

Domain Name: justcarfinance.com.au
Name of Complainant: Just Car Finance Pty Limited.
Name of Respondent: Aussie Pty Limited
Provider: LEADR
Panel: Dennis Liner

1 THE PARTIES

- 1.1 The **Complainant** in this proceeding is Just Car Finance Pty Limited ACN 114 114 864 169 of 91 Victoria Road, Rozelle, New South Wales, 2039.
- 1.2 The **Respondent** is Aussie Pty Limited ACN 090 437 371 of Suite 93, 24 Buchanan Street, Balmain, New South Wales, 2041.

2 THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 2.1 The disputed Domain Name is "justcarfinance.com.au" ("**the Disputed Domain Name**")
- 2.2 ; The Registrar of the Disputed Domain Name is Bottle Domains;
- 2.3 The Provider in relation to this proceeding is LEADR ("**Provider**").

3 PROCEDURAL HISTORY

The Provider has advised the Panel that the procedural history of this dispute is as follows:-

- 3.1 The complaint was submitted for decision in accordance with the (auDRP) Policy and Rules, which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplementary Rules (LEADR is the Provider).
- 3.2 The complete application was received from the Complainant by LEADR on 18 July 2005;
- 3.3 On 19 July 2005 the Respondent received e-mail notification of the complaint. On the same day LEADR express posted to the Respondent a dispute notification letter and also faxed a copy of the complaint;
- 3.4 A copy of the dispute notification letter was also e-mailed to the Complainant on 19 July 2005.
- 3.5 A copy of the application and a copy of the dispute notification letter were also express posted to the Registrar (Bottle Domains) on 19 July 2005;
- 3.6 LEADR advised auDA of the Complaint on 19 July 2005 via e-mail.
- 3.7 The Registrar was additionally advised by e-mail to lock the website www.justcarfinance.com.au on 19 July 2005. The Registrar by return e-mail on 20 July 2006 advised LEADR that the lock had been confirmed.

- 3.8 On 27 July 2005 the Provider approached the Panelist via telephone. The nominated panelist confirmed his availability and informed LEADR that he had no conflict issues with the parties instantaneously.
- 3.9 The Respondent's Response was received on 5 August 2005 via fax and courier. Therefore, the Response has been made in time, as the expiry date for the Response was 8 August 2005.
- 3.10 The Panelist was informed on 5 August 2005 that the package was being sent for Adjudication and that a Response had been received.
- 3.11 Subsequent to the Panelist receiving the package the following took place:-
- a) On 9 August 2005 the Panelist forwarded an e-mail to LEADR requesting that the Respondent provide proof of trade mark registration;
 - b) On 9 August 2005 the Complainant and the Respondent each forwarded Responses to the Panelist's request by e-mail and LEADR forwarded such Responses to the Panelist.

4 FACTUAL BACKGROUND

Facts alleged by the Complainant

- 4.1 In submissions attached to its Complaint, the Complainant alleges the following:-
- a) The Complainant registered the business name "Just Car Finance" on 6 August 2003 with the person carrying on business under such name as set out in the New South Wales business extract showing the proprietor of such business as Aisha Carey Felton.
 - b) On 9 June 2005 the Complainant was registered as a company ("Complainant's Company Name");
 - c) The Complainant carries on business as a finance broker for motor vehicles ("The Complainant's business");
 - d) On 11 January 2005 the Disputed Domain Name was registered;
 - e) In June 2005 the Complainant attempted to register the Disputed Domain Name, but was unable so to do, the Domain Name Provider, Melbourne IT advising the Complainant that the Disputed Domain Name had been registered by the Respondent through Bottle Domains;
 - f) The Complainant, upon searching the internet, was unable to find a web page in the name of The Disputed Name, but merely a "Domain Pointer" and that the site was not being used;
 - g) The Complainant ascertained that the Director of the Respondent is also the Director of Aussie Car Loans Pty Limited which carries on a similar business to that of the Complainant and would be in direct competition to the Complainant's business;
 - h) Aussie Car Loans Pty Ltd has its own web site under the name "aussiecarloans.com.au"

- i) By e-mail of 8 August 2005 the Complainant advised that:-
- (i) the company commenced trading on 1 July 2005 and was generating income;
 - (ii) an application for registration of a trade mark similar to the Disputed Domain Name had been lodged for registration after notification of this dispute.

Facts alleged by the Respondent

4.2 In submissions attached to its Response, the Respondent alleges the following facts:

- a) the Respondent provides a financial service package called "Just Car Finance" and has done so since 2001;
- b) The Domain "www.carfinance.com.au" has advertised such financial services continuously using "a trade mark logo" consisting of the words "Just Car Finance".
- c) The Just Car Finance "trade mark" is highly ranked on most major search engines, has approximately 3000 page views monthly and generates an estimated 115 online finance applications per month.
- d) That due to an oversight the Disputed Domain Name has not been "pointed";
- e) There has been continuous usage of the "trade mark logo" consisting of the words "Just Car Finance" for over three years;
- f) By e-mail of 9 August 2005 Tony Salatino from a Domain "savemoney.com.au" advised the Provider that the "trade mark logo" had not been registered and an application for registration had been made a few days earlier.

Factual findings generally

4,3 The panel proceeds on the basis that the factual allegations made by the parties are true, and upon the basis that the e-mail referred to in paragraph 4.2 (f) refers to an application for registration of a trade mark by the Respondent.

5 THE PARTIES CONTENTIONS

The Complainant's contentions

5.1 The Complainant's submissions contend that:

- (a) the Disputed Name is identical to the Complainant's business name Just Car Finance registered 6 August 2003 and the Complainant's company name Just Car Finance Pty Ltd registered 9 June 2005;
- (b) the Respondent does not have an identical or similar name trade mark or service mark to the Domain Name;
- (c) Whist registered in January 2005, the Respondent has not established an active web site;
- (d) The Respondent does not offer goods or services in connection with the Domain Name;

- (e) The Respondent has not commonly been known by the Domain Name and, further, there is no connection between the name "Just Car Finance" and the Respondent "Aussie" and no apparent connection between the Respondent and the Disputed Domain Name.
- (f) The Respondent has no rights to "Just Car Finance";
- (g) In searching for the Respondent, Aussie Pty Limited, a consumer would not enter the Disputed Domain Name as there is no apparent connection. The Respondent is related to another entity Aussie Car Loans Pty Limited which shares the same Director. Such company carries on the same core business as the Complainant and it seems that the Respondent could be planning to redirect the Disputed Domain Name to the existing site "aussiecarloans.com.au" which could result in the Complainant's clients mistakenly confusing the Complainant's business with that of Aussie Car Loans business with Aussie Car Loans;
- (h) The Respondent has registered and used the Disputed Domain Name in bad faith in order to prevent the Complainant from reflecting its name in the corresponding Domain Name;
- (i) At the time of registration of the Domain Name the Respondent would have been able to ascertain that the business name "Just Car Finance" had been registered, but proceeded with the registration of the Disputed Domain Name to hinder the Complainant's business and its presence on the net. Furthermore, the Respondent has not used the Disputed Domain Name;
- (j) The Respondent has acted in bad faith in that it and Aussie Car Loans Pty Limited are related companies and is a direct competitor of the Complainant's business. The Respondent has registered the Domain Name only for the purpose of disrupting the business and activities of the Complainant to obtain financial gain;
- (k) The Respondent has acted in bad faith in planning to redirect the Disputed Domain Name, presumably to "aussiehomeloans.com.au" thereby attempting to attract the Complainant's customers for its own and thereupon obtain commercial gain, creating a likelihood of confusion between the products and services that the Complainant provides.

The Respondent's contentions:

5.2 In its Response, the Respondent contends that:-

- (a) having a business name and subsequently a company name in the name of the Complainant does not automatically grant sole rights to the use and ownership of the Disputed Domain Name nor give ownership or inclusive intellectual property rights to the words "Just Car Finance";
- (b) the Complainant has not commenced usage or marketing of the name or logo consisting of "Just Car Finance", thereby having no common law rights;
- (c) the Respondent provides a financial product and service package called "Just Car Finance" since at least December 2001 offering various financial services;

- (d) the products and service package have been advertised continuously using a trade mark logo consisting of the words "Just Car Finance" at the Domain "www.carfinance.com.au" which appears highly ranked on most major search engines;
- (e) the Just Car Finance "trade mark" consistently has approximately 3000 views and generates an estimated 115 online finance applications monthly;
- (f) the Respondent has prior usage and common law rights;
- (g) the fact that the Disputed Domain Name has not been pointed is merely an oversight on behalf of the Respondent;
- (h) the product named Just Car Finance and a substantial usage of the "trade mark" consisting of the words "Just Car Finance" in a device for over three years justifies registration and future usage of the Dispute Domain Name.

6 DISCUSSION AND FINDINGS

Jurisdiction

6.1 Paragraph 2.1 of the auDRP states.

"all domain name licences issued in the open 2L.Ds from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP. At this time of publication, the open 2LDs are asn.au, com.au, id.au, net.au and org.au..."

6.2 The Disputed Domain Name is an open 2LD within the meaning of this provision. It was registered with the Registrar on 14 May 2004. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP.

Basis of decision

6.3 Paragraph 15(a) of the auDRP Rules states,

"A panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy [the auDRP Policy], these Rules and any rules and principles of law that it deems applicable."

Elements of a successful complaint

6.4 According to paragraph 4 (a) of the auDRP Policy, 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, trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent to the Complainant has no rights or legitimate interests in respect to the domain name; and
- (iii) the Respondent's domain name has been registered or subsequently used in bad faith;

Note 1 to paragraph 4 (a) (i) provides for the purpose of the Policy auDA has determined that a “name...in which the Complainant has rights” refers to the Complainant’s company, business or other legal trading name, as registered with the relevant Australian Government authority, or the Complainant’s personal name.

- 6.5 It is noted that the three elements of a complaint under paragraph 4 (a) of the auDRP Policy are cumulative; all of them must be proved if the complaint is to be upheld.

Is the Disputed Domain Name identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights?

- 6.6 The Panel must determine whether, on the basis of the facts set out in section 4 above, that the Complainant has rights in a relevant name, trade mark or service mark.

- 6.7 The company name and previously the business name is “confusingly similar” to the Disputed Domain Name, the only difference being the spaces between the words “Just Car Finance” and the use of capitals for each of the words rather than being entirely in lower case, therefore the extent to which there are any differences only concerns capitalization and spacing. The Domain Name being so similar to the Complainant’s company name the Panel finds that paragraph 4 (a) (i) of the auDRP Policy satisfied.

Does the Respondent have any rights or legitimate interests in respect to the Disputed Domain Name?

- 6.8 The auDRP requires the Panel to have regard to several matters when considering whether the Respondent has “any rights or legitimate interests” in respect to the Disputed Domain Name;

- 6.9 Note 2 of the auDRP Policy states,
“For the purposes of this policy, auDA has determined that “right or legitimate interests in respect to 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.”

- 6.10 This means paragraph 4 (a) (ii) of the auDRP Policy is not satisfied simply because the Respondent has previously been treated as eligible for the Disputed Domain Name.

- 6.11 Paragraph 4 (c) of the auDRP Policy sets out particular circumstances, any of which, “if found by the Panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate...rights or legitimate interests to the domain name for purposes of paragraph 4 (a) (ii). These circumstances include:

- (i) before the Respondent is notified of the subject matter of the dispute, the Respondent’s 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 name acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) the Respondent (as in individual, business or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial 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.”

- 6.12 Paragraph 4 (c) of the auDRP Policy states that the above circumstances are “without limitation”, so that rights or legitimate interests could exist in respect to a domain name even if none of the above circumstances are applicable in the particular case.
- 6.13 The first question is whether the Respondent, prior to being notified of the subject matter of the present dispute, made “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” (paragraph 4 (c) (i)). There is no requirement that the nature of the goods or services have any connection with the Disputed Domain Name.
- 6.14 It is not clear that the Respondent has engaged in a “use” of the Disputed Domain Name. Upon the contention of the Complainant and, as admitted by the Respondent, the Disputed Domain Name is not used in connection with a web site of the same name. Moreover, the Respondent concedes that it is in the process of establishing a pointer to a website in a different name that provides goods and services similar to that of the Complainant’s business.
- 6.15 In this case, the Dispute Domain Name comprises three common and non distinctive words. Indeed, the Respondent annexes to its Response details of searches at major search engines which indicate that if a search were carried out in the names “Just Car Finance” there are over 29 million results in “Yahoo!”, over 28 million in “altavista”, over 26 million in “optusnet” and over 1 million in “ninemsn”. Accordingly, the use of these words or the combination thereof is clearly not as a result of the use of the Disputed Domain Name, but rather the use of the common names and a good knowledge of how the various search engines actually work and prioritize results.
- 6.16 The Respondent in its Response contends that it has been continuously using a trademark logo using the words “Just Car Finance”. Furthermore, the relevant site on the internet after the words “Just Car Finance” has “TM” adjacent which indicates that there is a trademark. Given the details supplied by the Respondent as set out in paragraph 4.2 (f) above, the Respondent’s contention and the use of the relevant words clearly are not sustained by the facts in that there is no trademark registered.
- 6.17 Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. In passing, the observation made in respect to the usage of the common words would not seem to preclude the Respondent, in any case, from using such words to attract persons to its site as such words are so common as to elicit many millions of relevant results upon a search enquiry at the major search engines (see paragraph 6.15 above).
- 6.18 From the above, the Panel finds that the Respondent was not commonly known by the Domain Name.
- 6.19 Further, the Panel finds that the Respondent has not been utilizing the Disputed Domain Name, but has been using the common words as contained in the Disputed Domain Name.

- 6.20 For the reasons as stated above, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name, Therefore paragraph 4 (a) (ii) of the auDRP Policy has been satisfied by the Complainant.

Has the Disputed Domain Name been registered or subsequently used in bad faith?

- 6.21 Paragraph 4 (b) of the auDRP Policy sets out circumstances which, "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". These are:

- (i) circumstances indicating that the Respondent has been registered or has 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) the Respondent has registered the domain name in order to prevent the owner of a name, trade mark or service mark from reflecting that name or mark from reflecting that name or mark in a corresponding domain name; or
- (iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
- (iv) by using the domain name, the Respondent has 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 as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location.

- 6.22 With respect to paragraph 4 (b) (i) of the auDRP Policy, upon the facts supplied, there is no basis for a finding that the Respondent has been registered or has acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person. On the contrary, the Respondent seeks to resist any transfer of the Disputed Domain Name.

- 6.23 With respect to paragraph 4 (b) (iii) of the auDRP Policy, there is insufficient evidence for a finding that the Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business or activities of another person, including the Complainant. It must have been foreseeable to the Respondent that its registration of the Disputed Domain Name might disrupt the Complainant's business in some way. However, the evidence does not establish that the Disputed Domain Name was registered *primarily* for that purpose.

- 6.24 The Panel is required to ascertain whether there is sufficient evidence for a finding in respect to paragraph 4 (b) (ii) of the auDRP Policy as to whether the Respondent registered the Domain Name in order to prevent another person, namely the Complainant, from reflecting its company name in a corresponding domain name. The Director of the Complainant had registered the business name "Just Car Finance" in August 2003, some seventeen months prior to the registration of the Disputed Domain Name. A simple search would have ascertained the existence of such business name. However, the Respondent contends that it had utilized the "trade mark" for some two years prior to the registration of such business name. Although, as noted above, there was no registered trade mark, the Respondent clearly had used the words comprising the Disputed Domain Name and therefore the

Panel considers there is insufficient evidence for a finding that the Respondent had registered the disputed Domain Name only in order to prevent the Complainant from reflecting the business name (as it then was) in a corresponding Domain Name.

- 6.25 In respect to paragraph 4 (b) (iv) the Panel determines that the Respondent, by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the Respondent's name as to the source of products or services advertised on that website. The likelihood of confusion comprises the probability that the consumers accessing the Disputed Domain Name would expect to be directed to the Complainant's website, not the Respondent's.
- 6.26 For the reasons outlined above, paragraph 4 (a) (iii) of the auDRP Policy have been satisfied by the Complainant.

7 RELIEF

Transfer of the Disputed Domain Name

- 7.1 The Complainant has sought relief in the form of:
- (a) revocation of the Respondent's licence in respect of the Disputed Domain Name; and
 - (b) transfer of the licence in the Disputed Domain Name to the Complainant.

- 7.2 According to paragraph 4 (i) of the auDRP,

"The remedies available to a Complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the Complainant (provided that the Complainant is otherwise eligible to hold that domain name)."

- 7.3 From the language of this paragraph, it seems that only one form of relief can be made in a given case: either cancellation or transfer. In the present case, the relief sought by the Complainant will be substantially impacted by an order that the Disputed Domain Name be transferred to the Complainant.

- 7.4 Eligibility for a domain name in the open 2LDs is governed by anDA's Domain Name Eligibility and Allocation Rules for the Open 2LDs (2002-07) which commenced operation on 8 May 2002 ("**Eligibility Rules**") Schedule C of the Eligibility Rules relates to "com.au" domain names and provides,

"1 To be eligible for a domain name in the com.au 2LD, registrants must be:

a. an Australian registered company;

2 Domain names in the com.au 2LD must:

(a) exactly match:

(i) the registrant's company, business, trading, association or statutory body name; or

(b) be an acronym or abbreviation of 2 (a) (i)...;or

- (c) *be otherwise closely or substantially connected to the registrant, because the domain name refers to:*
- (i) *a product that the registrant manufactures or sells; or*
 - (ii) *a service that the registrant provides..."*

7.5 The Complainant is an Australian registered company and the Disputed Domain Name is closely connected to the Complainant, as it refers to a service that the Complainant provides, namely, car finance.

7.6 The Panel orders that the Disputed Domain Name be transferred to the Complainant.

8 Decision

8.1 The Complainant has satisfied the elements of paragraph 4 (a) of the auDRP Policy.

8.2 The Panel directs that the Disputed Domain Name be transferred to the Complainant.

Dated this 15 day of August 2005.



Dennis Liner

Sole Panelist