

Nominet UK Dispute Resolution Service

DRS 0078

Telstra Corporation Limited –v- Flipjack

Decision of Independent Expert

1. Parties:

The Complainant is Telstra Corporation Limited of 242 Exhibition Road, Melbourne, Victoria 3000, Australia. It is represented by Mr Marcus Collins of White & Case, 7-11 Moorgate, London EC2R 6HH.

The Respondent is Mr Daniel Winkworth, trading as “flipjack” of 316 St John Street, London EC1V 4NT.

2. Domain Name:

The domain name in dispute is Telstra.org.uk (“the Domain Name”).

3. Procedure:

A Complaint in respect of the Domain Name under Nominet UK’s Dispute Resolution Service Policy (“the Policy”) was received by Nominet UK from the Complainant on 5 November 2001. The Complaint was forwarded to the Respondent on 7 November 2001. A Response was received from the Respondent on 28 November 2001 and forwarded to the Complainant on 29 November 2001. A Reply was received from the Complainant and forwarded to the Respondent on 7 December 2001.

The dispute was not resolved by mediation and was referred for a decision by an Independent Expert following payment by the Complainant of the required fee under cover of letter of 3 January 2002. Jonathan Turner was appointed as Independent Expert on 8 January 2002 and confirmed to Nominet that he was independent of the parties and knew of no facts or circumstances which might call into question his independence in the eyes of the parties.

Having reviewed the file, there does not appear to be any procedural deficiency.

4. The Facts:

The Complainant is a large telecommunications company based in Australia. It has UK and EC trade mark registrations for “Telstra” and other marks including the word “Telstra” for telecommunications equipment and services.

The Domain Name was registered on 11 February 2000. The Respondent states that he registered it for use as the name of an internet café which he has been developing. At present the domain name resolves to a default page of the ISP which effected the registration.

The Complainant wrote to the Respondent on 3 July 2001 asserting rights in the name “Telstra” and demanding undertakings not to use the Domain Name and to transfer it to the Complainant. The Respondent did not reply to this letter or to a subsequent letter of 9 August 2001 offering to reimburse his costs of registration up to £150.

5. The Parties’ Contentions:

The Complainant points out that the third level of the Domain Name is identical to its “Telstra” trade mark which is registered in the UK and EC, as well as other countries around the world. It asserts that it has used the “Telstra” mark in the UK for many years, but does not provide any specific evidence of such use. It contends that a person visiting the web page to which the Domain Name resolves would suppose that the Complainant was not yet trading on the internet and that its website was under construction. The Complainant refers to the One-in-a-million case and suggests that the facts of this case are similar.

The Respondent states that he likes the Domain Name, that he has had very positive feedback with regard to it, and that he has expended a great deal of energy in the formation of his internet café under this name, although no details or evidence of his preparations are provided. He does not see how a large Australian company thousands of miles away can have any say in the name of a small English company and that he feels he is being intimidated.

6. Discussion and Findings:

To succeed in this Complaint, the Complainant has to prove on the balance of probabilities: first, that it has rights in respect of a name or mark identical or similar to the Domain name; and, secondly, that the Domain Name is an Abusive Registration as defined in paragraph 1 of the Policy.

As to the first requirement, the Complainant clearly has registered trade mark rights in the mark “Telstra” which is identical or similar to the Domain Name. The generic suffix of a domain name (in this case <.org.uk>) should be discounted in assessing whether it is identical or similar to a complainant’s mark for the purposes of the Policy (see paragraph 4(b)(i) of the Policy and DRS 0001 *Eli Lilly and Company –v- David Clayton*). The Expert accordingly finds that the first requirement is satisfied.

As to the second requirement, an “Abusive Registration” is defined in paragraph 1 of the Policy as a domain name which was registered or acquired or which has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights. Non-exhaustive lists of factors which may be evidence that a domain name is or is not an Abusive Registration are set out in paragraphs 3 and 4 of the Policy.

In this case the Respondent claims to have registered the Domain Name for use as the name of an internet café. The Respondent’s address is in London and it may be inferred that his proposed internet café would also be in London. Although the Complainant has not filed specific evidence of any business conducted in the UK under the name “Telstra”, there are many Australians and others living in London who would be familiar with the Complainant’s business under this name in Australia. “Telstra” is a distinctive name and an internet café is an operation which would naturally be associated with a telecommunications company. This Expert considers that the proposed use of the Domain Name by the Respondent for an internet café in London would be liable to mislead persons familiar with the Complainant’s business into believing that this internet café was connected with the Complainant. It follows that the registration of the Domain Name for this purpose took unfair advantage of and was unfairly detrimental to the Complainant’s rights. The Expert accordingly finds that the Domain Name is an Abusive Registration within the meaning of the Policy.

The Domain Name is unlikely to be required for any legitimate purpose by any person other than a company in the Complainant’s group. In the circumstances, the Expert concludes that the Domain Name should be transferred to the Respondent.

7. Decision:

In light of the above findings, that the Complainant has rights in respect of the mark “Telstra” which is identical or similar to the Domain Name and that the Domain name is an Abusive Registration, the Expert decides that the Domain Name, Telstra.org.uk, should be transferred to the Complainant.

Jonathan Turner

Date