

Respondent's activity defeats '.au' DRP

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Legal updates: case law analysis and intelligence

- Frankie Shop, owner of several THE FRANKIE SHOP marks, including an international trademark designating Australia, sought the transfer of six domain names comprising its mark under the '.au' DRP
- While the respondent had not filed any submissions, the panel conducted a brief search using publicly available sources on the Internet
- The respondent had rights or legitimate interests in the domain names through its operations under the business name FRANKIES AUTO ELECTRICS in Australia

In a recent [decision](#) under the ['.au' Domain Name Dispute Resolution Policy](#) ('.au' DRP) before WIPO, a panel has refused to order the transfer of six domain names that comprised the complainant's trademark (or a slight variation of it), principally because the complainant had failed to demonstrate that the respondent lacked rights or legitimate interests in the domain names. '.au' is the country-code top-level domain for Australia.

Background

The complainant was Frankie Shop LLC (United States), an online fashion clothing retailer. The complainant was the owner of several trademarks for THE FRANKIE SHOP, including an international trademark designating Australia, which was registered on 12 October 2021. The respondent was Farrugia Global Enterprises Pty Ltd, a company based in Australia.

The domain names were 'frankieshop.au', 'frankiesshop.com.au', 'frankieshop.net.au', 'frankiesshop.au', 'frankiesshop.com.au' and 'frankiesshop.net.au', all registered on 22 June 2023.

At the time the complaint was filed, the domain names were all resolving to the same registrar parking page, containing sponsored links and a "Get this Domain" link.

To be successful in a complaint under the '.au' DRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

- (i) the domain name registered by the respondent is identical, or confusingly similar, to a name, a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered or subsequently used in bad faith.

Decision

First limb

The panel considered that the domain names consisted of the dominant feature of the complainant's FRANKIE SHOP trademark, namely the words 'frankie shop' or 'frankies shop' (with 'frankie' in the plural). The domain names were therefore confusingly similar to the complainant's trademark and the complainant satisfied the first element set out in Paragraph 4(a)(i) of the '.au' DRP.

Second and third limbs

Under the second requirement, a complainant must prove that a respondent has no rights or legitimate interests in respect of the domain name in question. A complainant is normally required to make out a *prima facie* case and it is for the respondent to demonstrate otherwise. If the respondent fails to do so, then the complainant is deemed to satisfy Paragraph 4(a)(ii).

Paragraph 4(c) of the '.au' DRP lists three non-exhaustive examples of ways in which a respondent may establish rights or legitimate interests in a domain name, as follows:

- “
- (i) before any notice to you of the subject of the dispute, your bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services (not being the offering of domain names that you have acquired for the purpose of selling, renting or otherwise transferring); or
 - (ii) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
 - (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, the trademark or service mark at issue.
- ”

In the case at hand, the complainant contended that its trademark had a global reputation and submitted articles in both English and French to describe the growth of its business and evidencing that it had been operating online since 2016. However, the panel noted that the complainant did not adduce any evidence relating to:

1. the complainant's sales of goods under its trademark in Australia;
2. any advertising/marketing initiatives under the complainant's trademark targeting Australian customers; or
3. the complainant's trademark reputation within the Australian market.

Noting that the respondent had not filed any submissions, the panel conducted a brief search using publicly available sources on the Internet and found that:

1. the respondent was an Australian private company, registered since December 2018 and located in New South Wales;
2. the respondent had been operating under the registered business name FRANKIES AUTO ELECTRICS since December 2018; and
3. the respondent promoted its business activities on its website available at www.frankiesautoelectronics.com.au, referring to two locations in New South Wales.

The panel further added that all domain names listed "Frank Farrugia" as the registrant contact, whose surname matched the respondent's name and whose first name matched that found in the construction of the domain names (ie, "frankie"). In addition, all of the domain names consisted of the terms 'frankies shop' or a version of the same. The panel noted that the domain names were registered only a few months before the complaint was filed and resolved to the same parking page containing sponsored links, not to fashion or clothing retail websites or referring to the complainant, but to websites under the dictionary term 'shop'. Under the circumstances, the panel was of the view that the respondent had rights or legitimate interests in the domain names through its operations under the business name FRANKIES AUTO ELECTRICS in Australia since 2018.

In light of this finding, the panel did not need to consider the issue of bad-faith registration or use. Nevertheless, it went on to find that the domain names had not been registered or used in bad faith, as there was no indication that the respondent had targeted the complainant or its trademark when registering or using the domain names.

Comment

This decision underlines that brand owners should investigate public sources of information about a domain name registrant as much as possible before filing a complaint to ensure that they are fully aware of the registrant's background. If a registrant has been legitimately trading under a name that is identical or similar to a complainant's trademark, but such use appears to be merely coincidental in nature and there is no evidence that the registrant deliberately chose the domain name(s) in order to target the complainant and profit from its reputation, then a complaint under the '.au' DRP will generally fail. This also applies to complaints filed under the [Uniform Domain Name Dispute Resolution Policy](#) for generic top-level domains such as '.com'.

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