



**THE CHARTERED INSTITUTE OF ARBITRATORS
(AUSTRALIA) LIMITED ACN 118 131 016**

.au Dispute Resolution Provider

ADMINISTRATIVE PANEL DECISION

AAT Australian Adventure Tours Pty Ltd

v.

Wade John t/as Top End Escapes

Reference: auDRP 07-01

Date: 8 October 2007

1. The Parties

- 1.1 The Complainant is AAT Australian Adventure Tours Pty Ltd (ACN 103 585 904) PO Box 564, Bondi Junction, NSW, 1355. Telephone 02 9028 5694 Fax 02 9028 5045 ("Complainant").
- 1.2 The Respondent and holder of the domain name registration, at the time of filing of the complaint was Wade John t/as Top End Escapes, Lot 3434 Smith Street Darwin NT 0800. Telephone 1300 736 892 Email info@ntescapes.com.au ("Respondent").

2. The Domain Name and Registrar

The domain name at issue is <darwindaytours.com.au> ("Domain Name"), currently registered by the Respondent. The Registrar is NetRegistry, registrar ID (R00015-AR).

3. Procedural History

- 3.1 This is an administrative proceeding pursuant to the .au Dispute Resolution Policy ("auDRP") adopted by auDA on 13 August 2001, which commenced operation on 1 August 2002; the auDA Rules for .au Dispute Resolution Policy ("Rules") and the CIArb Supplemental Rules for .au Domain Name Dispute Resolution Policy ("Supplemental Rules").
- 3.2 The Complainant submits the complaint for decision in accordance with au Dispute Resolution Policy (2002 – 22) and the rules there-in.

- 3.3 The complaint was lodged with The Chartered Institute of Arbitrators (the “Dispute Resolution Provider”) by the Complainant on 27 August 2007.
- 3.4 As required by the Policy, the Dispute Resolution Provider requested that AusRegistry place a server lock on the domain, which was done on 30 August 2007.
- 3.5 A copy of the Complaint was sent by the Dispute Resolution Provider to the Respondent on 28 August 2007 requiring him to submit all materials that he wished to have considered by the Panel, on or before 17 September 2007.
- 3.6 On 17 September 2007, the Respondent sent an email to the Dispute Resolution Provider providing information regarding the registration of the domain name, but not providing the material requested.
- 3.7 On 18 September 2007, the Dispute Resolution Provider wrote to the Respondent advising him of the deficiencies in his response and pursuant to Rule 5, granted the Respondent 5 calendar days to remedy his submission to ensure that it meet the requirements of the Rules.
- 3.8 By return email on 17 September 2007, the Respondent advised that he would not submit a Reply.
- 3.9 The Dispute Resolution Provider allowed the 5 calendar days granted, to elapse and appointed a single member Panel on 24 September 2007. The Panellist had submitted a Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Dispute Resolution Provider in compliance with paragraph 7 of the Rules.
- 3.10 The Panel finds that the Complaint complies with the requirements of the .au Domain Administration Dispute Resolution Policy, its Rules and the Supplemental Rules of the Dispute Resolution Provider.

4. Background

- 4.1 The current auDA Guidelines for Accredited Registrars on the Interpretation of Policy Rules for Open 2LDs (Policy No. 2005-02 published 15/3/2005) provide guidance on the process by which domain name licenses are granted. The policy lays out the eligibility and allocation rules that apply.
- 4.2 The eligibility criteria require the Registrant to provide relevant identification details for the 2LD that they want to license their domain name in. The Allocation criteria require the registrant to give a reason why the requested domain name can be allocated to them. The reasons available in each 2LD are where the domain name is:
 - a) an exact match of the registrant's name; or
 - b) an abbreviation or acronym of registrant's name; or
 - c) indicative of a close and substantial connection to the registrant.

- 4.3 However, as section 4.2 indicates, domain names are primarily allocated on a “*first come, first served*” basis. Provided that the registrant meets the relevant policy rules, the registrar may process the registration and issue a domain name licence to the registrant. Once issued the licence continues unless a Complainant can make a successful application for the domain name to be transferred to them.
- 4.4 In an administrative proceeding, the Complainant bears the onus of proof.
- 4.5 The Complainant is a related company of AAT Kings Tours Pty Ltd, within the meaning of section 50 of the Corporations Act 2001. The AAT group of companies is a leading coach tour operator in Australia offering holidays in the Northern Territory, Queensland, South East Australia, Western Australia, and Tasmania. In the Northern Territory, the AAT group carries on business as wholesaler/retailer of a large variety of tours and excursions under the business name “Darwin Day Tours” and widely promotes these by using its trademark on brochures, in print magazines, signage and promotions to travel agents and the general public.
- 4.6 The Respondent operates a business similar to that of the Complainant, conducting tours in the Northern Territory and specifically in the Darwin environs, but does so under the registered business names, “Top End Escapes” registration NT BN00999453 and “Uluru Holidays” registration NT BN00999441, both registered on 12 January 2005.

5. Parties’ Contentions

Complainant

- 5.1 “Darwin Day Tours” is a business name which was registered by Aussie Adventure Holidays Pty Ltd (ACN 061 743 002) in the Northern Territory since, at least, 27 October 1998 and which is now registered by the Complainant.
- 5.2 “Darwin Day Tours discovering Darwin tours” is a trademark, registration no. 821334, registered on 27 January 2000 in respect of Class 39, travel arrangement (day tours).
- 5.3 From about October 1998, Aussie Adventure Holidays Pty Ltd carried on business in Darwin and elsewhere under the business name and trademark and developed a substantial goodwill, which was associated with the business name and trademark.
- 5.4 In June 2003, the Complainant acquired from Aussie Adventure Holidays Pty Ltd for valuable consideration, the goodwill of the business of tour guide and tour operator in Darwin and other localities in the Northern Territory, including the rights to the registered business name and the trademark.
- 5.5 The Complainant became registered under the Northern Territory Business Names Act and the Trademarks Act in respect of the business name and the trademark and since June 2003 through its holding company, AAT Kings Tours Pty Ltd and related companies, carried on business under the business name and trademark which has developed a strong association in Darwin and elsewhere to the business of the Complainant and its holding company.

Respondent

5.6 According to the Respondent:

"The domain name was registered by me on 29th May 2006, and to my astonishment it was available, thus I parked the name and did some background checking into why AAT or Darwin Day Tours did not have it registered.

I was informed by the ex Northern Territory General Manager of the AAT Group of Companies, that their National General Manager Les Cox did not want the domain name as he 'Did not see a future with internet and the domain name' and not only let the name laps (sic), but deregistered the domain with their internet provider.

At the time their vehicles, brochures or offices had no reference to www.darwindaytours.com.au only to the parent company www.aussieadventures.com.au.

Mid September 2006 I hosted a web site on the domain name and clearly had all my logo's and no way implied that we were Darwin Day Tours, the mentality behind this action was that DarwinDayTours.com.au was a tool for greater search engine optimization and an easy call to action for people to write down or remember for phone enquiries opposed to www.TopEndEscapes.com.au.

I was always lead (sic) to believe that domain names were first in best served as long as it was a similar industry."

5.7 As to its present status the Respondent states:

"Times have changed with search engine rankings and the domain is not imperative to our operation anymore."

6. Discussion

- 6.1 The issue to be answered in this complaint is whether the registration of the domain name constitutes a breach of the auDRP such that the domain name should be transferred to the Complainant. This depends on the facts of the case as found in the material provided.
- 6.2 Paragraph 15(a) of the Rules requires the Panel to "*decide a complaint on the basis of the statements and documents submitted in accordance with the [auDRP and Rules], and any rules and principles of law that it deems applicable.*"
- 6.3 The auDRP is contained in Schedule A, paragraph 4(a) requires a Complainant to prove that:
- 6.3.1 the Disputed Domain is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights; and
 - 6.3.2 the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and
 - 6.3.3 the Disputed Domain has been registered or subsequently used in bad faith.
- 6.4 In Section 4(b) the following are deemed, non-exhaustively, to be evidence of registration or use in bad faith:

- 6.4.1 circumstances indicating that the domain name has been registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name, or
 - 6.4.2 the domain name has been registered in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name, or
 - 6.4.3 the domain name has been registered primarily for the purpose of disrupting the business or activities of another person; or
 - 6.4.4 the domain name has been used to intentionally attempt to attract, for commercial gain, Internet users to a website 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 website or location or of a product or service on that website or location.
- 6.5 Section 4(c) states that, in responding to a complaint, rights to and legitimate interest in a domain name may be demonstrated by a Respondent evidencing one of the following, non-exhaustive, situations:
- 6.5.1 before any notice of the subject matter of the dispute, bona fide use, or demonstrable preparations were made to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names acquired for the purpose of selling, renting or otherwise transferring), or
 - 6.5.2 it (as an individual, business, or other organisation) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights, or
 - 6.5.3 it is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue.

7. Findings

- 7.1 The domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights.**
- 7.1.1 The Complainant is the current registered owner of the business name "Darwin Day Tours" registration NT 71459B, which is identical in wording to the disputed domain name.
 - 7.1.2 The Complainant, through a related company, also owns the trademark "Darwin Day Tours discovering Darwin tours" which incorporates the disputed domain name.
 - 7.1.3 Not only are the words as used in the business name and trademark, the same as the disputed domain name, but they refer to the same tourist related activities conducted in the Darwin area of the Northern Territory. The uncontroverted submission of the Complainant is that the words "Darwin Day Tour" have been established and used in the marketplace by the Complainant and the Complainant's predecessor, continuously since not later than January 1998, and have been registered as a business name and trademark.

7.1.4 I therefore find that the domain name, <darwindaytours.com.au> is identical to the business name, and confusingly similar to the trademark in which the Complainant has proprietary rights.

7.2 The Respondent has no rights or legitimate interests in respect of the disputed domain name.

7.2.1 In determining whether the Respondent has rights or legitimate interests in respect of the disputed domain name, it is relevant to consider the matters set out in paragraph 4(c) of Schedule A of the Policy.

7.2.2 The Complainant and the Respondent are business competitors, both conducting sightseeing tours for visitors to the Northern Territory, particularly in the Darwin area. The Complainant advertises its tourist activities in the Northern Territory under its registered business name and trademark. However, the Respondent's business activity is advertised under the web site name <TopEndEscapes.com.au> and the Respondent is not known by the words of the disputed domain name.

7.2.3 There is no commercial association between the Respondent and the Complainant and the Complainant has not conferred on the Respondent any authority to use the business name "Darwin Day Tours" or the registered trademark incorporating those words.

7.2.4 The auDA Domain Name Eligibility and Allocation Rules for Open 2LDs Policy (2005-01) in Schedule C, sets out the eligibility and allocation rules for the <com.au> space. A domain name in the com.au 2LD, for which registration is sought must be an:

- (a) exact match, acronym or abbreviation of the registrant's company or trading name, organization or association name or trademark; or,
- (b) be otherwise closely and substantially connected to the registrant.

Because the Respondent has failed to supply a response as required, it is not clear on what basis the Respondent obtained and maintains registration of the disputed domain name.

7.2.5 The Respondent explained that he obtained registration of the disputed domain name in May 2006 and "parked it" until mid September 2006, when he "hosted a web site on the domain name and clearly had all my logo's and no way implied that we were Darwin Day Tours". The Respondent indicates that he knew that had no right to use the words "Darwin Day Tours", as a competitor to the Complainant, particularly as the Complainant had registered the words and operated under that business name in the same business category and in the same geographic area in which the Respondent operated.

7.2.6 Considering the matters set out in paragraph 4(c) of Schedule A of the Policy, the Respondent's information identifies that:

7.2.6.1 He did not make preparations to use the domain name or a name corresponding to the domain name, in connection with an

offering of goods or services. Instead he “parked” the name and then only used it to divert internet traffic to his own website.

7.2.6.2 He was not commonly known by the domain name, in fact the Respondent deliberately did not seek to suggest “*that we were Darwin Day Tours*” and continued to operate under from his own web site, distinct from the disputed domain name.

7.2.6.3 He was using the domain name for commercial gain by diverting consumers seeking the business and services run by the Complainant under its business name and registered trademark. This is evidenced by the emails sent to the Complainant from its users querying why entering the words of the Complainant’s registered business name diverted them to the Respondent’s website.

7.2.7 I find on the information before me, that the Respondent was not making fair use of the domain name as he has intentionally and deliberately sought to attract internet users who may be seeking the Complainant’s business; and to divert such internet users to the Respondent’s own website wholly for the purpose of commercial gain.

7.2.8 On balance, the Respondent has not shown that he has any overwhelming right or legitimate interests in the disputed domain name.

7.3 The Disputed Domain has been registered or subsequently used in bad faith.

7.3.1 In determining whether the Respondent has registered or used the domain name in bad faith, it is relevant to consider the matters set out in paragraph 4(b) of Schedule A of the Policy.

7.3.2 On the evidence before me, I do not find that the Respondent has registered the domain name in order to deliberately prevent the Complainant from reflecting their business name or trademark in a corresponding domain name, or to disrupt the Complainant’s business activities.

7.3.3 However, as discussed above, I do find that the domain name has been used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent’s website, by creating a likelihood of confusion with the Complainant’s business name and trademark as to the source, sponsorship, affiliation, or endorsement of that website or location of a product or service on that website or location.

7.3.4 I infer from the Respondent’s comment that: “*Times have changed with search engine rankings and the domain is not imperative to our operation anymore*” that he no longer requires the domain name, as the purpose for which it was employed is no longer vital or relevant to the Respondent’s business.

7.3.5 I therefore find that the use of the disputed domain name by the Respondent has been in “bad faith”.

8. Decision

The Panel having found that the Complainant has made out each of the three elements required by the abovementioned Section 4(a) of Schedule A of the Policy, it is the decision of the Panel that the disputed domain name <darwindaytours.com.au> be transferred to the Complainant.

A handwritten signature in black ink, appearing to read 'Derek Minus', written in a cursive style.

Derek Minus

Chartered Arbitrator and Sole Panellist