

ADMINISTRATIVE PANEL DECISION

First Education Pty Ltd v. First Education & Technology Group Pty Ltd
Case No. DAU2025-0018

1. The Parties

The Complainant is First Education Pty Ltd, Australia, represented by Clayton Utz Solicitors, Australia.

The Respondent is First Education & Technology Group Pty Ltd, Australia, self-represented.

2. The Domain Name and Registrar

The disputed domain name <firstedu.com.au> is registered with Web Address Registration Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2025. On April 29, 2025, the Center transmitted by email to Web Address Registration Pty Ltd a request for registrar verification in connection with the disputed domain name. On April 30, 2025, Web Address Registration 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”), 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 May 7, 2025. In accordance with the Rules, paragraph 5(a), the due date for Response was May 27, 2025. The Response was filed with the Center on May 14, 2025. The Complainant filed supplemental filings on May 17 and 19, 2025, and the Respondent filed a supplemental filing on May 17, 2025.

The Center appointed John Swinson as the sole panelist in this matter on June 4, 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 an educational provider that offers tutorial services to school students. The Complainant has centres located in Sydney, Australia, such as in Maroubra, Bondi, Randwick, and Mascot.

The Complainant owns Australian Registered Trademark No. 2274308 for FIRST EDUCATION that was filed on June 2, 2022 and entered on the register on March 4, 2025. This registration was opposed by First Education IP Pty Ltd but the opposition was discontinued.

The Complainant also owns Australian Registered Trademark No. 1984436 for 1 FIRST EDUCATION, a logo mark that includes a Roman wreath and the words “First Education” and the number 1, that was filed on January 22, 2019 and entered on the register on October 8, 2019.

The Complainant registered and uses the domain name <firsteducation.com.au> to promote its services.

First Education IP Pty Ltd filed Australian Trademark Application No. 2076457 on March 18, 2020 for F1RST EDUCATION, a logo mark that included the words “F1rst Education”, some Chinese characters that may be transliterated as “di yi jiao yu ke ji ji tuan” and translated into English as “First Education & Technology Group”. This application was successfully opposed by the Complainant, and thus was not registered. See *First Education Pty Ltd v First Education IP Pty Ltd* [2024] ATMO 173 (September 17, 2024). It is not in dispute that First Education IP Pty Ltd is associated with the Respondent.

The Respondent is an Australian corporation that was established on June 13, 2013.

The disputed domain name was registered on January 5, 2014.

In October 2016, the disputed name was used by the Respondent for its website that was branded “First Education VCE Learning Centre”. The disputed domain name was used for websites with similar branding until 2024.

According to the Respondent, in 2022 - 2023 a strategic decision was made to rebrand to “Realus Education” for national expansion. This rebranding took place in 2023 - 2024, and the disputed domain name was redirected to <realus.com.au> at that time. The disputed domain name also continues to be used for email addresses for transitional purposes.

The disputed domain name currently redirects to a website located at <realus.com.au>. This domain name is registered to First Education & Publications Pty Ltd. The website at <realus.com.au> promotes tutorial services to school students in the Melbourne area. The branding on this website is predominately “Realus Education.” The website states: “First Education & Technology Group (FETG), with headquarters in Melbourne, Australia, is a leading provider of educational services and products through its two prominent brands: Realus Education and MarsLadder. We offer comprehensive offline K-12 programs in English, Maths, and Science for students aged 6 to 18, as well as innovative online learning platforms that enhance educational experiences through interactive and collaborative features.” The faculty for this business have titles such as “Founder and CEO of First Education & Technology Group”. The website states that First Education Group was founded in an underground warehouse in 2009.

On March 21, 2025, the Complainant’s authorised representatives wrote to the Respondent, putting the Respondent on notice that the use of the disputed domain name constituted trademark infringement and passing off under Australian law. On March 25, 2025, the Respondent responded to that correspondence, claiming that the disputed domain name was “no longer promoted” and that the disputed domain name had been redirected to <realus.com.au>.

5. Parties' Contentions

A. Complainant

In summary, the Complainant made the following submissions:

Since the creation and adoption of the FIRST EDUCATION trademark in 2010, the Complainant has been using the trademark continually in respect of the education and tuition services provided by the Complainant. The Complainant provided evidence of the ways in which the trademark has been used and promoted, including on social media and other advertising.

The Respondent has not been granted any right by the Complainant to use the Complainant's FIRST EDUCATION trademark. The Complainant has never been associated with the Respondent or in any way licensed, granted or otherwise endorsed the use of the FIRST EDUCATION trademark by the Respondent, with respect to the disputed domain name or otherwise.

It cannot be said that the Respondent's use of the disputed domain name is in connection with a bona fide offering of goods and services. Where a respondent is found to be infringing a complainant's trademark rights, this precludes a finding that a respondent is acting in good faith, which in turn, precludes a finding that a respondent is making a bona fide offering of goods or services.

The disputed domain name redirects to another website which states that the services are delivered through two brands that do not resemble the disputed domain name.

The Complainant considers the Respondent's conduct to be misleading or deceiving consumers, in contravention of the Australian Consumer Law or to misappropriate the Complainant's business reputation, amounting to the common law tort of passing off.

Given the reputation and significant sales of the Complainant at the time the Respondent registered the disputed domain name, the Respondent either knew or should have known of the Complainant's trademark rights in Australia. Given the Complainant's online presence, it would not have been difficult for the Respondent to find the Complainant's business.

In circumstances where the Respondent has actual notice of the Complainant's trademark rights and has alleged that it no longer intends to brand itself by use of the disputed domain name, yet refuses to de-register the disputed domain name, the continued use of the disputed domain name ought to be found to be in bad faith.

B. Respondent

In summary, the Respondent made the following submissions:

The disputed domain name is derived from the Respondent's long-standing educational brand "First Education," which has been in use in Victoria since 2009.

The Respondent began using the name "First Education" in 2009 for educational services delivered exclusively in Victoria, including highly specialized Chinese-language VCE tutoring services targeting the local community. The corporate name "First Education & Technology Group Pty Ltd" was formally registered with ASIC in 2013. The disputed domain name was registered in January 2014 - well before the Complainant held any relevant trademark rights.

The disputed domain name was used continuously from 2014 to 2025 for legitimate business functions, including a website, marketing to Victorian students, and administrative email.

The disputed domain name was never offered for speculative sale, rental, or impersonation.

The Respondent further notes that a “[...]@firstedu.com.au” address remains passively listed as a legacy customer enquiry point on the Respondent’s website, solely for internal continuity purposes and without any active promotion or marketing of the disputed domain name.

The Respondent had no knowledge of the Complainant’s brand at the time of registration of the disputed domain name and did not seek to profit from or interfere with it.

It was only during the Respondent’s trademark application with IP Australia that either Party became aware of the other’s existence. The Complainant did not initiate legal proceedings or raise concerns at any time prior. The delay of nearly a decade in asserting rights undermines any claim of reputational harm or confusion.

While the Respondent does not dispute confusing similarity, the Complainant has failed to prove either lack of legitimate interest or bad faith. On the contrary, the Respondent has demonstrated long-standing, lawful, and good faith use.

6. Discussion and Findings

Paragraph 4(a) of the auDRP provides that a complainant must prove each of the following elements:

- (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.

The burden of proof of each element is borne by the Complainant.

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.

In supplemental filings after the Response was filed, the Parties made submissions as to whether certain exhibits in the Response were “without prejudice” communications from the Complainant. The Panel has decided not to consider the exhibits that the Complainant identified as “without prejudice”. See *Adjudicate Today Pty Limited v. The Institute of Arbitrators and Mediators*, WIPO Case No. [DAU2012-0033](#) (but note *Mrsupplement Australia Pty Limited and Mrsupplement.com.au Pty Limited v. Tony Hatzeandreu*, WIPO Case No. [DAU2012-0018](#) to the contrary). The Panel followed the process set out in *Nokia Corporation v. Avionics Australia Pty Ltd and Marilyn Kay Ritson*, WIPO Case No. [DAU2023-0035](#), and did not review the alleged “without prejudice” communications in reaching a decision in this case.

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, trademark or service mark.

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

The first element functions primarily as a standing requirement.

The auDRP makes no specific reference to the date on which the owner of the trademark or name must have acquired rights so as to satisfy the requirements of paragraph 4(a)(i) of the Policy. Panels have found that the relevant time by which a complainant must establish its rights is at the time of the filing of the complaint. It follows that registration of a domain name before a complainant acquires rights in a trademark or name does not prevent a finding of identity or confusing similarity under the Policy, although this fact may be relevant to determining whether the second and third elements of the Policy are satisfied. Overview of Panel Views on Selected auDRP Questions, Second Edition (“auDRP Overview 2.0”), section 1.1.4.

The Complainant owns an Australian trademark registration for FIRST EDUCATION. The Panel considers that the disputed domain name, which comprises “firstedu”, is confusingly similar to the Complainant’s registered trademark. In the Panel’s view, “edu” is a common and recognizable abbreviation for “education”.

The Panel finds the first element of the Policy has been established.

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 subject matter of the dispute, your bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that you have 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 trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark 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](#).

Based on the evidence before the Panel, the Panel considers that the Respondent used the disputed domain name from at least 2016 for a bona fide business offering educational services in the Melbourne area. This was before any notice of any dispute with the Complainant. The Complainant’s first relevant trademark application was filed in January 2019. The Complainant and the Respondent operate in different capital cities, and appear to focus on students in their local areas. It is believable that the Respondent registered the disputed domain name without knowledge of the Complainant. Even if that is not the case, in 2016 (before notice of the dispute), due to the different geographic areas in which the Parties operate, it is believable that the Respondent used the disputed domain name in good faith and without intent to mislead consumers or to trade off the Complainant’s reputation.

The Panel has also considered the Respondent's assertions that it commenced use of the FIRST EDUCATION branding in 2009. The Respondent was incorporated in June 2013 but claims to have commenced business (presumably as a sole trader operated by the Respondent's founder) in 2009. This is relevant, because the Complainant was not incorporated until 2010. The Respondent provided no direct evidence of its alleged early use of FIRST EDUCATION. However, the Respondent did provide evidence of its ten-year anniversary celebrations in 2019 to support its assertions as to the 2009 start date, but provided no evidence to establish that the use in 2009 was by a predecessor in title to the Respondent (who was incorporated in 2013). In short, the Panel does not rely on the alleged 2009 start date to reach the conclusion in this case.

The Complainant states that the Respondent has rebranded, and is now known as Realus or MarsLadder, not "First Education". The rebranding took place in 2024. (The Respondent does not appear to have changed its corporate name.) The Respondent states that it has residual reputation in "FIRST EDUCATION" and that the disputed domain name continues to be used for administrative email accounts and to redirect to the website with the new brand. The Respondent states:

"This redirect was implemented solely to preserve the SEO value of the long-standing firstedu.com.au domain and ensure a seamless transition for legacy users. The domain itself is no longer actively promoted or marketed. This evidences the Respondent's ongoing good faith conduct and intent to avoid any potential market confusion."

In these circumstances, the Panel concludes that the Respondent, in 2016, before any notice to the Respondent of the subject matter of the dispute, made bona fide use of the disputed domain name in connection with an offering of educational services, and that the Respondent continues to make bona fide use of the disputed domain name at the present time as part of its transition to new branding.

The Panel is aware of the prior decision *Geek Group Pty Ltd v. SG Corporate Services Pty Ltd*, WIPO Case No. [DAU2019-0009](#), but the facts in that decision are different to the present case in several respects. In the present case for example, the Respondent has not fully abandoned its prior branding.

The Panel finds the second element of the Policy has not been established.

C. Registered or Subsequently Used in Bad Faith

Unlike the UDRP, the requirements that the disputed domain name be registered or used in bad faith are disjunctive in the auDRP. That is, it is sufficient for the Complainant to show either that the disputed domain name was registered in bad faith or has been used in bad faith.

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 trademark owned by (usually) the complainant.

The Respondent asserts that at the time of registration of the disputed domain name in early 2014, "the Respondent had no knowledge of the Complainant's brand at that time [...]".

In summary, for the reasons stated above in respect of the second element of the Policy, the Panel does not consider that the Respondent registered or used the disputed domain name to take advantage of the Complainant's brand.

The Complainant and the Respondent operate in different capital cities, and appear to focus on students in their local areas. Both the Complainant and the Respondent purportedly operate legitimate businesses, and provide similar services, although it is difficult to reach a conclusion on whether they are actual competitors because of their different geographic markets.

Based on the evidence before the Panel, the Panel is unable to conclude that the Respondent knew or likely knew of the Complainant when the Respondent registered the disputed domain name in 2014. Accordingly, the Panel does not find that the Respondent registered the disputed domain name in bad faith.

However, clearly the Respondent was aware of the Complainant in May 2022 (which was when the Complainant filed opposition proceedings against an associated entity of the Respondent) and the Respondent continues to use the disputed domain name after that time.

The Complainant submits that in circumstances where the Respondent has actual notice of the Complainant's trademark rights and has alleged that it no longer intends to brand itself by use of the disputed domain name, yet refuses to de-register the disputed domain name, the continued use of the disputed domain name ought to be found to be in bad faith. The Panel is not prepared to make such a finding in the present case based on the evidence in the case file. On the present facts, using the disputed domain name for a genuine transition to new branding where there was no bad faith registration is not, in this Panel's view, bad faith use.

In short, the Panel finds that the Respondent's purpose in continuing to use the disputed domain name is for transitional reasons in respect of legacy customers rather than to divert traffic or to disrupt the business of the Complainant. The Panel finds no evidence of bad faith use of the disputed domain name.

If the Respondent changes how it uses the disputed domain name in the future and then uses the disputed domain name to take advantage of the Complainant's trademark, it may be open to the Complainant to file a new complaint at that time.

The Panel finds the third element of the Policy has not been established.

7. Decision

For all the foregoing reasons, the Complaint is denied.

/John Swinson/

John Swinson

Sole Panelist

Date: June 18, 2025