

ADMINISTRATIVE PANEL DECISION

S J Salisbury Constructions Pty Ltd v. Domain Admin, Privacy Protect, LLC /
Hadley Dove

Case No. D2022-3291

1. The Parties

The Complainant is S J Salisbury Constructions Pty Ltd, Australia, represented by Lynch Meyer Lawyers, Australia.

The Respondent is Domain Admin, Privacy Protect, LLC, United States of America / Hadley Dove, Australia, self-represented.

2. The Domain Name and Registrar

The disputed domain name <scottsalisburyhomes.com> is registered with Launchpad.com Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 5, 2022. On September 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 6, 2022, the Registrar 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 9, 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 amendment to the Complaint on September 12, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 2, 2022. The Response was filed with the Center on September 17, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on October 17, 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 builder of residential housing, based in Adelaide, South Australia. It trades under the name "Scott Salisbury Homes".

One of the homes the Complainant built, or renovated, was for the Respondent.

The Respondent contends the work was defective and requires work valued at over AUD 70,000 to repair the defects. The Complainant disagrees.

On November 19, 2021, the Respondent registered the disputed domain name. It resolves to a website (illustrated by a partial screenshot provided by the Respondent) headed in the top left:

"Scott Salisbury Homes Review

Read our Horror Review of Scott Salisbury Homes".

Then prominently centered in the screenshot:

"Welcome To

WHAT WE EXPERIENCED BUILDING WITH SCOTT SALISBURY HOMES

A HORROR STORY".

All this text is superimposed over an image of a building, presumably representing the Respondent's home. What if anything appears below "the fold" is not disclosed. The Respondent also appears to have circulated a leaflet with similar headings and wording. It is headed:

"A Horror Story.

This is what we experienced".

And then in smaller type "building with Scott Salisbury Homes". The words "Scott Salisbury Homes" are in bold and larger type than "building with". The narrative then continues with the Respondent's claim that there are over AUD 70,000 in defects required and comments attributed to an unnamed "SSH Construction Manager".

After a link to the website at the disputed domain name and a disclaimer "NOTE: this is NOT a Scott Salisbury Homes website" appears the text:

"All we ever wanted was to have our home finished to the promised standard of Scott Salisbury Homes' advertising of 'Excellence in Design' & 'Attention to Detail'.

Do the right thing and give us what we paid for

Either fix the defects or pay us enough to fix them".

On January 24, 2022, the Complainant applied to register Australian Trade Mark No. 2244291, SCOTT SALISBURY HOMES, in respect of relevant services in International Classes 37 and 42. The trademark was formally entered on the Register on September 1, 2022 with effect from the filing date: *Trade Marks Act 1995 (Cth) s 72(1)*.

Earlier, in May 2022, the Complainant had written to the Respondent stating that the Respondent's campaign was not having any effect on the Complainant's business, especially after the Complainant showed prospective customers the Respondent's material and tell them [the Complainant's story]. The Complainant's letter then made a proposal to settle the dispute once and for all. The proposal was not acceptable to the Respondent.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a 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 and is being used in bad faith.

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 it 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 trademark rights.

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 shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of at least the registered trademark SCOTT SALISBURY HOMES identified in section 4 above.

The Respondent contends that he registered the disputed domain name before the Complainant acquired its registered trademark. However, the second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademark. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, priority of registration, and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See, e.g., WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain ("gTLD") as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical with the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

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 can be situations in which the Respondent has rights or legitimate interests in a 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 organization) has been commonly known by the [disputed] 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 [disputed] 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. 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., [WIPO Overview 3.0](#), section 2.1.

It is not in dispute between the Parties that the Respondent is not authorised by the Complainant to use its trademark or otherwise associated with the Complainant in some way that the Complainant's authority to use the trademark could be inferred. Nor is the Respondent commonly known by the disputed domain name or some other name from which the disputed domain name could be derived.

As noted in section 5A above, the Respondent contends he has rights or a legitimate interest in the disputed domain name as he registered it before the Complainant registered its trademark.

The Respondent did in fact register the disputed domain name before the Complainant registered its trademark. However, it is apparent that the Complainant had been using its trademark before the Respondent registered the disputed domain name and had in fact been dealing with the Respondent by reference to the (unregistered) trademark.

As the Respondent knew that the Complainant was using the trademark before he registered the disputed domain name and the whole point of his use of the Complainant's trademark in the disputed domain name is to capture the attention of people searching for the Complainant's trademark – that is, to take advantage of the trademark significance of the disputed domain name – the Respondent's registration of the disputed domain name before the Complainant formally registered its trademark cannot confer rights or legitimate interests over the disputed domain name on the Respondent. See, e.g., (in the context of the bad faith requirement) [WIPO Overview 3.0](#), section 3.8.2.

As the Respondent contends he has prior use rights under the *Trade Marks Act* 1995, the Panel notes that the prior registration of the disputed domain name in these circumstances would not provide a defence to trademark infringement: *Trade Marks Act* 1995, section 124(1)(f).

The Respondent also contends he has a defence under the *Trade Marks Act* 1995 section 122(1)(d) as a protected use for purposes of comparative advertising. The manner of the Respondent's use, however, does not appear to be comparative advertising in the sense that expression would usually be understood – comparing one product to another.

The Respondent's website is (as he also more aptly describes it) a review or criticism site.

As paragraph 4(c)(iii) of the Policy shows, a genuine review or criticism site can provide a basis for rights or legitimate interests.

As the disputed domain name is identical to the Complainant's trademark, however, there is a high risk of implied affiliation. Generally speaking, domain names identical to a complainant's trademark do not qualify for this "defence". See, e.g., [WIPO Overview 3.0](#), section 2.5.1 ("Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation.") and section 2.6.2 ("Panels find that even a general right to legitimate criticism does not necessarily extend to registering or using a domain name identical to a trademark (i.e., <trademark.tld> (including typos)); even where such a domain name is used in relation to genuine noncommercial free speech, panels tend to find that this creates an impermissible risk of user confusion through impersonation."); see also *Dover Downs Gaming & Entertainment, Inc. v. Domains By Proxy, LLC / Harold Carter Jr, Purlin Pal LLC*, WIPO Case No. [D2019-0633](#).

In this case, the content of the Respondent's website is highly critical of the Complainant and its services. Whether rightly or wrongly so is not something the Panel is in a position or qualified to determine. Nonetheless, there is nothing in the content of the website or the Respondent's leaflet to suggest that the Respondent does not genuinely hold the views expressed.

The Respondent's leaflet, however, does reveal an additional factor: the Respondent is using the disputed domain name and the content of the website in an attempt to pressure the Complainant into yielding to his demands.

It is not clear from the materials before the Panel whether the website itself includes the same plea. Even if it does not, however, the leaflet is revealing of the Respondent's motivations and intentions.

This additional factor may not be "commercial" in the sense of that the Respondent is a business trying to get some advantage for his business. However, it can be seen as an attempt to gain a commercial advantage or tarnish the Complainant's trademark. See, e.g., [WIPO Overview 3.0](#), section 2.5.3 ("Notably in this regard, commercial gain may include the respondent gaining or seeking reputational and/or bargaining advantage, even where such advantage may not be readily quantified.")

Having regard the identity of the disputed domain name to the Complainant's trademark and this additional or ulterior motive, therefore, the Panel finds that the Respondent has not rebutted the Complainant's *prima facie* case that he does not have rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has established the second requirement under the Policy.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see, e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

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 and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

Further, as noted in section 5B above, the Respondent's registration of the disputed domain name before the Complainant registered its trademark does not protect him where, as here, the Complainant was already using the (unregistered) trademark. See [WIPO Overview 3.0](#), section 3.8.2. Here, noting the relationship between the Parties, it is clear the Respondent knew of and was directly targeting the Complainant's trademark.

The finding that the Respondent does not have rights or legitimate interests under the Policy is not dispositive of this requirement under the Policy. See, e.g., *Dover Downs Gaming & Entertainment, Inc. v. Domains By Proxy, LLC / Harold Carter Jr, Purlin Pal LLC*, WIPO Case No. [D2019-0633](#).

In the present case, as already noted, it appears that the Respondent genuinely holds the views expressed on his website. On the materials before the Panel, however, it appears the Respondent is not, and was not at the time of registration, solely motivated by a criticism or whistleblower intention. Rather, the registration and use of the disputed domain name was motivated by a desire to pressure the Complainant into settling the dispute between the Parties over the quality of the services rendered to the Respondent by the Complainant.

In this limited sense, the Panel considers the registration and subsequent use of the disputed domain name for this purpose constitutes registration and use in bad faith under the Policy. Moreover, the inherently misleading nature of the disputed domain name, being identical to the Complainant's trademark, further supports the finding of bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

6. Decision

For 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 <scottsalisburyhomes.com> be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: October 31, 2022