



auDRP01/08

Domain Name: *marinebusiness.com.au*
Name of Complainant: *Yaffa Publishing Group Pty Ltd*
Name of Respondents: *CA, PD and RD Scott trading as GO BOATING PUBLICATIONS [ABN 5689116076]*
Provider: *LEADR*
Panel: *Philip N Argy*

1. The Parties

- 1.1 The complainant in this proceeding is Yaffa Publishing Group Pty Ltd (the "Complainant").
- 1.2 The respondents to this proceeding are CA Scott, PD Scott and RD Scott in their capacity as joint proprietors of the business name GO BOATING PUBLICATIONS with an Australian Business Number of 5689116076 (the "Respondents").

2. The Domain Name, Registrar and Provider

- 2.1 The domain name subject to this proceeding is "marinebusiness.com.au" (the "Domain Name").
- 2.2 The registrar of the Domain Name is Melbourne IT (the "Registrar").
- 2.3 The provider in this proceeding is LEADR of Level 9, 15 - 17 Young Street, Sydney, NSW, 2000, AUSTRALIA (the "Provider").

3. Procedural Matters

- 3.1 This proceeding relates to the Complaint submitted by the Complainant in accordance with:
 - i) the .au Dispute Resolution Policy No. 2002-22 (the "auDRP") published on 25 July 2002 which includes: Schedule A ("Policy") and Schedule B ("Rules"); and
 - ii) the Provider's Supplemental Rules for au Domain Name Dispute Policy.

- 3.2 The Provider supplied the Panel with a summary document entitled “Procedural History”. According to this document, the Complaint was lodged with the Provider on 13 June 2008.
- 3.3 The Provider mailed a copy of the Complaint and a Notice of Dispute to the Respondents via express post on 17 June 2008.
- 3.4 The Registrar was notified of the Complaint by email on 17 June 2008 and locking of the Domain Name was confirmed by that Registrar on 19 June 2008.
- 3.5 The Response was due on 9 July 2008. It was in fact received on 7 July 2008 from Guy Hinton, a law firm representing the Respondents.
- 3.6 The Panel was approached on 8 July 2008 and, having confirmed that there was no conflict of interest, was duly appointed on 9 July 2008.
- 3.7 All other procedural requirements appear to have been met.

Factual Background and submissions

Facts alleged by the Complainant

- 4.1 The following salient facts are alleged by the Complainant.
- 4.2 The Complainant has published monthly to the marine industry for the last eight years a magazine called *Marine Business*. It currently has an audited circulation in Australia of around 4,000 copies (up from 3,177 in October 2005).
- 4.3 The Respondents publish a directly competing magazine called *Boating Business*. It was launched approximately two years ago. Its associated website is at www.boatingbusiness.com.au.
- 4.4 The Domain Name was registered on 17 March 2006 and has since then always been pointed to www.boatingbusiness.com.au.

Complainant’s Contentions

- 4.5 The Complainant contends that the Domain Name is identical to the name of its *Marine Business* magazine and that the name of its magazine is a common law trade mark in which it has rights derived from eight years of usage in the marine industry.
- 4.6 The Complainant next contends that the Respondents have no rights or legitimate interests in respect of the Domain Name either in fact, or by virtue of paragraph 4(c) of the Policy, because they are not known by that name, are not bona fide using that term in connection with an offering of goods or services, do not use the term “marine business” anywhere except as part of the Domain Name, and that the term is not a generic equivalent to the more

apposite term “marine industry” which is the target demographic of both the Complainant’s and the Respondents’ magazines.

- 4.7 The Complainant also asserts that the Respondents are not making a legitimate non-commercial or fair use of the Domain Name as the Respondents registered the Domain Name in order to prevent the Complainant from registering it and/or in order to attract potential readers and advertisers away from the Complainant to its detriment.
- 4.8 In relation to the bad faith element of the Policy the Complainant asserts that the Respondents’ conduct has the requisite character because the Domain Name resolves to the Respondents’ *Boating Business* magazine website on which there is no reference to the term “marine business”, advertisers looking for the Complainant’s contact details by “guessing” its website name are mislead into thinking that the Respondents’ *Boating Business* website is the Complainant’s website, that as the Respondents have boatingbusiness.com.au already, which resolves to their *Boating Business* website, they have no need for the Domain Name, and that the Respondents’ claim that “marine business” is an appropriate generic term for them to use is not made bona fide.

Facts alleged by the Respondents

- 4.9 The Respondents registered the Domain Name on 17 March 2006.
- 4.10 The Respondents adopt and embrace the Complainant’s own description of its magazine as follows:

Marine Business is Australia’s leading boating business magazine... *Marine Business* is written for the manufacturers, suppliers, distributors and retailers of pleasure boats, boating equipment and components, marina operators and associated marine businesses

- 4.11 The Domain Name was registered “in order to redirect marine business enquiries” to the Respondents’ domain site www.boatingbusiness.com.au which deals extensively with the activities of marine businesses in Australia and overseas.

Respondents’ Contentions

- 5.1 The Respondents’ contentions are quite detailed.
- 5.2 They first contend that the term “marine business” is a generic term apt to describe the business carried on by the marine industry.
- 5.3 They submit that the Complainant has failed to establish that it has any trade mark or common law rights either in the name “marine business” or in a name identical or confusingly similar to the Domain Name. Moreover they say (in reference to Note 2 of the Policy) that the Complainant does not possess any company, business or other legal or trading name as registered with the

relevant Australian government authority for the generic words “marine business”.

- 5.4 The Respondents deny that “Marine Business” is a common law trade mark capable of distinguishing any of the Complainant’s goods and services (including, implicitly, its *Marine Business* magazine) from other goods or services in the Australian marine industry.
- 5.5 The Respondents claim to have “substantial and irrefutable rights and legitimate interests in respect of the [Domain Name]”. The Respondents operate a publishing business that publishes Australian marine magazines which cover various aspects of the marine industry. Such titles as produced by the Respondent are:
- Go Boating*
Go Fishing
Boating Business
Go Cruising
- 5.6 They say that “evident in the titles of the magazines is that all titles deal with elements of marine business within the marine industry”. The Respondents say that they clearly operate within the marine industry, and that their publications reflect their substantial involvement within the marine industry.
- 5.7 The Respondents consider their *Boating Business* magazine to be the Australian marine industry’s “flagship business magazine”. The Respondents also operate the domain website www.boatingbusiness.com.au, which, like their *Boating Business* magazine, “extensively covers the activities of marine businesses in Australia and overseas”.
- 5.8 The Respondents cite *TrueLocal Inc., Geosign Technologies Inc. and True Local Limited v. News Interactive Pty Limited*, WIPO Case No. DAU2006-0003, where the generic domain name <truelocal.com.au> was in issue. That panel said:

“In this case, it is important that the disputed domain name is comprised of generic words. Prior panel decisions have found that if a respondent is using a generic word to describe its product/business, or to profit from the generic value of the word without intending to take advantage of the complainant’s rights in that word, then it has a legitimate interest... In other words, it is not a general knowledge of the Complainant’s business that is important. It is knowledge of “the complainant’s rights in that word”.

- 5.9 The Respondents then assert that, “for the reasons submitted above”, the Complainant has no more rights than any other party operating in the marine industry in the generic term ‘marine business’.
- 5.10 The Respondents say that, before they received any notice of the subject matter of this dispute, they had a demonstrably bona fide use of the “domain names” in connection with an offering of goods or services pursuant to

para.4(c)(i) of the Policy which should be taken as a proven demonstration of legitimate rights and interests.

- 5.11 The Respondents say they have been using the Domain Name in connection with their business “since registration”. It is, they say, a legitimate use of the Domain Name to advertise the Respondent’s own publication, which offers services and news relating to marine business.
- 5.12 The Respondents deny that the Domain Name was acquired for the purposes of selling, renting or otherwise transferring it.
- 5.13 The Respondents submit that they have a legitimate interest to use the Domain Name because it is a generic and descriptive term, that the Complainant held no rights in the words at the time registered, and the Respondents had no knowledge of any rights, “as extremely unlikely as they may be”, being in existence in Australia, and that the Respondents have been engaged in a bona fide use of the Domain Name in connection with an offering of goods and services before they received any notice of this dispute.
- 5.14 The Respondents submit that the Domain Name “could not have been” registered in bad faith “due to the term ‘marine business’ being a generic name”. The generic and descriptive nature of the term ‘marine business’ was chosen, so the Respondents say, because they “offer various publications which serve as a news and information service to the marine business clients of the Respondents”.
- 5.15 The Respondents registered the Domain Name in order to “redirect” marine business enquiries to the Respondents’ “domain site www.boatingbusiness.com.au which deals extensively with the activities of marine businesses in Australia and overseas”.
- 5.16 The Respondents say that they registered a domain name with a descriptive term and that “many” UDRP panels have denied a finding of bad faith under the equivalent provision of paragraph 4(a)(iii) of the Policy where a descriptive term has been registered. See for example: <allocation.com> WIPO Case No D2000-0016 and <libro.com> WIPO Case No D2000-0186. The Respondents say that they did not register the Domain Name in bad faith and have not been using it in bad faith. auDRP and UDRP Panels have regularly upheld that respondents have a legitimate interest in a domain name, where generic or descriptive domain names have been used by the Respondent for offering goods or services. See for example <internet.com.au> WIPO Case No DAU2003-0005.
- 5.17 The Respondents submit that the registration of a generic term which aptly describes the field the Respondents offer services in, is evidence itself of a lack of registration in bad faith. The continuing use of the Domain Name to direct enquiries to the Respondents’ services is furthermore evidence in itself of a lack of subsequent use in bad faith.

- 5.18 auDRP and UDRP Panels have regularly upheld that respondents have a legitimate interest in a domain name, where generic or descriptive domain names have been used by the Respondent for offering goods or services.
- 5.19 See for example <internet.com.au> WIPO Case No DAU2003-0005.
- 5.20 Further and alternatively, even if the Panel were to infer that the Domain Name was registered and/or used in bad faith, which the Respondents strenuously deny, the Policy does not provide for the transfer of the domain name if the Respondents have legitimate rights and interest in the Disputed Domain Name. It was recognized in *Lonely Planet Publications Pty Ltd v. Mike Tyler* (WIPO Case No. D2004-0670) that even when the Panel finds that a domain was clearly registered and/or used in bad faith, the domain will not be transferred if the Complainant cannot prove its claim under paragraph 4(a)(ii) of the Policy. The Respondents submit that they have displaced their onus of refuting the allegations made by the Complainant and that the Respondents do have rights and legitimate interests in the Domain Name.
- 5.21 As such, the Respondents submit that the Panel cannot possibly infer that the Domain Name was either registered or subsequently used in bad faith, as the Respondents had rights and legitimate interests in the Domain Name and the registration and use of the Domain Name was undertaken as part of a legitimate business.

6. Discussion

- 6.1 Paragraph 15(a) of the Rules states:

“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

- 6.2 Paragraph 4(a) of the Policy provides that a person is entitled to complain about the registration or use of a domain name where:
- i) *the domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and*
 - ii) *the respondent to the complaint has no rights or legitimate interests in respect of the domain name; and*
 - iii) *the respondent’s domain name has been registered or subsequently used in bad faith.*

The Panel notes that all three components of Paragraph 4(a) are required to be proven for any Complaint to be upheld.

- i) **The Domain Name is identical or confusingly similar to a name or trade mark in which the Complainant has rights**

- 6.3 The Panel has compared the Domain Name with the name of the Complainant’s magazine *Marine Business* and finds it to be relevantly identical. So much could hardly be controversial.

6.4 The Panel also has no difficulty with the proposition that the Complainant, after eight years' publication of *Marine Business*, has rights in that name. The magazine has an audited circulation of 4,004 and the publisher claims a readership of some 14,000. The Panel has little doubt that the Complainant could, under the *Trade Practices Act, 1974*, for example, successfully restrain anyone else from commencing publication of another magazine under the same name directed at the same audience. According to the copies of *Marine Business* supplied with the Complaint, it had an audited circulation in October and November 2005 of 3,177.

6.5 The Panel considers that the Complainant has also acquired common law trade mark rights to *Marine Business* as the name of its magazine but, unlike the UDRP, the auDRP recognises rights in a name whether or not those rights are in the nature of trade mark rights. If Note 2 to the Policy means that the name of a magazine published by a complainant is not a name of the kind intended to be afforded protection under the Policy, the Panel formally finds that the Complainant has rights in the nature of common law trade mark rights in the name of its *Marine Business* magazine. It may well be, however, that even registration as a magazine with Australia Post would be sufficient to satisfy the Policy's 'requirement' for a name to be registered in some fashion to attract protection.

ii) Respondents have no legitimate rights or interest in respect of the Domain Name

6.6 The Complainant submits that the Respondents have no legitimate rights or interests in respect of the Domain Name. The Respondents submit to the contrary.

6.7 The Panel notes that the relevant rights or interests must be "in respect of" the Domain Name. That is not the same as showing legitimate rights or interests in the use of words that comprise the Domain Name. The Panel readily accepts that the Respondents are entitled to use the phrase "marine business" to describe facets of the business carried on in the marine industry, but that no more gives them the right to use the Domain Name than it gives them the right to use *Marine Business* as the name of their magazine. No doubt the Respondents would rightly complain if the Complainant registered boatingbusiness.net.au and directed it to its existing site. What seems to be the case is that the Complainant and the Respondents each operate websites that work in conjunction with their magazines. In the case of the Complainant, this site is at <http://marinebusinessmag.com.au> and, in the case of the Respondents, it is at the somewhat more intuitive <http://www.boatingbusiness.com.au/>. Whilst the Complainant might have chosen the Domain Name for its magazine, it was not required to do so and, perhaps with the benefit of hindsight, and increased knowledge of how people 'guess' website URLs, the Complainant may now wish to use the Domain Name for its magazine's website. Certainly people's knowledge of how the Internet, and the World Wide Web in particular, operate and are used has matured significantly since the Complainant's website was launched at the end of the last century.

- 6.8 The Respondents quote from the Complainant's own magazine to describe it, namely, as "Australia's leading boating business magazine". Whilst they deny it, the Panel finds that the Respondents must have known of the Complainant's magazine in March 2006, and it is disingenuous of the Respondents to say that they chose the Domain Name on the basis that it comprised generic words that the Respondents innocently decided to use to "redirect" marine business enquiries to their *Boating Business* magazine's website. Regrettably, the Panel finds that assertion to be quite implausible, and the use of the word "redirect" rather than "direct" quite telling.
- 6.9 The Respondents' submissions revolve around their basic contention that, because the Complainant's *Marine Business* magazine goes by a name that comprises generic words, which they are otherwise entitled to use in discourse, the Complainant cannot stop them using those same words to redirect web users to the website of their competing *Boating Business* magazine. None of the UDRP or auDRP cases cited stand for that proposition, and none of the submissions put by the Respondents compel the Panel to that conclusion.
- 6.10 In the Panel's view, after six years of publication to the marine industry of the Complainant's *Marine Business* magazine, the Respondents had no legitimate rights or interests in marinebusiness.com.au at the time of its registration on 17 March 2006, and their position is no stronger now.
- 6.11 The Panel is satisfied that the Respondents have never had any legitimate rights or interest in the Domain Name at or since its registration. Accordingly, Paragraph 4(a)(ii) of the Policy is made out.
- iii) Domain Name was registered or subsequently used in bad faith**
- 6.12 The question of the Respondents' bona fides is really a question of credit which the auDRP, like the UDRP, is usually ill-equipped to decide. Occasionally, however, as is the case here, a respondent's contentions simply cannot be believed or accepted based on one's experience or logic.
- 6.13 The Respondents must have been aware of the Complainant's *Marine Business* magazine as at 17 March 2006. Their claim to be publishing at that time a magazine covering the marine industry and therefore to be familiar with that industry makes it impossible to accept that they were not aware of the Complainant's magazine.
- 6.14 Paragraphs 4(b)(iii) and (iv) of the Policy deal with registration with intent to disrupt someone else's business or to attract persons seeking someone else's business to your own site. In the Panel's view, a finding that the Respondents must have known of the Complainant's *Marine Business* magazine in March 2006 leads to the conclusion that at least paragraph 4(b)(iv) and probably paragraph 4(b)(iii) as well are enlivened.
- 6.15 Independently of the deeming provisions of paragraph 4(b) of the Policy, the Panel simply cannot believe the Respondents' assertion that they innocently

registered the name of the Complainant's *Marine Business* magazine as a domain name and pointed it to their *Boating Business* website without any intention to disrupt or interfere with the Complainant's business. Even without that intent, that conduct was misleading and deceptive under the *Trade Practices Act 1974*.

The Panel formally finds that the Domain Name was registered in bad faith and is also being used in bad faith, either of which findings are sufficient under the auDRP to satisfy paragraph 4(a)(iii) of the Policy.

7. Decision

- 7.1 The Complainant has satisfied all of the requirements for the Complaint to be upheld and has requested that the Domain Name be transferred to it.
- 7.2 Accordingly, the Panel orders that marinebusiness.com.au be transferred to the Complainant on the basis of its *Marine Business* magazine name and trade mark.

P Argy

Philip N Argy
Sydney
16 July 2008