



## ADMINISTRATIVE PANEL DECISION

### **BlueChip InfoTech Pty Limited v Roslyn Jan and Blue Chip Software Development Pty Limited**

**LEADR – Case No. 06/03**

1. **The Parties**

The Complainant is BlueChip InfoTech Pty Limited of Sydney Australia. The Respondent is noted as being Roslyn Jan although the disputed domain name is listed as being owned by Blue Chip Software Development Pty Limited.

2. The disputed domain name is “bluechip.com.au”.

3. **Procedural History**

(a) The complaint was submitted by the Complainant for decision in accordance with the Policy (auDRP), which was approved by (auDA) in 2001 and commenced operation on 1 August 2002, and LEADR’S supplementary rules (LEADR is the Provider).

- (b) The Complainant submitted its complaint on 12 November 2003. The Provider advised auDA of the complaint on 12 November 2003.
- (c) The Respondent, NetRegistry and Melbourne IT were notified on 12 November 2003.
- (d) On 1 December 2003, I was appointed to constitute the Panel in this case.
- (e) On 1 December 2003, the Respondent contacted the Provider by email seeking extension of time to 10 December 2003, in which to respond. The Provider exercised its discretion in favour of an extension to the close of business on 10 December 2003.
- (f) No response was received by the Respondent by 5pm on 10 December 2003. However, the Respondent telephoned a representative of the Provider at 4.50pm on 10 December 2003, seeking an extension beyond close of business. The Provider declined to allow any further extension in favour of the Respondent. However, the Respondent provided its response at 11.21pm on 10 December 2003. The Provider asked my advice as to whether I believed that I had discretion to consider the Respondent's response and, if so, whether I wanted to exercise such discretion in favour of the Respondent.
- (g) Rule 10(b) of the auDRP Rules provides that the Panel shall ensure that "each party is given a fair opportunity to present its case". Rule 10(c)

grants the Panel the power, on its own motion, to extend, in exceptional cases, a period of time fixed by the Rules. I therefore considered that I had such a discretion pursuant to rule 10(c) of the auDRP Rules to extend time for the Respondent to file its response. In all the circumstances, I determined that it was, as a matter of natural justice, appropriate to consider the Respondent's response having regard to the short period of the delay.

#### 4. **Factual Background**

- (a) The Complainant was registered as a company, according to records of the Australian Securities and Investment Commission ("ASIC"), on 13 December 1996. It was registered under the name of Servex Australia Pty Limited. It is not clear from the evidence when the Complainant changed to its present name of BlueChip InfoTech Pty Limited (or Bluechip Infotech Pty Limited), although it was probably on or about 1 July 2002.
- (b) There is evidence of another corporation now known as Servex Australia Pty Limited, which was incorporated on 17 January 2002, having been known previously as "BlueChip InfoTech Pty Limited". This other corporation changed its name from BlueChip InfoTech Pty Limited in or about 1 July 2002. There is a reasonable inference therefore that the Complainant changed its name to BlueChip InfoTech Pty Limited on or

about 1 July 2002 in a “name swap” with the other corporation. It is necessary to stress that I have not been provided with full ASIC searches. For example, I do not know the nature of the relationship between the Complainant and the company now known as Servex Australia Pty Limited. However, there is an inference that the first use by either the Complainant or the company now known as Servex Australia Pty Limited of the name “BlueChip InfoTech Pty Limited” was in January 2002.

- (c) There is no evidence, nor submissions made, as to the nature of the business of the Complainant. In particular, there are no details of when it first used the name “BlueChip”, nor of the extent of the use of that name. The Complainant has not provided any evidence of the goods or services it supplies, or any other evidence of the Complainant’s reputation in relation to its name.
- (d) The Respondent was incorporated on 1 November 1995 and registered the disputed domain name in 1996. It was re-registered on 29 October 2003. Although it is not clear from the ASIC search, the Respondent contends that it has been known as “Blue Chip Software Development Pty Limited” since 1995.
- (e) No evidence has been provided, nor submissions made, as to how, if at all, the Respondent has, prior to the complaint, used the disputed domain name. The Respondent contends that the disputed domain name was

acquired initially “for the primary purpose of advertising the goods and services it would be providing”. There is no evidence whatsoever of what those goods or services might be. Indeed, there is some evidence (though disputed) that there has been no use at all of the disputed domain name by the Respondent. The only inference which can be drawn from the lack of submissions or evidence is that there has been no use by the Respondent or the disputed domain name at all as at 12 November 2003. Furthermore, there is no evidence of any preparations the Respondent has made to use the domain name, nor any reason given as to why there has been such a long delay in using the domain name.

- (f) There is evidence of certain negotiations between the Complainant and the Respondent taking place concerning the possible purchase of the disputed domain name by the Complainant. Some details of the negotiations including when the negotiations commenced and the substance of those communications are disputed.

## **5. The Parties’ Contentions**

### **A. The Complainant**

The Complainant contends that the Respondent:

- (i) has registered the disputed domain name that is either identical or confusingly similar to its company name;
- (ii) has no rights or legitimate interest in respect of the disputed

domain name;

- (iii) has registered the disputed domain name and subsequently used it in bad faith.

As noted earlier in these reasons, the Complainant has not made any contentions, nor provided any evidence of any reputation in its name.

Rather, the Complainant contends that:

- The Respondent registered and acquired the disputed domain name for the primary purpose of selling, renting or otherwise transferring the domain name registration to another person for valuable consideration in excess of the out of pocket costs directly related to the disputed domain name.
- The Complainant initially contacted the Respondent in June 2001 in order to purchase the disputed domain name. The Complainant alleges the Respondent admitted that it did not use the disputed domain name, but that it considered the disputed domain name to be an investment for sale or profit. The Respondent is alleged to have sought an amount of at least \$10,000.00 for the transfer of the disputed domain name.

- On numerous occasions between June 2001 and May 2003, the Respondent made unsolicited phone calls to the Complainant asking if the Complainant was interested in the disputed domain name.
- In or about June 2003, an agreement was reached between the Complainant and Respondent for the transfer of the disputed domain name for the price of \$3,000.00. The Complainant alleges that this agreement is constituted, in part or in whole, by an invoice rendered by the Respondent to the Complainant. The Complainant further says that despite making available a bank cheque for \$3,000.00, the Respondent refused to transfer the registration of the disputed domain name but sought to re-open negotiations for a purchase price greater than \$3,000.00.
- The disputed domain name has not, and could not at present, be used for any legitimate purpose.

As a consequence, the Complainant seeks transfer of the disputed domain name to it together with payment of its costs.

**B. The Respondent's Contentions**

The Respondent contends that:

- (a) the requirements set out in paragraph 4(a) of the Policy, and which

were relied upon by the Complainant, are cumulative. That is, each of sub-paragraphs (i), (ii) and (iii) of paragraph 4(a) must all be made out;

- (b) the disputed domain name is not identical to the Complainant's name, nor is it confusingly similar;
- (c) the term "Blue Chip" is a well known term associated with "good quality and prestige" products and that a search of ASIC records discloses the term "Blue Chip" is used in a large number of company and business names, trade marks and domain names;
- (d) The disputed domain name was registered by the Respondent well before the Complainant changed its name to BlueChip InfoTech Pty Limited;
- (e) The disputed domain name was chosen because it is an abbreviation of its own name;
- (f) the Respondent met, and still meets, the eligibility criteria for registration of the disputed domain name which was not, at the time of registration, similar to the Complainant's name as the Complainant did not then exist;
- (g) The Respondent's clients are familiar with its name. The disputed domain name has been registered for use by the Respondent in the course of its business; and
- (h) In relation to the agreement between the parties for the purchase of the disputed domain name for \$3,000.00 in June 2003, the Respondent does not deny there was agreement, but indicates that the Complainant was, in fact, the party which refused to complete



the agreement because it was no longer interested in purchasing the disputed domain name, as it was happy to continue using its current domain name “BlueChipit.com.au”.

6. **Discussion and Findings**

(a) Relevant Principles

Paragraph 15(a) of the Rules provides that:

*“(a) A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.*

The Complainant bases its complaint on paragraph 4(a) of the Policy. This provides that a Respondent is required to submit to a Mandatory Administrative Proceeding in the event that a complainant asserts that:

- “(i) your domain name is identical or confusingly similar to a name<sup>1</sup>, trademark or service mark in which the complainant has rights; and*
- (ii) you have no rights or legitimate interests in respect of the domain name<sup>2</sup>; and*
- (iii) your domain name has been registered or subsequently used in bad faith.”*

Footnote 1 provides 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; or

- (b) The complainant's personal name.

Footnote 2 provides that for the purposes of the Policy "rights or legitimate interests in respect of the domain name" are not established merely by a registrar's determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration.

Paragraph 4(a) provides that the Complainant bears the onus of proof.

Paragraph 4(b) of the Policy provides some guidance as to what factors are to be considered as evidence of the registration and use of a domain name in bad faith for the purposes of paragraph 4(a)(iii). Paragraph 4(c) of the Policy also provides some indications of factors a Respondent may rely upon to demonstrate a Respondent has a right or a legitimate interest in a domain name for the purposes of paragraph 4(a)(ii). I do not repeat these here.

Therefore, in order to succeed, the Complainant must make out each of the matters set out in 4(a) of the Policy as set out above, for which it bears the onus of proof.

- (b) Complainant's right to a name, trademark or service mark.

The footnote to paragraph 4(a)(i) makes it clear that the Complainant will establish it has sufficient rights in respect of the name upon which its complaint is based if that name refers to the Complainant's company as registered with the relevant Australian government authority.

The ASIC search makes it clear that the Complainant has rights in its name BlueChip InfoTech Pty Limited.

(c) Identical or confusingly similar

The test set out in paragraph 4(b)(i) of the policy requires a comparison between the disputed domain name “bluechip.com.au” and the Complainant’s name “BlueChip InfoTech Pty Limited”.

Essential or virtual identity is sufficient, see *The Crown Right on the State of Tasmania T/A Tourism Tasmania* v *Gordon James Craven* ("*Tourism Tasmania Case*") WIPO Case No. DAU 2003 – 0001 and the cases cited therein.

Furthermore, the test of confusing similarity under the Policy is confined to a comparison of the disputed domain name and the name above, independent of the other marketing or use factors usually considered in trademark infringement or unfair competition cases: see *Tourism Tasmania Case* and the cases cited therein.

As noted above, there is a lack of evidence generally from both parties of the kind one would normally expect in such cases. Indeed, the Complainant's submissions on this matter do not go beyond the mere assertion that the disputed domain name is identical or confusingly similar.

The principal difference between the disputed domain name and the Complainant’s name is that the Complainant’s name has the additional words “InfoTech”.

As the Respondent contends, the words “Blue Chip” is a common term. The Respondent has made submissions and attached evidence that the term “Blue Chip”, both by it and with other words, are widely used in corporate/business names and trade marks.

Furthermore, the disputed domain name was registered six years before the Complainant chose to change its name to “Blue Chip”.

I find that the Complainant has failed to establish that the disputed domain name is identical or confusingly similar to its name having regard to:

- The additional words “InfoTech”; and
- The common descriptiveness of the words “Blue Chip” which thereby, in my view, makes the additional words “Info Tech” an essential feature of the name.

Therefore, the Complainant has failed to discharge its onus in establishing the first of the three matters set out in paragraph 4(a) of a policy.

In these circumstances, it is unnecessary to set out my views concerning the remaining two limbs of paragraph 4(a).

(d) Other Issues.

Finally, it is appropriate briefly to refer to the disputed evidence of the negotiations between the parties. This evidence forms the major focus of the Complainant’s submissions. The Complainant alleges that there was an agreement between the Complainant and the Respondent for the transfer of the disputed domain name for an amount of \$3,000.00. The Complainant further alleges that the Respondent is in breach of such an agreement. The Respondent disputes various allegations made by the Complainant in its narrative of the negotiations and, further, alleges that it was in fact the Complainant who failed to comply with its obligations pursuant to the agreement.

Proceedings of this kind are unsuited to the determination of issues such as

those arising in relation to the agreement or any negotiations. I do not therefore make any findings in that regard.

7. **Decision**

The Complaint is denied.

Dated: 23 December 2003

Michael Daniel