

ADMINISTRATIVE PANEL DECISION

Ausgrid Management Pty Ltd, Ausgrid Operator Partnership v. Bektash Pty Ltd

Case No. DAU2023-0052

1. The Parties

The Complainants are Ausgrid Management Pty Ltd and Ausgrid Operator Partnership, represented by King & Wood Mallesons, Australia.

The Respondent is Bektash Pty Ltd, Australia.

2. The Domain Name and Registrar

The disputed domain name <ausgridelectrics.com.au> is registered with Domain Directors Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 21, 2023. On December 21, 2023, the Center transmitted by email to Domain Directors Pty Ltd. a request for registrar verification in connection with the disputed domain name. On January 7, 2024, Domain Directors Pty Ltd. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and 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 proceeding commenced on January 9, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was January 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 1, 2024.

The Center appointed Sebastian M.W. Hughes as the sole panelist in this matter on February 14, 2024. 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

A. Complainants

The First Complainant Ausgrid Management Pty Ltd is a company incorporated in Australia, the owner of the domain name <ausgrid.com.au>, and an authorised user of the various AUSGRID registered Australian trade marks owned by the Second Complainant, Ausgrid Operator Partnership.

The Second Complainant, Ausgrid Operator Partnership, is the largest distributor of electricity on Australia's east coast, operating since 2011 under the AUSGRID trade marks, including Australian registered trade mark No. 1412375 for the word mark AUSGRID, with a registration date of March 3, 2011, registered in respect of a wide range of goods and services (the "Trade Mark").

B. Respondent

According to the evidence submitted by the Complainants, the Respondent is a company incorporated in Australia and a provider of electrical maintenance, installation, and repair services.

C. The Disputed Domain Name

The disputed domain name was registered on July 5, 2021.

D. Use of the Disputed Domain Name

The disputed domain name was previously resolved to a website promoting the Respondent's business under the names Ausgrid Electrics and Ausgrid Electrics Pty Ltd (the "Website").

As at the date of this Decision, the disputed domain name is no longer resolved to an active website.

5. Parties' Contentions

A. Complainants

The Complainants contend that the disputed domain name is identical to the Trade Mark, the Respondent has no rights or legitimate interests in respect of the disputed domain name, and the disputed domain name has been registered or subsequently used in bad faith.

Notably, the Complainants contend that the disputed domain name has been registered and used with the intention of causing confusion with the Second Complainant, its business and/or the Trade Mark to take advantage of their reputation and thereby mislead consumers.

The Complainants contend further that, in response to a series of cease and desist letters from the Complainants' solicitors, the Respondent undertook, amongst other things, not to use or hold any domain name that contains the name "Ausgrid" or "Ausgrid Electrics", to cancel its registration for the disputed domain name, and not to engage in any conduct in Australia which is likely to mislead the public that there is any connection between the Respondent and the Complainants. The Respondent has failed to cancel its registration for the disputed domain name, as agreed, which led the Complainants to file the Complaint.

B. Respondent

The Respondent did not respond to the Complainants' contentions.

6. Discussion and Findings

The Complainants must prove each of the three elements in paragraph 4(a) of the Policy in order to prevail.

A. Identical or Confusingly Similar

The Panel finds that the Complainants have rights in the Trade Mark.

The entirety of the Trade Mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy.

Although the addition of other terms (here, “electrics”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the Trade Mark for the purposes of the Policy.

The Panel therefore finds that the disputed domain name is confusingly similar to the Trade Mark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to the respondent of the dispute, the respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; 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 trade mark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The Complainants have not authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the Trade Mark. The Panel finds on the record that there is therefore a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name, and the burden is thus on the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to show that it has acquired any trade mark rights in respect of the disputed domain name or that the disputed domain name has been used in connection with a bona fide offering of goods or services. While the Respondent previously applied for trademark registrations in Australia in 2023 for the terms “Ausgrid Electrics” (see, e.g., Australian trademark application numbers 2365232 and 2365233), the Respondent has withdrawn both applications. Relatedly, the Panel notes that the Respondent has a registered business name for “Ausgrid Electrics” since 2021. The fact that a respondent has registered a business name or a company name does not, of itself, establish that the respondent has rights or legitimate interests in the domain name that corresponds to the business name or the company name. The core issue is whether the respondent has traded under the business name or company name in good faith. Considering the circumstances of the case, namely the operation of the confusingly similar disputed domain name for services in direct competition with the Complainant, the Panel finds that the registration of the business name years after the Complainants’ trademark registrations and use thereof does not give rise to rights or legitimate interests to the Respondent in the disputed domain name.

To the contrary, the disputed domain name has previously been used to promote the Respondent’s electrical maintenance, installation and repair services, under the names “Ausgrid Electrics” and “Ausgrid Electrics Pty Ltd”, which are confusingly similar to the Trade Mark, and in competition with the same services provided by

the Complainants since 2011 under the Trade Mark. Accordingly, there has been no evidence adduced to show that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

In light of the above uncontested matters, the Panel finds that the Respondent has failed to produce any evidence to establish genuine rights or legitimate interests in the disputed domain name.

C. Registered or Used in Bad Faith

In light of the manner of use of the disputed domain name highlighted in section 6.2.B above, the Panel concludes that the disputed domain name has been registered and used in bad faith pursuant to paragraph 4(b)(iv) of the Policy.

The evidence suggests that the Respondent has targeted the Complainants in registering the disputed domain name; and that there cannot be any actual or contemplated good faith use of the inherently misleading disputed domain name by the Respondent.

The Panel finds further grounds in support of a finding of bad faith in light of the Respondent's failure to comply with its undertaking to cancel its registration for the disputed domain name.

For all the foregoing reasons, the Panel concludes that the disputed domain name has been registered and used in bad faith.

7. Decision

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

/Sebastian M.W. Hughes/

Sebastian M.W. Hughes

Sole Panelist

Dated: February 28, 2024