ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

(Kuala Lumpur Office)

ADMINISTRATIVE PANEL DECISION

AIAC/ADNDRC-809-2020

Complainant: Victorian Ambulance Union

Authorized Representative of the Complainant: Gordon Legal Pty Ltd

Respondent: Hall Payne Lawyers

Authorized Representative of the Respondent: Dale Blackmore, Lawyer, Hall Payne Lawyers

Domain Names:
<victorianambulanceunion.com>
<victorianambulanceunion.org>
<victorianambulanceunion.net>

Registrar: GoDaddy.com, LLC

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1. PROCEDURAL HISTORY

On 14 January 2020, Complainant submitted a Complaint with the Kuala Lumpur Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC), in accordance with the ICANN Uniform Domain Name Dispute Resolution Policy ("the Policy").

On 30 January 2020, the Registrar, GoDaddy.com, LLC, confirmed to the ADNDRC that the disputed domain names are registered with GoDaddy.com, LLC and that Respondent is the current registrant of the domain names. GoDaddy.com, LLC has verified that Respondent is bound by its registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with the Policy. GoDaddy.com, LLC stated that the language of registration agreement for the domain names is English and the domain names were registered on 24 June 2019.

On 20 February 2020, Respondent submitted a timely Response, requesting that the case by heard by a three-member Panel.

On March 4, 2020, having followed its list procedure, ADNRC appointed Mr. Andrew Sykes and Dr. Andrew Christie as Panelists and Dr. Richard Hill as Presiding Panelist. The Panelist appointments and the commencement of proceedings were duly communicated to the parties on the same day.

The undersigned Panelists certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelist in this proceeding. In particular, Panelist Dr Richard Hill is not related to, and has no association with, Mr Danny Hill who is associated with Complainant.

2. FACTUAL BACKGROUND

For the reasons set forth below, the Panel will not make any findings of fact other than the finding that the Respondent holds the disputed domain names on trust for the United Workers' Union (referred to hereafter as "Respondent's principal").

3. PARTIES' CONTENTION

Complainant

The disputed domain names are confusingly similar to the trade mark, business name and Complainant's incorporated name. Respondent is an entity completely unrelated to Complainant and Complainant never authorised Respondent to register and retain the disputed domain names. Further, Respondent is not in the ambulance business, nor is it a union. Respondent has not created any website with the disputed domain names, or (it appears) made any preparation to use the disputed domain names in connection with any offering of goods or services. Respondent has no rights or legitimate interests in the disputed domain names.

The use of the disputed domain names by Respondent is likely to mislead the public into believing that the disputed domain names belong to or are related to Complainant due to them being identical or confusingly similar to the name under which Complainant has rights. Complainant contends that the disputed domain names were registered with the Respondent having full knowledge of the intention of the Complainant to use the name "Victorian Ambulance Union" and with a view to:

a) obtaining unjust benefits through selling or renting the disputed domain names;

b) preventing Complainant from registering and using domain names made up of its trading name and unregistered trade mark;

c) disrupting the business of Complainant; and

d) attempting to attract, for commercial gain, by creating a likelihood of confusion as to an affiliation with Complainant.

Complainant acknowledges that the date of its incorporation and application to register trademarks post-date the date of registration of the disputed domain names, but the period of time between the two events is only ten days, and for the reasons set out below, it is contended that the registration of the disputed domain names was done to prevent Complainant from reflecting its trading name in a corresponding domain name, and that Respondent is engaging in a pattern of conduct by registering multiple domain names identical to Complainant's name. The relevant facts are:

From 11 June 2019, Complainant operated as an unincorporated association under the name "Ambulance Employees' Association".

On 19 June 2019 Complainant announced on its closed Facebook page that it was adopting the name "Victorian Ambulance Union".

On 4 July 2019, Complainant was registered as an incorporated association registered with Consumer Affairs Victoria and has been the registrant of the business name "Victorian Ambulance Union" since 8 October 2019, being the date that the Minister approved its use of the restricted word 'ambulance' in Complainant's business name.

On 3 October 2019, Complainant applied for an Australian trademark that includes the phrase VICTORIAN AMBULANCE UNION.

Respondent

Respondent is the legal representative of the United Worker's Union (UWU). In the present proceedings, it is a mere agent or nominee of the Proper Respondent, which is the UWM.

Complainant has not evidenced that it was established on 11 June 2019 either as an unincorporated association or as an incorporated association. Complainant has not evidenced any actual rights to the name "Victorian Ambulance Union" and has merely demonstrated an intention to use the name. Complainant has not proven use of the phrase Victorian Ambulance Union as a trademark or demonstrated that an application for that phrase as a trademark was made prior to the registration date of the disputed domain names. Consequently, Complainant has not evidenced any rights to the name prior to the date of registration of the disputed domain names.

Further, Complainant has failed to provide evidence that it has acquired common law trademark rights in the mark VICTORIAN AMBULANCE UNION. Complainant has failed to demonstrate that the mark has acquired a secondary meaning, and it has failed to demonstrate that the mark was distinctive prior to the date of registration of the disputed domain names.

The mark is wholly descriptive, and Complainant has failed to evidence that the mark has become associated with the Complainant for the following reasons:

(a) Complainant has purportedly evidenced use of the mark in a closed Facebook group open only to its members;

(b) Complainant has purportedly evidenced use of the mark in a bulletin to Ambulance Victoria employees who comprise its intended membership;

(c) the name Victorian Ambulance Union is wholly descriptive or generic; and

(d) it cannot be correct that the words Victorian Ambulance Union acquired a secondary meaning associated with the Complainant because (i) Complainant was not incorporated until 4 July 2019 and the words cannot have acquired an immediate secondary meaning; and (ii) the steps it relies upon to establish its

use of the name occurred after Respondent's registration of the disputed domain names.

Respondent has rights or legitimate interests in the disputed domain names because they are descriptive of the Proper Respondent's business; further, the Proper Respondent has been commonly known by the disputed domain names, and it is making a legitimate or fair use of the names, without intent to mislead.

In support of its allegations, Respondent alleges the following facts:

Prior to 1994, the Ambulance Employees Association of Victoria was an employee organization registered under the (then) Industrial Relations Act 1988 (Cth). Since then, it is the only registered organization enrolling as members those employees who work in, or in connection with, the provision of ambulance services in Victoria.

On 1 June 1994, an amalgamation took place between the Ambulance Employees Association of Victoria and the Australian Liquor, Hospitality and Miscellaneous Workers Union (ALHMWU) being an organisation registered under the (then) Industrial Relations Act 1988 (Cth).

The Ambulance Employees Association of Victoria was subsequently de-registered, and the ALHMWU was the registered union who could enroll and represent members who worked in the ambulance industry in Victoria.

An agreement was reached between the two former organisations prior to the amalgamation, that would afford the former members of the Ambulance Employees Association of Victoria recognition in the amalgamated ALHMWU.

This recognition was given effect by the creation of a section of the Victorian Branch of the ALHMWU called the Ambulance Employees Association of Victoria (AEAV).

On 12 March 2004, the Australian Liquor, Hospitality and Miscellaneous Workers Union changed its name to Liquor, Hospitality and Miscellaneous Union. On 1 March 2011, the name was again changed from Liquor, Hospitality and Miscellaneous Union to United Voice.

From 1994 to 2019, the AEAV were afforded special recognition as a section of the Proper Respondent.

On 11 November 2019, United Voice and the National Union of Workers amalgamated. As a result of the amalgamation, United Voice changed its name to United Workers' Union and the National Union of Workers was de-registered.

The section of the Proper Respondent known as the AEAV remains a part of the Proper Respondent post-amalgamation.

The Secretary and Assistant Secretary of Complainant were former position holders and staff of Respondent.

Complainant has asserted that the status of the AEAV section was altered under the post-amalgamation rules of the Proper Respondent. Respondent rejects this assertion but confirms its understanding that this was asserted to employees of Ambulance Victoria and may have been the reason that these former members of the Proper Respondent joined Complainant.

Because the Victorian Government has referred their power to legislate in relation to Industrial Relations to the federal Government, there is no organisation registered under Victorian industrial legislation. Consequently, there is no distinct state entity capable of providing industrial representation to the employees who work in, or in connection with, the provision of ambulance services in Victoria.

It is for these reasons that the Proper Respondent was historically, and still is, the union for those employees who work in, or in connection with, the provision of ambulance services in Victoria.

The length of time in which the Proper Respondent has held the disputed domain names without use is not evidence of bad faith. The Proper Respondent has for the past six months been going through a process of amalgamation, involving a significant number of reporting units across the whole of the country, that has taken up significant resources and time of the relevant officers.

4. LEGAL DISCUSSION AND FINDINGS

Before turning to the substantive issues, the Panel will discuss a procedural issue and a preliminary issue.

Procedural Issue

Paragraph 8 of the Rules for the Policy ("the Rules") states: "All communications between a Party and the Panel or the Provider shall be made to a case administrator appointed by the Provider in the manner prescribed in the Provider's Supplemental Rules."

Article 4.1 of the ADNDRC Supplemental Rules states: "Where a Party intends to send any communication to the Panelist(s), it shall be addressed through the Office of the Centre which the Complainant has selected to administer the proceedings."

Both Complainant and Respondent have violated these rules, by sending submissions directly to the panelists.

For the reasons set forth below, the Panel finds that it does not need to consider these submissions formally, even if it does take note of them.

If the Panel had found that it was advisable to consider the submissions formally, it would have issued a Procedural Order accepting Complainant's submission, reminding the parties to make submissions through the ADNDRC pursuant to the applicable rules, and setting a deadline for Respondent to reply to Complainant's submission.

Preliminary Issue

As a preliminary matter, a majority of the Panel (Dr Hill and Mr Sykes) notes that this case falls outside the scope of the Policy and would better be handled in national court proceedings. *See Indoor Air Technologies, Inc. v. Casey Janke / My Tech Company LLC / Privacy Administrator / Anonymize*, Inc., FA 1714547 (Forum Mar. 14, 2017); *see also Everingham Bros. Bait Co. v. Contigo Visual*, FA 440219 (Forum Apr. 27, 2005) (The Panel finds that this matter is outside the scope of the Policy because it involves a business dispute between two parties. The UDRP was implemented to address abusive cybersquatting, not contractual or legitimate business disputes.); *Frazier Winery LLC v. Hernandez*, FA 841081 (Forum Dec. 27, 2006) (holding that disputes arising out of a business relationship between the complainant and respondent regarding control over the domain name registration are outside the scope of the UDRP Policy).

In particular, on the material before this majority of the Panel it appears there is a dispute between the parties over the alleged subsistence and ownership of rights in relation to the VICTORIAN AMBULANCE UNION trade mark in Australia. Such a dispute needs to be handled by an Australian national court applying Australian law. It is not appropriate for the Panel to determine a complex dispute of this nature. The UDRP was not designed to cater for such disputes between parties.

A minority of the Panel (Dr Christie) is of the view that the Complaint is within the scope of the UDRP Policy – it relates to domain names to which the UDRP applies, it is based on a claim to a right (a trademark) that the UDRP recognises, it concerns alleged activity in relation to the domain names (bad faith registration and use) that the UDRP recognises, and it seeks a remedy available under the UDRP.

However, for the reasons set forth below, the Panel finds that the above matter is not dispositive for the present proceedings.

Substantive Issues

Paragraph 4(a) of the Policy requires that Complainant must 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 Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(2) 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.

Paragraph 15(a) of the Rules instructs this Panel to "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."

Identical and/or Confusingly Similar

In order to succeed on this element of the Policy, Complainant must prove that it has acquired trademark rights, either in a registered trademark, or in a common law trademark. Complaint does not have registered trademark rights: while its trademark application has been accepted, it has not yet been registered. The acceptance is currently open to opposition and Respondent has stated that it will lodge an opposition to registration, so the trademark might not ever be registered.

Complainant asserts that it has acquired common law trademark rights.

According to 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition:

> To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services.
>
> Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.
>
> ...
>
> Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.

The Panel finds, unanimously, that Complainant has not provided adequate evidence to support its allegation that it acquired common law trademark rights. In particular, it has not provided sufficient evidence of acquired distinctiveness to support its conclusory allegations.

The Panel notes that an auDRP Panel has found that Complainant did prove common law rights in the mark VICTORIAN AMBULANCE UNION: *Victorian Ambulance Union Inc. v United Workers' Union*, auDRP_20_1. That case can be distinguished from the present case because it was decided under the auDRP, which has relevant provisions that are different from the UDRP. In particular, paragraph 4(a)(i) of the auDRP is not limited to rights in a trademark (registered or common law). That paragraph is satisfied if the Complainant has rights in a name (including a company name or business name) to which the disputed domain name is identical or confusingly similar. Further, the instant Panel disagrees with the findings of the Panel in the cited case on the question of

whether the Complainant has proved that it has rights in VICTORIAN AMBULANCE UNION as a common law trademark.

Consequently the Panel finds that Complainant has failed to satisfy its burden of proof for this element of the Policy.

The Panel notes that Complainant is not precluded from filing another Complaint in respect of the disputed domain names at a later stage, when it may be able to demonstrate that it has acquired trademark rights in VICTORIAN AMBULANCE UNION because the mark has been registered, or through use the mark has acquired secondary meaning. In this respect, 4.18 of the cited WIPO Compendium states: "Panels have accepted refiled complaints only in highly limited circumstances such as (i) when the complainant establishes that legally relevant developments have occurred since the original UDRP decision ...".

Rights or Legitimate Interests

Given that Complainant fails on the first element of the Policy, the Panel need not analyze the other elements. Nevertheless, the Panel makes the following non-dispositive observations.

Prima facie, a majority of the Panel (Dr Hill and Dr Christie) is of the view that Complainant has not discharged its burden of establishing that Respondent's principal (the alleged Proper Respondent) has no rights or legitimate interests in the disputed domain names. Between 1994 and 2019, Respondent's principal or its predecessor in title has apparently been the union that represents Victorian ambulance workers. Since 2019, there has apparently been competition for representation of Victorian ambulance workers. Respondent's principal is one of the two organisations that seeks to, and does, do so. Thus Respondent's principal has a plausible claim to rights or legitimate interests in the disputed domain names.

A minority of the Panel (Mr Sykes) does not accept that Respondent has established rights or legitimate interests in the disputed domain name, even if VICTORIAN AMBULANCE UNION may be used in a descriptive manner. In particular the minority says that the Respondent is not known as "VICTORIAN AMBULANCE UNION" and further that regardless of the fact that the those words may be used in a descriptive manner the Respondent has not established they have a legitimate right or interest in such use.

Registration and Use in Bad Faith

As already noted, the Panel need not analyze this element of the Policy. Nevertheless, the Panel makes the following non-dispositive observations.

The Panel notes that Respondent mistakenly cites (§ 90 of the Response) the provisions of 4(b) of the auDRP, which are not identical to the corresponding provisions of the Policy: the Policy has no equivalent of auDRP 4(b)(v), and the Policy requires finding a pattern of conduct under 4(b)(ii).

Be that as it may, a majority of the Panel (Dr Hill and Dr Christie) is of the view that Respondent's principal can plausibly claim that "Victorian Ambulance Union" is descriptive of its business; that that is the purpose for which it registered the disputed domain names; and that, given its ongoing process of amalgamation, the length of time in which Respondent has held the disputed domain names without use is not evidence of bad faith.

A minority of the Panel (Mr Sykes) is of to the view that the disputed domain names were registered for the purpose of preventing Complainant from reflecting its newly developed trade mark in corresponding domain names or for otherwise disrupting Complainant's business. The trade mark was promoted shortly before the registration, so the registration cannot be a coincidence. In this regard, the minority wonders why Respondent registered the disputed domain names unless it was to disrupt Complainant, and it notes that Respondent has not provided any detailed explanation or plans for its intended use of the disputed domain names, which were registered more than six months before the Complaint was filed. The minority nevertheless accepts that its finding on bad faith is moot when due to the Complaints inability to establish trade mark rights un accordance with the first provision of the Policy, which it would seem may need to be determined by a national court.

5. DECISION

For the reasons given above, the Complaint is **DISMISSED** and it is **ORDERED** that the disputed domain names <victorianambulanceunion.com>, <victorianambulanceunion.org>, and<victorianambulanceunion.net> **REMAIN** with Respondent.

The Panel finds that the Complainant is not prohibited from filing a subsequent Complaint in relation to the said domain names if circumstances change.

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Richard Hill

Presiding Panelist

16 March 2020

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Andrew Sykes

Panelist

16 March 2020

Andrew F. Christie

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Andrew Christie

16 March 2020