



## ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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### Decision Submission

English Print

Decision ID	DE-0200006
Case ID	HK-0200010
Disputed Domain Name	www.raineandhornecommercial.com
Case Administrator	Iris Wong
Submitted By	Karen Mills
Participated Panelist	Karen Mills
Date of Decision	06-11-2002

### The Parties Information

<b>Claimant</b>	Raine & Horne (Holdings) P/L
<b>Respondent</b>	Daniel Waldron

### Procedural History

Complainants (1. Raine & Horne (Holdings) Pty Ltd ( “First Complainant” ) 2. Raine & Horne Pty. Limited ( “Second Complainant” ) 3. Raine & Horne Commercial (NSW Pty. Limited ( “3rd Complainant” )) filed a Complaint, dated 20 July, 2002, with the Hong Kong office of Asian Domain name Dispute Resolution Centre ( “ADNDRC” ), through its counsel, Messrs Aitken McLachlan & Thorpe of Sydney, Australia. The complaint was advised to Respondent, who filed his Response with date 6 September, 2002.

Both Complainants and Respondent indicated the preference for a single panelist to decide the matter. ADNDRC then appointed this panelist, Karen Mills, who confirmed her availability, freedom from conflict, and ability to act impartially and independently. The file was then forwarded to this panelist by ADNDRC under cover letter dated 2 October, 2002, by courier, while other correspondence was transmitted by e-mail and telefax.

Both parties confirmed that no legal proceedings have been commenced by the parties in conjunction with or relating to the domain name which is the subject of this dispute.

### Factual Background

#### For Claimant

According to the Complaint, Complainants are all members of a corporate group of companies which operate a network of franchise real estate and real estate related businesses throughout New South Wales, other parts of Australia and various other countries throughout the world. The First Complainant has been in trading in such business since 1883, and is the owner of the following registered trademarks:

Raine & Horne (Australian Trade Mark No. 331234 in class 36);  
Raine & Horne (Australian Trade Mark No. 432649 in class 36); and  
Raine & Horne (Australian Trade Mark No. 809732 in class 35).

The Second Complainant is the owner of the registered business name: Raine & Horne Commercial, New South Wales Registration No. BN97799536, in respect of real estate services, and is the owner of the domain name: raineandhornecommercial.com.au, created on 10 January, 2001.

The Complainants trade extensively under the name Raine & Horne Commercial for real estate brokerage, management, leasing and other real estate related services, as enumerated in the Complaint, and therefore are considered the owners of the same unregistered trademark.

## For Respondent

The Respondent is registered as a self employed individual, but also states that he is currently engaged as a litigation assistant in the United Kingdom. Respondent does not contest the assertions of Complainants, as outlined in above paragraphs in this section. Respondent asserts that since Complainants have not registered the trademark “Raine and Horne Commercial”, Complainants have no legitimate right to such name. Likewise the Respondent contends that Complainants ownership of the domain name: raineandhornecommercial.com.au, should not preclude Respondent from registering the domain name: raineandhornecommercial.com.

Respondent further states that although he has not engaged in any business under the contested domain name, it was his intention to use it in conjunction with business as a “mercantile agent” in the UK in the future.

## Parties' Contentions

### Claimant

Complainants contend as follows:

- a. Complainants’ business under the trademarks and tradenames Raine & Horne and Raine & Horne Commercial, as well as the domain name raineandhornecommercial.com.au, are a well known name throughout Australia and other parts of the world and these are “instantly recognisable as describing the Complainants both in Australia and overseas.” Complainants have provided a list of their offices and franchisees throughout Australia and approximately 16 other countries. The domain name under dispute, as registered by Respondent, is either identical or confusingly similar to the registered and unregistered intellectual property of Complainants.
- b. Complainants have not licensed nor otherwise permitted Respondent to use its said intellectual property, trademarks, service marks or tradenames, nor to apply for or use any domain name incorporating any of such intellectual property, nor has Respondent traded under any such names, including the domain name in dispute, and thus the Respondent had no legitimate right or interests in respect of the domain name.
- c. Upon request by Complainant that Respondent surrender the disputed domain name to Complainants, Respondent offered the same for sale to Complainants at a cost greater than ten times the amounts Respondent seeks as recompense in its Statement of Response for this dispute, and further in subsequent correspondence urged Complainants to purchase the domain name from it rather than bringing a complaint with ADNDRC, claiming that many customers do the same; and that therefore it is clear to Complainants that Respondent has registered the domain name in dispute for the purpose of selling the same to its rightful owner for valuable compensation in excess of his out-of-pocket costs directly related to such domain name, and thus did not register such domain name in good faith.
- d. Visits to the website of the domain name in dispute showed not only that the domain name was for sale, but that the page held advertising and links to pornographic materials, further indication that the domain name is, or was, being used in bad faith.

### Respondent

Respondent contends that:

- a. The domain name in dispute, registered by him, is substantially different from the intellectual property owned by Complainants, in that “&” and “and” differ, as well as that raineandhornecommercial.com.au is not to be confused with raineandhornecommercial.com and that therefore the names are neither identical nor confusingly similar, and the Complainants have no legitimate rights to the name “Raine and Horne Commercial”, nor to the domain name in dispute.
- b. He registered the domain name in dispute with the intention of trading commercially under such name, and did not initiate contact with Complainants in its offer to sell the domain name to Complainants, and thus registered the domain name in dispute in good faith.

## Findings

### Identical / Confusingly Similar

In determining the dispute, the Panel is instructed, under Article 15 (a) of the Rules for Uniform Domain Name Dispute

Resolution Policy (the “Rules” ), to decide a complaint on the basis of the statements and documents submitted and in accordance with the Uniform Domain Name Resolution Policy (the “Policy” ), the Rules and any rules and principles of law that it deems applicable.

Article 4 (a) of the Policy sets out the criteria upon which the findings of the Panel shall be based, which criteria must be established by the parties. In order to establish its rightful ownership of a domain name in dispute, a complainant must show that:

(i) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) that the Respondent has no rights nor legitimate interests in respect of the domain name; and

(iii) that the domain name has been registered and is being used in bad faith.

Based upon the submissions by the parties and exhibits thereto, this Panel finds:

1. The symbol “&” is an abbreviation for and therefore specifically and exclusively means and refers to the word “and” and has the identical meaning and significance. Thus use of the service mark “Raine and Horne” , either by itself or in combination with “Commercial” has the identical meaning, and is therefore confusingly similar, to “Raine & Horne” , in which the Complainant has intellectual property rights by virtue of its registrations thereof and widespread use thereof. Any use or intended use of such name, either as an internet website address or as a business within the scope of businesses of international class 35 or 36 by any person other than the registered owner thereof (in this case being one of the Complainants) without the express license by or consent of the registered owner thereof is not only unauthorized (and possibly a violation of the laws governing such intellectual property rights) but also creates confusion in the mind of the public and is therefore confusingly similar to the trade or service name registered in the name of one or more of Complainants. Furthermore the country-specific suffix “.au” after a domain name indicates only the location of the host server and does not alter the significance of, nor intellectual property rights in, the prefix of a domain name, and thus “raineandhornecommercial.com” is, if not substantially identical, certainly confusingly similar to “raineandhornecommercial.com.au” , and any reasonable person seeking to contact a well known company under the name of Raine & Horne, Raine & Horne Commercial, or any other variation thereof, on the internet would be likely first to try the address “raineandhorne.com” or “raineandhornecommercial.com” . Therefore the domain name in dispute is, if not identical, at least confusingly similar to the registered trademarks and domain name owned by the Complainants.

### **Rights and Legitimate Interests**

2. Respondent has not traded under the domain name in dispute in any legitimate manner, nor has he provided any evidence to show that he made any preparations to do so, nor that he has any connection whatsoever with either the name “Raine” or “Horne” , nor the two together. The only use he has made of the domain name which he registered is to indicate that it is for sale and also to advertise his pornographic website or services, which latter is not an acceptable purpose, and in fact may well be embarrassing to, or impugn the reputation of Complainants. Therefore the Respondent has no rights nor legitimate interests in respect of the domain name in dispute.

### **Bad Faith**

3. According to Article 4 (b) (i) of the Policy, bad faith in the registration of a domain name is indicated where it appears that the registrant of the domain name has acquired such domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name or registration to the owner of the same or a similar trademark or service mark for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name. It is clear from the submissions of Complainants that the Respondent sought to offer to sell, or rent, the disputed domain name to the Complainants on a number of occasions, and that such domain name is not the only well known trade or service name which Respondent is offering for sale. The price sought by the Respondent of the Complainants is in excess of ten times the out-of-pocket costs indicated by Respondent in the remedies he has sought from this Panel. The only use it appears that the Respondent made of the disputed domain name, other than to offer it for sale, was as a vehicle for certain pornographic material, which is prohibited under the rules of its host Registrar, joker.com, as violating the prevailing laws of the Federal Republic of Germany. (Rule 5 (i), as shown in Complainants’ Annexure R). Therefore the Panel finds that the Respondent registered, and used, the disputed domain name in bad faith.

### **Status**

www.raineandhornecommercial.com Domain Name Transfer

## Decision

### Decision/Award

In summary, this Panel has found that the domain name disputed herein, as registered by Respondent, is identical or confusingly similar to the trademarks and other intellectual property in which the Complainants have rights; the Respondent has no legitimate right nor interest therein; and the said domain name was registered and used by the Respondent in bad faith. Therefore this Panel hereby directs that the domain name, raineandhornecommercial.com be forthwith transferred to the Complainants, or such of them that they may designate.

With regard to the Respondent's request for compensation of his expenses, such request is denied, and the Respondent is ordered to effect the transfer of the domain name to the Complainant without any compensation whatsoever.

### Commentary

It is unfortunately beyond the jurisdiction of this Panel to award costs or impose any other sanctions upon the Respondent in this reference. The Registrar, to whom a copy of this Award must be provided, will no doubt take note of the violation of both its rules and of the relevant provisions of German law to the effect that the latter prohibits use of domain names to provide access to pornographic or other offensive content and is, of course, free to act accordingly and appropriately within its own jurisdiction.

As for possible violation of trademark/service mark rights of the Complainants, this would be a matter not for this Panel but for the Australian courts to determine, if any such claim should be presented to them. This Panel does find it interesting, however, that the Respondent has removed himself, or so claims to have done, from the jurisdiction of the Australian courts.

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