

# LEADR DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

auDRP 06/2005

## Single Panellist Decision

**FAST ENTERPRISES PTY LTD**

v

**GIFTS FOR GIRLS PTY LTD (ACN 098 896 372)**

### 1. The Parties

- 1.1. The Complainant is **Fast Enterprises Pty Ltd** of 257 Enmore Road, Enmore NSW 2042 (“FE”).
- 1.2. The Respondent is **Gifts For Girls Pty Ltd** (ACN 098 896 372) of 9 Sleath Street, Toowong QLD 4066 (“GG”).

### 2. Domain Name and Registrar

- 2.1 The domain names at issue are **Flowersfast.com.au** and **fastflower.com.au** (“the Disputed Domain Names”) (“the Names”).
- 2.2 The provider in relation to this proceeding is LEADR (“Provider”).

### 3. Preliminary Matters

- 3.1 Schedule A of the .au Dispute Resolution Policy (“auDRP”) applies to disputes which meet the requirements set out in paragraph 4(a) of Schedule A of the auDRP. This subparagraph 4(a) requires that any party holding a domain name licence issued in the 2LDs “... submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure that:
  - (i) [their] domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
  - (ii) [they] have no rights or legitimate interests in respect of the domain name, and
  - (iii) [their] domain name has been registered or subsequently used in bad faith.

*In an administrative proceeding, the complainant bears the onus of proof.”*

- 3.2 On 22 May 2005 FE (“Complainant”) wrote a letter to the Provider requesting its complaint as to the Disputed Domain Names be submitted for decision in accordance with the Policy and Rules. Elements of the submitted complaint will be referred to subsequently.

#### **4. Procedural History**

- 4.1 The complaint was submitted for decision in accordance with the (auDRP) Policy and Rules, which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplementary Rules (LEADR is the Provider).
- 4.2 The Complainant lodged a complete application with the Provider on 27 May 2005.
- 4.3 On 27 May 2005 the Respondent was sent by express post a dispute notification letter and a copy of the complaint. The dispute notification letter was also emailed to the Respondent on the same day.
- 4.4 A copy of the dispute notification letter was also emailed to the Complainant on 27 May 2005.
- 4.5 The dispute notification letter and a copy of the complaint was also posted to the Registrar (Bottle Domains) on 30 May 2005.
- 4.6 The Provider advised auDA of the complaint on 30 May 2005 via email.
- 4.7 The Registrar was additionally advised by email to lock the website(s) www.flowersfast.com.au and www.fastflower.com.au on 30 May 2005. The Registrar by return email advised LEADR on 1 June 2005 that the domain name(s) had been locked.
- 4.8 LEADR has appointed this Panellist as the sole panellist in the matter. The Panellist has no conflict of interest.
- 4.9 All procedural requirements appear to have been satisfied. The Panel has been properly constituted.
- 4.10 Certain written and related material has been submitted to the Panel as provided by the parties to the Provider. The observations in this determination arise singularly from the material so submitted and the submissions made.
- 4.11 Paragraph 15(a) of the auDRP Rules states:  
*"A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy [the auDRP Policy], these Rules and any rules and principles of law that it deems applicable".*

#### **5. Factual Background – The Complainant's (FE) Case**

5.1 In submissions made with its complaint, FE as Complainant essentially raised the following matters:-

- It is the owner of the Domain Name and Trademark “Fastflowers.com.au”.
- Fastflowers.com.au is a well known florist operating for over six years.
- The brand (by reference the aforesaid name) has been subjected to extensive media exposure (various formats) over that period in particular since 1999, and including certain business award exposure.
- The brand (by reference to the name) has been heavily advertised in mass media (various formats).
- That FE was recently made aware that GG “have been trading using the disputed domain names which are redirected to the URL Profowers.com.au . . .”.
- That FE has been “. . . made aware of the existence of the disputed domains by many of our clients”.
- That on 22 July 2004 FE emailed GG in relation to the Profowers.com.au site “displaying images and paragraphs of text owned by our company” and asserting unauthorised use by GG of intellectual property of FE (to that extent, apparently subsequently removed), but that at such stage FE had not become aware “that the disputed domain names were being redirected to the website Profowers.com.au”.

## **6. Factual Background – The Respondent’s (GG) Case**

6.1 Within its submissions, the Respondent (GG) essentially put:-

- “professionalflowers.com.au” is a florist website selling flowers for same day delivery.
- The site denotes the name of the business “Professional Flowers”, which site does not resemble the www.Fastflowers.com.au site.
- Its main business premise is delivery of flowers in a “fast or speedy manner at reasonable prices”.
- That “. . . the phrase flowers fast or fast flower describes the service that is provided by Professional Flowers”.
- That the website of GG “also has several other names diverted to the site which describe our service . . .”.
- That Professional Flowers is a small business.
- GG submitted a “history of hits to the website”.
- That Professional Flowers did not commence its business or accept orders until 8 September 2004.
- That the images and text contended by FE in its email to GG of 22 July 2004 as an unauthorised use of FE intellectual property are,

according to GG “. . copies of a draft website which was inadvertently displayed for a few days in July 2004 for amendment and was never operational”.

## **7. The Complainant’s Contentions**

7.1 FE as Complainant seeks to have the Disputed Domain Names transferred to itself.

7.2 FE as Complainant makes three essential Complaint contentions namely:-

- (i) The Disputed Domain Names are identical or confusingly similar to a name, trademark or service mark in which the complainant has rights.
- (ii) The Respondent has no rights or legitimate interests in the two Disputed Domain Names.
- (iii) The Respondent’s Disputed Domain Names have been registered or subsequently used in bad faith.

7.3 The submissions and background put by FE with respect to each of these three primary contentions can be summarised as follows:-

(i) Identical or confusingly similar:

Here, FE essentially contends:

- That FE began trading as Fastflowers.com.au on the internet in July 1999 selling flowers and gifts.
- In November 1999 Trademark registration was granted to it under class 35 for the term “Fastflowers.com.au” Trademark number 813268”.
- Contends that the “. . sole purpose of the two disputed domain names is to mislead and confuse our customers into purchasing on a site they believe to be ours”.
- That “. . Several of our clients have inadvertently visited and even ordered at the disputed domain names while trying to access fastflowers.com.au”.
- That the “. . Respondent would have been well aware of the fastflowers.com.au domain name and trademark upon registering the disputed domain names in 2002”.
- That the “. . disputed domain names are confusingly similar to . .” the trademark of FE.
- That the matter goes further than a “mere similarity” between names; here, FE contends that the confusion arises from GG having chosen a domain name which “. . because of the renown of the Complainant in the floral industry and among its customers, people would expect it to be the domain name of the Complainant”.

(ii) GG has no rights or legitimate interests:

Here, FE essentially contends:

- GG trades under the name Proflowers.com.au and “. . . simply redirects the disputed domain names to that website in an attempt to confuse our clients”.
- That GG is not commonly known as Fastflower.com.au or Flowersfast.com.au.
- That GG has no rights or interests in the domain name “. . . because he does not conduct a business under that name and is not commonly known by it”.
- That GG does not meet the eligibility criteria “. . . for holding the domain under Schedule B, Paragraph 2”. This is a contended reference to the criteria as to exact matching of names of the registrant’s company or trading name or be otherwise closely and substantially connected to the registrant.
- That GG does not hold such trading names within Australia or a matching company name; specifically, that the “unregistered trading name that Respondent operates under is the name Professional Flowers that is neither closely nor substantially related to the disputed domain names”.

(iii) Used in bad faith:

Here, FE essentially contends:

- The domain names “. . . are being used to pass off as a fastflowers.com.au website”.
- That GG “began redirecting traffic from the disputed domain names in bad faith to their site Proflowers.com.au using some of our images and text” – although now removed, that GG “. . . is still using third party content to gain financially from attempting to attract our clients based on confusion”.
- That FE has incurred financial loss from lost sales and deterring of customers.
- That both of the disputed domain names are not being used in their own right but being redirected to GG’s website Proflowers.com.au.
- That this “. . . process of diverting traffic to other sites for profit, is known as auto forwarding” and is a domain name use in bad faith.

## **8. The Respondent’s Contentions**

### **8.1 Within its submissions, GG as respondent put:-**

- Submitted certain contended matters as to some history (referred to within the factual background commentary previously).
- That “. . . the phrase flowers fast or fast flower describes the service that is provided by Professional Flowers (with its website also having several other names diverted to it).

- That with reference to its website “hits” record, specifically as to “. . visitors . . redirected from the flowersfast.com.au domain name . . The amount of visitors generated from these web sites are very small . .”.
- That “. . if visitors are looking for flowers to be delivered fast, then that is exactly the service we provide”.
- The offending website text and images complained of by FE (and withdrawn or adjusted) were (essentially) an inadvertent display on a “draft website”.

8.2 Specifically, with reference to some of the elements of the FE complaint contentions, GG as Respondent put:-

(i) Identical or confusingly similar:

- Disputes that its purpose was to mislead and confuse customers.
- That the websites are not similar, but that the site of Professional Flowers is clearly marked as such.
- That the “. . name flowers fast for example describes a service . .”.
- That the disputed domain names “. . do not mislead customers into purchasing from the site because if what the applicant argues was correct then they would have generated more than three and four visitors respectively”.

(ii) No rights or legitimate interests:

GG denies this contention essentially putting that:-

- The names “. . exactly describe the service” which GG provides.

(iii) Bad Faith

GG denies this contention putting:-

- Refers to some of its other submissions.
- That it trades as Professional Flowers, not Proflowers.
- Denies ever trading using any of the text or pictures from FE’s website.
- Denies “. . attempting to attract FastFlowers customers . .never had . . complaint from any customer that . . they believed our site to be the fastflowers.com.au company”.
- Denies that any of its orders “. . were placed in the mistaken belief that our web site is the fast flowers website”.

## 9. Discussion and Findings

9.1 This dispute has its jurisdiction for determination within Paragraph 2.1 of the auDRP including that the Disputed Domain Names are an open and registered 2LD within the Policy and subject to the mandatory administrative proceeding.

### Elements of a successful complaint

9.2 According to paragraph 4(a) of the auDRP Policy, a person is entitled to complain about the registration or use of a domain name where:

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

9.3 It is to be noted that the three elements of a complaint under paragraph 4(a) of the auDRP Policy are cumulative; all of them must be proved if the complaint is to be upheld.

### Are the Disputed Domain Names identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights?

9.4 The Panel must determine whether, on the basis of the facts set out in section 4 above, the Complainant has rights in a relevant name, trademark or service mark.

9.5 The auDRP Policy states:

*“For the purposes of this policy, auDA has determined 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;*
- (b) *The complainant's personal name.”*

9.6 Accordingly, the Complainant has relevant rights in or within at least:-

- (a) FE's registered Trademark 813268; and
- (b) Within its company name.

9.7 The auDRP Policy does not provide guidance as to the intended meaning of “identical” or “confusingly similar”. However, “essential or virtual identity” is sufficient. (*BlueChip Info Tech Pty Limited v Roslyn Jan and another* [LEADR case 06/03]).

9.8 Although it may appear that there is no exactitude as to what is contemplated in the term “confusing”, the test of “confusing similarity” could have reliable precedent in the trademark infringement case application of the expression, where the concept of “deception” contemplates consumers who may be deceived or “caused to wonder” about the source or origin of goods or services. (As, for example, noted in *Camper Trailers WA Pty Ltd v Off Road Equipment Pty Ltd* [LEADR 06/04]).

9.9 The Panel, including to the relative submissions and contentions put by either party, makes the following observations and notations, and in no priority or selected order:-

These observations (and those under the other headings following) have taken close account of all submissions and contentions and deal only with certain of the primary elements of them.

9.10 Both parties are in the online florist or flower ordering trade. Both are seeking to attract efficient floral orders for speedy delivery. Both parties and presentations, in various forms, have had attached, or sought to attach, the combinations of the words “fastflower” and “Flowersfast”. Although there are no submissions here from either party specifically as to the relative customer “market” for their respective businesses, each may well be globally described as “floral delivery”, but here especially narrowed (essentially) to the confine (including for marketing and attraction of custom purposes, of which the disputed domain names element is an inherent component) of speedy or “fast” delivery.

9.11 The Complainant FE already has statutory trademark intellectual property rights in the specific representation attached to its business of “Fastflowers.com.au” under Trademark 813268 registered in class 35 in November 1999. Further, FE’s submitted chronology attests to original common law intellectual property authorship of, and a very active commercial use and exposure (in the media and elsewhere) of, the specific description consistent with the Trademark. This appears to attach to the predominance of FE’s business use, including marketing for custom, as well as to its very business title where, corporately and consistently, the word “Fast” appears. Further, consistently, all of this has been for some time (since July 1999) apparently supplemented by its trading on the internet under reference Fastflowers.com.au.

9.12 The Respondent GG has more latterly entered the same “market” (in terms of the broad descriptions above). GG obtained the disputed domain name registrations, against the above background, immediately adducing the complaints here set out of FE as Complainant.

9.13 The Panel does not accept the GG contentions that its own site under reference Professional Flowers, denoting as it might its own business identity, removes the prospect or reality of confusing similarity. GG effectively contends that, as the

“main premise” of its business is “fast or speedy” floral delivery, such validates the descriptions they have sought to register as describing “the service” provided by Professional Flowers. The contention is not sound or properly based. That a promptness of service is so described does not avoid confusing similarity. There is in fact a “meshing” of the Complainant’s statutory and historical, as well as active, uses within the same confined market of “Fastflowers.com.au” with the disputed domain names which the Respondent has by registration sought to superimpose within the same precise area of activity. In short, a “service description” does not avoid the fact or reality of identical descriptions or of confusingly similar descriptions or use. Some of the Respondent’s contentions here assume that names can or may be similar, but if one or other (and in this case, as to intellectual property use, the Respondent is the latter in time) is meant only to describe a service, the similarity or confusion is excusable and provides no basis for rights of complaint, or rights generally, in the Applicant. This is not so.

9.14 GG contends that (in effect), because its use of the disputed domain names (whether by redirection or otherwise) has “generated” a minimal level of “visitors”, such attests to there being no misleading of customers. The level of sales or reaction is not by any means the definitive test as to abuse of intellectual property rights, nor is it the test under this heading. Here, on the balance of material before the Panel, there is the real potential, and the actuality of, confusion of identity. On balance, the Applicant’s contentions here are accepted, in particular, the FE assertion that the confusion “goes further than a mere similarity between the two names”, and springs from the Respondent having chosen names which, because of the Complainant’s established reputation in the floral industry and with its customers and generally, the expectation is the disputed domain names were those of the Complainant. On the material, this contention has a strong basis. It is evidenced (one example only) by several of the FE clients already having inadvertently visited and ordered from the disputed domain names and with many of the FE clients bringing awareness of the matter to FE.

9.15 The Respondent contends for some “separateness” in deliberations upon the matter with reference to the identities “Flowersfast.com.au” and “fastflower.com.au”. In the view of the Panel, there is the clearest mirror identity, and certainly confusing similarity of the Applicant’s traditional usage including under registered and actively used Trademark “Fastflowers.com.au” with that sought to be superimposed under this disputed domain name reference now of the Respondent “fastflower.com.au”. Further, there is in the view of the Panel sufficient similarity under this heading of the Respondent’s disputed domain name “Flowersfast.com.au” with the same long-standing usage of the Applicant including as associated with its Trademark. There is in the determination of the Panel a deceptive similarity in both of the disputed domain names, both individually and operating together, to the names and Trademark associated with the Complainant.

9.16 Accordingly, the Panel determines that the Complainant has satisfied the requirement of “confusingly similar” in paragraph 4(a)(i) of the auDRP Policy.

Does the Respondent have any rights or legitimate interests in respect of the Disputed Domain Names?

9.17 Paragraph 4(c) of the auDRP Policy sets out particular circumstances, which can demonstrate a Respondent’s “rights or legitimate interests to the domain name for purposes of Paragraph 4(a) (ii).”

9.18 The first issue to consider is whether the Respondent, prior to being notified of the subject matter of the present dispute, made “bona fide use” of the disputed domain names in terms of paragraph 4(c)(i).

9.19 The Respondent has (in various ways) contended for such use. Again, GG contended for its utility of the descriptions associated with its “visitors” looking for “fast” delivery and that such is “exactly the service we provide”. This is against the background of the complaint contentions of FE including that GG under the name of “Proflowers.com.au” simply redirects the disputed domain names to that website “in attempt to confuse” the clients of FE. As previously referred to, FE as complainant asserts that GG is not commonly known under or by reference to either of the disputed names or similar descriptions. Further, FE asserts that GG does not conduct its business under the disputed names and is certainly not commonly known by way of business identity under those descriptions. Further also, FE asserts that GG as Respondent does not meet the eligibility criteria for holding the domain under Schedule B, Paragraph 2 of the Policy Rules (previously referred to) in that (paraphrasing it) there is no reconciliation with the Respondent’s trading or corporate name or closely or substantially connected to the Respondent. Here, FE refers to GG not holding, or activating, any of the disputed names essentially as trading names in any State or Territory of Australia, but singularly operates under the “unregistered trading name” of “Professional Flowers”.

9.20 The Panel turns to the analysis of any “bona fide” use by GG. The Panel is not satisfied that the Respondent’s use of the disputed domain names in connection with the offering of goods or services was “bona fide”. In particular, the Panel has considered:-

- (a) At all relevant times, the parties have been essentially competitors within the same confined market (earlier commentary refers).
- (b) Since 1999, FE has been the owner of the Domain Name and Trademark (the latter under specific registration in Class 35, 813268) “Fastflowers.com.au”, registrations and descriptions calculated to, and activated stridently to, inform consumers about the source of services offered and to provide that very facility for activating orders and custom. By contrast, the Respondent has, other than for the disputed domain names under this reference, no business name, trademark or service mark (submitted in the materials here)

similar to the disputed domain names, and the disputed domain names are not themselves suggestive of the Respondent's business or company name.

- (c) The utility by GG as Respondent of the disputed domain names has not (on the reliable balance of materials before this determination) apparently been by way of use in their own right, but rather more by way of redirection, if not singularly so, to the Respondent's own singular website of "Proflowers.com.au" (referred to by FE as the "auto forwarding" objection).

9.21 With respect to paragraphs 4(c)(ii) and 4(c)(iii) of the auDRP Policy, the Panel is satisfied that the Respondent has neither been commonly known by the Disputed Domain Names, nor is the Respondent making legitimate non-commercial or fair use of them. The Panel considers the Respondent's website to be "*likely to misleadingly divert customers*" from the Complainant.

9.22 Accordingly, the Panel finds that the Respondent has no right or legitimate interest in the Disputed Domain Name, and so paragraph 4(a)(ii) of the auDRP Policy has been satisfied by the Complainant.

#### Have the Disputed Domain Names been registered or subsequently used in bad faith?

9.23 Paragraph 4(b) of the auDRP Policy sets out circumstances of "evidence of the registration and use of a domain name in bad faith". This Paragraph contains four sets of circumstances, any one of which, if established, can constitute evidence of registration in bad faith. It is important to note also that it is a non-exhaustive list of circumstances such that, for example, the Panel is not necessarily constrained from a finding of bad faith should it arise (also by example) from not only any one or other of them, but from a combination of them, or indeed, upon the basis of other reliable material before the Panel inclusive of the illustrated list. So far as is pertinent here, elements of Paragraph 4(b) are set out as following (leaving aside the first two subparagraphs where there appear to be no contentions put in the context of this matter by either party):-

- (i) where the respondent has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or
- (ii) where, by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation or endorsement of that web site or location or of a product or service on that web site or location.

9.24 The Panel is satisfied that there is sufficient evidence for a finding with respect to Paragraph 4(b)(iv) of the auDRP Policy including for these reasons:-

- o The parties are competitors (refer earlier commentary).

- The Respondent was aware of the Complainant's presence in the market. On balance, there appears to be a reliable basis for the Complainant's contention that the Respondent would have been well aware of the Fastflowers.com.au domain name and registered Trademark upon seeking the registration of the disputed domain names in 2002. Some of the credible basis for that Complainant contention is grounded in its extensive and intense commercial exposure in the confines of the floral market referred to in the factual background and elsewhere in these reasons.
- The denial of the Respondent of "ever trading using any of the text or pictures . . . from the fast flowers website in any way at any time" is not correct. By its own acknowledgement, the Respondent, including on the materials before the Panel, used or extracted some text content of original authorship of FE, the subject of the immediate July 2004 email complaint of FE for withdrawal, and the explanation for which given only now within these submissions as to being copies only from a "draft website . . . inadvertently displayed . . .".
- The only utility of the Respondent to the disputed names appears primarily or substantively to be a diversionary process ("auto forwarding") (notwithstanding the Respondent's explanation as to the result thereof being only limited "visitors"). The Panel has commented earlier as to the consequences of "redirection", one being that, resultantly, both disputed names and name presentations merge and intermesh creating the actuality of customer confusion. The Respondent itself in fact acknowledges its activity of redirection, proffering only the explanation as to limited "visitor" response.
- The clear inference from the substance of the above background is that the Respondent was hoping to capture the custom of consumers who may be seeking to access the Complainant's website and, once captured, to divert the inquirer to the Respondent's own site.
- The actuality of "redirection", of itself, does not necessarily attract an automatic conclusion of "bad faith". It is certainly a highly examinable factor however, and the question can only be answered in respect of the particular facts of each specific presentation. The total context and history are accountable under the heading (*Global Centre Pty Ltd v Global Domain Hosting Pty Ltd* [DAU2002-001] and *Telstra Corporation Limited v Nuclear Marshmallows* [D2000-003]). The totality of pertinent history and background are for scrutiny as has been applied here. It is in this context that (including for reasons previously set out) the Complainant's contentions are persuasive and compelling. Additionally, by illustration, it may be revealing to ask whether, had the Respondent and Complainant not been competitors, the Respondent would have even initiated the registrations of the disputed names as opposed to some other name. The Respondent might have had available to it, by further illustration, other descriptions in place of "fast" (with reference to its assertions as to "service" descriptions only), as for instance, "speedy" or "quick" or the like (leaving aside alliterative alternatives). It would seem, on the materials before this presentation, inherently unlikely that the Respondent

would, by some mere coincidence, have chosen a domain name exactly identical to, and a choice of names individually and taken together as reflective of, the Complainant's own business promotional name and, what is more, a reflection of its traditionally registered Trademark within the narrow confines of their competitive markets.

- In the Panel's view, these matters taken together reliably establish that the Respondent registered the disputed domain names "intentionally attempting to attract, for commercial gain, Internet users to a website or other online location by creating a likelihood of confusion".

9.25 For the reasons outlined above, the Complainant has satisfied the requirements of Paragraph 4(a)(iii) of the auDRP Policy.

## **10. Relief**

### Transfer of the Disputed Domain Names

10.1 The Complainant has sought that the Disputed Domain Names be transferred to the Complainant.

10.2 Eligibility for a domain name in the open 2LDs is governed by auDA's Domain Name Eligibility and Allocation Rules for the Open 2LDs (2002-07) ("Eligibility Rules"). Having regard to the Complainant's accumulated and prior registered rights including (not exclusively) with reference to its 1999 registered Trademark "Fastflowers.com.au" it would appear to the Panel that the Complainant satisfied the Eligibility Rules.

10.3 The Panel orders that the Disputed Domain Names be transferred to the Complainant.

## **11. Decision**

11.1 The Complainant has satisfied the elements of Paragraph 4(a) of the auDRP Policy.

Dated this 28th day of June 2005

**JOHN A McGRUTHER**  
Sole Panellist