*, WIPO Case No DAU2013-0012 (18 June 2013) (“*Statoil v Creative Domain*”).
186. UDRP, paragraph 4(a)(iii).
187. WIPO Case No D2000-0003 (18 February 2000). See also, the following literature that addresses this point: Moreira (2004, pp.153–154); Badgley (2001, p.384).
188. *World Wrestling Federation Entertainment, Inc. v Michael Bosman*, WIPO Case No D99-0001 (14 January 2000) (“*WWF v Bosman*”).
189. See, WIPO Poverview 2.0, Question 3.2.
190. *Bathox Australia Pty Ltd v Hareesh Bhojwani*, WIPO Case No DAU2011-0040 (20 February 2013).
191. See, auDRP Overview 1.0, Question 3.2. See also, e.g. *Sterling Marine Pty Ltd v Etolin Pty Ltd*, LEADR Case No auDRP03/13 (16 April 2013).
192. WIPO Case No D2000-0005 (5 March 2000).
193. *Miele Inc v Absolute Air Cleaners and Purifiers*, WIPO Case No D2000-0756 (11 September 2000) (“*Miele v AACP*”).
194. WIPO Case No D2012-0014 (11 May 2012).
195. *Leipa Pack Srl v Ulrich Brunhuber and SC Health Care Packaging SRL* WIPO Case No D2005-0920 (8 November 2005) (“*Leipa Pack v Ulrich Brunhuber*”).
196. There have been a few instances where UDRP panels have attempted to overcome the conjunctive language. See example *Jappy GmbH v Satoshi Shimoshita*, WIPO Case No D2010-1001 (28 September 2010):

Accordingly, in our view the requirement that the domain name “has been registered and is being used in bad faith” can, in certain circumstances, be satisfied in the absence of bad faith intent upon initial registration where such registered domain name is being used in bad faith.

- Yet, more recent panel decisions (e.g. *Networks Limited, Extreme Drinks Limited v Ex Drinks LLC*, WIPO Case No D2013-0197 (18 March 2013)) have preferred to give full effect to the conjunctive language, which seems to be the view of most UDRP panels.
197. Notably, in *e-Duction, Inc. v John Zuccarini, d/b/a The Cupcake Party and Cupcake Movies*, a panel constituted under the UDRP observed “the Policy is deliberately limited in scope and, accordingly, unable to address all instances of domain name misuse. Any changes, whether to the conjunctive ‘registration and use’ requirement [...] would have to be publicly debated and formally adopted by ICANN”. Unfortunately, and despite the problematic outcome of the conjunctive language in the UDRP’s bad faith limb, ICANN has not reconsidered its approach. This is evidenced by the continued use of the conjunctive language in ICANN’s latest introduction, the Uniform Rapid Suspension System (“URS”), which aims to offer lower-cost and faster relief for right-holders experiencing the most clear-cut cases of infringement.
 198. auDRP Overview 1.0, Question 3.1.
 199. LEADR Case No auDRP13/02 (24 April 2013).
 200. *Cobb International Limited v Cobb Australia & New Zealand (Pty) Ltd*, WIPO Case No DAU2013-0005 (23 April 2013) (“*Cobb International v Cobb Australia*”).
 201. *Ibid.*
 202. For an example under the UDRP, see, *Mr. A.C.S. Pinedo v Marvyn Josefa*, WIPO Case No. D2011-0152 (11 March 2011). For an example under the auDRP, see, *Michael Sweep v Douglas Berry*, WIPO Case No DAU2012-0008 (23 May 2012).
 203. See, n193 and accompanying text.
 204. *Ibid.*
 205. *Cobb International v Cobb Australia* (n200).

206. See e.g. *Pelican Products, Inc. v Terri Curyer*, WIPO Case No DAU2011-0021 (26 October 2011), *Bayerische Motoren Werke Aktiengesellschaft v Gregory James Talifero*, WIPO Case No DAU2011-0009 (25 April 2011), *Mothercare Plc v Arthur Jason Bobrow*, LEADR Case No auDRP01/10 (18 February 2010). The only exception to this is *Sharp Corporation of Australia Pty Ltd v Sharp Computing Services Pty Ltd*, LEADR Case No auDRP11/09 (11 February 2010), where the panel denied the complaint despite there being clear evidence of bad faith use at the time of the complaint and the respondent not making legitimate use of the domain name for almost five years preceding the complaint. This decision has been criticised elsewhere by these authors (Roy and Marsoof, 2015).

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