



ABN: 69 008 651 232

## Administrative Panel Decision

**Domain Name:** netratings.com.au

**Name of Complainant:** NetRatings Australia Pty Ltd

**Name of Respondent:** APT Strategies Pty Ltd

**Provider:** LEADR

**Panel:** J A Scott

### 1. THE PARTIES

- 1.1 The complainant in this proceeding is NetRatings Australia Pty Ltd of 59 Wentworth Avenue Surry Hills, NSW 2010 ("**Complainant**").
- 1.2 The respondent to the proceeding is APT Strategies Pty Ltd of Level 3, 425 Elizabeth Street, Surry Hills, NSW 2010 ("**Respondent**").

### 2. THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 2.1 The domain name in dispute in this proceeding is "netratings.com.au" ("**Disputed Domain Name**").
- 2.2 The registrar of the Disputed Domain Name is Melbourne IT of Level 2, 120 King Street, Melbourne, Victoria ("**Registrar**").
- 2.3 The provider in relation to this proceeding is LEADR ("**Provider**").

### 3. PROCEDURAL MATTERS

- 3.1 This proceeding concerns a complaint ("**Complaint**") submitted in accordance with:
  - (a) the .au Dispute Resolution Policy No. 2002/22 ("**auDRP**"), which was approved by .au Domain Administrator Ltd ("**auDA**") in 2001 and which commenced operation on 1 August 2002, including:
    - (i) Schedule A ("**auDRP Policy**"); and
    - (ii) Schedule B ("**auDRP Rules**");
  - (b) The Provider's Supplemental Rules to Rules for au Domain Name Dispute Resolution Policy ("**LEADR Rules**").
- 3.2 The Provider has supplied the Panel with a document entitled "Procedural History - netratings.com.au". Pursuant to this document, the Complaint

was lodged on 25 February 2005 (following the rectification of certain defects by the Complainant).

- 3.3 On the 28 February 2005 the Respondent was sent a dispute notification letter. The Respondent confirmed with the Provider that a copy of the Complaint had been received by the Respondent.
- 3.4 The Provider advised auDA of the Complaint, on the 28 February 2005 and the Registrar was advised to lock the Disputed Domain Name. The Registrar confirmed the lock on the 1 March 2005.
- 3.5 The Provider appointed Jennifer Scott as the sole panelist in this matter on 21 March 2005. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, Paragraph 7.

#### **4. FACTUAL BACKGROUND**

##### **Facts alleged by the Complainant**

- 4.1 In submissions attached to its Complaint, the Complainant raises the matters set out below:
  - (a) The Complainant has traded in Australia using a NetRatings trademark since about 2000 and claims it has a strong reputation in its NetRatings trademark.
  - (b) The Complainant's parent company, NetRatings Inc ("Parent Company") has been operating in the USA since 1997 and is the owner of a number of overseas trademarks, including "NETRATINGS"
  - (c) The Complainant was registered as a company on 26 February 1998 ("**Complainant's Company Name**").
  - (d) The Complainant provides a range of services relating to internet audience measurement and analysis.
  - (e) Since at least 1998 the Complainant and its Parent Company have had an active website at the URL [www.netratings.com](http://www.netratings.com).
  - (f) The Complainant operates within the Nielsen group of companies. During 2004 the Complainant promoted its products by reference to its NetRating trademark in Australia and received media coverage under NetRatings, Nielsen//NetRatings and NielsenNetRatings.

- (g) On 11 August 2004, the Disputed Domain Name was registered with the Registrar.
- (h) On 12 January 2005, the Claimant's Mr Henning had a telephone conversation with the Respondent's Marc Phillips.
- (i) On 20 January 2005, the Complainant's legal representative wrote to the Respondent requiring:
  - (a) The Respondent cease using the name NetRatings and remove all such references from the Respondent's websites, and
  - (b) The Respondent transfer the Disputed Domain Name to the Complainant.

#### **Facts alleged by the Respondent**

- 4.2 The Respondent replied to the Complainant's letter by email on 4 February 2005 and sent a response to the Provider on 18 March 2005 claiming:
  - (a) In the email that the Respondent had provided online research and ratings since 1994. As part of its service it provides to clients the *"analysis of keyword positioning and procurement of such generic keywords (such as 'net' and 'ratings')."* It further claimed that *"APT Strategies has invested heavily in proprietary methodologies used to determine keyword phrases and we provide advice on purchasing these keywords as generic domain names."*
  - (b) The Respondent was incorporated on 28 June 1993.

### **5. THE PARTIES' CONTENTIONS**

#### **The Complainant's contentions**

- 5.1 The Complainant's submissions in summary contend that;
  - (a) The Disputed Domain Name is subject to the auDRP Policy;
  - (b) The Disputed Domain Name is identical to or confusingly similar to a domain name owned by the parent company Nielsen//Netratings Inc, namely "netratings.com";
  - (c) The Disputed Domain Name is confusingly similar to the Complainant's company name, namely "NetRatings Australia Pty Ltd" ("**Complainant's Company Name**");

- (d) The Respondent has no rights or legitimate interests in respect of the Domain Name. The Complainant claims that the Respondent is in the same industry as the Complainant and would be familiar with the Complainant and its reputation. In fact, the Respondent has attached a letter to its Response, received by it from the ACNielsen eRating.com dated 23 January 2002 regarding the Nielsen//NetRating service;
- (e) The phrase "internet ratings" is not directly used on the website, although other "ratings" are referred to;
- (f) The term "internet ratings" does not explain the contraction to netratings and the use of the style NetRatings;
- (f) The Disputed Domain Name website is not in itself promoted and links back to the Respondent's aptstrategies.com.au website;
- (g) The Complainant and the Respondent are competitors, providing the same nature of services;
- (h) Due to the confusion, consumers mistakenly go to the web-site operated by the Respondent using the Disputed Domain Name instead of the Complainant's website;
- (j) The Respondent is intentionally attempting to attract, for commercial gain, internet users to its website.
- (k) There is an absence of any legitimate connection between the Respondent and the Disputed Domain Name. The Complainant alleges that Marc Phillips said "*he isn't doing much with it [the name] at the moment but likes the name.....it is only using it for leads*". Further it is alleged that Marc Phillips suggested that he "*could put up a blank page or change the content*".
- (l) The Respondent acquired the Disputed Domain Name for the purpose of sale.
- (m) The Respondent has registered the Disputed Domain Name in bad faith;

### **The Respondent's contentions**

5.2 In its Response, the Respondent contends that:

- (a) The Respondent has a long and distinguished history in "*conducting training in online statistics, ratings, rankings, online marketing, advertising, online media metrics and the analysis of websites.*"

- (b) The Respondent has conducted Internet ratings since the early 1990's.
- (c) Melbourne IT, the domain name registrar, "*proactively approached the Respondent with the Disputed Domain Name in August 2004.*"
- (d) The Respondent's business involves commercial ratings surveys and has conducted studies of Australian websites since 1996.
- (e) A critical part of the Respondent's service is to "*advise client's on domain name acquisition, selection of generic URLs and the process of search engine optimisation.*"
- (f) Since the Disputed Domain Name relates to services the Respondent supplies in Australia, it was not registered in bad faith;
- (g) The Respondent has not at any time offered the Disputed Domain Name for sale;
- (h) The terms 'net' and 'ratings' are generic dictionary words and generic domain names are allowed to be registered.
- (i) There are other domain name other than the Disputed Domain Name that refer to ratings and that the Claimant already owns Neilsennetratings.com.au

## 6. DISCUSSION AND FINDINGS

### Jurisdiction

- 6.1 Paragraph 2.1 of the auDRP states:  
*"All domain name licences issued in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP. At the 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 11 August 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 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.*
- 6.5 It is to be 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, the Complainant has rights in a relevant name, trademark or service mark.
- 6.7 The auDRP Policy states:
- "For the purposes of this policy, auDA has determined that a "name...in which the complainant has rights" refers to*
- (a) the complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority;*
  - (b) the complainant's personal name."*
- 6.8 Accordingly, the Complainant has relevant rights in at least:
- (a) the Complainant's Company Name; and
  - (b) the Complainant's common law (unregistered) trademark.
- 6.9 The auDRP Policy does not provide guidance as to the intended meaning of "identical" or "confusingly similar". Panelist N J Hickey in *Camper Trailers WA Pty Ltd v Off Road Equipment Pty Ltd* LEADR Case number 06/2004(12 November 2004) provided a summary of recent principles arising out of other domain name dispute decisions:
- "(a) "Identical"*

As was noted in *BlueChip InfoTech Pty Limited v Roslyn Jan and Blue Chip Software Development Pty Ltd* LEADR Case No. 06/03 (26 December 2003), “essential or virtual identity” is sufficient.

(b) “Confusingly Similar”

- (i) The “level domain” components of domain names (that is, “.com”, “.net” and similar suffixes) are to be ignored when comparing domain names with other names or marks (see for example *GlobalCenter Pty Ltd v Global Domain Hosting Pty Ltd*, WIPO Case No DAU2002-0001 (5 March 2003) referred to in *Esat Communications Pty Ltd v Kingford Promotions Pty Ltd* LEADR Case No. 03/2003 (11 July 2003)).
- (ii) The test of “confusing similarity” is confined to a comparison between the disputed domain name and the name or trade mark alone, independent of other marketing and use factors usually considered in trade mark infringement or other competition cases (see for example *The Crown in Right of the State of Tasmania trading as “Tourism Tasmania” v James Gordon Craven*, WIPO Case No DAU2003-0001 (16 April 2003)).

6.10 These principles do not clarify what is meant by “confusing similarity”. In particular, it is not clear what is contemplated to be “confusing” in circumstances where similar domain names and other names are registered or used by different persons. As noted in *Camper Trailers WA Pty Ltd* the test of “confusing similarity” could be applied in much the same way as the test of “deceptive similarity” in trade mark infringement cases, where the concept of “deception” contemplates consumers who may be deceived or “caused to wonder” about the source or origin of goods or services.”

6.11 It is clear in the present case that the only additional component between the Complainant’s Company Name with the Disputed Domain Name, concerns capitalisation and the “.au”. As stated in *GlobalCentre* one should ignore the “.com.au” component of the Disputed Domain Name in making the comparison. Further in the text of the Respondent’s website the Respondent stylises the phrase ‘NetRatings’ in identical terms to the Complainant’s Company Name and trademark by the capitalisation of the letters ‘N’ and ‘R’ and the combining of the two words into one phrase.

6.12 The Disputed Domain Name is sufficiently similar to the Complainant’s Company Name and the Complainant’s trademark that the Complainant has satisfied the requirement of “confusingly similar” in paragraph 4(a) (i) of the auDRP Policy.

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

- 6.13 Paragraph 4(c) of the auDRP Policy sets out particular circumstances, which can demonstrate a Respondent's *"rights or legitimate interests to the domain name for purposes of Paragraph 4(a) (ii)."*
- 6.14 The first issue to consider 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)).
- 6.15. The Respondent contends that it has used the Disputed Domain Name in connection with a web-site that advertises services such as training in online statistics, ratings, rankings, online marketing, advertising, online media metrics and the analysis of websites.
- 6.16 The question, however, is whether that use was "bona fide". Based on its evaluation of all the evidence presented, the Panel is not satisfied that the Respondent's use of the Disputed Domain Name in connection with the offering of goods or services was "bona fide". In particular, the Panel has considered:
- (a) At all relevant times the Complainant and the Respondent have been competitors in the same market and known to each other;
  - (b) The Respondent has not only used confusingly similar name, but also adopted the style of the Complainant's Company Name.
  - (c) The Respondent has until recently in marketing, both in brochures and online, generally used the terms 'ranking' or 'measuring' rather than 'rating'.
  - (d) The Respondent has not satisfied the Panel that the phrase 'NetRating' is a generic term.
  - (d) Since 1998 the Complainant through its parent company has been the registrant of NetRatings.com, a domain name calculated to inform consumers about the source of services offered by the Complainant as well as using the phrase 'Netratings' as part of the Complainant's Company Name. By contrast, the Respondent has no business name, trade mark or service mark similar to the



Disputed Domain Name, and the Disputed Domain Name is not suggestive of the Respondent's business name, or company name.

- 6.17 With respect to paragraphs 4(c) (ii) and 4(c) (iii) of the auDRP Policy, the Panel is satisfied that the Respondent has neither been commonly known by the Disputed Domain Name, nor is the Respondent making legitimate non-commercial or fair use of it. The Panel considers the Respondent's website to be "*likely to misleadingly divert customers*" from the Complainant.
- 6.18 Accordingly, the Panel finds that the Respondent has no right or legitimate interest in the Disputed Domain Name, and so 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?**

- 6.19 Paragraph 4(b) of the auDRP Policy sets out circumstances "*evidence of the registration and use of a domain name in bad faith*."
- 6.20 With respect to paragraph 4(b) (i) of the auDRP Policy, the Complainant has not satisfied the Panel 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.
- 6.21 The Panel considers there is sufficient evidence for a finding with respect to paragraph 4(b) (ii) of the auDRP Policy, namely that the Respondent has registered the Disputed Domain Name in order to prevent another person, namely the Complainant, from reflecting its company name in a corresponding domain name, namely the Disputed Domain Name.
- 6.22 The Panel considers there is sufficient evidence for a finding with respect to paragraph 4(b) (iv) of the auDRP Policy. The evidence clearly shows that the Complainant and Respondent are competitors. The Respondent was aware of the Complainant's presence in the market. The clear inference is that the Respondent was hoping to capture the custom of consumers who were seeking to access the Complainant's website but who had added ".au" to the domain name. Once captured, a customer would be diverted to the Respondent's other websites. In the Panel's view, the likelihood is that the Respondent registered the Disputed Domain Name "*intentionally attempting to attract, for commercial gain, Internet users to a website or other online location by creating a likelihood of confusion*."

6.22 For the reasons outlined above, the Complainant has satisfied the requirements of paragraph 4(a) (iii) of the auDRP Policy.

**7. RELIEF**

**Transfer of the Disputed Domain Name**

7.1 The Complainant has sought that the Disputed Domain Name be transferred to the Complainant.

7.2 Eligibility for a domain name in the open 2LDs is governed by auDA's Domain Name Eligibility and Allocation Rules for the Open 2LDs (2002-07) ("**Eligibility Rules**").

7.3 The Complainant is an Australian registered company and the Disputed Domain Name forms part of the Complainant's Company Name. The Complainant therefore satisfies the Eligibility Rules.

7.4 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.

Dated this 29th day of March 2005.

Jennifer A Scott  
Sole Panelist