



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Version

Decision ID DE-0800176

Case ID HK-0800169

Disputed Domain Name
www.wilcoxsafety.com
www.adeptsafetyonline.com

Case Administrator Dennis CAI

Submitted By Yun Zhao

Participated Panelist

Date of Decision 01-12-2008

Language Version : English

The Parties Information

Claimant	Linda Wilcox
Respondent	Kereni Martin

Procedural History

On 8 July 2008, the Complainants submitted a Complaint in the English language to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and elected this case to be dealt with by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On 24 July 2008, the ADNDRC sent to the complainants by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules. All correspondence to and from the HKIAC described herein was in the English language.

On October 13, 2008, the ADNDRC informed the Complainant by email of the deficiency in the Complaint and requested the Complainant to resubmit the Complaint by October 20, 2008. After some queries, the Complainant submitted the revised Complaint on October 20, 2008.

On 24 July 2008, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. With no response from the Registrar, the ADNDRC sent the same request by emails for another 6 times (on September 1, September 22, September 24, September 25, October 1 and October 12, 2008 respectively). On October 12, 2008, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details. The ADNDRC requested by emails on October 12, 2008 and October 21, 2008 the Registrar to take measures preventing the transfer of the disputed domain name. On October 22, 2008, the Registrar confirmed that certain measures had been taken.

On 31 October 2008, the ADNDRC transmitted the Complaint to the Respondent and notified the Respondent of the commencement of the action. In accordance with the Rules, the due date for the Response was November 24, 2008. The Respondent did not submit any response before the deadline. Accordingly, the ADNDRC notified the Respondent's default on November 26, 2008.

The ADNDRC appointed ZHAO Yun as the sole panelist in this matter on November 26, 2008. 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 ADNDRC to ensure compliance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 26 November 2008, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 10 December 2008.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, thus the Panel determines English as the language of the proceedings.

Factual Background

For Claimant

The Complainant in this case is Linda C Wilcox. The Complainant is the owner of Wilcox Safety & Signs. The registered address of the Complainant is as follows: 1/19 Burgess Road, Bayswater North, VICTORIA 3153 AUSTRALIA.

For Respondent

The Respondent, Kereni Martin (ID00192177), is the current registrant of the disputed domain name <wilcoxsafety.com/adeptsafetyonline.com> according to the Whois information. The address of the Respondent is 6/1-3 Albert Street, Highett, Victoria 3190 Australia.

Parties' Contentions

Claimant

The Complainant registered the domain names "wilcoxsafety.com.au" and "adeptsafetyonline.com.au" on May 4, 2004. Wilcox is the Complainant's surname. Wilcox

Safety & Signs and Adept Safety Online are registered business entities, having commenced business on April 27, 2004. the entities traded as firms for the purposes of Victorian law and were 100% owned and operated by the Complainant, who was the relevant legal entity for the purpose of Australian state and federal law. On June 3, 2005, Wilcox Safety and Signs Pty Ltd succeeded to the business of the firms. The corporation is a wholly owned entity of the Complainant who is its sole director and authorized company officer. The Complainant has conducted her businesses of safety signage and safety products in Victoria continuously since April 2004. The Complainant utilises the domain names for marketing and communications and to gain commercial advantage. The Complainant promotes the domain names with a reasonable expectancy of preference amongst the businesses' customers and potential customers. The domain names have, in accordance with the Complainant's business plan, contributed materially to the benefit and advantage of the good name and reputation of the Complainant's businesses.

The Respondent registered the disputed domain names on November 28, 2007. The Respondent conducts the business of registering and selling domain names, as well as tips and information blogs for new businesses. The Respondent does not conduct a safety signage or related business. The Respondent registered the domain names primarily for the purpose of selling, renting or otherwise transferring the domain names and has no legitimate right or interest in respect of the disputed domain names. The Respondent's conduct is not incidental or inadvertent, rather it is deliberate and intended to have an adverse impact on the Complainant's business by causing a sensible diminution in customer and potential customer hits on the Complainant's front of business electronic commerce platform. Accordingly, the disputed domain names were registered by the Respondent in bad faith.

The disputed domain names are identical or confusingly similar to the Complainant's domain names as by their nature appears.

The Complainant's user and intended continued user of the marks "wilcoxsafety" and "adeptsafetyonline" in connection with its electronic commerce and as demonstrated by its domain name registration and business name registration of same, unequivocally establish them as trademark. The marks are used and intended to continue to be used by the Complainant to distinguish its goods and services in the course of trade from the goods or services of any other person or business. The Respondent has infringed the trademarks by registering them as domain names on November 28, 2007 without the Complainant's authority and with the intention of using the domain names or on selling them to a third party who intends to use them in circumstances where the trademarks are likely to be confused with the goods or services of the Complainant.

The Registration of the disputed domain name is conduct that its misleading and deceptive or likely to mislead and deceive in trade and commerce. The conduct by the Respondent will tend to lead consumers of safety signage products and services into error and is accordingly prohibited conduct of a corporation engaging in trade and commerce in Australia.

The Complainant is entitled to protection from economic loss arising from the Respondent's representations via the disputed domain names that its goods or services are those of the Complainant. Such protection is necessary to protect the goodwill associated with the Complainant's businesses.

In accordance with Paragraph 4(b)(i) of the Policy, the Complainants request the Panel to issue a decision to transfer the Disputed Domain Name to the Complainant.

Respondent

The Respondent did not reply to the Complainant's contentions.

Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4 (a) of the Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- 1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) the domain name has been registered and is being used in bad faith.

Identical / Confusingly Similar

The evidence submitted by the Complainant shows that the Complainant registered the business names "Wilcox safety & Signs" and "Adept Safety Online" in 2004. The Panel thus finds that the Complainant enjoys the common law service mark rights in the above names. The main parts of the two disputed domain names are "wilcoxsafety" and "adeptsafetyonline" respectively. As the suffix ".com" only indicates that the domain name is registered under this gTLD and is not distinctive, the Panel has no problem in finding that the disputed domain names <wilcoxsafety.com / adeptsafetyonline.com> are identical and/or confusingly similar to the Complainant's service marks "Wilcox safety & Signs" and "Adept Safety Online".

The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4 (a)(i) of the Policy

Rights and Legitimate Interests

The Complainant contends that the Respondent does not have rights to or legitimate interests in the Disputed Domain Names. The Respondent has no relationship with or permission from the Complainant for the use of the service marks. The Complainant's assertion is sufficient to establish a *prima facie* case under Policy 4 (a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests. The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the Disputed Domain Names.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

Bad Faith

Under Paragraph 4 (b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- (i) Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in pattern of such conduct; or
- (iii) You have registered the domain name primarily for the purpose disrupting the business of a competitor; or
- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Complainant registered the two service marks in 2004 and has been continuously using the marks for his business since then. The Respondent registered the two disputed domain names, which are both identical and/or confusingly similar to the marks of the same entity, in 2007 and on the same date. Since the registration, the Respondent has not been actively using the disputed domain names. The Respondent's conduct cannot be reasonably explained by coincidence or inadvertence. This entitles the Panel to infer that the Respondent should be aware of the existence of the Complainant and the marks. The above circumstance has further led to the assumption that the Respondent registered the disputed domain name to hinder the Complainant from registering it. The action of registering the disputed domain name per se has constituted bad faith.

In conclusion, the Panel finds that the Respondent has registered and used the domain name in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4 (a) (iii) of the Policy.

Status

www.wilcoxsafety.com	Domain Name Transfer
www.adeptsafetyonline.com	Domain Name Transfer

Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain names <wilcoxsafety.com / adeptsafetyonline.com> should be TRANSFERRED from the Respondent to the Complainant.

ZHAO Yun

Sole Panelist

DATED: 27 November 2008