



# ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	<b>HK-1100384</b>
<b>Complainant:</b>	<b>Marathon Food Industries Pty Limited</b>
<b>Respondent:</b>	<b>John Bade / Outback Computers Pty Ltd</b>

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### 1. The Parties and Contested Domain Name

The Complainant is Marathon Food Industries Pty Limited, an Australian registered company, represented by Minter Ellison Lawyers.

The Respondent is John Bade / Outback Computers Pty Ltd, self-represented.

The domain name at issue, <**marathonfoods.com**>, is registered with Network Solutions LLC.

### 2. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the “Center”) on August 5, 2011. On August 10, 2011, the Center transmitted by email to Network Solutions LLC. a series of requests for registrar verification in connection with the domain name at issue. On that same day Network Solutions LLC. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules of Procedure under the Policy (the “Rules”), and the Center’s Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 22, 2011. In accordance with the Rules, the due date for Response was September 11, 2011. A Response was filed on September 11, 2011.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on October 12, 2011. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

Both parties made Additional Submissions in accordance with the Rules which have been fully taken into account by the Panel in reaching its Decision.

### **3. Factual background**

#### **A. For Complainant**

1. The Complainant is an Australian manufacturer of foodstuffs.
2. The Complainant has used and registered the trademark MARATHON FOODS in relation to those goods.
3. The Complainant promoted and offered for sale its goods at a website corresponding with the disputed domain name, www.marathonfoods.com.
4. The Complainant had engaged the Respondent as a contractor for a period of time prior to filing of the Complaint.
5. The Complainant terminated the Respondent's services in May 2011 and later, through its legal representatives, demanded transfer of the disputed domain name.

#### **B. For Respondent**

6. The Respondent was a consultant IT service provider to the Complainant in the period from June 1998 to May 2011.
7. The Respondent registered the disputed domain name on October 21, 1999.
8. The Respondent later used the domain name to develop the website at www.marathonfoods.com and to provide electronic mail services for the Complainant.

### **4. Parties' Contentions**

#### **A. Complainant**

The Complainant asserts rights in the trademark MARATHON FOODS and states that the disputed domain name is identical or confusingly similar to the trademark.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant alleges that the Respondent registered and used the disputed domain name in bad faith.

The Complainant petitions the Panel to order transfer the disputed domain name from the Respondent to the Complainant.

#### **B. Respondent**

The Respondent argues in particular that it has not acted in bad faith.

#### **C. Additional Submissions**

As indicated, both parties made additional submissions which have also been taken into account. The detail of those submissions and of the parties' primary contentions are set out in more detail where necessary in the Findings which follow.

## 5. Preliminary Findings

### **A) Proper identification of Respondent**

The named Respondent is not the registrant of the disputed domain name. According to the publicly available WHOIS data, the domain name is registered to “Outback Computers”.

It is common ground between the parties that “Outback Computers” was the trading name of the Respondent and was registered in the State of Victoria as a business name. The Respondent, together with others, was the recorded owner of that name.

The Respondent is also shown to be the director of an Australian Company by the name of Outback Computers Pty Ltd. The Complainant submits that the John Bade and Outback Computers Pty Ltd “are the rightful respondents in these proceedings”. The Complaint has thus defined the Respondent to be both the individual and the company.

Paragraph 1 of the Rules defines “Respondent” to mean “the holder of a domain-name registration against which a complaint is initiated.” Paragraph 3(b)(v) of the Rules states that the Complaint will “[P]rovide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and telefax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to send the complaint as described in Paragraph 2(a).”

The Panel follows the consensus of former panelists applying the Policy who have considered substantive compliance with these Rules to be adequate. In the case of paragraph 3(b)(v), the Panel is satisfied that it was adequate in these administrative proceedings for the Complaint to have nominated the Respondent as it did since there is an undeniable nexus between the domain name holder and at least John Bade.

### **B) Scope of the Policy**

A fundamental question arises in this case as to whether the dispute between the parties properly falls for determination under the Policy. In *Draw-Tite, Inc. v. Plattsburgh Spring Inc.*, WIPO Case D2000-0017, it was said “[T]his Panel well recognizes that its jurisdiction is limited to providing a remedy in cases of ‘the abusive registration of domain names,’ or ‘Cybersquatting’ . . . Like any other tribunal, however, this Panel can determine whether it has jurisdiction only from the facts and arguments presented to it.”

In *Thread.com, LLC v. Poploff*, WIPO Case D2000-1470, the panel refused to transfer the domain name, stating that the Policy did not apply because attempting “to shoehorn what is essentially a business dispute between former partners into a proceeding to adjudicate cybersquatting is, at its core, misguided, if not a misuse of the Policy.” (see also, *First Nationwide Exchange, Inc. v. Reskyu*, FA 956937 (Nat. Arb. Forum May 26, 2007)).

Similarly, previous panels have found that disputes between employers and employees are outside the scope of the Policy and should be decided in a court of law. In *Latent Tech. Group, Inc. v. Fritchie*, FA 95285 (Nat. Arb. Forum Sept. 1, 2000), the panel held that a dispute concerning an employee’s registration of a domain name in his own name and his

subsequent refusal to transfer it to his employer raised issues of breach of contract and breach of fiduciary duty that were more appropriately resolved in court, not before a UDRP panel (see also, *Discover New England v. Avanti Group, Inc.* FA 123886 (Nat. Arb. Forum Nov. 6, 2002)).

Moreover, in *Love v. Barnett*, FA 944826 (Nat. Arb. Forum May 14, 2007), the panel found the dispute to be outside the scope of the Policy because the respondent could not be characterized as a cybersquatter or individual who registered and used the domain names at issue in bad faith. The panel stated that the purpose of the Policy is not to resolve disputes between parties who might each have legitimate rights in a domain name. The purpose of the Policy is to protect trademark owners from cybersquatters, that is, from people who abuse the domain name system in a very specific way, which specific way is outlined in Paragraph 4(a) of the Policy (see also *Frazier Winery LLC v. Hernandez*, FA 841081 (Nat. Arb. Forum Jan. 2, 2007)).

Clearly, the Respondent is not a cybersquatter and there is no such suggestion in the submissions. Nor, on the other hand, was the Respondent an employee or business partner of the Complainant. Nevertheless, whilst there was no written consultancy agreement (or any other written agreement) regulating the parties' business relationship, it lasted for a good many years during which time the Respondent was responsible for all the Complainant's IT needs.

Another panel might dismiss these proceedings for want of a proper mandate, however, on the facts this Panel takes the view that it is proper for it to move forward and apply the Policy. Whilst there might be unfinished business between the parties for all manner of reasons given the longevity of their business dealings, it does not seem to the Panel that there could be any real controversy about the rightful claim to the disputed domain name. That said, there is a serious question as to whether it can justifiably be alleged that the Respondent has acted in bad faith and that is something which is best analysed under the Policy.

## 6. Primary Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at paragraph 4(a), that each of three findings must be made in order for the Complainant to prevail:

- i. Respondent's domain name must be identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

### **A) Identical / Confusingly Similar**

No findings required. For reasons which follow, the Panel finds that the question of bad faith is determinative of these proceedings (see *Creative Curb v. Edgetec Int'l Pty. Ltd.*, FA 116765 (Nat. Arb. Forum Sept. 20, 2002) holding that because Complainant must prove all three elements under the Policy, Complainant's failure to prove one of the elements makes further inquiry into the remaining element unnecessary; see also *Hugo*

**B) Rights and Legitimate Interests**

No findings required.

**C) Bad Faith**

Paragraph 4(a)(iii) of the Policy requires both registration in bad faith and use in bad faith.

The evidence suggests that following notification of termination of the Respondent's services, certain actions taken by the Respondent may have been less than professional. Taken in isolation, some of the Respondent's dealings with, or in connection with, the domain name might be properly characterised as having been undertaken in bad faith.

Moreover, in spite of the Respondent's protestations to the contrary, a persisting question remains as to why the Respondent has not subsequently transferred the disputed domain name to the Complainant since it is manifestly clear that no use of that name in the future by the Respondent could be in good faith.

Nevertheless, these are not enquiries for this Panel since for the purposes of the Policy the critical question in these proceedings is whether the domain name was registered in bad faith.

The domain name was registered on October 21, 1999. As described, the Complainant has chosen to define the Respondent in these proceedings as both of John Bade and Outback Computer Pty Ltd. The Complainant's evidence shows that the company was incorporated in 2004. That fact alone ends any claim of bad faith registration so far as that "Respondent" is concerned.

The Complaint states that "on or about 21 October 1999, the Complainant directed the Respondent to register the Disputed Domain Name, at the Complainant's expense, in the Complainant's name. It has only recently become apparent that, contrary to Complainant's direction, the Respondent registered the Disputed Domain Name in his own name."

The Complainant further submits that the Respondent did so "as surety for his continued appointment as the Complainant's IT Services provider." It is further alleged that during the course of its registration, the disputed domain name has been renewed at the Complainant's direction and expense and that, upon confirmation of renewal, the Respondent did not disclose that the domain name was not registered to the Complainant. The Panel notes here that the Complaint is laced with terms such as "dishonesty" and "concealment".

For its part, the Respondent strongly refutes the assertion that on or about October 21, 1999 the Complainant directed the Respondent to register the disputed domain name in the name of the Complainant.

The Respondent states that "for a period of approximately 13 years the Respondent provided a comprehensive range of IT services. These included research, advice, training,

policy, installation, maintenance and support of computer hardware and software in relation to the Complainant's business and personal activities including security systems, factory SCADA systems, factory operations with quality QA reporting, accounting system, marketing and sales."

The Respondent alleges that "part of the services provided to the Complainant's organisation was the original establishment of email addresses. In 1998 the Complainant organisation had no email addresses or a connection to the Internet."

The Respondent describes the Complainant as a large Greek family business, in its words, "characterised by poor levels of English literacy, a minimal level of computer literacy, frequent absences by owners and executives on overseas trips for business and personal reasons and erratic behaviours by and between owners."

The Respondent further states that "due to the [*Complainant*] Managing Director's poor English language skills, illiteracy, fear of the Internet and reluctance to provide his staff with an Internet connection, the task of resolving any Internet related issues were compounded."

It is well established that, under the Policy, the Panel must decide evidentiary matters on the civil standard of the balance of probability.

There is no evidence before the Panel to support the assertion that, on or before October 21, 1999, the Respondent was directed to register the domain name in the Complainant's name. There is no evidence that the Complainant took real interest in matters of that kind. The Complainant concedes in its additional submissions that it "was heavily reliant on the Respondent to provide the IT Services, due to the Complainant's limited IT experience and capabilities." Within that context, the Response as a whole makes it fairly clear that registration of the domain name in the name of Outback Computers was expedient rather than malevolent and that continued renewal(s) of the domain name in that name were as routine as they were routinely uninteresting to the Complainant.

The Complainant's additional submissions state that the Response makes "unnecessary statements concerning the characteristics of individuals in the Complainant's organisation. These ... allegations and statements have no relevance to the dispute." The Panel gives the statements made by the Respondent the weight they deserve which is to say that they portray a company management with low IT literacy and giving proportionately less attention to that side of its business than to others. Finally, it should be said that the repeated charges in the Complaint of "dishonesty" and "concealment" on the part of, or by, the Respondent seem to have no foundation on the evidence.

On balance, the Panel finds that the Respondent did not act in bad faith when it registered the domain name.

In reaching that conclusion it is entirely appropriate for a UDRP panelist to give weight to its own appreciation of commercial matters of relevance. Whilst on the evidence alone the Panel would have reached the same finding, it is nonetheless mindful that in 1999 domain names were seen less as a species of intellectual property than they are today and it was correspondingly more common for IT service providers to make domain name registrations in their names or in the names of their service companies without the perception that they were usurping the property rights of others.

These findings do not entirely dispose of the matter. Paragraph 4(b) of the Policy sets out the circumstances which shall be evidence of the, *per se*, registration and use of a domain name in bad faith. They are:

- (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 a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of 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 has alleged that, following termination of the Respondent's services in mid 2011 and during an ensuing telephone conversation between the Respondent and the Complainant's legal representative, the Respondent is said to have indicated that it would only transfer the disputed domain name to the Complainant on payment of an agreed sum of money.

Referencing that allegation, the Complaint states that "[A]ny sum of money demanded by the Respondent would therefore constitute 'valuable consideration in excess of [the Respondent's] out of pocket expenses directly related to the Disputed Domain Name' which is listed in Article 4(b)(iii) as demonstrating unequivocal evidence of bad faith for the purposes of Article 4(a)(ii) of the UDRP".

The Panel must assume that the reference to "Article 4(b)(iii)" is intended to be a reference to paragraph 4(b)(i), set out above, but in any event the Panel does not find any support for that subparagraph since there is no evidence at all to suggest that, in October 1999, the Respondent registered the domain name "primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant". Whilst there might be cases where a respondent's actions subsequent to registration cast a telling shadow over its motives at the time of registration, the Panel is unable to draw any such inference here.

Finally, in its additional submissions, the Complainant reasons that "the Respondent now admits that, over a number of years, he invoiced the Complainant for a 'subscription fee' in excess of the costs of registering the Disputed Domain Name. This is itself an indicator of a bad faith registration on the part of the Respondent."

The Panel cannot agree. Even if that fee could more convincingly be linked to the Respondent's motives at the time of registration, it is unclear that it shows bad faith in any manner since on the evidence it would appear that the fee was simply a composite part of the Respondent's charges for IT services.

Accordingly, the Complainant has failed to satisfy the third element of the Policy.

**7. Decision**

Having failed to establish at least one of the three elements required under the Policy for the foregoing reasons, the Panel decides that relief shall be **DENIED**.



Debrett G. Lyons  
Sole Panelist

Date: October 28, 2011

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