

THE
INSTITUTE of
ARBITRATORS & MEDIATORS
——
AUSTRALIA

.au Dispute Resolution Provider

ADMINISTRATIVE PANEL DECISION

Single Panelist Decision of Stephen Semple

in the matter of

Hytorc South Pacific Pty Ltd

v

Byron Howell

Reference: IAMA 2865

1 THE PARTIES

- 1.1 The Complainant is Hytorc South Pacific Pty Ltd (ABN 31 059 625 204) of 6 Eton Road, Keswick, South Australia, 5035, Australia (the "Complainant").
- 1.2 The Respondent is Bryon Howell (ABN 18 149 030 175) (the "Respondent") c/- TorcUP Inc, 1025 Conroy Place, Easton, PA, 18040, USA ("TorcUP").

2 THE DOMAIN NAME AND REGISTRAR

- 2.1 The domain name at issue is www.hytorc.com.au (the "Disputed Domain Name"), and is currently registered by the Respondent.
- 2.2 The Registrar of the Disputed Domain Name is Melbourne IT Limited, Registrar ID R00010-AR.

3 DISPUTE RESOLUTION PROVIDER AND PANEL

- 3.1 au Domain Administration Limited (the "auDA"), are the policy authority and industry self-regulatory body for the .au domain space.
- 3.2 The Institute of Arbitrators and Mediators Australia ("IAMA") is a dispute resolution service provider ("Provider") approved by auDA.
- 3.3 Under cover of a letter dated 16 August 2005, the Complainant submitted a complaint concerning the registration of the Disputed Domain Name (the "Complaint") to the IAMA for resolution in accordance with the .au Dispute Resolution Policy (the "auDRP"), adopted by the auDA on 13 August 2001 and which commenced operation on 1 August 2002, the rules contained within Schedule B of the auDRP (the "auDRP Rules"), and the supplementary rules to the auDRP of the IAMA (the "auDRP Supplementary Rules").

3.4 The Complainant elected to have the Complaint decided by a Panel comprising a single member, and by instrument dated 2 September 2005 the President of the IAMA appointed Mr Stephen Semple as the Panelist.

4 PROCEDURAL HISTORY

4.1 From documentation available to the Panelist the procedural history is determined as follows:

4.1.1 The auDA advised the Complainant on 5 August 2005 that the creation date of the Disputed Domain Name was 30 November 2003 and the Disputed Domain Name is subject to a mandatory administrative proceeding under the auDRP.

4.1.2 The Complainant submitted the Complaint to the Provider on 16 August 2005.

4.1.3 The Provider sent a copy of the Complaint to the Respondent on 29 August 2005.

4.1.4 The Respondent replied to the Provider (the "Response") on 2 September 2005.

4.1.5 On 2 September 2005 the Complaint and the Response was provided to the Panelist.

4.1.6 On 7 September 2005 the Panelist, in accordance with paragraph 12 of the auDRP Rules, requested that the Provider seek further statements from the Complainant on why it claims to have rights to the Disputed Domain Name, and also requested that the Provider seek a reply from the Respondent on those further statements from the Complainant.

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- 4.1.7 On 13 September 2005 the Complainant emailed its further statements ("Complaint's Further Statements 1") directly to the Panelist, copied to the Provider.
- 4.1.8 On 14 September 2005 the Panelist copied the Complaint's Further Statements 1 to the Provider, and in accordance with paragraph 12 of the auDRP Rules, requested additional further statements from the Complainant on why it claims to have rights to the Disputed Domain Name, and the Panelist provided a copy of the same to the Provider with a request that the Provider provide the Respondent with a copy of those communications, and to seek the Respondent's reply.
- 4.1.9 On 14 September 2005 the Complainant emailed its further statements ("Complainant's Further Statements 2") directly to the Panelist, copied to the Provider.
- 4.1.10 On 23 September 2005 the Panelist requested the Provider remind the Respondent that it was waiting a reply to the Complainant's Further Statements 1 and the Complainant's Further Statements 2 from the Respondent.
- 4.1.11 On 1 November 2005 the Provider provided the Panelist with the Respondent's reply ("Respondent's Further Statement").

5 THE COMPLAINANT'S CASE

- 5.1 In its written submissions comprising the Complaint, the Complainant's Further Statements 1 and the Complainant's Further Statements 2, the Complainant alleges that:
- 5.1.1 The Disputed Domain Name is identical to a name or trade mark in which the Complainant has rights.

- 5.1.2 The Respondent "has no rights or legitimate interests in respect of" the Disputed Domain Name
- 5.1.3 The Respondent as registered owner of the Disputed Domain Name "has had that domain name registered, or subsequently used, in bad faith".
- 5.1.4 The Respondent "is using the HYTORC trademark name to purposely to (sic) gain sales inquires and generate revenue by means of deceit".
- 5.1.5 Hytorc and TorcUP are competitors in the market place.
- 5.1.6 The Respondent was employed as a sales associate by the Complainant from 21 January 2002 until September 2002
- 5.1.7 The Respondent is currently involved (in a capacity which is not clear from the submissions of the Complainant and the Respondent) with TorcUP, and is based in the USA.
- 5.1.8 The Respondent is registered as a sole trader in Australia and has been issued an ABN number.
- 5.1.9 Hytorc is a division of "Hytorc NJ" a USA based corporation, and Hytorc NJ is in turn a division of the Unex Corporation, another USA based corporation. Hytorc, Hytorc NJ and Unex Corporation are all owned by Mr John Junkers, a citizen of the USA
- 5.1.10 The domain name www.hytorc.com is currently being used by Hytorc NJ.
- 5.1.11 The remedy sought is the transfer of ownership of that Disputed Domain Name to the Complainant "as Hytorc are eligible to hold that domain name".

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5.2 In its written submissions comprising the Complaint, the Complainant's Further Statements 1 and the Complainant's Further Statements 2, the Complainant provided the following documents in support of its allegations:

5.2.1 Certificate of Registration Number 2,130,443 issued by the USA Commissioner of Patents and Trademarks on behalf of the United States Patent and Trademark Office concerning the granting of the trademark "HYTORC" to Unex Corporation 333 Route 17 North, Mahwah, NJ 07430 USA on 20 January 1998.

5.2.2 Certificate of Registration Number 583747 issued by the Registrar of Trade Marks on behalf of the Commonwealth of Australia Trade Marks Office concerning the granting of the trade mark "HYTORC" to Unex Corporation 120 Wesley Street, South Hackensack, NJ 07606 USA on 4 August 1992.

5.2.3 A letter dated 31 January 2002 from IP Australia, Trade Marks Office, Discovery House, Phillip, ACT 2605 headed 'Notice of Renewal of Registration, Re: Trade Mark No 583747, Unex Corporation' indicating that the Australian registered trade mark referred to in paragraph 5.2.2 had the date of registration renewed to 4 August 2012.

6 THE RESPONDENT'S CASE

6.1 In its written submissions comprising the Response and the Respondent's Further Statement, Mr John Kovacs, President of TorcUP in the USA, on behalf of the Respondent, alleges that:

6.1.1 The Complainant is "not aware of Trademark Registrations themselves and of abiding by Trademark Registration laws".

6.1.2 The "term TorcUP is a trademark protected phrase".

- 6.1.3 The phrase "TorcUP is listed within the source code of" the web sites www.hytorc-sales.com and www.hytorcsouthpacific.com.au "both of these [web sites] being registered" to the Complainant.
- 6.1.4 "Hytorc themselves are showing a direct relation to TorcUP through their Source Code at their sites. Thus, this is why TorcUP is directly linked to" the Disputed Domain Name
- 6.1.5 The "Source Code" reference to TorcUP "is direct proof that Hytorc is in direct relation (sic) to TorcUP and thus the reason why the [Disputed Domain Name] can point to either TorcUP or Hytorc".
- 6.1.6 "Also as you stated the registered and trademarked named (sic) of HYTORC is that of a US Based company and NOT that of an Australian division that is using the name in commerce. Any and all disputes should be handled in a US court of law".

7 DETERMINATION

- 7.1 After considering all submissions made by the parties including all documentary material provided as part of those submissions, I find that the Complainant is entitled to the relief which it seeks, more particularly for the reasons referred to in paragraphs 7.2 to 7.20 below.

Jurisdiction

- 7.2 The Respondent has stated that "any and all disputes should be handled in a US court of law", as described at paragraph 6.1.6.
- 7.3 I disagree with that contention, and find that the Panel has jurisdiction to hear and determine this dispute in accordance with the auDRP, for the following reasons:
- 7.3.1 At paragraphs 3.1 and 4.1.1, I referred to the fact that the auDA are the policy authority and industry self-regulatory body for the .au

domain space, and the auDA have advised that the Disputed Domain Name is subject to a mandatory administrative proceeding under the auDRP.

- 7.3.2 Paragraph 1.3 of the auDRP states *inter alia* that "[t]he auDRP is an adaptation of the Uniform Dispute Resolution Policy (UDRP) administered by the Internet Corporation for Assigned Names and Numbers (ICANN) with respect to the global Top Level Domains".
- 7.3.3 Note 2 to Schedule A of the auDRP states *inter alia* that "this policy is intended to operate between the registrar and its licensee (the domain name holder or registrant)".
- 7.3.4 Paragraph 1 of Schedule A to the auDRP states *inter alia* that: "[t]he au Dispute Resolution Policy is incorporated by reference into your Registrant Agreement, and sets forth the terms and conditions in connection with a dispute between [the domain name holder] and any party other than [the Registrar] over the registration and use of an Internet domain name registered by [the domain name holder] in one of the open au second level domains"
- 7.3.5 Paragraph 4 of Schedule A to the auDRP states *inter alia* that: "[t]his paragraph sets forth the type of dispute 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." This same paragraph also states *inter alia* that:

"[The domain name holder is] 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:

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- (i) *your domain name is identical or confusingly similar to a name, 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; and*
- (iii) *your domain name has been registered or subsequently used in bad faith."*

and the Complainant has so asserted to the Provider as described at paragraphs 5.1.1 to 5.1.3 of this decision.

Paragraph 4a(i) of Schedule A of the auDRP – Whether the domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights"

- 7.4 I accept that the Complainant has rights in the trademark Hytorc from having a current registration for that trademark in Australia, in the name of its parent company Unex Corporation.
- 7.5 I accept from the evidence that the Complainant, either by itself or through its parent company, has a legitimate right to use the domain name www.hytorc.com, and I find that such domain name is either identical or confusingly similar to the Disputed Domain Name.
- 7.6 I find that the Disputed Domain Name is substantially identical to the Australian registered trade mark Hytorc, to which the Complainant has rights.
- 7.7 I reject the Respondent's submissions to the contrary.
- 7.8 Accordingly, I conclude that the Complainant has satisfied the requirements of paragraph 4a(i) of Schedule A of the auDRP

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Paragraph 4a(ii) of Schedule A of the auDRP – Whether the Respondent has no rights or legitimate interests in respect of the domain name

- 7.9 I note what is said in paragraph 4c of Schedule A of the auDRP regarding a respondent demonstrating rights to, and legitimate interest in, the domain name in responding to a complaint. While paragraph 4a of Schedule A of the auDRP states that the Complainant “*bears the onus of proof*”, paragraph 4c of Schedule A of the auDRP states: “*[a]ny of the following circumstances [as identified at paragraphs 4c(i) to (iii) of Schedule A of the auDRP], 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 [the Respondent’s] rights or legitimate interests to the domain name for the purposes of paragraph 4(a)(ii) [of Schedule A of the auDRP]*”.
- 7.10 I accept from the evidence that the Complainant and the Respondent are separate companies and are in competition in the market place.
- 7.11 I accept from the evidence that the Respondent is using the Disputed Domain Name to redirect internet traffic from the Complainant to the Respondent’s web site.
- 7.12 I reject as wrong in law, the Respondent’s assertion that because the Complainant makes reference to the Respondent’s trade mark in the “Source Code” of a web site owned by the Complainant (and upon which I make no finding because that is a matter outside the scope of this dispute), that creates a legitimate right in the Respondent to direct internet traffic from the Disputed Domain Name “to either TorcUP or Hytorc”.
- 7.13 From the evidence I do not find that the Respondent has engaged in “bona fide use of” the Disputed Domain Name “in connection with an offering of goods or services” as stated at paragraph 4c(i) of Schedule A of the auDRP.

- 7.14 From the evidence I do not find that the Respondent has been "commonly known by the [Disputed Domain Name], even if [the Respondent has] acquired no trade mark or service mark", as stated at paragraph 4c(ii) of Schedule A of the auDRP.
- 7.15 From the evidence I do not find that the Respondent is "making a legitimate non-commercial or fair use of the [Disputed Domain Name] without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue", as stated at paragraph 4c(iii) of Schedule A of the auDRP.
- 7.16 Accordingly, I conclude that the Complainant has satisfied the requirements of paragraph 4a(ii) of Schedule A of the auDRP.

Paragraph 4a(iii) of Schedule A of the auDRP – Whether the Disputed Domain Name has been registered or subsequently used in bad faith

- 7.17 I note what is said in paragraph 4b of Schedule A of the auDRP regarding evidence of registration or use in bad faith, and that if any of the circumstances set out in paragraph 4b(i) to (iv) of Schedule A of the auDRP are found by the Panel, then that shall be evidence of the registration and use of a domain name in bad faith
- 7.18 From the evidence I accept that the Respondent is using the Disputed Domain Name in order to prevent the Complainant (or its parent company), as owner of the Hytorc trademark, from reflecting that trade mark in a corresponding domain name. I find that this is why the Respondent has registered the Disputed Domain Name, and therefore find that paragraph 4b(ii) of Schedule A of the auDRP has been made out.
- 7.19 From the evidence I accept that the Respondent is using the Disputed Domain Name to direct sales inquires to its business and to generate revenue for itself, and for that reason I find that the Respondent has

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registered, the Disputed Domain Name primarily for the purpose of disrupting the business activities of another person, and therefore find that paragraph 4b(iv) of Schedule A of the auDRP has been made out.

7.20 Accordingly, I conclude that the Complainant has satisfied the requirements of paragraph 4a(iii) of Schedule A of the auDRP.

8 DECISION

8.1 The Complainant has made out each of the three elements required by paragraph 4a of Schedule A of the auDRP.

8.2 Accordingly, the Complainant's claim for relief is granted, and the Disputed Domain Name is to be transferred by the Registrar to the Complainant.



Stephen Semple

Lawyer, Engineer & Arbitrator

Sole Panelist

9 November 2005.