

ADMINISTRATIVE PANEL DECISION

AAB Fashion (Australasia) Pty Ltd v. Sydney Solvents Pty Ltd
Case No. DAU2024-0035

1. The Parties

The Complainant is AAB Fashion (Australasia) Pty Ltd, of Australia, represented by KCL Law Lawyers, Australia.

The Respondent is Sydney Solvents Pty Ltd, of Australia.

2. The Domain Name(s) and Registrar(s)

The disputed domain name <artistschoice.com.au> is registered with GoDaddy.com, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 20, 2024. On November 21, 2024, the Center transmitted by email to GoDaddy.com, LLC a request for registrar verification in connection with the disputed domain name(s). On November 21, 2024, GoDaddy.com, LLC 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”), 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 December 2, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was December 22, 2024. The Response was filed with the Center on December 20, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on January 14, 2025. 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 is engaged in the business of producing, distributing, and selling products related to the beauty care industry. One of its “brands” is “Artists Choice” or “AC Artists Choice” which is used in relation to latex gloves, nailcare implements and solvents for nail related services such as removing nail polish. The Complainant’s target market under this brand are professional providers of nail care related services.

The Complainant is the owner of Australian Registered trade mark No. 1707326:



which has been registered with effect from July 15, 2015, in respect of nail care products; nail grooming products; nail buffing preparations; nail polish removers; adhesives and adhesive removal products for false nails; emery boards; cuticle preparations; latex gloves for hair and beauty purposes in International Class 3. The trade mark has been indexed by IP Australia as consisting of the words “AC ARTISTS CHOICE” and the device.

The Complainant’s registered trade mark features prominently on its products or their packaging.

The Complainant introduced its product range under this brand in October 2015. Between that date and 2021, the Complainant’s products were available on its website at “www.mojointernational.com”. Since then, the Complainant has promoted its products from its website at “www.aabfashion.com”. According to the Complaint, the Complainant’s products are also featured on over 100 websites throughout Australia. The Complainant’s products have been listed on “www.catchoftheday.com”, a discount or “specials” site, and “www.salonshop.com.au” and www.nationalsalonsupplies.com.au, the latter describing itself as Australia’s leading beauty wholesaler.

The Complainant also markets its products through catalogues which, according to the Complaint, it mails out to its customers on monthly basis.

The websites and catalogues in evidence feature the logo trade mark prominently. The catalogues also include “Artists Choice” in standalone text. An example is:

“Artists Choice professional nail files are designed with the highest quality abrasives which will outlast and outperform any other nail file in its field. The file cores are designed with the right amount of thickness to produce the perfect amount of flex and durability for each use.”

The Complainant’s website lists the product range as “Artists Choice”. The Catch of the Day, Salon Shop and National Salon Supplies’ websites list the products as “Artists Choice” such as “Artists Choice Anti-Bacterial Solution 1000ml”. The logo form of the trade mark appears on the product images where that is depicted.

According to the Complaint, the Complainant sells approximately AUD 500,000 worth of products bearing the trade mark each year.

According to the notice from auDA, the disputed domain name was registered on June 19, 2018.

From some time after that date, the disputed domain name redirects to the Respondent’s website at “www.sydneyssolvents.com.au”.

The Respondent specializes in the production and sale of a wide range of solvent products and clearing products. Those products include products such as acetone or nail polish remover. The Respondent's products are prominently branded "Sydney Solvents".

It does not appear that the Respondent uses "Artists Choice" on the website or otherwise as a trade mark.

In June 2019, the Complainant's lawyers sent a cease and desist letter to the Respondent arising from the Respondent's registration and use of the disputed domain name. The cease and desist letter alleged trade mark infringement, passing off and misleading or deceptive conduct against the Respondent and in effect reserved the Complainant's rights to take such action as it deemed necessary if its demands were not met.

The Respondent rejected the Complainant's demands but offered to sell the disputed domain name to the Complainant if the Complainant proposed a suitable price.

So far as the Panel is aware, there has been no further communication between the parties before the filing of the Complaint.

5. Discussion and Findings

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

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights;
- (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.

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 the Panel deems applicable.

A. Identical or Confusingly Similar

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

In this case, the Complainant has proven ownership of the Australian registered trade mark for the Artists Choice device trade mark. As discussed above this is a composite mark consisting of a device element, the words "Artists Choice" and at least arguably stylised representations of the letters "AC".

The evidence also shows significant use of "Artists Choice" in practice. For example, the product listings on third party websites identify the products as "Artists Choice" This usage in conjunction with the Complainant's evidence of sales and promotion also supports a conclusion, as the Complainant contends, that the Complainant has rights in the expression as an unregistered trade mark. auDA Overview of Panel Views on Selected auDRP Questions Second Edition ("auDRP Overview 2.0"), section 1.3.

In comparing the disputed domain name to the trade mark, the Panel undertakes a visual and aural comparison and assessment of the disputed domain name itself to the Complainant's trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd.*, WIPO Case No. [DAU2002-0001](#). This test is narrower than and thus different to the question of "likelihood of confusion" under trade mark law which can require an assessment of the nature of the goods or services protected and those for which any

impugned use is involved, geographical location or timing. Such matters, if relevant however, may fall for consideration under the other elements of the Policy.

Typically, and as is appropriate in this case, it is permissible to disregard the country code Top Level Domain (ccTLD), .au, and the second level .com category as functional components of the domain naming system. See for example auDRP Overview 2.0, section 1.11 and, for example, *Clarins v. Netlocal Consulting Pty Ltd* WIPO Case No. [DAU2023-0016](#).

Disregarding the “.au” ccTLD and “.com” second level domain, the disputed domain name consists of an important verbal phrase comprised in the Complainant’s registered trade mark.

The Complainant contends the Panel should disregard the device elements of the registered trade mark and treat it as “Artists Choice”. See for example, auDRP Overview 2.0, section 1.10. On the other hand, the Respondent contends that the verbal element of the trade mark is, as categorised by IP Australia, “AC Artists Choice”. The Respondent says to accept the Complainant’s contention would give the Complainant a monopoly of each individual element of the trade mark. The Respondent also points out that another person had registered the business name “Artists Choice” in New South Wales in 2011 before the Complainant commenced use.

The Panel does not place much weight on the business name registration in New South Wales. There is no evidence before the Panel that the name was actually in use nor of the scale, if any, of that use. The registration itself was cancelled in 2018.

The Panel accepts that there is a descriptive aspect to the words “Artists Choice” in the present context. In addition to skilled crafts such as makeup artists, the phrase also conveys a laudatory sense of quality. However, there is no evidence that the expression “Artists Choice” is in use by other suppliers of nail care or beauty care products.

On the other hand, the evidence shows that the phrase “Artists Choice” is recognised by third parties as identifying the Complainant’s products and, further, the evidence shows it is likely the Complainant enjoys rights in the phrase as an unregistered trade mark.

In those circumstances, the Panel does not accept the Respondent’s rebuttal of the Complainant’s contention.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trade mark and the Complainant has established the first requirement under the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances may be situations in which a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Previous panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent under this head and an evidential burden will shift to the respondent to rebut that prima facie case. The ultimate burden of proof, however, remains with the Complainant. See e.g., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#); auDRP Overview 2.0, section 2.1.1.

In the present case, the Respondent registered the disputed domain name several years after the Complainant began using its trade mark and also several years after the logo form of the trade mark was registered.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not hold any trade marks for the disputed domain name and, apart from use of the disputed domain name to redirect to the Respondent's website, does not appear to use "Artists Choice" as a trade mark or otherwise.

The Respondent does not expressly deny knowledge of the Complainant and its trade mark (either registered or unregistered).

Having regard to the association or identification with the Complainant of the phrase "Artists Choice", the use of the disputed domain name to redirect to a website offering solvent products of the kind the Complainant offers but under a competing brand, "Sydney Solvents", does not qualify as a good faith offering of goods or services under the Policy. It is calculated to mislead people familiar with the Complainant's trade mark (registered or unregistered) into a mistaken belief that the Respondent's products are products of the Complainant or in some way licensed by or associated with the Complainant.

The Panel notes that more than five years has passed between the issue of the cease and desist letter and the filing of the Complaint. Generally speaking, delay in bringing a complaint does not preclude a successful complaint under the Policy. See auDRP Overview 2.0, section 4.17.

In rare cases, a right owner may be estopped from pursuing its claim where the right owner's conduct has been such as to cause prejudice to the defendant such as by changing its position to its detriment. The Respondent has not identified any particular prejudice apart from the failure of the Complainant to raise the matter within seven days of the Respondent's reply to the cease and desist letter and the passage of five years before the filing of the Complaint.

Australia's intellectual property and consumer protection statutes, however, permit infringement actions to be brought in respect of conduct in the six years preceding the commencement of the litigation. Even then, while monetary remedies cannot be recovered in respect of conduct occurring more than six years earlier, injunctive relief is available in respect of future conduct. Mere delay, therefore, is not sufficient to disentitle a right owner from bringing infringement proceedings.

The Respondent does not appear to have changed its position in the intervening period. Rather, it just continued to use the disputed domain name to redirect to its own website. Rather than being prejudicial in

the relevant sense, therefore, the Complainant's delay has meant that the Respondent continued to derive benefit from the disputed domain name.

(Even if the delay were such as to insulate the Respondent from claims of pecuniary remedies (which the Panel makes no comment about), it would not preclude injunctive remedies against continuing conduct. See *Fisher v. Brooker* [2009] UKHL 41 at [79] per Lord Neuberger (rejecting a similar argument based on even longer delay in the context of copyright infringement).)

Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered or Subsequently Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent. In contrast to the Uniform Domain Name Dispute Resolution Policy, the requirements of registration or use are disjunctive. It is necessary for the Complainant to establish only one or the other.

Generally speaking, a finding that a domain name has been registered or is being used in bad faith requires an inference to be drawn that the respondent in question has registered or is using the disputed domain name to take advantage of its significance as a trade mark owned by (usually) the complainant.

It seems likely that the Respondent registered the disputed domain name for the purpose to which it has been put. That is, to redirect potential customers looking for "Artists Choice" solvents and nail polish removers to the Respondent's "Sydney Solvents" products.

The Respondent has not claimed ignorance of the Complainant's trade mark or products. Rather, as the Respondent makes no other use of the expression "Artists Choice" and otherwise does not appear to have any connection with the expression, also noting the overlap in the products offered by the Parties, it appears very likely that the Respondent was aware of the Complainant's use or products.

In these circumstances, therefore, the Panel concludes that the Respondent registered the disputed domain name to take advantage of its resemblance to the Complainant's trade mark (registered and unregistered). That opportunistic conduct constitutes registration of the disputed domain name in bad faith under the Policy and, as it appears likely to mislead people familiar with the Complainant's trade mark to the Respondent's unrelated website, use in bad faith also.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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, <artistschoice.com.au>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: January 28, 2025