

ADMINISTRATIVE PANEL DECISION

Adrian Thompson v. Bay Ferry Tours Pty. Ltd.
Case No. DAU2023-0031

1. The Parties

The Complainant is Adrian Thompson, Australia, represented by Somerville Legal Pty Limited, Australia.

The Respondent is Bay Ferry Tours Pty. Ltd., Australia, self-represented.

2. The Domain Names and Registrar

The disputed domain names <teagardensferry.com.au> (first disputed domain name) and <teagardensferry.au> (second disputed domain name) are registered with Netregistry Wholesale Pty Ltd (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 28, 2023. On July 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 5, 2023, the Registrar transmitted by email to the Center its verification responses confirming that the Respondent is listed as the registrant and providing the contact details. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on July 10, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the "Policy"), 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 10, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was July 30, 2023. On July 25, 2023, the Respondent requested for an extension to the Response due date. In accordance with paragraph 5(d) of the Rules, the Center informed the Parties on July 25, 2023, that the due date for Response was extended to August 4, 2023. The Response was filed with the Center on August 4, 2023.

On August 7, 2023, the Complainant submitted a request to file a supplemental filing in relation to matters alleged in the Response.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on August 14, 2023. 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 September 1, 2023, the Complainant made an unsolicited supplemental filing with a request to replace an unexecuted deed included in Annex 17 to the Complaint with a substituted document. The Respondent objected to the inclusion of this late filed document in the record.

4. Factual Background

The Complainant and the Respondent are both connected with rival businesses engaged in the provision of ferry services between Nelsons Bay and Tea Gardens in the Hunter Valley region of New South Wales, Australia.

The Complainant is the sole director, secretary, and shareholder of two companies, Tea Gardens Ferry Services Pty Ltd (ABN 84 097 866 049) ("049 Company") and Port Stephens Ferry Service Pty Ltd (ABN 98 102 803 305) ("PSFS").

According to the Complainant, the "Littler" family operated a business transporting passengers by ferry from Nelson Bay to Tea Gardens under the names "Port Stephens Ferry Service" and "Tea Gardens Ferry Service" from 1990 until around October 2002.

In October 2002, the Complainant appears to have entered into a letter of intent to purchase one ferry (the MV Jesse) and a business described in the subject line of the letter as Port Stephens Ferry Service Pty Ltd. An unexecuted Deed dated November 1, 2002, included in Annex 17 to the Complaint contemplates that the transaction was completed on that date and, amongst other things, required the company then known as Port Stephens Ferry Service Pty Ltd to change its name.

On November 12, 2002, the Complainant incorporated PSFS and, as noted above, became its sole director, secretary, and shareholder.

According to the Complainant, in December 2002 or in March 2003, the Complainant purchased a second ferry from the Littler family, the MV Tea Gardens. In any event, on December 19, 2002, the Complainant became the sole director, secretary, and shareholder of 049 Company.

Also according to the Complainant, in January 2003 the Complainant leased the ferry service business and the ferry MV Jesse to PSFS. The 049 Company had, and has, licence agreements with the relevant local government authorities to operate particular wharves or berths. According to the Complainant, the 049 Company granted the Complainant rights to use the berths provided the Complainant paid the berthing fees.

The business name Tea Garden Ferry Service was registered between October 1989 and December 1993. This name was registered by the Dawsons. The business name "tea garden ferry" was registered between October 2014 and March 2018 by the 049 Company.

On December 19, 2018, PSFS as the owner of the business known as "Port Stephen Ferry Service" and the vessels MV Jesse and MV Tea Gardens granted the Respondent a lease to operate the business and the ferries for a term of 13 months. The lease included amongst other things an option to purchase the business and also included provisions for the lease to continue on a month to month basis after the expiry of the initial term. It was also a term of the lease that the business name at all times remained the property of the lessor, PSFS, and was available for use by the lessee only during the term of the lease.

The lease was executed by the Complainant for PSFS.

It does not appear to be in dispute between the Parties that, as a result of this arrangement, the Respondent gained administrative access to social media pages associated with the business including a Facebook page and an Instagram page and used those services to promote a Tea Gardens Ferry service.

According to the Complainant, in April 2019 the Complainant terminated the "Extended Lease" (which appears to be a reference to the agreement between PSFS and the Respondent) and granted a new lease to A & G Equities Pty Ltd, another company of which the Complainant is the sole director and secretary. The basis of this termination (which was within the original 13 month term) and the lease to A & G Equities Pty Ltd are not disclosed in the Complaint.

On May 1, 2019, the Federal Court of Australia appointed a liquidator over PSFS.

On May 27, 2019, the Respondent registered the business name Tea Gardens Ferry.

The first disputed domain name was registered on May 27, 2019. The second disputed domain name was registered on April 16, 2023.

The first disputed domain name currently resolves to a website promoting the Tea Gardens Ferry services provided in the Port Stephens Great Lakes Marine Park by the Respondent. (There is a dispute between the Parties about whether the Respondent owns any ferries to provide such a service or does so through a third party.)

There have been three captures of websites relating to the first disputed domain name by the Wayback Machine. The first of these, on December 26, 2021, redirected to a website at "www.portstephensferry.com.au", which also promoted the Tea Gardens Ferry. The Wayback Machine records 107 captures of "www.portstephensferry.com.au" landing page between August 28, 2010 and April 5, 2023. The first of these captures is headed Port Stephens Ferry Service Pty Ltd and in the footer states Copyright 2010 [PSFS].

According to the Complainant, in or around September 2022 and notwithstanding the earlier termination of the Extended Lease in April 2019, the Complainant terminated, or purported to terminate, the agreement between PSFS and the Respondent.

On September 13, 2022, the Complainant incorporated a further company, TG Ferry Service Pty Ltd. This company operates "The Original Tea Gardens Ferry Service" using the vessels MV Jesse, MV Tea Gardens, and MV Wallamba. Its website, at "www.teagardensferry.com.au", uses a similar style and colour scheme to that introduced by the Respondent under the agreement with PSFS.

In November 2022, the liquidator of PSFS and PSFS commenced proceedings in the Supreme Court of New South Wales against the Complainant and A & G Equities Pty Ltd, Case Number 2022/00243153 (the NSW Proceedings). The pleadings in the NSW Proceedings allege that the Respondent exercised the option to purchase the business granted under the December 2018 agreement with PSFS. The pleadings also allege various breaches of director's duties and other misconduct against the Complainant. The Panel infers from the Complainant's request to file a supplemental filing that the Complainant disputes these allegations including the allegations against him personally.

The second disputed domain name has not resolved to an active website to date. According to the Complainant, the second disputed domain name was originally registered in October 2022 by the Complainant's agent. The agent, however, mistakenly registered the second disputed domain name in the name of PSFS. The Respondent filed an objection against the registration of the second disputed domain name in or about January 2023 as a result of which the second disputed domain name became registered by the Respondent.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain names, the Complainant must demonstrate each of the following:

- (i) the disputed domain names are identical or confusingly similar to a trade mark 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 names; and
- (iii) the disputed domain names have been registered or subsequently used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

A. Supplemental Filing

As noted above, the Complainant initially requested permission to submit a supplemental filing on the basis that the Respondent's reliance on the NSW Proceedings initiated by the liquidator of PSFS constitutes "exceptional circumstances". See section 4.6 of Overview of Panel Views on Selected auDRP Questions, Second Edition (auDRP Overview 2.0).

The Respondent objects to the further expense and delay that the Complainant's request would cause, if granted.

The Panel is rather surprised by the Complainant's claim that the Respondent's reliance on the NSW Proceedings is unexpected and could not reasonably have been anticipated.

The Panel considers that the proposed supplemental filing is unnecessary and would not be appropriate in the present case.

Assuming (as the Panel does) that the Complainant disputes the allegations made in the NSW Proceedings, it is unlikely that the Panel would be in a position to reach an informed decision about whether the liquidator's allegations are proved or fail.

The issues raised in the NSW Proceedings go to the heart of the Respondent's entitlement to the disputed domain names as they go to the heart of the issue whether the Complainant owns the rights claimed in this proceeding over "Tea Gardens Ferry" as an unregistered trade mark or the company PSFS does. The issues raised in the NSW Proceeding also include the significance of the representation made in the December 2018 deed that PSFS is, or was, "the owner of the business conducted under the business name" and whether or not the Complainant validly terminated that agreement in April 2019 or September 2022 (when a liquidator had been appointed over PSFS) and granted a valid lease to A & G Equities Pty Ltd. The NSW Proceedings also involve allegations that the purported termination of the Extended Lease and subsequent grant to A & G Equities Pty Ltd involved breaches of director's duties or are otherwise liable to be set aside as an impermissible attempt to remove assets from the claims of creditors.

As is well known, proceedings under the Policy are proceedings on the papers without the benefit of oral evidence, cross-examination or discovery amongst other things. The procedures and processes available to the Court will be particularly valuable in addressing the issues raised by both this Complaint and the NSW Proceedings. The issues can be authoritatively determined by the Court. In addition, the NSW Proceedings involve a party, the liquidator, who is not a party to this proceeding and whose rights, on behalf of the creditors and the company in liquidation, could be prejudicially affected by a decision in this proceeding.

If the Complainant were to be given an opportunity to make a supplemental filing (about an issue he was fully aware of when filing the Complaint), the Panel would not have the benefit of submissions from the liquidator and the company under administration. Any decision reached by the Panel would not be binding on the Court or the Parties or the liquidator and at best based on limited information, much more limited than potentially available to the Court through the Court's processes and procedures.

Accordingly, the Complainant's request to submit a supplemental filing is denied.

As noted above, the Complainant has also submitted an unsolicited supplemental filing seeking to substitute what appears to be an executed lease agreement between the Complainant and PSFS. The Respondent not unreasonably objects to the lateness of this submission.

In the event, it does not matter. In preparing the decision, the Panel has assumed in the Complainant's favour that there was a lease between the Complainant and PSFS granted in 2002 or early 2003. Even assuming that matter in the Complainant's favour, however, leaves unresolved the issues raised by the December 2018 deed, the Complainant's execution of that deed on behalf of PSFS, and the other issues raised in the NSW Proceeding.

B. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain names are identical with, or confusingly similar to, the Complainant's name, trade mark or service mark.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a name, trade mark or service mark at the date the Complaint was filed and, if so, the disputed domain names must be identical or confusingly similar to the name or mark.

The Complainant does not own a registered trade mark, but relies on rights in TEA GARDENS FERRY as an unregistered trade mark (Complaint [13]). This requires the Complainant to advance evidence that his use, or use under his control, is sufficient for the term to have become a badge of origin. See *e.g.* auDA Overview 2.0, section 1.3.

TEA GARDENS FERRY, as the Respondent contends, is a descriptive term.

That has significance here because the evidence presented by the Complainant to support his claim is, at least until the Respondent began operating the service after the December 2018 deed, patchy. For the most part, the evidence before the Respondent became involved indicates that the service was promoted as the Port Stephens Ferry Service.

There appears to be much more extensive use in a trade mark form after the Respondent became involved, although much of that use appears to be in a fancy or stylised form. As to the issues raised in such a context, see *e.g.* *The Agency Group Australia Limited v H.A.S. Real Estate Pty Ltd* [2023] FCA 482.

Putting that to one side, the Respondent's use was engaged in pursuant to the December 2018 deed (at least before the possible termination in April 2019). Under that deed, the benefit of the Respondent's use enured to PSFS.

It is perhaps arguable that the Complainant as the sole director, secretary, and shareholder in PSFS was exercising sufficient control over PSFS' operations to constitute some kind of head licensor and so be able to claim ownership of any resulting rights.

On the other hand, the December 2018 deed expressly asserts that PSFS is the owner of the business including the intellectual property and the "goodwill of the business including the right to use any name or mark used in or associated with it".

Moreover, the Complainant executed the deed on behalf of PSFS.

It is not at all clear to the Panel that it is appropriate for the Panel to allow the Complainant to resile from that express representation, especially when it appears to be one of the matters in issue in the NSW Proceedings.

If PSFS is the owner of the rights (as appears to be the effect of the December 2018 deed), the Complainant is not the owner of the unregistered trade mark and, accordingly, does not have standing under the Policy. The Complainant is the sole director, secretary and shareholder of PSFS. However, the company is in liquidation so the Complainant's role in controlling the company and its operations has largely been displaced in favour of the liquidator. It is the liquidator who is managing the company and its business, not the Complainant as the director or shareholder and so it is the liquidator, or the company under the liquidator's control, which would have standing. Accordingly, the case is different to the circumstances in *Ernesto Huerta v. Erick Calder*, WIPO Case No. [D2023-2349](#).¹

Further, accepting the Complainant's claims would involve making findings adverse to the claims made by the liquidator in the NSW Proceeding. As noted above, however, the liquidator (and PSFS under the liquidator's administration) are not parties to this proceeding.

In these circumstances, the Panel is not able to find that the Complainant has satisfied the first requirement under the Policy on the basis of rights claimed in the unregistered trade mark TEA GARDENS FERRY.

As the sole director and shareholder in the 049 Company, the Complainant may have standing to act on its behalf on the basis of the 049 Company's rights in its name.² See *Ernesto Huerta v. Erick Calder*, WIPO Case No. [D2023-2349](#).

The evidence that the 049 Company has used its name as trading name or unregistered trade mark is very limited.

Even if it be sufficient, however, the issues about the effects of the December 2018 deed, the purported April 2019 termination and lease to A & G Equities Pty Ltd, amongst others, already discussed still bear on whether the Respondent can claim rights or legitimate interests in the disputed domain names or registered and has subsequently been using the disputed domain names in good faith or bad faith.

In view of those issues, the Panel would also find that the Complainant had not established either of those requirements under the Policy for the reasons already explained in ruling that the Complainant has not established ownership of the TEA GARDENS FERRY unregistered trade mark.

Ultimately, the Panel considers that the issues arising in this proceeding are not well suited to a proceeding under the Policy and should more appropriately be dealt with in the Court proceedings already on foot.

6. Decision

For all the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: September 2, 2023

¹ Noting the similarities between auDRP and the Uniform Domain Name Dispute Resolution Policy ("UDRP"), the Panel may refer to the UDRP decisions, where appropriate.

² Note 1 of the Policy explains that this is: "(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."