

ADMINISTRATIVE PANEL DECISION

B.S.A. v. Internet Products Sales & Services Pty Ltd
Case No. DAU2022-0019

1. The Parties

The Complainant is B.S.A., France, represented by Inlex IP Expertise, France.

The Respondent is Internet Products Sales & Services Pty Ltd, Australia.

2. The Domain Name and Registrar

The disputed domain name <president.com.au> is registered with Drop.com.au Pty Ltd.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 8, 2022. On September 9, 2022, the Center transmitted by email to Drop.com.au Pty Ltd a request for registrar verification in connection with the disputed domain name. On September 12, 2022, Drop.com.au Pty Ltd transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 20, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 21, 2022.

The Center verified that the Complaint together with the amended 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 September 23, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was October 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 21, 2022. Shortly after the Center’s notification of the Respondent default, the Respondent sent an email to the Center requesting for an extension to submit a response.

On October 25, 2022, the Center requested the Registrar for clarification of the registrant contact information. On October 26, 2022, the Registrar disclosed additional contact information of the registrant.

On the same day, the Center re-notified the Respondent of the Complaint and the due date for Response was reset to November 15, 2022. The Response was filed with the Center on November 15, 2022.

The Center appointed John Swinson as the sole panelist in this matter on November 24, 2022. 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 French entity. It is a subsidiary of LACTALIS Group. LACTALIS Group was created in 1933 and is involved in the dairy industry.

The Complainant sells cheese in Australia under the PRESIDENT brand. The Complainant's cheese is sold at retail stores such as Woolworths supermarkets.

The Complainant owns Australian registered trademarks, including Australian Registration No. 314512 for PRESIDENT in class 29 for cheese. This registration has a priority date of January 6, 1978.

A company called Lactalis Australia Pty Ltd owns and uses the domain name <presidentaustralia.com.au> to promote and market President cheese.

The Respondent is an Australian corporation. The Respondent is well known in Australia as a domain name investor.

According to Registrar records, the creation date for the disputed domain name was June 22, 2006.

At the present time, the disputed domain name resolves to a pay-per-click webpage with links to "President of the Senate", "Presidents of America" and "Company President". At the top of this webpage, in small print, is the following: "The domain President.com.au may be for sale. Click here to inquire about this domain." These words link to the Above.com domain name marketplace. The Above.com page states that the disputed domain name "might be for sale" and provides a web form to make an offer. No price is indicated on any of these webpages.

5. Parties' Contentions

A. Complainant

In summary, the Complainant made the following submissions:

The Complainant is well known.

The Complainant uses the PRESIDENT brand in Australia for a range of cheeses. The Complainant owns registered trademarks in Australia for or including PRESIDENT that precede the Respondent's registration of the disputed domain name. These trademarks are currently used and have acquired an undisputed notoriety around the world.

The disputed domain name is identical to the Complainant's PRESIDENT trademark.

The Respondent does not own any trademark including PRESIDENT in the field of dairy products. The Respondent does not own any registered trademarks. There is no business or legal relationship between the Complainant and the Respondent. The Complainant has neither authorised nor licensed the Respondent to use its trademarks in any way.

The Respondent registered the disputed domain name with the intent to resell it to the Complainant. The uses of the disputed domain name made by the Respondent for parking pages and the like were intended to promote the disputed domain name in order to sell it.

The use the Respondent is making of the disputed domain name is to offer it for sale. The price is not specified but it is likely that the Respondent would calculate it by reference to the Complainant's trademark.

Even if aggregating and holding domain names for resale can constitute a good faith offering of goods or services, it is well-established that mere registration of a domain name comprised of a dictionary word does not by itself confer rights or legitimate interests under the Policy.

It seems unlikely that the Respondent could have been unaware of the Complainant's activity and business, and the existence of its trademarks for PRESIDENT when reserving the disputed domain name, which is identical to the Complainant's trademark.

It cannot be coincidence that the Respondent has registered the trademark PRESIDENT as the disputed domain name.

The Respondent owns over 7,240 domain names. The Respondent has a duty to establish whether the disputed domain name will infringe on the rights of some third party.

The disputed domain name disrupts the Complainant's business. The disputed domain name diverts Internet traffic to the Respondent.

The Respondent has configured MX records for the disputed domain name. Noting the composition of the disputed domain name, there is a high risk that the disputed domain name will be used as part of an email address for phishing and scams.

B. Respondent

The Respondent filed a Response, but only one page of the Response was received by the Center. The Center followed up with the Respondent regarding what appears to be a technical mistake by the Respondent. The Respondent did not reply to the Center. The Panel considered issuing a Procedural Order to the parties, but in light of the decision reached below and the Respondent's lack of communication with the Center, the Panel considered such step to be futile.

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.

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 name or mark at the date the Complaint was filed and, if so, the disputed domain name must be identical or confusingly similar to the name or mark.

For present purposes, the Complainant has proven that it owns a registered trademark for PRESIDENT as discussed in section 4 above.

Typically and as is appropriate in this case, it is permissible to disregard respectively the Top and Second Level Domains, ".com.au", as a functional component of the domain name system.

Accordingly, the disputed domain name is identical to the Complainant's PRESIDENT trademark.

The Complainant succeeds on the first element 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 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 the respondent of the subject matter of the dispute, the respondent's *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) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial 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 the burden of production 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](#).

Where the domain name is a dictionary word/phrase, the complainant must make a strong case to establish, *prima facie*, that the respondent does not have rights or legitimate interests in it. As a general principle, the less unique the complainant's trademark or name, the more likely it is the respondent will have rights or legitimate interests in a corresponding domain name. See *Makegoods Pty Limited / Niche Group Holdings Pty Limited v. Zoran Petkovic, GMP Constructions Pty Ltd*, WIPO Case No. [DAU2019-0003](#).

The Complainant states that the Respondent does not own any trademark including PRESIDENT in the field of dairy products, that the Respondent does not own any registered trademarks, and that there is no business or legal relationship between the Complainant and the Respondent. The Complainant states that the Complainant has neither authorised nor licensed the Respondent to use its trademarks in any way.

The Complainant also asserts that the Respondent registered the disputed domain name with the intent to resell it to the Complainant, and that the uses of the disputed domain name made by the Respondent for parking pages and the like “were intended to promote the domain name in order to sell it.” Accordingly, the Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name.

The appropriate time to assess the Respondent’s claim to rights or legitimate interests in the disputed domain name is at the time when the Respondent became aware of the dispute about the disputed domain name – which will be no later than the date of the filing of the Complaint, and may be earlier (e.g. upon receipt of a letter of demand from the Complainant). *Ogio International Inc v. Ogio Pty Ltd*, WIPO Case No. [DAU2019-0011](#); and *eScuba Pty Limited v. Underwater Australasia Pty Ltd*, WIPO Case No. [DAU2022-0023](#).

At the present time, the disputed domain name resolves to a pay-per-click website (not a parking page or error page as referred to by the Complainant) that has links relevant to the dictionary meanings of the word “president”.

Without more, use of a domain name to resolve to generate revenue through pay-per-click links is generally not considered to be a *bona fide* offering of goods or services such as to give rise to rights or legitimate interests in a domain name. However, where the domain name consists of a dictionary word and is used to host pay-per-click links genuinely related to the dictionary meaning of the word, and not to trade off the complainant’s trademark, respondent rights or legitimate interests can arise. This is especially so where the domain name has been used for pay-per-click links for a long period of time.

There is no evidence before the Panel that shows that the Respondent’s pay-per-click website at any time advertised the Complainant’s products, the Complainant’s competitor’s products, or has anything to do with cheese.

As discussed below, the Complainant has failed to submit evidence to demonstrate that the Respondent’s registration or use of the disputed domain name has been in bad faith.

Noting the Complainant fails in respect of the third element of the Policy, the Panel does not need to make a final determination on the second element.

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.

The disputed domain name was registered in 2006. There is no evidence in the Complaint that explains the Complainant’s reputation in Australia in 2006. There is no evidence in the Complaint that the Complainant sold President cheese in Australia in 2006.

The evidence before the Panel is that the disputed domain name has only been used by the Respondent in respect of its dictionary meanings. There is no evidence in the Complaint that the disputed domain name has been used at any time since 2006 in respect of cheese, the Complainant, the Complainant’s competitors, or the Complainant’s PRESIDENT trademark.

In short, there is no evidence before the Panel that when the Respondent registered the disputed domain name in 2006, the Respondent did so with the Complainant in mind or to trade off the Complainant’s

trademark.

The Complainant asserts that “it seems unlikely that the Respondent could have been unaware of the Complainant’s activity and business, and the existence of its trademarks PRESIDENT when reserving the disputed domain name, which is identical to the Complainant’s mark.” Based on the evidence before the Panel, the Panel disagrees. The Complainant provided no evidence of use, reputation, or awareness of the PRESIDENT trademark in Australia in 2006. In any event, and as discussed below, noting that the disputed domain name is composed of a dictionary word, the Respondent’s possible awareness of the Complainant’s cheese is not determinative.

The Complainant also asserts: “The Complainant’s trademark PRESIDENT is perfectly distinctive to designate dairy products. It is a fancy and highly distinctive name.” While this is true, in the sense that the term “president” is distinctive in respect of cheese and dairy products, however, based on the evidence, the Respondent has never used the disputed domain name in respect of cheese and dairy products.

In addition to use related to its dictionary meanings, there are other uses of the term “president” that would not infringe upon the Complainant’s rights.

The Complainant asserts that the Respondent, who owns a large portfolio of domain names, had a duty to search the Australian trademarks register, and if the Respondent had done so, the Respondent would have found the Complainant’s registered trademarks. However, in this Panel’s view, in respect of dictionary terms that are intended to be used for their dictionary meaning, no inference can be drawn against the Respondent or knowledge implied to the Respondent for not conducting trademark searches in respect of dictionary terms in the circumstances of this case. See *Merryvale Limited v. Domains By Proxy, LLC., DomainsByProxy.com / Oliver Worth, Twenty Two Solutions Ltd*, WIPO Case No. [D2020-2187](#)¹.

Accordingly, the Panel finds that there is no evidence that the Respondent registered the disputed domain name in bad faith.

In relation to bad faith use, the Complainant asserts that the Respondent registered the disputed domain name with the purpose of selling the disputed domain name to the Complainant, that the Respondent’s pay-per-click pages disrupts the business of the Complainant, and that the Respondent is attempting to attract Internet traffic to the Respondent’s website by confusing Internet users as to the Respondent’s association with the Complainant.

For bad faith to be shown, generally the Complainant must provide that there was some intent on the part of the Respondent to take advantage of the Complainant’s trademark. The Complainant has not shown such intent here.

In *Mecu Limited v. OZ8 Pty Ltd*, WIPO Case No. [DAU2016-0003](#), the respondent had a large portfolio of domain names, and the disputed domain names in that case resolved to pay-per-click websites. In finding against the complainant, the panel in that case considered several factors, including that the respondent’s websites did not appear to make any direct reference to the complainant and the links on those websites appear to be related to the descriptive words that comprise the domain names. Further, in that case, there was also no evidence that the respondent registered other domain names similar to well-known trademarks.

Here, despite a large domain name portfolio, there is no evidence that the Respondent has registered domain names other than domain names composed of dictionary terms. From 2006 to 2022, there appears to be only one other complaint filed against the Respondent under the Policy. The Respondent was successful in that case. *Affirm, Inc. v. Internet Products Sales & Services Pty Ltd*, WIPO Case No. [DAU2021-0014](#).

¹ Although the cited case was filed under the Uniform Domain Name Dispute Resolution Policy (“UDRP”), given the similarity between the UDRP and the AUDR Policy, in the circumstances the Panel finds it is appropriate to refer to this case and other cases under the UDRP.

The Complainant has not provided sufficient evidence to demonstrate that the Respondent registered the disputed domain name with the intent to resell it to the Complainant. Panels have drawn a distinction between an offer made by the respondent directly to the complainant and the general listing or advertising of the domain name for sale, particularly where the domain name is a dictionary term. Without more, a general offer to sell or an invitation to submit an offer for a domain name consisting of a dictionary term does not in itself constitute bad faith.

In *Lytro, Inc. v. Drift Alliance Pty Ltd*, WIPO Case No. [DAU2014-0019](#), the respondent did not approach the complainant. The panel stated: “Merely because a domain name owner has negotiations with a trade mark owner regarding a possible sale of a domain name is not, of itself, conclusive evidence of bad faith. [...] A registered trade mark does not provide a monopoly that prevents all uses of a domain name that is similar to the registered trade mark.”

In the recent *Amadeus* case, the respondent owned a large domain name portfolio. The panel stated: “In view of the widespread use of the name ‘amadeus’ in commerce by a wide range of business entities, the Complainant has failed to meet the burden of showing that the Respondent registered and has used the disputed domain name with the purpose of targeting the Complainant’s AMADEUS mark and the goodwill attaching to it.” See *Amadeus IT Group, S.A. v. Domains By Proxy, LLC / Narendra Ghimire, Deep Vision Architects*, WIPO Case No. [DCO2022-0040](#). The same applies in the present case.

The Complainant fails in respect of the third element of the Policy.

7. Decision

For all the foregoing reasons, the Complaint is denied.

/John Swinson/

John Swinson

Sole Panelist

Date: December 8, 2022