



DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

auDRP_22_14

Single Panellist Decision

Gavin Romer and Anthea Romer (trading as Port Macquarie Locksmiths)
v
Corinthian Capital Pty Ltd

1. The Parties

1.1 The Complainants are Gavin Romer and Anthea Romer, trading as Port Macquarie Locksmiths Blackbutt Road, Port Macquarie, New South Wales, Australia 2446 (“the Complainant”).

1.2 The Respondent is Corinthian Capital Pty Ltd ABN 74 636 589 789, a company registered in New South Wales.

2. Domain Name, Registrar and Provider

2.1 The domain name upon which complaint is based is portmaquarielocksmiths.com.au (the Domain Name).

2.2 The Registrar of the Domain Name is Domain Directors Pty Ltd trading as Instra (“the Registrar”).

2.3 The Provider in this Proceeding is Resolution Institute of Suite 602, Level 6 Tower B, Zenith Centre, 821-843 Pacific Highway, Chatswood (“the Provider” or “Resolution Institute”).

3. Procedural History

3.1 This proceeding relates to the Complaint submitted by the Complainant in accordance with:

- (i) the .au Dispute Resolution Policy No. 2016-01 published 15 April 2016 (“auDRP”) which includes Schedule A (Policy) and Schedule B (Rules); and
- (ii) the Provider’s supplemental rules for the .au Domain Name Dispute Resolution Policy.

- 3.2 The Complainant lodged a complaint with the Provider through solicitors on 2-11-22.
- 3.3 The documents supplied by the Complainants comprise the complaint and schedule of attachments relating to the Complaint:
- (i) The ASIC record of registration of the Business Name “Port Macquarie Locksmiths”.
 - (ii) WHOIS Domain name search
 - (iii) ABN Lookup search
 - (iv) ASIC Organisational Historical Extract
 - (v) Copy of a text message between the Complainant and All Pro
 - (vi) Yellow pages advertisements of both the Complainant and All Pro
 - (vii) Copy Master Security Licence of the Complainant
 - (viii) Email from auDA providing the creation date of the domain name.
- 3.4 On 2.11.2022 the Provider notified auDA of the Domain Name complaint, which Complaint was acknowledged on 3.11.22.
- 3.5 On 7.11.2022 the Respondent was notified by the Provider of the Domain Name Dispute Complaint, with a copy of that Notification also sent to the Complainant and the Registrar.
- 3.6 On 8.11.2022 the Registrar confirmed that the Domain Name in dispute had been locked.
- 3.7 Pursuant to 5(a) of Schedule B of the auDRP Rules, the Respondent was required to submit a response to the Provider no later than 30.11.2022, this being twenty (20) days after the date of commencement of the administrative proceeding.
- 3.8 No response was received from the Respondent by the Provider by 30.11.22.
- 3.9 The Resolution Institute appointed Rowena McNally as the sole panellist in the matter on 8-12-22. The Panellist has confirmed that she has no conflict of interest in relation to the matter. All procedural requirements appear to have been satisfied.
- 3.10 On 8.12.22 the Complainant and the Provider were advised that the Complaint had been referred to a single panellist for decision.
- 3.11 On 9.12.22 the Respondent contacted the Provider to advise that they had just become aware of the Complaint with the explanation that all correspondence from the Provider had apparently “gone into [their] spam inbox” and requesting that all relevant documentation be resent.
- 3.12 The Provider responded on 9.12.22 confirming that all documentation had been sent/resent to the Respondent on 9.12.22 and noting that it would be at the Panel’s sole discretion whether it would permit further statements or documents by the parties.
- 3.13 The Respondent’s response was received on 14.12.22 and forwarded to the Panellist on 15.12.22.
- 3.14 Rule 5 sets out various requirements for a Respondent in submitting a response to the Provider, including the requirement that a respondent should:

“(i) Respond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name...”

3.15 The Panellist exercised discretion in favour of receiving the Respondent's response which, when received, was brief, and lacked the specificity anticipated in Rule 5(i).

4. Background

4.1 The Complainant seeks a transfer of the Domain Name.

4.2 The Complainant says, and I accept, that they have run a locksmith business in Port Macquarie under the name Port Macquarie Locksmiths since 2007.

4.3 The Complainant says, and I accept, that they are the registered owners of the business name "Port Macquarie Locksmiths".

4.4 The Complainant has provided a copy of a Record of Registration for Business Name from the Australian Securities and Investments Commission (ASIC) which records that the business name has been registered since 11.07.1989 and that the registered business name holders are Anthea Romer and Gavin Paul Romer.

4.3 The Complainant says that they became the owner of the Domain Name on 8.11.12 and held that Domain Name continually until sometime in 2021 when the Complainant's registration of the Domain Name inadvertently lapsed.

4.4 The Complainant says, and I accept, that the Complainant had engaged a third party to manage some of their subscriptions but due to an oversight, the domain name was inadvertently not renewed, and the Complainant's registration of the Domain Name lapsed.

4.5 The Complainant says that it only became aware on 29.03.22 that the Domain Name was no longer directing to the Complainant's website and learned that the Domain Name had inadvertently been allowed to lapse.

4.6 The Complainant says, and I accept that its investigations revealed that the Domain Name had become registered to Corinthian Capital Pty Ltd (the Respondent) and was directing traffic to the domain "allprolocksmiths.com.au".

4.7 The Complainant has produced material indicating that "All Pro Locksmiths" is the name of a locksmith business which is run out of Port Macquarie by Adam Marotte (Mr Marotte).

4.8 Mr Romer says that Mr Marotte is known to him as a result of a past work relationship.

4.9 The Complainant has also provided copies of Yellow Pages which show adjacent advertisements in the local business advertising section over a number of years for both the Complainant's business and for All Pro Locksmiths, which includes their contact and other details.

4.10 The Complainant says, and I accept, that the Complainant promptly contacted Mr Marotte and requested the transfer of the domain name back to the Complainant, and the Complainant has provided a copy of text correspondence between Mr Romer and Mr Marotte.

5. Jurisdiction

5.1 Paragraph 2.1 of the auDRP states:

"All Domain Name licences issued or renewed in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP."

5.2 The Domain Name, being “com.au” is an open 2LD within the scope of the previous paragraph. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP.

6. Response

6.1. As indicated previously, the Respondent provided a late response to the Complaint on 14.12.2.

6.2 The Respondent says that it had contacted its client, All Pro Locksmiths”. ... “who has confirmed that he wishes to retain the domain name lead generation service we offer”.

6.3 The Respondent’s response is -

“... [that] the domain name registration is valid as the registration complies with the auDA Policies and specifically that allow domain names to be registered for the purpose of monetisation.”

6.4 In relation to the Respondent’s submission regarding monetisation, the Panellist notes that the Rules nonetheless require the domain name be either (a) an exact match, abbreviation or acronym of the registrant’s name or trademark; or (b) otherwise closely and substantially connected to the registrant, in accordance with the categories of “close and substantial connection” set out in the Guidelines on the Interpretation of Policy Rules for the Open 2LDs.

6.5 The Rules also provide that a domain name may be registered in the com.au 2LD under paragraph 2(b) for the purpose of domain monetisation, in accordance with the explanation of “domain monetisation” set out in the Guidelines on the Interpretation of Policy Rules for the Open 2LDs, provided that the following conditions are met:

- (a) the content on the website to which the domain name resolves must be related specifically and predominantly to subject matter denoted by the domain name; and
- (b) the domain name must not be, or incorporate, an entity name, personal name or brand name in existence at the time the domain name was registered.

6.6 The Respondent has not otherwise addressed either its asserted compliance with the Rules, or address other matters raised in the Complaint.

7. Complaint Elements and the Onus of Proof

7.1 Schedule A of the auDRP applies to disputes which meet the requirements set out in paragraph 4(a) of Schedule A of the auDRP. Subparagraph 4(a) requires that any party holding a domain name licence issued in the 2LDs “...submit to a mandatory administrative proceeding in the event that a third party (complainant) asserts to the applicable Provider, in compliance with the Rules of Procedure that:

- (i) [the] domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
 - (ii) [they] have no rights or legitimate interests in respect of the domain name, and
 - (iii) [the] domain name has been registered or subsequently used in bad faith.
- In an administrative proceeding, the complainant bears the onus of proof.”*

8. Is the Domain name identical to or confusingly similar to a name, trade name or service mark in which the Complainant has rights ?- subpara 4(a)(i)

8.1 The Complainant's business name was registered with ASIC on 11.7.89, and the Complainant has been the owner of the registered business name and trading under the business name "Port Macquarie Locksmiths" since 2007.

8.2 The Complainant says that the Domain Name which has now been registered by the Respondent is identical to, or confusingly similar to the Complainant's trading name.

8.3 The Complainant says that the Respondent is using the Domain Name to divert web traffic searches of its business name, "Port Macquarie Locksmiths", to the website of its client, All Pro Locksmith; and/or to disrupt the Complainant's legitimate business.

8.4 The Complainant says that this disruption will continue unless the Complainant regains the Domain Name and submits that the Respondent has caused and maintains registration of the Domain Name in order to prevent the Complainant from reflecting the Complainant's business name in a corresponding domain name.

8.5 Sub-paragraph 4(a)(i) contains a number of elements and requires that the Domain Name is identical to or confusingly similar to a name, trade name or service mark in which the Complainant has rights.

8.6 The Complainant says, and I accept, that the Domain Name consists of the words "Port Macquarie Locksmiths" followed by the second-level domain (2LD) suffix ".com.au".

8.7 The Complainant says, and I accept, the Domain Name is substantially identical to the Complainant's advertised trading name, which it has registered.

8.8 The Complainant submits that –

- (a) the Complainant has legal rights in and to the name "Port Macquarie Locksmiths" through the lengthy use of that business name and registration of the business name;
- (b) the Domain Name is substantially identical, or confusingly similar to the name under which the Complainant trades.

8.10. I accept the Complainant's submissions and find that the Domain Name is identical to or confusingly similar to a name, trade name or service mark in which the in which the Complainant has rights.

9. Does the Respondent have a right or legitimate interest in the Domain name (4(a)(ii))?

9.1 I will turn now to consider whether the Respondent has rights or legitimate interests in the domain name.

9.2 The Complainant's submission is that at the time the Respondent registered the Domain Name:

- (a) the Respondent did not hold (nor currently holds) any business name or company name, nor any registered or pending Australian trade mark for which the Domain Name is, or was, and exact match, abbreviation or acronym;
- (b) the Respondent had, and has, no legitimate or bona fide interest or rights in or to the name "Port Macquarie Locksmiths".

- (c) There was and remains no close or substantial connection between the Domain Name; and the Respondent, or the Respondent's business activities as they can be discerned and
- (d) the Respondent was aware, or ought to have been aware, of the matters in sub-paragraphs (a) – (c) above.

9.3 The Complainant has provided an ASIC Current and Historical Organisation Extract dated 22.08.22 of the Respondent which indicates that the company is registered and controlled by Mr Richard Trainer but that the Status of the Respondent is recorded as "Strike-off Action in Progress", with ASIC mail returned undelivered.

9.4 The Complainant has also provided a copy of an Australian Government Australian Business Register (ABN Lookup) search conducted on 6.10.22 with details for the Respondent.

9.5 The ABN Lookup search records several businesses associated with the Respondent's ABN, being: Adelaide's Appliance Repairs and Servicing (10.06.21); Canberra Appliance Repairs (27.04.21); Bad Credit Loans Sunshine Coast (17.02.21); Macquarie Mergers & Acquisitions (17.04.21); and MM4 (9.10.19).

9.6 The Complainant submits that the Domain Name is specific and only useful to a locksmith business operating out of or based in Port Macquarie, New South Wales.

9.7 The Complainant submits, and I accept, that based on ASIC searches, the Respondent does not appear ever to have had a locksmith business that operated or was based in Port Macquarie and cannot have been using or intending to use the domain name for the offering of such goods or services, nor that the Respondent was ever commonly known by the Domain Name.

9.8 Having regard to these matters, the Panellist is satisfied that the Respondent's registration of the Domain Name did not, and does not, satisfy the requirements of Rules 2.4.4 or 2.4.5 of the auDA .au Domain Administration Rules: Licensing (Licensing Rules) in force for domains renewed or registered on or after 12 April 2021.

9.9 In particular, the Panellist is satisfied that the Respondent's registration the Domain Name, did not, and does not, satisfy:

- (a) Schedule C paragraph 2 (a) of the Eligibility Policy – in that the Domain Name was not, and is not, an "exact match, abbreviation or acronym of the [Respondent's] name..."; or
- (b) Schedule C, para. 2(b) of the Eligibility Policy – in that the Domain Name was not, and is not, "otherwise closely or substantially connected to the [Respondent]"; or
- (c) Rule 2.4.4(2)(a) and (b) of the Licensing Rules – in that the Domain Name was not, and is not, "a match of the [Respondent's] company, business, [or] statutory...name" or "an acronym of the [Respondent's] company, business, [or] statutory...name"; or
- (d) Rule 2.4.4(2)(c) of the Licensing Rules – in that the Domain Name was not, and is not, "a match of any Australian Trade Mark"; or
- (e) Rule 2.4.4(2)(f) of the Licensing Rules – in that the Domain Name was not, and is not "a match or synonym of: (i) a service that the [Respondent] provides; (ii) goods that the [Respondent] sells (whether retail or wholesale); (iii) an event that the [Respondent] registers or sponsors; (iv) an activity that the [Respondent] facilitates, teaches or trains; or (v) premises which the [Respondent] operates" which the Respondent provided at the time of application for the Domain Name.

9.10 The Complainant says that the Respondent was not, either as at the Domain Registration Date or as at the date of this Complaint, and nor at any material times, ever eligible to hold the Domain Name.

9.11 The Complainant's submissions are supported by the fact that the Respondent's only use of the name "Port Macquarie Locksmiths" is to now re-direct traffic from the Domain Name (and from the Complainant's existing business of the same name) to that of one of its competitors, who is also a client of the Respondent, namely All Pro Locksmiths.

9.12 The Panellist is satisfied on the basis of the material provided by the Complainant that the Respondent did not at the time of registration, and does not currently have any right or legitimate interest in the Domain Name.

10. Has the Domain Name has been registered or subsequently used by the Respondent in bad faith: (4(a)(iii))?

10.1 The third limb of sub-paragraph 4(a) is whether the Domain Name has been registered or subsequently used by the Respondent in bad faith (4(a)(iii)).

10.2 For the purposes of paragraph 4(a)(iii), the following circumstances, if found to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that a respondent registered or 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 documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent 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) the respondent 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 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; or
- (v) if any of the respondent's representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

10.3 The Complainant submits that the Domain Name is specific and only useful to a locksmith business operating out of or based in Port Macquarie, New South Wales.

10.4 The Respondent says that the Domain Name relate to generic terms, relating to "a town called Port Macquarie" and the "trade term Lock Smiths."

10.5 The Complainant submits, and I accept, that based on ASIC searches, the Respondent does not appear ever to have had a locksmith business that operated or was based in Port Macquarie and cannot have been using or intending to use the domain name for the offering of such goods or services, nor that the Respondent was ever commonly known by the Domain Name.

10.6 The Complainant says that a search of "Port Macquarie Locksmiths", which is the Complainant's business, results in a re-direction to the domain "allprolocksmiths.com.au", which is the domain name of All Pro Locksmiths, a business owned and/or operated by a business operated by Mr. Marotte.

10.7 The Complainant says that Mr Marotte had a previous working relationship with the Complainant and knows that the Complainant trades under the business name “Port Macquarie Locksmiths.”

10.8 The Complainant says that both the Complainant and All Pro Locksmiths have advertised on multiple occasions in the same section of the local Yellow Pages, and that the Complainant’s advertisements consistently use the name “Port Macquarie Locksmiths” in the name and the website that has consistently been advertised.

10.9 The Complainant says that immediately after becoming aware that they no longer owned the Domain Name, the Complainant contacted Mr Marotte from All Pro Locksmiths.

10.10 Mr Marotte initially indicated by text in response to the Complainant’s request for assistance in getting the domain name back, that he -

“.. [didn’t] think that will be an issue. Yes I acquired it and 20 others from a broker last year. I’ll look into it and get back to you.”

10.11 The Complainant says that All Pro Locksmiths have subsequently declined to assist the Complainant in having the domain name transferred back to the Complainant and the Respondent’s Response has since confirmed All Pro Locksmiths wishes to continue with the diversion of the Domain Name to the All Pro Locksmith website.

10.12 The Complainant says that the Respondent is using the Domain Name to prevent the Complainant, as the owner of the business, and registered business name “Port Macquarie Locksmiths” from continuing to reflect its business name in a corresponding domain name, and/or to disrupt the Complainant’s legitimate business.

10.13 The Complainant says that this disruption is likely to continue into the future unless the Complainant regains the Domain Name and submits that the Respondent has caused and maintains registration of the Domain Name in order to prevent the Complainant from reflecting its business name in a corresponding domain name,

10.14 The Complainant says that it holds a Master Licence issued under the *Security Industry Act 1997* registered for the business name “Port Macquarie Locksmiths” and the Respondent’s registration of the Domain Name and diversion of traffic to one of its competitors is likely to detrimentally affect the Complainant’s business and may detrimentally affect the Complainant’s Master Licence.

10.15 The Complainant submits that the Respondent has registered and subsequently used the Domain in bad faith on the following basis:

- (a) The Respondent has registered, or has subsequently maintained the Domain Name to prevent the Complainant from reflecting its business name and/or to disrupt the Complainant’s business, in contravention of paragraphs 4(a)(iii), 4(b)(ii) and 4(b)(iii) of the auDRP;
- (b) The Respondent registered or acquired the Domain Name primarily for the purpose of selling, or otherwise transferring the Domain Name registration or usage to another person, namely All Pro Locksmiths, for valuable consideration,
- (c) The Respondent has intentionally used the Domain Name in bad faith and in a manner intended to damage the Complainant.

10.16 The Respondent has not specifically responded to or disputed the recitation of events and facts outlined in the Complaint.

10.17 The Respondent's position is that it was entitled to register and to continue to use the Domain Name in the manner in which it is currently being used because (says the Respondent) "the auDA policies specifically allow domain names to be registered for the purposes of the monetisation".

10.18 The Respondent has not addressed in its Response any of the conditions relevant to the registration of domain names, namely that that the name should be either (a) an exact match, abbreviation or acronym of the registrant's name or trademark; or (b) otherwise closely and substantially connected to the registrant, in accordance with the categories of "close and substantial connection" set out in the Guidelines on the Interpretation of Policy Rules for the Open 2LDs.

10.19 The Respondent has also not addressed the conditions pertinent to registering a domain name in the com.au 2LD under paragraph 2(b) for the purpose of domain monetisation, namely (a) the content on the website to which the domain name resolves must be related specifically and predominantly to subject matter denoted by the domain name; and, (of particular relevant in relation not the Complaint) that (b) the domain name must not be, or incorporate, an entity name, personal name or brand name in existence at the time the domain name was registered.

10.20 Even accepting the Respondent's explanation that all previous email correspondence relating to the Complaint had remained undetected in its "spam" folder, the Respondent has since received the Complaint, which includes the Complainant's submissions and materials.

10.21 The material provided by the Complainant illustrates that the Domain Name exactly reflects a business entity in existence at the time the domain name was registered, namely the Complainant's business, "Port Macquarie Locksmiths".

10.22 It appears that the Domain Name was directed to the All Pro Locksmiths website almost immediately upon registration, indicating that the Domain Name was initially registered either to prevent Port Macquarie Locksmiths from reflecting, or continuing to reflect its business name in a corresponding domain name, or to intentionally divert the Complainant's custom to All Pro Locksmiths by creating a likelihood of confusion with the Complainant's business.

10.23 The Respondent has confirmed that it has discussed the Complaint with All Pro Locksmiths and both intend that the Domain Name should continue to divert directly to All Pro Locksmith's website for the purposes of lead generation.

10.24 Given the exact wording of both names, the consequence of the diversion of the Domain Name to All Pro Locksmith's website means that customers and potential customers of the Complainant searching for "Port Macquarie Locksmiths" will instead be diverted to the website of one of the Complainant's competitors, All Pro Locksmith, who is the Respondent's client.

Finding

10.25 Having regard to the Complainant's complaint and the material provided, and also to the Respondent's Response, the Panellist finds that:

- (a) at the time the Respondent registered the Domain Name the Respondent had no right or legitimate interest in the Domain Name;
- (b) the Respondent registered the domain name in order to prevent the Complainant from reflecting its business name in a corresponding domain name; or
- (c) the Respondent registered the domain name primarily for the purpose of disrupting the business or activities of the Complainant; or
- (d) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the All Pro Locksmith website, by creating a likelihood of

confusion with the Complainant's business name. sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location;

10.26 These findings indicate that some or all of the Respondent's representations or warranties as to eligibility or third party rights given on application or renewal will have been incorrect, false or misleading.

10.27 It follows from this that the Panel find that the Domain Name was registered and/or has subsequently been used by the Respondent in bad faith.

10.28 All three components of paragraph 4(a) are required to be satisfied for any Complaint to be upheld.

10.29 As the Panel has found that the Complainant has discharged its onus of proof in relation to each element of paragraph 4(a) it follows that I find the Complainant's Complaint should be upheld.

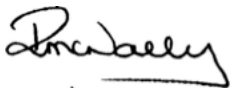
10.30 The Complainant says that the grounds for the Complaint have been made out and seeks that the Domain Name be transferred to the Complainant.

10.31 The Panellist agrees.

11. Decision

The Panellist finds that the Domain Name should be transferred to the Complainant.

DATE: 22 December 2022



Rowena McNally
Panellist