



ADMINISTRATIVE PANEL DECISION

People Telecom Limited v Kenneath Laming

LEADR Case No 02 of 2004

1. THE PARTIES

- 1.1 The complainant is People Telecom Limited, Level 9, 76 Berry Street, North Sydney NSW 2060 (**Complainant**).
- 1.2 The respondent is Kenneath Laming PO Box 441, Glenside SA 5066 (**Respondent**).

2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name is <people.com.au> (**Domain Name**). The registrar is Melbourne IT.

3. PROCEDURAL HISTORY

- 3.1 The Complaint was submitted for decision in accordance with the .au Dispute Resolution Policy (**auDRP**) which was approved by auDA in 2001 and commenced operation on 1 August 2002, the auDA Rules for .au Dispute Resolution Policy (**Rules**) and the LEADR Supplemental Rules for .au Domain Name Dispute Resolution Policy (**LEADR Supplemental Rules**).
- 3.2 The Complaint was lodged with LEADR on 18 May 2004.
- 3.3 The Respondent was sent the Complaint and the explanatory covering letter on 19 May 2004 by post. The Respondent was advised by LEADR that he had 20 days from 19 May 2004 to submit all materials he wished to have considered by the Panel. A copy of the Notification Letter was forwarded to the Complainant, and the registrar was sent a copy of the Notification Letter and Complaint.
- 3.4 LEADR advised auDA of the Complaint on 19 May 2004. The registrar was additionally advised by email to lock the website <people.net.au> on 19 May 2004.
- 3.5 On 19 May 2004 the Panellist was appointed by LEADR, having provided a statement of acceptance and confirming that there was no conflict of interest.
- 3.6 No response was received by the end of the 20 days, which expired on 8 June 2004.
- 3.7 The Panellist was informed on 9 June 2004 that the Complaint was being sent by express post for Adjudication and that no response had been received.
- 3.8 On 11 June 2004, the Respondent faxed a letter to LEADR which, although not in the form prescribed in paragraph 5(b) of the Rules, purported to respond to some of the allegations made in the Complaint.

- 3.9 At no time before the deadline of 8 June 2004 did the Respondent seek an extension of time to file a response pursuant to paragraph 5(d) of the Rules, despite having acknowledged receipt of the Complaint in an email to LEADR on 19 May 2004. As the Respondent has defaulted under paragraph 5(a) of the Rules, the Panel will therefore proceed to a decision based on the Complaint alone in accordance with paragraph 14(a) of the Rules.

4. FACTUAL BACKGROUND

4.1 The Complainant and its Trade Marks

From the Complaint, the Panel finds the following facts:

- The Complainant is a provider of telecommunication services. It has an annual turnover of \$65 million and a customer base of more than 10,000 customers.
- The Complainant is actively involved in large-scale advertising promotions and has an annual advertising budget of \$1 million. As such, the Complainant claims it has a strong presence in the market place.
- The Complainant submits that it has used the trade mark “People” since 2001 and that it has acquired common law rights in this trade mark.
- The Complainant also uses the common law trade marks “People Telecom” and “Getting People Talking”, and the registered business name “People Telecom Australia” (NSW BN97765593). The Complainant has not provided the Panel with details of the date of first use of these law trade marks, the date of registration of the business name, or the goods and/or services in respect of which these trade marks and business name are used.

4.2 The Respondent

The Respondent is the registrant of the Domain Name. As at the date of the Complaint, the Domain Name does not resolve to a website or other on-line presence.

5. PARTIES’ CONTENTIONS

5.1 Complainant

The Complainant asserts that the:

- (a) Domain Name is confusingly similar to the Complainant’s company name, business name and common law trade marks;
- (b) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (c) Respondent has registered or subsequently used the Domain Name in bad faith.

Apart from asserting its common law rights in the trade mark “People”, the Complainant relies on the following in support of paragraph 4(a)(i) of the auDRP:

- The Complainant has applied for other trade marks incorporating the name “People”. The Complainant has not supplied any details of these trade mark applications.
- The Complainant is entering into franchise agreements with third parties, who will be licensed to use the Complainant’s business names and common law trade marks. The Complainant has provided no evidence or other information in respect of these franchise agreements.
- The Respondent has engaged in passing off as there has been a misrepresentation of an association between the parties by the Respondent to prospective customers, which is calculated to injure the business and goodwill of the Complainant and which has or will cause damage.

The Complainant relies on the following in support of paragraph 4(a)(ii) of the auDRP:

- The Complainant has “sole rights” to the Domain Name on the basis of its company name, business name and common law trade mark rights in “People”, and its use thereof since 2001.
- The Respondent has engaged in misleading and deceptive conduct under sections 52 and 53 of the *Trade Practices Act* 1974 (Cth) simply by “using” the Complainant’s name.

The Complainant relies on the following in support of paragraph 4(a)(iii) of the auDRP:

- The Respondent has breached Melbourne IT’s Terms and Conditions for .au Domain Names in applying to register the Domain Name by making representations, and giving warranties and undertakings that any and all information provided by the Respondent is true and correct including that the:
 - (a) Respondent met the eligibility criteria prescribed in auDA’s Published Policies for Registering a Domain Name under clause 8(a);
 - (b) Domain Name is used or was registered for the purpose of diverting trade from another business or website under clause 7(f)(ii);
 - (c) Domain Name is registered and then passively held for the purpose of preventing another licensee from registering it under clause 7(f)(iv); and
 - (d) registration of the Domain Name will not infringe upon “or otherwise violate” the rights of a third party under clause 9.

In support of these contentions, the Complainant submits that the Domain Name:

- was originally automatically re-routed to the website of Chariot Internet Limited (**Chariot**) at www.chariot.net.au. The Complainant claims Chariot is its direct competitor. A letter was forwarded to Chariot, a copy of which has not been included in the Complaint. The Complainant received a response to this letter on 3 May 2004, wherein Chariot confirmed its status as the ISP and that the Respondent was its client. Chariot immediately changed the DNS configuration so that the Domain Name no longer points to <chariot.net.au>; and

- is being passively held as “there is no domain name site being built”. In support, the Complainant provides the Statutory Declaration of Bede Mooney (solicitor for the Complainant) dated 17 May 2004 that merely confirms the above position with respect to Chariot.

Accordingly, the Complainant requests that the Domain Name be transferred to it.

5.2 Respondent

The Respondent did not reply to the Complaint in accordance with paragraph 5(a) of the Rules. As such, any response provided by the Respondent to the Panel will be disregarded.

6. DISCUSSION AND FINDINGS

In order to have the Domain Name transferred to it, the Complainant must make out each of the following elements under the auDRP, for which it has the onus of proof:

- the Respondent's domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights (paragraph 4(a)(i)); and
- the Respondent has no rights or legitimate interests in the domain name (paragraph 4(a)(ii)); and
- the Respondent registered or subsequently used the domain name in bad faith (paragraph 4(a)(iii)).

A. Identical or Confusingly Similar

Firstly, the Complainant is able to establish that it has rights in the name “People” as that name refers to its name “People Telecom Limited”, business name “People Telecom Australia” and common law trade mark “People”. The Complainant's right is clearly supported by the evidence of use of “People” as a common law trade mark in its various marketing materials, copies of which have been provided to the Panel.

Secondly, the Domain Name and the name or trade mark must be compared independently of other marketing factors or use factors usually considered in trade mark infringement or unfair competition cases: *The Crown in Right of the State of Tasmania trading as "Tourism Tasmania" v. Gordon James Craven Case No. DAU2003-0001* and the cases cited therein.

Although the Complainant has demonstrated that the Domain Name is confusingly similar to its name and trade marks, the Complainant's assertions that the Respondent's registration of the Domain Name constitutes passing off is unsubstantiated.

The mere registration of a domain name that contains a trade mark does not constitute passing off. The Complainant has not provided any evidence that it has a reputation in the Domain Name, which is a generic word. It is doubtful that the Complainant's goodwill in the Domain Name extends beyond its own goods and services. Further, there is no evidence of any misrepresentation of an association between the Respondent and Complainant: *Capital Webworks Pty Ltd v Adultshop.Com Ltd* [2000] FCA 492 (5 April 2000). An action for passing off cannot be made out if there is no misrepresentation: *ConAgra Inc v McCain Foods (Aust) Pty Ltd* (1992) 33 FCR 302 at 365.

However, the Panel does find that the Domain Name is confusingly similar to the Complainant's company name, business name and common law trade marks, in which it is prepared to accept that the Complainant has rights.

The Complainant has therefore established this element of its case and meets the criteria of Paragraph 4(a)(i) of the auDRP.

B. Rights or Legitimate Interests

As the Respondent failed to submit a response in a timely fashion, the Panel may accept as true all of the allegations of the Complaint. Paragraph 14(b) of the Rules expressly provides that the Panel "shall draw such inferences" from the Respondent's failure to comply with the Rules "as it considers appropriate." Under paragraph 15(a) of the Rules, the Panel must therefore render its decision "on the basis of the statements and documents submitted" by the Complainant.

However, the Complainant has simply asserted that it has the "sole right" to the Domain Name based on its company name, business name and common law rights and, on this basis alone, the Respondent has no rights or legitimate interests in the Domain Name.

As the Domain Name is a generic term, it will be difficult for the Complainant to argue that the Respondent has no right or legitimate interest to it simply on the basis of its common law rights, which must (in the absence of any evidence to the contrary) be limited to the goods and services offered by the Complainant. Furthermore, the Complainant offers no evidence of an illegitimate purpose or explanation of its allegation that the Respondent has engaged in misleading conduct simply by registering the Domain Name.

The Domain Name is essentially a generic term that may be legitimately used by third parties in respect of a wide variety of goods and services. Therefore, to give the Complainant a monopoly over the Domain Name would be undesirable: *Eauto, L.L.C. v Eauto Parts* (WIPO D2000-0096).

The Panel concludes that the Complainant has failed to show that the Respondent does not have a right or legitimate interest in the Domain Name. The Complainant has not satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

In light of the Complainant's failure to establish the absence of the Respondent's right or legitimate interest in the Domain Name, the Panel need not consider the Complainant's assertions of bad faith.

7. DECISION

The Panel finds that the Complainant has not made out all of the elements of paragraph 4(a) of the Policy. Accordingly, the Complaint is therefore denied.

Sara Kerum
Sole Panellist
Dated: 22 June 2004