

## **ADMINISTRATIVE PANEL DECISION**

Bluehost Inc. v. Andrew Walter Harward

Case No. DAU2024-0036

### **1. The Parties**

The Complainant is Bluehost Inc., United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Andrew Walter Harward, Australia.

### **2. The Domain Name and Registrar**

The disputed domain name <bluehost.com.au> (the “Disputed Domain Name”) 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 11, 2024. On December 11, 2024, the Center transmitted by email to Domain Directors Pty Ltd. a request for registrar verification in connection with the Disputed Domain Name. On December 11, 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 proceedings commenced on December 17, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was January 6, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 9, 2025.

The Center appointed Nicholas Weston as the sole panelist in this matter on January 21, 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 a United States incorporated company that operates a webhosting business founded in 2003 with more than two million customers globally. Bluehost Inc. holds registrations for the trade mark BLUEHOST and variations of it in numerous countries, including United States Registration No. 3,417,116 for the mark BLUEHOST, registered by the Complainant on April 29, 2008, in class 42, and Australian Registration No. 1973447 for the mark BLUEHOST Registered on December 5, 2018, in classes 38, 42, and 45.

The Complainant is also the owner of the domain name <bluehost.com>, which resolves to its main website.

The Disputed Domain Name <bluehost.com.au> was registered on April 11, 2024. The Complainant has provided evidence that the Disputed Domain Name is inactive.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant cites its trade mark registrations of the trade mark BLUEHOST in various countries, including Australia, as prima facie evidence of ownership.

The Complainant submits that the mark BLUEHOST is distinctive and that its rights in that mark predate the registration of the Disputed Domain Name <bluehost.com.au>. It submits that the Disputed Domain Name is identical to its trade mark, because the Disputed Domain Name incorporates in its entirety the BLUEHOST trade mark.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because none of the paragraph 4(c) circumstances are present in this case. It infers that the Respondent has no trade mark rights in, or license to use, the BLUEHOST mark. The Complainant contends that "that Respondent is not commonly known by the [D]isputed [D]omain [N]ame" and that by passively holding the Disputed Domain Name the Respondent "cannot establish rights or legitimate interests pursuant to paragraph 4(c)(i) of the Policy".

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith. On the issue of registration, the Complainant contends that the Respondent must have had the BLUEHOST trade mark in mind when it registered the Disputed Domain Name given that "the BLUEHOST Trademark is well-known, given that it is protected by at least 64 trademark registrations in at least 24 countries or jurisdictions around the world".

On the issue of use, the Complainant has supplied evidence that the Disputed Domain Name is inactive.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that, for the Complainant to succeed, it has the burden of proving the following:

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

- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered or subsequently used in bad faith.

#### **A. Identical or Confusingly Similar**

The Complainant must first establish that the Disputed Domain Name is identical with, or confusingly similar to, the Complainant's name, trade mark or service mark by demonstrating that it has rights in a trade mark at the date the Complaint was filed and, if that is the case, the Disputed Domain Name must also be identical or confusingly similar to the trade mark.

This Panel finds that the Complainant has rights in the BLUEHOST trade mark acquired through use and registration.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the BLUEHOST trade mark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant's trade mark BLUEHOST; (b) followed by the country code Top-Level Domain ("ccTLD") ".com.au".

It is well established that the ccTLD used as technical part of a domain name may be disregarded (see: *BT Financial Group Pty Limited v. Basketball Times Pty Ltd*, WIPO Case No. [DAU2004-0001](#)). The comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "bluehost".

This Panel observes that the Australian Registered trade mark in which the Complainant has rights, is identical to the Disputed Domain Name. It is also well established that, where a domain name incorporates the entirety of a trade mark, the domain name will normally be considered confusingly similar to that mark for purposes of auDRP standing.

Accordingly, the Panel finds that the Complainant has established the first element of paragraph 4(a) of 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 a list of non-exhaustive circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the 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 organisation) 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 noncommercial 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 Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the BLUEHOST trade mark. Furthermore, the Disputed Domain Name is not derived from the Respondent's name or any name by which it or those behind it were commonly known before registering the Disputed Domain Name. The term is a portmanteau of the words "blue" and "host", which the Panel does not regard as descriptive of a webhosting business. The Disputed Domain Name may

be comprised of generic or dictionary words, but it is also a trade mark registered by the Complainant and there are only two registered trade marks on the register in Australia using the term and both are owned by the Complainant. Moreover, the Disputed Domain Name was registered as a domain name by the Respondent on October 3, 2022, three years and 10 months after the Complainant's first Australian registered trade mark, BLUEHOST, took effect in December 2018 and more than 14 years and five months after the Complainant's registered United States trade mark, BLUEHOST, took effect in April, 2008. 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, see: *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

The Respondent has failed to submit a Response and so has not shown that it has acquired any trade mark rights in respect of the Disputed Domain Name or that the Disputed Domain Name is used in connection with a bona fide offering of goods or services. In the absence of a Response, the Panel finds that the Complainant has prior rights in the BLUEHOST trade mark which precede the Respondent's registration of the Disputed Domain Name.

There is also evidence that the Disputed Domain Name resolves to an inactive webpage. In the circumstances, such use does not amount to a bona fide offering of goods or services under the Policy.

The Complainant also adduced evidence to show that the Respondent has not been commonly known by the Disputed Domain Name, nor does any of the evidence demonstrate that the Respondent is making legitimate non-commercial or fair use of the Disputed Domain Name.

The Panel therefore finds that the Complaint fulfils the second condition in paragraph 4(a)(ii) of the Policy.

### **C. Registered or Subsequently Used in Bad Faith**

The third element of the Policy that the Complainant must also demonstrate is that the disputed domain name has been registered or subsequently used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both.

It is uncontroversial that a domain name investor, or anyone else, can register a commonly used word as a domain name and hold it provided that the circumstances do not indicate illegitimate conduct or bad faith.

The evidence supports a finding that the Respondent registered and has used the Disputed Domain Name in bad faith. The *onus* is on the Respondent to make the appropriate enquiries when registering a domain name. Paragraph 2 of the Policy clearly states: "It is your [domain-name holder's] responsibility to determine whether your domain name registration infringes or violates someone else's rights." A simple Internet search would have alerted the Respondent to the Complainant's prior rights, the Respondent's registration of the Disputed Domain Name incorporating the Complainant's trade mark could not be attributable to pure coincidence and creates a presumption of bad faith. The Panel finds that the Respondent must have been aware of the relevant trade mark. The Panel's finding is reinforced given the Complainant's use of the domain name <bluehost.com>, the Complainant's evidence that the Respondent is a software engineer, and the choice of a domain name that is based on a widely recognised trade mark rather than a generic term (see *Bluehost Inc. v. Borislav Misic*, WIPO Case No. [D2020-3223](#) "its BLUEHOST trademark is very distinctive and has a strong international reputation, given that it has been used for more than 17 years with trademark registrations in many countries worldwide").

The Panel finds that these circumstances amount to evidence of bad faith and is satisfied that the Respondent registered the Disputed Domain Name to prevent the Complainant from reflecting its trade mark in a corresponding domain name, contrary to paragraph 4(b)(ii) of the Policy.

Further, this Panel finds that on balance the Respondent, who registered the Disputed Domain Name in his own name appears to have given a false warranty to its Registrar regarding its compliance with auDA's policies. In the absence of a reply containing evidence to the contrary, the Panel finds that Respondent did not, and does not, meet the eligibility and allocation criteria set out in auDA's "Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs" for the ".com.au" domain space, a further indicator of bad faith registration and use under paragraph 4(b)(v) of the Policy, for the reason that the Disputed Domain Name is not an exact match or acronym of the Respondent's name, the Respondent does not own any trade mark rights in Australia, and the Respondent is not providing any goods. Further, the Respondent's non-use or passive holding of the Disputed Domain Name would not prevent a finding of bad faith registration or use under the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 Disputed Domain Name <bluehost.com.au> be transferred to the Complainant.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: January 28, 2025