

## **ADMINISTRATIVE PANEL DECISION**

Metal Biz Recyclers Pty Ltd v. Mel Metalbiz Pty Ltd  
Case No. DAU2024-0026

### **1. The Parties**

The Complainant is Metal Biz Recyclers Pty Ltd, Australia, represented by Wynnes Patent and Trademark Attorneys, Australia.

The Respondent is Mel Metalbiz Pty Ltd, Australia, internally represented.

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

The disputed domain name <melmetalbiz.com.au> is registered with Web Address Registration Pty Ltd (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 6, 2024. On September 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 9, 2024, the Registrar 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 "auDRP" or "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 10, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was September 30, 2024. The Respondent sent an email to the Center on September 13, 2024. Accordingly, the Center notified the commencement of panel appointment process on October 1, 2024.

The Center appointed John Swinson as the sole panelist in this matter on October 3, 2024. 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 operates a scrap metal recycling business with three locations in Brisbane, Queensland.

According to the Complainant's website, located at the domain name <metalbiz.com.au>, the Complainant has been in business since 2007. This website states that the Complainant pays cash for old cars and operates a large scrapyards and accredited recycling facility.

The Complainant owns Australian Trade Mark No. 2027307 for METALBIZ. This trade mark was filed on August 1, 2019. and entered in the Register on April 15, 2020.

The Respondent is a company based near Melbourne, Victoria. The Respondent was incorporated on October 5, 2023. The Respondent appears to operate a business associated with scrap metal recycling. According to the Respondent's website located at the disputed domain name, the Respondent will purchase old cars for cash. The website states: "Turn your scrap car into quick cash in Melbourne. At Mel Metal Biz, we offer top cash for cars. Our process is very simple and quick, just let us know what make, Model, year car you have and what suburb are you located in. Our team will handle the rest, from instant cash to pick up." It does not appear that the Respondent operates a scrapyards or has a recycling facility.

The disputed domain name was registered on January 8, 2024.

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

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

The Complainant's submissions were not detailed. In summary, the Complainant makes the following submissions:

The Respondent is infringing the Complainant's registered trademark rights. The website at the disputed domain name is misleading, as it will attract customers looking for the Complainant and it could give the impression that it is associated with the Complainant.

Government regulator ASIC gives notice to people who register companies to be aware of trademarks that may affect the choice of company name and recommends conducting proper searches for existing trademarks.

If the Respondent had been operating in good faith, its company name and the disputed domain name would never have been registered.

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

The Respondent filed a short informal Response. In full, the Response states: "This domain name is registered under my company name. I don't know to whom that is disputed. I have registered company name in govt of Victoria Australia in this name as i attached the registration of my company."

#### **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 an Australian registered trademark for METALBIZ as discussed in section 4 above.

In comparing the disputed domain name to the Complainant's trademark, it is permissible to disregard the Top and Second Level Domains, for example ".com.au", as a functional component of the domain naming system.

The entirety of the METALBIZ trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the trademark for the purposes of the Policy.

Although the addition of other terms (here, "mel") may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the trademark for the purposes of the Policy.

Accordingly, the disputed domain name is confusingly similar to the Complainant's METALBIZ trademark.

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 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 the Respondent has 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 non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, 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](#).

The mere fact that the Respondent was able to register the disputed domain name does not, of itself, establish that the Respondent has rights or legitimate interests in the domain name. Note 2 of the Policy states that, for the purpose of paragraph 4(a)(ii), rights or legitimate interests in the domain name “are not established merely by a registrar’s determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration”.

The Complainant asserts that the Respondent has not been commonly known by the disputed domain name due to the short time that the disputed domain name has been registered, that the Respondent has not acquired any trademark, and that the Respondent is not making a noncommercial use of the disputed domain name.

The Respondent appeared to assert that she has a registered company name that corresponds to the disputed domain name, and thus appears to rely upon paragraph 4(c)(ii) of the Policy. However, the company name was only registered a year ago (in October 2023), and there is no evidence that the Respondent is commonly known by the disputed domain name, as required by paragraph 4(c)(ii). The registration and use of a disputed domain name, in connection with the Respondent’s website, does not by itself support a conclusion that the Respondent is commonly known by the disputed domain name. *Bernard Janes v. L.J. Bubenicek & A. J. Main, A&L Technologies*, WIPO Case No. [DAU2010-0014](#).

As for the registered company name, registration of a company name does not, of itself, mean that the Respondent is entitled, under the Policy, to use that name. Registration of a company name does not confer rights in the name which would override accrued registered trademark rights.

In respect of paragraph 4(c)(i) of the Policy, the key issue is whether the Respondent’s use of, or preparations to use, the disputed domain name is bona fide – i.e., is in good faith. This requires consideration of the Respondent’s motivation for undertaking that use – which, in turn, requires an evaluation of all the facts and evidence. Relevant facts here include the degree of similarity of the disputed domain name to the Complainant’s trademark, the likelihood of customer confusion, and the fact that it appears likely that the Respondent is infringing the Complainant’s registered trademark rights. As discussed below in relation to the third element, the Respondent’s use of the disputed domain name is, more likely than not, not in good faith.

The Panel finds the second element of the Policy has 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 and 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 (usually) owned by the complainant.

Paragraph 4(b)(iv) of the Policy states that evidence of the registration and use of a domain name in bad faith includes the respondent using the domain name to intentionally attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant’s

trademark or name as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service thereon.

In the present case, the Complainant and the Respondent are operating very similar businesses, although in different geographical areas within the same country. The Complainant is known in this industry, and it has been in business long before the Respondent was incorporated. An Internet search by the Respondent would clearly have identified the Complainant's competing business, as would a search of the Trade Marks Register. The Panel concludes that the Respondent would likely have had knowledge of the Complainant when registering the disputed domain name. Moreover, any use of the disputed domain name by the Respondent would likely imply an affiliation with the Complainant that does not exist.

The Respondent did not assert that it was not aware of the Complainant when the Respondent chose to use the name "Mel Metalbiz" or the disputed domain name. Rather, the Respondent's position appears to be that the Respondent was able to register the company name "Mel Metalbiz Pty Ltd" and thus is entitled to use the disputed domain name. As mentioned under Section B above, this is incorrect. One cannot register a company name that is deceptively similar to another's trademark, and then claim good faith use of a domain name that corresponds with that company name.

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

## **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 <melmetalbiz.com.au> be transferred to the Complainant.

*/John Swinson/*

**John Swinson**

Sole Panelist

Date: October 15, 2024