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**CIArb**

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

**.au Dispute Resolution Provider**

**ADMINISTRATIVE PANEL DECISION**

**Thompsons, Kelly & Lewis Pty Ltd  
trading as Flowserve Pump Division Australia  
v.  
DNS Advertising Pty Ltd**

Reference: auDRP 08-01

Date: 24 March 2008

**1. The Parties**

- 1.1 The Complainant is Thompsons, Kelly & Lewis Pty Ltd trading as Flowserve Pump Division Australia (ABN 15 004 249 012) of 5 Parker Street, Castlemaine, VIC, 3450. Telephone 03 5479 1256 Fax 03 5479 1213 Email Bmurfett@flowserve.com ("Complainant").
- 1.2 The Respondent and holder of the domain name registration, at the time of filing of the complaint was DNS Advertising Pty Ltd, (ABN 96 127 909 791) 4 Todd Place Adelaide SA 5000. Email admin@dnsadvertising.com ("Respondent").

**2. The Domain Name and Registrar**

The domain name at issue is <www.tklcom.au> ("Domain Name"), currently registered by the Respondent. The Registrar is Enetica.

**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 (2008 – 01) and the rules there-in.
- 3.3 The complaint was lodged with The Chartered Institute of Arbitrators (Australia) Limited (the “Dispute Resolution Provider”) by the Complainant on 18 February 2008.
- 3.4 As required by the auDA Clarification of Registrar Obligations Policy no. 2003-01 paragraph 2.2, the Dispute Resolution Provider requested on 18 February 2008 that Enetica request that Ausregistry place a server lock on the domain.
- 3.5 A copy of the Complaint was sent by the Dispute Resolution Provider to the Respondent on 18 February 2008 requiring it to submit all materials that it wished to have considered by the Panel on or before 9 March 2008. The Respondent did not submit a Reply.
- 3.6 The Dispute Resolution Provider appointed a single member Panel on 12 March 2008. 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.
- 3.7 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. Discussion**

- 4.1 The auDA Domain Name Eligibility and Allocation Rules For Open 2LDs Policy (2004-01) explains the rights to the use of domain names:
  - 2.1 *There are no proprietary rights in the domain name system (DNS). A registrant does not “own” a domain name. Instead, the registrant holds a licence to use a domain name, for a specified period of time and under certain terms and conditions.*
  - 2.3 *There is no hierarchy of rights in the DNS. For example, a registered trade mark does not confer any better entitlement to a domain name than a registered business name. Domain name licences are allocated on a ‘first come, first served’ basis. Provided the relevant eligibility rules are satisfied, the first registrant to apply for a particular domain name will be permitted to license it.*
- 4.2 The purpose of an administrative process conducted under the auDRP is stated in section 1.2 of the Policy:

*The purpose of the auDRP is to provide a cheaper, speedier alternative to litigation for the resolution of disputes between the registrant of a .au domain name and a party with competing rights in the domain name.*
- 4.3 The issue to be answered in this complaint is whether the registration of the domain name by the Respondent 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.

- 4.4 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.*”
- 4.5 The auDRP is contained in Schedule A, paragraph 4(a) requires a Complainant to prove that:
- 4.5.1 the Disputed Domain is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights; **and**
  - 4.5.2 the Respondent has no rights or legitimate interests in respect of the Disputed Domain; **and**
  - 4.5.3 the Disputed Domain has been registered or subsequently used in bad faith.
- 4.6 In an administrative proceeding, the Complainant bears the onus of proof.

## **5. Factual Background**

- 5.1 The Complainant had previously registered and used the Domain Name. Information provided by Melbourne IT indicated that the Domain Name was renewed by the Complainant in 2005 for a period of two years. However, the domain registration expired at November 2007 and was not renewed. The Domain Name was therefore returned to the Registry and subsequently registered by the Respondent.
- 5.2 The Respondent company, DNS Advertising Pty Ltd was incorporated on 9/10/2007 according to a trading history report by Veda Advantage Information Services. It is not clear from the papers when the Respondent became the registered owner of the disputed Domain Name, but it has only held the registration for approximately 4 months.

## **6. Parties' Contentions**

### **Complainant**

- 6.1 The Complainant contended that Thompsons, Kelly & Lewis are well known as Australia's leading brand of centrifugal pumps for major water supply and industrial applications. Thompsons having commenced in business in 1875 and Kelly & Lewis in 1899. They merged in 1987. They are recognised industry leaders.
- 6.2 The trademark TKL is a registered business name and property of Thompsons, Kelly & Lewis (see attachment #7 of the complaint). It has been registered in all States of the Commonwealth of Australia since 1987.

### **Respondent**

- 6.3 The Respondent did not provide a Reply. However, on 13 March 2008, Wade Davidson, the director of the Respondent, emailed the Dispute Resolution Provider that:
- “I have emailed Flowserve and told them if they withdraw the complaint I will transfer the domain to them. I have not hear (sic) back from them.”*

## **7. Findings**

### **7.1 The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights.**

- 7.1.1 For the purposes of this policy, auDA has determined that a “*name ... in which the complainant has rights*” refers to:
- 7.1.1.1 the complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority; or
  - 7.1.1.2 the complainant’s personal name.
- 7.1.2 The Complainant’s business name is, **Thompsons, Kelly & Lewis Pty Ltd**. It is an Australian company with a long history stretching back to 1875. They have been known by the name “TKL” since 1987.
- 7.1.3 The Domain Name is an alliteration of the first letter of each of the words in the company name. The addition of “.com.au” at the end of the name offers no substantive, meaningful or material change to the use of the name which could differentiate it in the eyes of customers of the Complainant and users of the Domain Name, now registered by the Respondent.
- 7.1.4 A search of the Australian Trademarks Online Search System (ATMOSS) reveals that the Complainant holds the registered trademark number 537925 in the word “TKL” for goods and services in Class 7, for pumps and parts, lodged on 13 July 1990.
- 7.1.5 The word “TLK” is registered by the Complainant as a business name in all States of the Commonwealth of Australia since 1987.
- 7.1.6 It is fair to say, that as the company that previously held the registration of the Domain Name, the Complainant’s connection with the word “TKL” is overwhelming.
- 7.1.1 By comparison, it is not clear on what basis the Respondent was able to register the Domain Name, as it appears to have no connection with the word “TKL”.
- 7.1.2 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.
- 7.1.3 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.
- 7.1.4 The Respondent cannot show that it complies with these criteria in any way.

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

- 7.2.1 For the purposes of this policy, auDA has determined that “rights or legitimate interests in respect of the domain name” are not established merely by a registrar’s determination that the Respondent satisfied the relevant eligibility criteria for the domain name at the time of registration.
- 7.2.2 Paragraph 4(b) of 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:
- 7.2.2.1 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
- 7.2.2.2 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
- 7.2.2.3 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.
- 7.2.3 The Respondent not having provided a Reply, there is no evidence that the Respondent has any connection with the Domain Name. Certainly none is apparent from the information available. Nor is the company name in any way connected with the Domain Name. I have already observed that the Respondent does not appear to comply with the auDA policy with respect to the eligibility rules that would apply to the allocation of the Domain Name.
- 7.2.4 There is no evidence that the Respondent was making preparations for the bona fide use of the domain name in connection with any offering of goods or services. The Respondent company has only been in existence some 5 months and its own company website is still incomplete.
- 7.2.5 What evidence exists, in the form of a copy of a single webpage (attachment #4 to the complaint), indicates that the Respondent was attempting to provide a commercial service, in part, in the same field of business activity, namely water pumps, as the Complainant.
- 7.2.6 I therefore find that the Respondent does not have any prior or legitimate interests in respect of the domain name.

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

- 7.3.1 Paragraph 4(b) of Schedule A deems the following, non-exhaustively, to be evidence of registration or use in bad faith:
- 7.3.1.1 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
- 7.3.1.2 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
  - 7.3.1.3 the domain name has been registered primarily for the purpose of disrupting the business or activities of another person; or
  - 7.3.1.4 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.
- 7.3.2 On the evidence before me, I am unable to determine 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, the website to which the Domain Name previously resolved (attachment #4 to the complaint) featured a number of products, including; water pumps, pumps, submersible pumps and electric water pumps. The Complainant states that the references to 'Water Pumps', 'Pumps', 'Hydro Titan' and 'Lk-iso' (the latter being a distortion of one of the Complainant's products KL-ISO) is an attempt to create a likelihood of confusion with the Complainant's products, trademark and business name.
- 7.3.4 I agree. I 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.
- 7.3.5 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 <tkl.com.au> be transferred to the Complainant.



**Derek Minus**

Chartered Arbitrator and Sole Panellist