

THE
INSTITUTE *of*
ARBITRATORS & MEDIATORS
—(A)—
AUSTRALIA
.au Dispute Resolution Provider

ADMINISTRATIVE PANEL DECISION

Domain Name Dispute: billingbureau.com.au

between

Objective Ware Pty Ltd

and

Select Software Telecommunications Pty Ltd

Reference: IAMA 2757

1 THE PARTIES

- 1.1 The Complainant is Objective Ware Pty Ltd, Level 5, South Tower, 459 Collins Street, Melbourne, Victoria 3000 ('the Complainant').
- 1.2 The Respondent is Select Software Telecommunication Pty Ltd, Level 8, 222 Clarence Street, Sydney, New South Wales 2000 ('the Respondent').

2 DOMAIN NAME AND REGISTRAR

- 2.1 The domain name in dispute is www.billingbureau.com.au, currently registered by the Respondent. The Registrar is Melbourne IT Limited, Level 2, 120 King Street, Melbourne, Victoria 3000. Although there appears to be no evidence before me of the actual date of registration, it does not appear to be in issue that the domain name was registered in or about September 2003.

3 DISPUTE RESOLUTION PROVIDER AND PANEL

- 3.1 Under cover of a letter dated 11 March 2005, the Complainant submitted its Complaint to the Institute of Arbitrators & Mediators Australia ('IAMA') for resolution under the rules of the .au Dispute Resolution Policy ('the Rules') in Schedule A of that Policy. IAMA is a Dispute Resolution Provider approved by auDA. The Complainant elected to have the dispute determined by a Panel comprising a single member.

- 3.2 Under cover of a letter dated 8 April 2005, the Respondent submitted its Response to IAMA. The Respondent agreed to have the dispute determined by a Panel comprising a single member.
- 3.3 By instrument dated 11 April 2005, IAMA appointed Robert William Hunt as arbitrator, to comprise the Panel to determine the Dispute.
- 3.4 By instrument dated 12 April 2005, Robert William Hunt accepted appointment as Panelist in accordance with the Rules, and the IAMA Supplemental Rules to the .au Dispute Resolution Policy.

4 RULES OF THE .AU DISPUTE RESOLUTION POLICY

- 4.1 Relevantly, the Rules provide as follows:

‘4. Mandatory Administrative Proceeding. *This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative dispute resolution service providers listed on the auDA website at <http://www.auda.org.au/policy/audrp> (each, a "Provider").*

a. Applicable Disputes. *You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure that:*

- (i) your domain name is identical or confusingly similar to a name [Note 1], trademark or service mark in which the complainant has rights; and*
- (ii) you have no rights or legitimate interests in respect of the domain name [Note 2]; and*
- (iii) your domain name has been registered or subsequently used in bad faith.*

In an administrative proceeding, the complainant bears the onus of proof.

b. Evidence of Registration or Use in Bad Faith. *For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:*

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or*
- (ii) you have registered the 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; or*
- (iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or*
- (iv) by using the domain name, you have intentionally attempted 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.

c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. *When you receive a complaint, you should refer to Paragraph 5 of the auDRP Rules in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):*

- (i) before any notice to you of the subject matter of the dispute, your bona fide use of, or demonstrable preparations 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 that you have acquired for the purpose of selling, renting or otherwise transferring); or*
- (ii) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or*
- (iii) you are 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.'*

4.2 At the outset, it is necessary to consider whether the sub-paragraphs of paragraph 4a of the Rules are to be read conjunctively or disjunctively. If they are to be read disjunctively, then a complainant would need to prove one of (i), (ii) and (iii) whereas if they are to be read conjunctively, a complainant would need to prove each of (i), (ii) and (iii). While this is not something which is free from doubt, applying settled principles of construction of documents I consider that the better view is that the sub-paragraphs are to be read conjunctively, more particularly because it would seem contrary to the Policy if a complainant could succeed if it established only that the domain name is *'identical or confusingly similar to a name, trademark or service mark in which the complainant has rights'*.

4.3 I note that this interpretation of paragraph 4a of the Rules is consistent with other published decisions under the Rules, and that a consistent approach is desirable so that parties using the Policy can have a level of confidence know that the Rules will be interpreted in a particular way regardless of the identity of the Panel appointed in a particular dispute.

5 THE COMPLAINT

5.1 The Complaint is set out in an 8 page document and Annexures A to F to that document.

5.2 Paragraph 8 of the Complaint says:

'The following names and trademarks are relevant to the dispute:

- (a) *The Victorian Business Name “The Billing Bureau” with the Victorian Business Name No. B1427591G registered on 5 March, 1999 in relation to telecommunications billing services.*
- (b) *The Complainant had also been trading for many years with the name “Billing Bureau”, in relation to telecommunications billing services, prior to registering the name in Victoria*
- (c) *Trademark No. 1011307 “The Billing Bureau” in class 36 (financial services) and class 38 (telecommunications) filed on 16 July, 2004 – this trademark is pending – the initial examination report has been answered and a response is being awaited.*
- (d) *Trademark No. 1039838 for the logo “Billing Bureau” in class 36 (telecommunications) filed on 1 February, 2005. This trademark is awaiting examination.*
- (e) *The Complainant has been using the common law trademark “the Billing Bureau” since at least early 1999 and has established a reputation in the telecommunications billing services area under this name since at least early 1999.*

Supporting documentation evidencing the business name and trademark registrations is annexed to this Complaint.

Copies of correspondence and other material used by the Complainant since at least early 1999, using the words “billing bureau” in association with its telecommunications billing business are also annexed.’

5.3 The grounds for the Complaint are set out in paragraph 9 of the Complaint, as follows:

- ‘(a) *When the Respondent applied for the Domain Name, it incorrectly warranted to the Registrar pursuant to Rule 2 of Schedule A of the auDRP, that:*
 - (i) *Registration of the Domain Name would not infringe upon or otherwise violate the rights of any third party;*
 - (ii) *The Respondent would not use the Domain Name for an unlawful purpose; and*
 - (iii) *Knowingly use the Domain Name in violation of any applicable laws or regulations.*
- (b) *The Respondent could not make these warranties under Rule 2 of Schedule A of the auDRP as, at the time it registered the Domain Name, it was aware or ought to have been aware, that the Complainant had registered the Victorian Business Name “The Billing Bureau” with the Victorian Business Name No. B1427591G on 5 March, 1999 in relation to telecommunications billing services and had for*

many years been trading with the name “Billing Bureau” in relation to telecommunications billing services.

As evidence of the use of the name “Billing Bureau” in relation to telecommunications billing services by the Complainant, copies of some of the Complainant’s advertising material from the period 1999-2000 are attached with the dates of publication being, respectively:

- (i) Annexure D – 29 April, 1999;*
 - (ii) Annexure E – 5 June, 1999; and*
 - (iii) Annexure F – 5 August, 2000.*
- (c) The Respondent was aware or ought to have been aware that the Complainant had used the common law trademark “Billing Bureau” since at least 1999, in relation to its telecommunications billing services and that the Complainant had applied or was likely to apply for Trademarks in relation to the name “The Billing Bureau”.*
- (d) The Respondent was aware of these facts or ought to have been aware of them, as the Respondent was and still is a direct competitor of the Complainant in the telecommunications billing services business and has had numerous occasions to contact my client for business reasons since at least 1999.*
- (e) The Respondent registered the Domain Name in bad faith under Rule 4(b) of Schedule A of the auDRP in that it did so:*
- (i) expressly in order to prevent the Complainant from reflecting that name or mark in a corresponding domain name; or*
 - (ii) primarily for the purpose of disrupting the business or activities of the Complainant; or*
 - (iii) intentionally attempted to attract, for commercial gain, internet users to its website (selectsoftware.com.au to which the Domain Name resolves) by creating a likelihood of confusion with the Complainant’s name or mark as to the source, sponsorship, affiliation or endorsement of the Respondent’s website or the telecommunications billing services referred to on the Respondent’s website.*
- (f) Under Schedule C of the auDA Domain Name Eligibility and Allocation Policy Rules for Open Second Level Domains, which deals with .com.au 2LDs, the Respondent’s use of the Domain Name must exactly match:*
- (i) the registrant's company, business, trading, association or statutory body name; or*
 - (ii) the words comprising the registrant’s Australian Registered Trade Mark or application for an Australian Registered Trade Mark; or*

- (iii) *be an acronym or abbreviation of (i) or (ii); or*
- (iv) *be otherwise closely and substantially connected to the registrant, because the domain name refers to.*
 - (A) *a product that the registrant manufactures or sells; or*
 - (B) *a service that the registrant provides; or*
 - (C) *an event that the registrant organises or sponsors; or*
 - (D) *an activity that the registrant facilitates, teaches or trains; or*
 - (E) *a venue that the registrant operates; or*
 - (F) *a profession that the registrant's employees practise.*
- (g) *At no time did the Respondent comply with the requirements of 9(f)(i) through (iii) above and the Respondent was aware or ought to have been aware that the Complainant had clearly established a reputation and use for the words "billing bureau", since at least May 1999, in respect of telecommunications billing services, which the Complainant incorrectly claimed as being associated with its telecommunications billing services.*
- (h) *None of the Respondent's literature, or indeed the website which is resolved to the Domain Name (selectsoftware.com.au), refers to "billing bureau", rather the Respondent refers to its telecommunications billing services as the "ASP/Telecom bureau service".'*

5.4 I note that, as at 27 April 2005, the material at www.billingbureau.com.au is the same as the material at the Respondent's other site www.selectsoftware.com.au.

6 THE RESPONSE

6.1 The Response is set out in an 8 page document and Annexures A to L to that document.

6.2 The Respondent's submissions are set out in paragraph 9 of the Response, as follows:

'9.1 The grounds on which the Complainant relies fall into the following categories:

- *an allegation that the warranties made by the Respondent at the time that it applied for the registration of the domain name www.billingbureau.com.au were incorrect;*
- *an allegation that the Respondent registered the domain name in bad faith; and*
- *an allegation that the Respondent's registration of the domain name did not comply with certain of the auDA Domain Name Eligibility and Allocation Policy Rules.*

- 9.2 *In support of its allegation that the warranties made by the Respondent at the time that it applied for the registration of the domain name www.billingbureau.com.au were incorrect, the Complainant refers to the fact that the Respondent was, at the time that the Respondent registered the domain name, the proprietor of a Victorian registered business name. The Respondent does not deny the existence of the Respondent's registered business name, but had no knowledge of that registration at the time that it applied to register the domain name.*
- 9.3 *The Respondent submits that while the Complainant had registered the business name THE BILLING BUREAU before the Respondent registered the domain name www.billingbureau.com.au, this does not of itself mean that the Respondent was not entitled to register that domain name. It merely illustrates that the Complainant had an entitlement to register the domain name itself, something which it failed to do. However, this does not mean that the Respondent which, as acknowledged by the Complainant, is a direct competition of the Complainant providing the same services, was not entitled to register the domain name when it did.*
- 9.4 *The Respondent submits that even if it had known of the Complainant's business name registration, the Respondent would not have taken the existence of that registration per se as indicating that the Complainant had any rights in the name "billing bureau" which would be infringed upon or otherwise violated by the registration of the domain name.*
- 9.5 *The words "billing bureau" are words which directly describe the service of the provision of billing bureau services. In the Respondent's view, because of their direct descriptiveness, they are not words with trade mark or trade name significance and the Complainant thus had/has no rights in that name. By way of analogy, every shoe shop would use the word "shoes" in connection with its business. A shoe shop may also have registered the word "Shoes" as a business name. However, that does not mean that a shoe shop which had registered the business name "Shoes" somehow has obtained rights in that name.*
- 9.6 *Accordingly, the fact that the Complainant had registered the name "The Billing Bureau" as a business name in Victoria did and does not give the Complainant any rights in those words when they are used descriptively. A business name registration does not mean that there has been any determination by any competent authority that the Complainant has any rights in the words "billing bureau" in respect of billing bureau services, or that it had or has any entitlement to prevent other traders in billing bureau services from using those words to describe their similar services.*
- 9.7 *The notion that directly descriptive words have no trade mark significance is reflected in section 41 of the Trade Marks Act 1995 which prevents the registration of trade marks if such marks are "not capable of distinguishing the*

applicant's goods or services in respect of which the trade mark is sought to be registered ... from the goods or services of other persons". The same Act indicates that "trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate "the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services". It is the Respondent's contention that the words "billing bureau" fall into this category when they are applied to billing bureau services.

- 9.8 *The Complainant has referred to two of its trade mark applications. The first of these applications, an application for the registration of the words "The Billing Bureau" as a trade mark (application No. 1011307), was lodged some 10 months after the Respondent registered its domain name. The other, an application for the registration of a logo incorporating the words "The Billing Bureau" (application No. 1039838) was lodged on 1 February 2005 nearly 18 months after the domain name was registered. The Complainant alleges that the Respondent should have known when it registered its domain name in 2003 that the Complainant was likely to apply for the registration of the name "THE BILLING BUREAU" as a trade mark. The Respondent submits that no valid objection to the registration of a domain name can be based on a person's alleged failure to gaze into a crystal ball. In addition, knowing that the words "billing bureau" were wholly descriptive and thus not registrable for the services they describe, the Respondent could not have harboured any suspicion either that the Complainant would attempt to register those words as a trade mark, or that it had any rights in those words.*
- 9.9 *The Respondent notes that the Complainant's application for the registration of a logo incorporating the words "Billing Bureau" has not yet been examined by IP Australia, but that its application for the registration of "The Billing Bureau" as a trade mark has been examined and that an adverse examination report was issued on 9 November 2004. Annexed and marked "A" is a copy of an extract from the Australian Trade Marks Register showing the details of the Complainant's application to register "The Billing Bureau", together with a listing of the history of that application showing the date of the adverse report and indicating that no response has been lodged in relation to it.*
- 9.10 *The Complainant makes reference to this in its Complaint, but does not refer to the basis of IP Australia's objection. In the Respondent's view, because of the descriptiveness of the words "The Billing Bureau" in relation to the services claimed in the Complainant's trade mark application, it is likely that IP Australia has taken the view that the words "The Billing Bureau" have insufficient distinctiveness for registration as a trade mark and that other traders should be entitled to use those words to describe their similar services. The Respondent submits that this is precisely the reason that the second application for the registration of a logo device would have been lodged by the*

Complainant, as such an application would have a greater chance of achieving a registration than an application for the bare words “The Billing Bureau”.

- 9.11 *In addition, the Respondent notes the Complainant’s claim to have answered the initial adverse examination report in respect of the Complainant’s trade mark application No. 1011307 and its claim to be awaiting a response.*

Annexed as part of Exhibit “A” is a listing of the history of activity in relation to that trade mark application as taken from the official IP Australia record. The respondent notes an entry in that history for IP Australia’s adverse report dated 9 November 2004, but no record of any response by the Complainant.

The documents comprising Exhibit “A” were printed by us on 7 April 2005, showing the history of the application as at that date, while a copy of the Complaint making the claim that the Complainant had answered IP Australia’s adverse report was transmitted to the Respondent on 11 March 2005, nearly a month earlier.

We are experienced trade mark lawyers and our experience shows that if there had been any such response it would have appeared on the history listing within 3-4 days of its receipt by IP Australia. We thus believe that no such response had been filed with IP Australia at the time that the Complainant claimed to have filed such a response.

- 9.12 *As indicated by the Complainant, it and the Respondent are direct competitors. For this reason, the Respondent has visited the Complainant’s website www.objware.com.au on many occasions and has done so fairly regularly. On the last such occasion prior to being notified of this dispute, the Respondent visited the Complainant’s website in the latter part of 2004 but did not see any evidence of non-descriptive use of the words “billing bureau” on that website. The Respondent was similarly not aware of any other non-descriptive use of those words by the Complainant at any earlier time which might have given rise to rights in those words.*

- 9.13 *The Respondent’s attorneys have conducted a search of the Complainant’s website as archived and as retrieved by the Internet Wayback Machine search engine (located at <http://www.archive.org/web/web.php>). Annexed and marked “B” is a copy of the search results obtained by using the Internet Wayback Machine search engine in respect of the Complainant’s website www.objectware.com.au. That search indicates that the Complainant’s website was last updated on 20 July 2003, 2 months before the Respondent applied to register its domain name.*

- 9.14 *Annexed and marked “C” is a copy of the Complainant’s website much as it appeared on 20 July 2003 (as revealed by the Internet Wayback Machine search engine). The respondent submits that while these web pages refer variously to “ObjectiveWare’s bereau [sic] service” and “the bureau”, the only reference to*

the words “billing bureau” or “bureau service” are descriptive in the same way that the words “custom application development” and “web hosting” are used descriptively. It is clear from these pages that the Complainant’s billing services trade mark in July 2003 was not “billing bureau”, but “BEN”, or the “BEN Billing System”. Certainly, the Respondent submits, there is no evidence of trade mark use of the words “billing bureau” by the Complainant and no inference could be drawn from that website that the Complainant had any rights in those words at that time.

- 9.15 The Complainant has indicated that it has “been trading with the name billing bureau” in relation to telecommunications billing services for many years. Annexed and marked “D” is a copy of an email printed from the Respondent’s email records concerning the “AusBilling 2003” conference/exhibition, held in Melbourne on 17 September 2003. The Complainant promoted its billing products at that conference/exhibition, and was heavily involved with that conference/exhibition. In fact, Mr David Werdiger of ObjectiveWare was a featured speaker and delivered the opening remarks from the Chair. The attachment to the Annexure “D” email is a copy of the promotional brochure and program for the conference/exhibition. It should be noted that nowhere in the brochure/program can be found any reference to the use by the Complainant of the business name THE BILLING BUREAU. All references are to ObjectiveWare. The Respondent submits that if the Complainant had been trading under the name THE BILLING BUREAU in September 2003 it would be reasonable to expect that it would have been promoting that name at the “AusBilling 2003” conference/exhibition.*
- 9.16 The Respondent does not dispute that the Complainant has used the words “billing bureau” in its business, as has the Respondent, but certainly disputes that the Complainant has built up any rights in relation to those descriptive words and disputes that the Complainant had been trading under that name when the Respondent registered its domain name.*
- 9.17 The Complainant has annexed three documents to its complaint which it states are evidence of the use of “Billing Bureau” by the Complainant (see the Complainant’s Annexures D, E and F). The Respondent submits that these documents should be disregarded because they are undated (in the case of Annexures D and F), and dated 11 March 2005 (in the case of Annexure E). The Complainant asserts that these documents were published in 1999 and 2000, but it provides no proof that this was the case.*
- 9.18 The Respondent has certainly never seen these or any similar documents. However, this is not surprising as far as at least Annexure D (a private letter purportedly between the Complainant and a potential client) and Annexure E (a document marked “Commercial in Confidence”) are concerned.*

9.19 *The Complainant has alleged that the Respondent registered its domain name in bad faith. There is no allegation that the Respondent subsequently used its domain name in bad faith. As evidence of bad faith registration the Complainant has asserted that none of the Respondent's literature, or its website, refer to billing bureau services.*

9.20 *Annexed and marked "E" are a number of pages printed from the Respondent's website at www.billingbureau.com.au. A perusal of those web pages reveals the following references:*

"Selcomm™ ASP/bureau" (in the context of "Billing and CRM solutions", "Customer care and billing software", "billing and customer care modules" and "complete outsourced billing and customer care services");

"Telecom Billing and CRM ASP/bureau" (in the context of the Respondent's clients' "customer care and billing requirements", a "Customer Care and Billing system", and a "Customer Care and Billing solution" provided by the Respondent); and

"Selcomm™ Telco Billing and CRM ASP/bureau" and an "ASP/Telecom bureau service" (in the context of the "Selcomm™ Billing and Customer Care" client solution, the provision of "billing and associated services", "billing and customer care systems", "telco billing software" and "Outsourced Telco Billing Services" to clients).

The Respondent submits that these references show that it is providing billing bureau services to its clients.

9.21 *In addition, the Respondent submits the materials referred to below. In some cases, because of confidentiality considerations, only selected pages/parts of the original documents referred to below have been provided. In other cases, pages/parts of documents have been redacted so as to obliterate confidential material such as confidential business information belonging to the Respondent, the identity of the Respondent's customers or potential customers, or details of costings etc. For ease of reference, the pages in the annexures referred to below have been hand numbered.*

The Respondent's representatives hold un-redacted copies of the material referred to below and the Respondent would be prepared to allow the panellist appointed under the auDA rules to view that material, provided that the panellist agreed to be bound by a signed undertaking to keep this information confidential.

The Respondent submits the following materials:

- *annexed and marked "F" are a number of pages taken from a document entitled "Selcomm Implementation Paper" prepared and sent by the Respondent to a potential customer. While the first page shows the date*

on which the document was printed (5 April 2005), the full implementation document was actually sent to the potential customer in March 2003. Page 2 of Annexure F refers to “Bill Run Service” and “Customer Billing”, while pages 3 and 5 refer to Select’s “Billing Bureau Service” and “Billing Bureau Service Offering”;

- annexed and marked “G” are three pages taken from a Master Services Agreement dated 21 March 2003 under which the Respondent agreed to provide “Bureau Services” to its customer. Page 1 of the annexure shows that “Bureau Services” are to be provided and that “Bureau Charges” are to be paid. Page 2 shows some of the clauses of the agreement dealing with “Bureau Services” and page 3 lists some of the “Bureau Services” to be provided, including “bill run services”;
- annexed and marked “H” is a quotation dated 21 May 2003 for the provision of a “Billing Bureau Service” by the Respondent to a customer. There is a reference to this service in the Project Name field;
- annexed and marked “I” are nine pages taken from a document entitled “Response to RFI” dated 29 May 2003 under which the Respondent provide further information to its potential customer in connection with the supply of systems and services by the Respondent. Pages 2 to 6 of the annexure refer to billing and bill run services, and page 5 indicates that the Respondent’s solutions can be provided on either a licence basis or via the Respondent’s ASP/bureau. Page 7 is a listing of the Respondent’s customers as at 29 May 2003, clearly showing that a number of customers use the Respondent’s “Bureau Services”. Page 8 refers to the provision of a pricing structure by the Respondent in relation to “an ASP fully managed bureau service”, and page 9 is the Respondent’s “bureau pricing schedule”;
- annexed and marked “J” is a quotation dated 1 July 2003 for the provision of a “Billing System Bureau Service” by the Respondent to a customer. There is a reference to this service in the Project Name field;
- annexed and marked “K” is a quotation dated 17 October 2003 for the provision of a “Billing Bureau Service” by the Respondent to a customer. There is a reference to this service in the Project Name field; and
- annexed and marked “L” is a copy of an open letter dated 26 May 2003 from one of the Respondent’s customers, iTEL Community Telco Limited, indicating that iTEL started using the Respondent’s system as its billing platform in early 2002, and that the Respondent had offered it the option of a “bureau service or in-house operation” of the system.

9.22 The Respondent submits that these documents show that it has been providing billing bureau services for some years, including before it applied for the

registration of its domain name. The Respondent continues to have many customers to whom it is providing billing bureau services and is actively continuing to promote such services.

9.23 In addition, in registering its domain name, the Respondent had in mind a plan to develop a dedicated website in relation to its billing bureau services. The Respondent still has plans to do this as soon as its other business commitments permit.

9.24 In conclusion, the Respondent submits that the Complainant's case is without merit. While the Complainant and the Respondent are competitors offering competing billing bureau services, the Complainant has failed to show any evidence of bad faith on the part of the Respondent. It has not provided any evidence of any reputation in the descriptive words "billing bureau", or any evidence that the Respondent has acted in any improper manner in registering or using its domain name.

9.25 On the other hand, the Respondent has shown that it was entitled to register its domain name by virtue of having offered billing bureau products and services to its clients for a number of years, including before applying to register its domain name. It has also demonstrated that it is continuing to provide such products and services today.

9.26 The Respondent therefore submits that the complaint should be dismissed.'

6.3 I note that, as at 27 April 2005, the material at the Claimant's site www.objware.com.au now carries a banner heading '**Billing Bureau**', in contrast to its appearance as noted in Annexure C to the Respondent's submissions.

7 DETERMINATION

7.1 After considering the submissions by the parties and the documentary material in the annexures to those submissions, as well as the matters referred to in paragraphs 5.4 and 6.3 above, I find that the Complainant is not entitled to the relief which it seeks, more particularly for the reasons referred to in paragraphs 7.2 to 7.16 below.

Paragraph 4a(i) of the Rules - Whether the domain name is identical or confusingly similar to a name etc in which the Complainant has rights

7.2 I accept that the Complainant has rights in the name '*The Billing Bureau*' from registration of that business name in Victoria on 5 March 1999. I reject the Respondent's submissions to the contrary, more particularly in paragraphs 9.5 and 9.6 of the Response.

7.3 I do not accept that the Complainant has rights in the name '*The Billing Bureau*' or the term '*billing bureau*' from lodgement of applications for trademarks in 2004 and 2005. I accept the

Respondent's submissions in that regard, more particularly in paragraphs 9.7 to 9.11 of the Response.

- 7.4 I do not accept that the Complainant has rights in the term '*billing bureau*', from its trading with that name '*for many years*' or otherwise. Those are descriptive words and I accept the Respondent's submissions in that regard, more particularly in paragraphs 9.5, 9.6 and 9.15 to 9.17 of the Response.
- 7.5 I do not accept that the domain name www.billingbureau.com.au is identical to the business name '*The Billing Bureau*', in which the Complainant has rights.
- 7.6 Although the issue of whether the domain name www.billingbureau.com.au is confusingly similar to the business name '*The Billing Bureau*' is one which is more finely balanced, I am not satisfied that the Complainant has discharged the necessary onus of proof. It appears unlikely to me that a reasonable person in the market for services of the type offered by the Complainant and the Respondent would be confused.
- 7.7 Accordingly, I am not persuaded that the Complainant has satisfied the requirements of sub-paragraph (i) of paragraph 4a of the Rules.

Paragraph 4a(ii) of the Rules - Whether the Respondent has no rights or legitimate interests in respect of the domain name

- 7.8 I note what is said in paragraph 4c of the Rules regarding a respondent demonstrating rights to, or legitimate interests in, the domain name in dispute. While paragraph 4a of the Rules provides that a complainant bears the probative onus of establishing its case, it is reasonable to proceed on the basis that a respondent which relies on paragraph 4c of the Rules bears an evidentiary onus in respect of matters it seeks to demonstrate under sub-paragraphs (i), (ii) or (iii) of paragraph 4c.
- 7.9 I am satisfied from the evidence that the Respondent has demonstrated its rights or legitimate interest in the domain name www.billingbureau.com.au, by establishing the matters in sub-paragraph (i) of paragraph 4c, namely:

'before any notice to you of the subject matter of the dispute, your bona fide use of, or demonstrable preparations 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 that you have acquired for the purpose of selling, renting or otherwise transferring);'

- 7.10 In particular, I refer to the evidence in Annexures F, G, H, H, I, J, K and L of the Response. I accept the submissions in paragraphs 9.21 and 9.22 and 9.25 of the Response.
- 7.11 Accordingly, I am not persuaded that the Complainant has satisfied the requirements of sub-paragraph (ii) of paragraph 4a of the Rules.

Paragraph 4a(iii) of the Rules - Whether the domain name has been registered or subsequently used in bad faith

7.12 Contrary to what is put in paragraph 9(e) of the Complaint, I am not satisfied from the evidence that:

'The Respondent registered the Domain Name in bad faith under Rule 4(b) of Schedule A of the auDRP in that it did so:

- (i) expressly in order to prevent the Complainant from reflecting that name or mark in a corresponding domain name; or*
- (ii) primarily for the purpose of disrupting the business or activities of the Complainant; or*
- (iii) intentionally attempted to attract, for commercial gain, internet users to its website (selectsoftware.com.au to which the Domain Name resolves) by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website or the telecommunications billing services referred to on the Respondent's website.'*

7.13 There is simply no evidence which satisfies the onus of proof which the Claimant bears in this regard. In addition, there is no inference reasonably available from the evidence before me which would satisfy that onus of proof, wholly or in part.

7.14 The auDA *'Guidelines for Accredited Registrars on the Interpretation of Policy Rules for Open 2LDs (2002-17)'* were in force when the domain name was registered in about September 2003. Having considered those Guidelines, more particularly the provisions of paragraphs 9.1 to 9.7 and the examples of close and substantial connection set out in Table C, I am satisfied that the Respondent satisfied the criteria for *'close and substantial connection'* in registering the domain name www.billingbureau.com.au. I particularly note that no submission to the contrary is made in the Complaint in which it is said, rather tellingly, in paragraph 9(g) that *'(a)t no time did the Respondent comply with the requirements of 9(f)(i) through (iii) above'*, which ignores the *'close and substantial connection'* provisions which are referred to in paragraph 9(f)(iv).

7.15 Accordingly, I reject the submissions in paragraphs 9(b) and (g) of the Complaint, which are apparently relied upon to underpin the assertion of bad faith.

7.16 It follows that I am not persuaded that the Complainant has satisfied the requirements of subparagraph (iii) of paragraph 4a of the Rules.

8 DECISION

- 8.1 As indicated in paragraphs 7.1 to 7.16 above, the Panel finds that the Complainant has not established any of the three elements which it must satisfy pursuant to sub-paragraphs (i), (ii) or (iii) of paragraph 4a of the Rules.
- 8.2 Accordingly, the Complainant's claim for relief is denied and the license for the domain name www.billingbureau.com.au should remain with the Respondent.

Robert Hunt

Sole Panelist

28 April 2005