

ADMINISTRATIVE PANEL DECISION

Rice Rice Baby Limited v. Tony Le
Case No. DAU2022-0014

1. The Parties

The Complainant is Rice Rice Baby Limited, New Zealand, represented by THELOFT.LEGAL, New Zealand.

The Respondent is Tony Le, Australia.

2. The Domain Name and Registrar

The disputed domain name <ricericebaby.com.au> is registered with Web Address Registration Pty Ltd. (the "Registrar")

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 26, 2022. On June 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 5, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Complainant filed amended Complaints on July 7, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the "Policy" or ".auDRP"), the Rules for .au Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 7, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was July 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 3, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on August 8, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant or its predecessor has operated a Vietnamese restaurant and catering/takeaway business at Mt. Maunganui in New Zealand since approximately 2019 under the trading name and trade mark RICE RICE BABY. The Complainant owns registered trade mark rights for RICE RICE BABY in New Zealand under number 1152933 registered on January 7, 2021, with a priority date of July 6, 2020 and it also owns registered trade mark rights in Australia under trade mark registration number 2137217 registered on April 13, 2021, with a priority date of November 19, 2020. The Complainant operates its restaurant website from a website at “www.ricericebaby.co.nz” since at least 2019.

The disputed domain name was registered on February 8, 2021. As at December 22, 2021 it resolved to “https://rrbaby.square.site/” from which restaurant type services were promoted under the name “Rice Rice Baby”. The disputed domain name continues at the date of this decision to be diverted to a site from which Asian restaurant items are offered for order over the Internet from a base that appears to be in Perth, Australia.

5. Parties’ Contentions

A. Complainant

The Complainant submits that it owns registered trade mark rights in its RICE RICE BABY mark as noted above and that the disputed domain name is identical to its registered trade marks.

The Complainant submits that it has developed reputation and goodwill in its RICE RICE BABY mark since 2019 such that customers would expect the disputed domain name to lead to a website operated by the Complainant. It says that it has never authorised the Respondent to register a domain name or to make use of a name incorporating “Rice Rice Baby”. It also submits that the Respondent has not demonstrated any rights in the disputed domain name, particularly considering the Complainant’s rights in its Australian registered trade mark.

On April 14, 2022, the Complainant sent a cease and desist letter to the Respondent asserting its rights and noting that it plans to expand to Australia in the near future. It also sought to engage with the Respondent through Instagram but received no response to either communication.

As far as bad faith is concerned, the Complainant asserts that the Respondent has made no legitimate use of the disputed domain name other than to divert Internet users to its own website. It says that the Respondent is seeking to profit from and exploit its registered trade mark and that by using the disputed domain name to divert Internet users to its own website in relation to similar services, the Respondent has intentionally attempted to attract for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s RICE RICE BABY trade mark as to the source, sponsorship or affiliation or endorsement of the Respondent’s website, products or services in terms of paragraph 4(b)(iv) of the Policy.

It further submits that the Respondent registered the disputed domain name in order to prevent the Complainant from reflecting its RICE RICE BABY mark in a corresponding domain name specific to Australia in terms of paragraph 4(b)(ii) of the Policy or that it has sought to disrupt the business or activities of the Complainant, including its expansion under paragraph 4(b)(iii) of the Policy. The Complainant notes that the Respondent’s registration of the disputed domain name precludes it from registering the equivalent “.com.au” domain name for its mark.

The Complainant submits that the Respondent should have been aware of its Australian registered mark when it registered the disputed domain name by undertaking a simple trade mark search and suggests that the disputed domain name was so obviously connected to the Complainant that its unauthorised use by the Respondent suggests opportunistic bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns registered trade mark rights in Australia under trade mark registration number 2137217 for its RICE RICE BABY mark. The disputed domain name wholly incorporates this mark without any addition before the country code Top-Level Domain "com.au", and is therefore identical to it. As a result, the Panel find that the Complaint succeeds under this element of the Policy.

B. Rights or Legitimate Interests

The Complainant has submitted that it never authorised the Respondent to register the disputed domain name or to make use of a name incorporating "Rice Rice Baby". It has also submitted that the Respondent has not demonstrated any rights in the disputed domain name in view of the Complainant's pre-existing rights in its Australian registered trade mark.

The Complainant appears through use since 2019 to own developed reputation and goodwill in its RICE RICE BABY mark in the localised region of New Zealand where based on the record it operates a single outlet restaurant, takeaway, and catering business. It is however a stretch for it to suggest that Perth based customers thousands of kilometres away would expect the Australian based disputed domain name to lead to a website operated by the Complainant thousands of kilometres away in a different jurisdiction and there is no evidence on the record to support this assertion. That said, the Complainant acted to protect its position in Australia by applying for and obtaining a valid Australian trade mark registration for its RICE RICE BABY mark. It appears that it obtained this mark with the aspiration of expanding into the Australian market and the registration of the mark was several months prior to the registration of the disputed domain name.

Noting the distinctive nature of the Complainant's trademark for restaurant services, as well as the identical nature of the disputed domain name and the temporal proximity between the registration of the Complainant's trade mark and the Respondent's domain name registrations and absent any explanation to the contrary, the Panel finds it unlikely that Respondent would have adopted the disputed domain name independently. However, even if the Respondent independently created the disputed domain name, had it searched the term "rice rice baby" prior to seeking to register the disputed domain name it would have immediately become aware of the Complainant and its website "www.ricericebaby.co.nz" (bearing the Complainant's mark). Had it also sought to "clear" its prospective mark in Australia it would have found the Complainant's trade mark registration there. If on the other hand it chose to register the disputed domain regardless of the Complainant's prior rights (and whether it was aware of them or not) then the Respondent either acted recklessly, or illegitimately, in doing so. Neither position is consistent with the Respondent having rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond to the Complainant's pre-action communications to explain its conduct, or to rebut the Complainant's case in these proceedings and for these reasons and for the reasons set out under Part C below, the Panel finds that the Complaint also succeeds under this element of the Policy.

C. Registered or Subsequently Used in Bad Faith

Section 4(a) 3 of the Policy requires that a domain name has been registered *or* has subsequently been used in bad faith.

The disputed domain name was registered in February 2021, a few months after the effective registration of the Complainant's Australian trade mark. The Complainant's RICE RICE BABY mark is a coined trade mark (even if possibly a pun on the 1990 song entitled "Ice Ice Baby") which is highly distinctive for restaurant services. The Respondent has failed to explain how it came to choose an identical disputed domain name for its very similar food service business, although it has had the opportunity to do so on three separate occasions.

It seems to the Panel most likely that the Respondent did not independently create the disputed domain name but became aware of the Complainant's business and name, possibly by searching on the Internet and decided that this would be a good name for its very similar Perth based business and that it would take advantage of this opportunity. This strategy might have worked for the Respondent had the Complainant not registered an Australian trade mark. However, the Complainant does have such a registration which provides notice to the Australian public of its rights in the mark.

In circumstances that the Respondent chose to register a domain name that was identical to a highly distinctive mark in use then it was up to the Respondent to check that the trade mark position in Australia was clear before it went on to register the disputed domain name, in default of which it risked infringing that user's rights. For the avoidance of doubt, this is not to develop a general doctrine of constructive notice under the auDRP (see section 3.4 of the auDA Overview of Panel Views on Selected auDRP Questions First Edition) but rather seeks to confirm that the Policy does not permit a respondent to register knowingly a domain name which is identical to a highly distinctive mark in commercial use without first checking for trade mark rights. This is also consistent with the position under paragraph 2(b) of the Policy that, to a respondent's knowledge, the registration of a disputed domain name does not infringe upon or otherwise violate the rights of any third party.

Either the Respondent was not aware of this registration because it failed to search the register, or if it was so aware then it proceeded recklessly with its registration of the disputed domain name. In the absence of any explanation by the Respondent to the contrary, the Panel finds it more likely than not that the Respondent was at least aware of the Complainant's website and RICE RICE BABY mark for its restaurant services business, if not also its Australian trade mark registration prior to its registration of the disputed domain name, but decided knowingly to proceed with registration of the disputed domain name in any event. The Panel finds that registration by the Respondent in these particular circumstances amounts to taking advantage of the Complainant's registered Australian trade mark rights and to registration in bad faith of the disputed domain name which fulfils the requirements of this element of the Policy.

Under paragraph 4(b)(ii) of the Policy there is evidence of registration and use in bad faith where a respondent has registered a domain name in order to prevent the owner of a name, trade mark, or service mark from reflecting that name or mark in a corresponding domain name. Past auDRP panels have generally found that registration of a domain name which consists solely (once the second-level and top-level domain extensions are ignored) of the complainant's trade mark or name has the effect of preventing the complainant from reflecting its mark or name in that domain name and hence is evidence of bad faith (See paragraph 3.1B of the auDA Overview of Panel Views on Selected auDRP Questions First Edition).

The Panel has already found that it is more likely than not that the Respondent was aware of the Complainant's business and mark in New Zealand when it registered the disputed domain name and that he proceeded with registration, either without having checked the trade mark position in Australia, or with such knowledge, but without regard to the Complainant's rights. In doing so the Respondent has prevented the Complainant from reflecting its Australian registered mark in a corresponding domain name in the ".com.au" ccTLD and this amounts to evidence of registration and of use in bad faith under paragraph 4(b)(ii) of the Policy.

Accordingly, the Panel finds that the disputed domain name was registered and has been used in bad faith and the Complaint also succeeds under this element of the Policy

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <ricericebaby.com.au> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: August 21, 2022