

ADMINISTRATIVE PANEL DECISION

Car Sound Exhaust System, Inc v. David Robinson, Performance Exhaust
Nationwide Pty Ltd
Case No. DAU2022-0031

1. The Parties

The Complainant is Car Sound Exhaust System, Inc, United States of America (“United States”), represented by Spruson & Ferguson Lawyers, Australia.

The Respondent is David Robinson, Performance Exhaust Nationwide Pty Ltd, Australia.¹

2. The Domain Names and Registrar

The disputed domain names <magnaflow.au> and <magnaflow.com.au> are registered with Netregistry Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2022. On the following day, the Center transmitted by email to Netregistry Pty Ltd. a request for registrar verification in connection with the disputed domain names. On October 28, 2022, Netregistry Pty Ltd. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant of both disputed domain name sand providing the contact details.

The Center verified that the 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 November 2, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was November 22, 2022. The Respondent sent an informal email communication to the Center on November 8, 2022. The Complainant submitted a supplemental filing to the Center on November 14, 2022.

¹ The Complaint identified the former registrant of one disputed domain name as an additional respondent. Given that the Registrar did not verify this party as the current registrant of either disputed domain name, the Panel does not consider it a proper respondent in this proceeding.

The Center appointed Matthew Kennedy as the sole panelist in this matter on November 28, 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.

On November 29, 2022, the Center sent a follow-up email to Netregistry Pty Ltd seeking clarification of its verification response. On the following day, Netregistry Pty Ltd sent a reply updating its verification response as regards the dates of registration of the disputed domain names.

4. Factual Background

The Complainant produces catalytic converters, mufflers, exhaust pipes all for motors and engines, and other related products. It does business as “Magnaflow” and holds multiple trademark registrations in multiple jurisdictions for MAGNAFLOW, including:

- United States trademark registration number 2052171, registered on April 15, 1997, specifying catalytic converters, mufflers, and exhaust pipes all for motors and engines in class 7; and
- Australian trademark registration number 1029496, registered on June 27, 2005, specifying exhaust for motors and engines; exhaust pipes, exhaust systems, and tips for motors and engines; catalytic converters; mufflers; their parts and fittings comprised in class 7.

The above trademark registrations remain current. The Complainant has also registered multiple domain names including <magnaflow.com> that it uses in connection with a website where it provides information about itself and its products.

The Respondent is an Australian company registered on April 9, 2013. David Robinson is a director of the company, the company secretary, and the contact person for the disputed domain names (hereinafter, “Mr. Robinson” unless otherwise indicated).

The disputed domain name <magnaflow.com.au> was created on April 18, 2005, according to information provided by auDA to the Complainant, or on May 18, 2016, according to the Registrar’s verification response. According to searches of the Registrar’s Whois database provided by the Complainant, the registrant of this disputed domain name was Mellbay Pty Ltd as recently as October 12, 2022. Mr. Robinson was the contact person before and after the transfer to the Respondent. This disputed domain name redirects to <performanceexhaust.com.au>, which is associated with a website titled “Performance Exhaust” and sub-titled “Home of the best brands” that offers for sale performance exhausts of various brands including the Complainant’s MAGNAFLOW brand.

The registrant of the domain name <performanceexhaust.com.au> is shown in the Whois database as “Performance Exhaust” but its Australian Business Number is that of Mellbay Pty Ltd. According to results of searches of an Australian Securities & Investments Commission database provided by the Complainant, this company was originally established in 1997 as “Performance Exhaust Pty Ltd”, changed its name in 2003 and was deregistered in 2006. Mr. Robinson is the contact person for this domain name as well.

The disputed domain name <magnaflow.au> was created on August 10, 2022. It does not resolve to any active website; rather, it is passively held.

5. Parties' Contentions

A. Complainant

The disputed domain names are identical or confusingly similar to the Complainant's MAGNAFLOW trademark. This Complaint is based on the Complainant's common law rights in, and registrations for, the MAGNAFLOW trademark.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not an authorized reseller or distributor of the Complainant's goods under or by reference to the Complainant's mark and neither is authorized by the Complainant to register and or use the disputed domain names. The Respondent does not meet the test in *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), because it has not used the site to sell only the trademarked goods or services of the Complainant; and the Respondent's website does not accurately and prominently disclose its relationship with the trademark holder

The disputed domain names were registered or are subsequently being used in bad faith. The Respondent has used the disputed domain name <magnaflow.com.au> to redirect to the Performance Exhaust website operated by the Respondent which promotes and offers for sale goods that compete with those of the Complainant. It is apparent that this is also the intention with respect to the recently registered disputed domain name <magnaflow.au>. The holding of the disputed domain names prevents the Complainant from registering its trademark in the .com.au and .au domains.

B. Respondent

In its informal email communication, the Respondent advised that it had decided to deregister the disputed domain names so as to simplify the process. Its contact person asserts that he has owned the disputed domain name <magnaflow.com.au> since approximately 2006 and further claimed to currently sell the Complainant's products via the Australian distributor.

6. Discussion and Findings

6.1 Preliminary Issues

A. Respondent's Request to Delete

In its informal email communication, the Respondent indicated that it had decided to deregister the disputed domain names "so as to simplify the process". The Registrar confirmed in its updated verification response that both disputed domain names had been set to delete at the Respondent's request.

The Panel takes note that (i) the registrations of the disputed domain names have not yet been deleted; (ii) the Respondent did not consent to the remedy sought by the Complainant, which is a transfer of the disputed domain names rather than cancellation; and (iii) the Respondent's email communication seems to imply a denial that it registered or used the disputed domain names in bad faith. Accordingly, the Panel will proceed to an evaluation of the merits. See generally See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 4.10.

B. Complainant's Unsolicited Supplemental Filing

The Complainant made an unsolicited supplemental filing on November 14, 2022, prior to the due date for the Response. The Panel recalls that the auDRP and Rules make no specific provision for the filing of supplemental submissions. In any event, given that the Complainant's supplemental filing only contains a list of links to prior decisions of UDRP panels already cited in the Complaint to which the Panel already has access, the Panel considers it unnecessary to determine its admissibility.

6.2 Substantive Issues

Paragraph 4(a) of the auDRP provides that a complainant must prove each of the following elements with respect to each disputed domain name:

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

A. Identical or Confusingly Similar

Based on the evidence provided, the Panel finds that the Complainant has rights in the MAGNAFLOW mark.

The disputed domain names wholly incorporate the MAGNAFLOW mark as their respective operative elements. The only additional element in the disputed domain names is the Second Level Domain (“2LD”) extension “.com.au” or the country code Top-Level Domain (“ccTLD”) “.au” which, as technical requirements of domain name registration, may be disregarded for the purposes of the comparison with the Complainant’s trademark for the purposes of the first element of paragraph 4(a) of the Policy.

Therefore, the Panel finds that the disputed domain names are identical to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the auDRP.

B. Rights or Legitimate Interests

Paragraph 4(c) of the auDRP sets out circumstances which, without limitation, if found by the Panel to be proven based on its evaluation of all evidence presented, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the auDRP:

- (i) before any notice to [the respondent] of the subject matter of the dispute, [the respondent’s] *bona fide* use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with an offering of goods or services (not being the offering of domain names that [the respondent has] acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As regards the first and third circumstances set out above, both disputed domain names wholly incorporate the Complainant’s MAGNAFLOW trademark, adding only a 2LD or ccTLD suffix, which *prima facie* carries a high risk of implied affiliation with the Complainant. The disputed domain name <magnaflow.com.au> redirects to another domain name which is associated with the Respondent’s website where the Respondent offers for sale performance exhausts of various brands, including the Complainant’s brand. The Complainant submits that the Respondent is not an authorized reseller or distributor of the Complainant’s goods. Even if the Respondent’s goods are genuine, the Respondent is clearly using the Complainant’s MAGNAFLOW trademark in the disputed domain name to attract Internet users and then offer them, among other things, goods that compete with the Complainant’s goods. That is not a use of the disputed domain name in connection with a *bona fide* offering of goods. The other disputed domain name <magnaflow.au> is passively held only. These circumstances do not indicate that either disputed domain name is being used in connection with a *bona fide* offering of goods or services, nor in connection with a legitimate noncommercial or fair use.

As regards the second circumstance set out above, the Respondent is named “Performance Exhaust Nationwide Pty Ltd” and its contact person is named “David Robinson”. Nothing indicates that the Respondent has been commonly known by the disputed domain name.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Turning to the Respondent’s arguments, it claims that it currently sells the Complainant’s products via the Australian distributor. The Panel accepts that nothing on the record indicates that the Respondent’s goods are anything but genuine but, given the way that the disputed domain name <magnaflow.com.au> is being used, this is not sufficient to show that it is being used in connection with a *bona fide* offering of goods for the reason given above. Accordingly, the Panel finds that the Respondent has not rebutted the Complainant’s *prima facie* case.

Therefore, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant has satisfied the second element in paragraph 4(a) of the auDRP.

C. Registered or Subsequently Used in Bad Faith

Paragraph 4(b) of the auDRP provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, although it is not an exhaustive list of such circumstances. The fourth circumstance is as follows:

(iv) by using the [disputed] 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 website or location or of a product or service on that website or location.

As regards registration, it may be deduced from the WhoIs extracts presented by the Complainant that the disputed domain name <magnaflow.com.au> was acquired by the Respondent no earlier than October 12, 2022. However, the Respondent’s contact person, Mr. Robinson, asserts that he has owned this disputed domain name since approximately 2006. The Panel considers that an entity controlled by Mr. Robinson may well have previously held this disputed domain name but it suffices for present purposes to note that the disputed domain name was not created until 2005 (according to auDA) or until 2016 (according to the Registrar), which was, in either case, years after the Complainant’s earliest registration of the MAGNAFLOW mark in the United States in 1997. This disputed domain name wholly incorporates the MAGNAFLOW mark, which is an invented word with no other apparent meaning than as a reference to the Complainant and its goods. The Complainant uses its mark in relation to performance exhausts, among other products, and the Respondent is a reseller of that same specialized type of product and actually displays the Complainant’s MAGNAFLOW mark on its website. It appears that the Respondent or its related entities have been selling such products since at least the time when the disputed domain name was created, as the prior holder of this registration (Mellbay Pty Ltd) was established as “Performance Exhaust Pty Ltd” in 1997. In view of these circumstances, the Panel finds it very likely that the Respondent was aware of the Complainant’s mark and targeted it at the time that it registered the disputed domain name <magnaflow.com.au>.

The disputed domain name <magnaflow.au> was registered in August 2022. It is composed of the same mark as the other disputed domain name, the only difference between them being that this one is registered directly in the ccTLD “.au” rather than the 2LD “.com.au”. It is held by the same registrant as the other disputed domain name. Therefore, for the reasons set out above, the Panel finds that the Respondent was also aware of the Complainant’s mark and targeted it at the time that it registered the disputed domain name <magnaflow.au>.

As regards subsequent use, the Respondent uses the disputed domain name <magnaflow.com.au> to redirect to another domain name, which is associated with its own website where it offers for sale not only the Complainant’s MAGNAFLOW performance exhausts but also those of other brands that compete with

the Complainant's products. In view of these circumstances and the findings set out in Section 6.2B above, the Panel is persuaded that, by using this disputed domain name, 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 MAGNAFLOW mark as to the source, sponsorship, affiliation, or endorsement of that website within the terms of paragraph 4(b)(iv) of the auDRP.

The disputed domain name <magnaflow.au> is passively held but this does not preclude a finding of use in bad faith. See *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), followed in prior decisions under the auDRP such as *Chegg, Inc. v Knoxweil Pty Ltd*, WIPO Case No. [DAU2022-0010](#). In the present dispute, the only difference between the disputed domain names is that one is registered directly in the ccTLD ".au" rather than the 2LD ".com.au". Their operational elements are identical and the Respondent actively uses the ".com.au" disputed domain name in bad faith. The Respondent provides no explanation of any potential good faith use of the ".au" direct disputed domain name. In view of these circumstances, the Panel finds that the most likely intended use of the disputed domain name <magnaflow.au> is the same as that of the other disputed domain name and in bad faith.

Therefore, the Panel finds that the disputed domain names have been registered and are being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) of the auDRP.

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 disputed domain names, <magnaflow.au> and <magnaflow.com.au>, be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: December 4, 2022