

ADMINISTRATIVE PANEL DECISION

Petesal Enterprises Pty Ltd. v. Grayson's International Pty Ltd
Case No. DAU2022-0020

1. The Parties

The Complainant is Petesal Enterprises Pty Ltd., Australia, represented by Sandercock & Cowie, Australia.

The Respondent is Grayson's International Pty Ltd, Australia.

2. The Domain Name and Registrar

The disputed domain name <completeleaf.com.au> is registered with Synergy Wholesale Pty Ltd (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 16, 2022. On September 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 19, 2022, 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 "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 30, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was October 20, 2022. The Response was filed with the Center on October 6, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on October 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 parties are competing suppliers of gutter guard mesh. The mesh is installed over guttering to prevent leaves and other debris falling into the gutters and blocking them up.

For some time prior to May 2020, the Complainant had been using the disputed domain name to resolve to a website apparently offering for sale gutter guard mesh products. How long it has been doing so and on what basis is not clear.

The Complainant says it has been using the disputed domain name for its website since 2006. Until June 2020, however, the disputed domain name was registered in the name of Complete Leafscreeener Services Pty Ltd. That company was deregistered in 2009 following a liquidator's winding up.

The Complaint includes screenshots obtained from the Wayback Machine showing single pages of the website offering for each of the years from 2006 to 2020. For each of those years, apart from the capture for September 2, 2012, the pages appear to be offering for sale gutter guard products and services or testimonials for those services. The capture for September 2, 2012, offers for sale water tanks and pumps. It does so, however, under a frame "Complete Leafscreeener NEVER Clean Your Gutters AGAIN!" followed by the Complainant's current telephone number.¹ The capture for June 11, 2014, is a downloadable brochure which includes the Complainant's Australian Business Number.

On May 4, 2020, the Respondent acquired by assignment from the previous owner registered trade marks for LEAFSCREENER. The Respondent now uses those trade marks, as registered trade marks, on its website at "www.leafscreeener.com.au".

According to the Response, on May 5, 2020, the Respondent discovered what the Respondent considered an illegal website – the website to which the disputed domain name then resolved which used "Leafscreeener" on every page, in the source code, page titles and the main text body. (The Complainant claims that "leafscreeener" is generic in the gutter guard mesh field.)

On or about May 19, 2020, the Respondent notified auDA that the disputed domain name was then registered in the name of a company which had been defunct since 2009 seeking its cancellation.

On May 23, 2020, the Complainant brought proceedings in IP Australia (the Trade Marks Office) seeking to have the Respondent registered trade marks removed for non-use. (By a decision pronounced on February 1, 2022, the application for removal was partially successful in relation to some, but not all, of the goods.)

Meanwhile on June 4, 2020, the Complainant filed two trade mark applications:

- (a) Trade Mark No. 2093714, COMPLETE LEAF, in respect of a range of goods and services in International Classes 6, 19 and 37; and
- (b) Trade Mark Application No. 2093718, COMPLETE LEAFSCREENER, also in respect of the range of goods and services in International Classes 6, 19 and 37.

The Respondent opposed acceptance of Trade Mark Application No. 2093718 and that application lapsed in due course. The Respondent did not oppose Trade Mark No. 2093714 which is now registered with effect from June 4, 2020.

On June 19, 2020, auDA notified the Respondent that it had upheld the objection that the disputed domain name was improperly registered and would be deleted in accordance with auDA's then in force Domain

¹ Following the events described below, the Complainant has registered the domain name <completeleaf.net.au> which resolves to a modified form of the former website, now using a "Complete Leaf" logo instead of a "Complete Leafscreeener" logo.

Renewal, Expiry and Deletion Policy (2010-01). In accordance with that policy, the registration then “dropped” and, on June 22, 2020, the Respondent secured the registration. It has since renewed the registration earlier this year.

At least since 2021, the disputed domain name has redirected to the Respondent’s website at “www.leafscreeener.com.au”.

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 name, trade mark 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.

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, trade mark or service mark.

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

The Complainant has proven that it owns the registered trade mark for COMPLETE LEAF referred to in section 4 above.

On the question of identity or confusing similarity, what is required is simply a visual and aural comparison and assessment of the disputed domain name itself to the Complainant’s trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd.*, WIPO Case No. [DAU2002-0001](#). This test is narrower than and thus different to the question of “likelihood of confusion” under trade mark law which can require an assessment of the nature of the goods or services protected and those for which any impugned use is involved, geographical location or timing. Such matters, if relevant however, may fall for consideration under the other elements of the Policy.

Typically and as is appropriate in this case, it is permissible to disregard the Second Level Domain, “.com.au”, as a functional component of the domain naming system. See for example auDA Overview of Panel Views on Selected auDRP Questions First Edition (“auDRP Overview 1.0”), section 1.2.

The Respondent contends that the registration of the COMPLETE LEAF trade mark was obtained in bad faith as it was filed during the period of auDA’s investigation into the eligibility of the registration of the disputed domain name and as part of an attempt to genericise “leafscreeener”. The Respondent also claims that the Complainant is not really conducting a business in gutter guard mesh and services and contends its real, or main, business is the supply of water tanks and pumps.

Proceedings under the Policy are not usually appropriate venues to challenge the registration of a trade mark on grounds of bad faith. Indeed, it has been put as highly as that a panel lacks jurisdiction or competence to do so save in extraordinary circumstances. See e.g. *Julie & Jason, Inc. d/b/a The Mah Jongg Maven v. Faye Scher d/b/a Where the Winds Blow*, WIPO Case No. [D2005-0073](#) (“Except in the most extraordinary circumstances, the Panel lacks jurisdiction or authority (not to mention the competence) to set aside a trademark registration issued by governmental authority. E.g., *Deutsche Telekom AG v. Terrabit Working Group*, WIPO Case No. [D2004-0153](#); *Webe Web Corporation. v. Website Holdings Corp.*, WIPO Case No. [D2002-1057](#). That is true even when the mark at issue consists of common words. *Classmates Online, Inc. v. John Zuccarini, individually and dba RaveClub Berlin*, WIPO Case No. [D2002-0635](#).”)²

There are no such extraordinary circumstances present in this case.

It is not apparent to the Panel how the registration of the trade mark COMPLETE LEAF “genericises” the Respondent’s trade mark as opposed, potentially, to consequences flowing from the content of for example the Complainant’s former website or even the name Complete Leafscreener also formerly used by the Complainant.

Whether or not the Complainant offers other products such as water tanks and pumps, even as the main line of its business, does not preclude it from also offering other goods and services or from registering trade marks for such subsidiary lines (if in fact they are subsidiary or minor lines only).

The fact that the Complainant applied to register the trade mark during the pendency of auDA’s investigation does not invalidate by itself the application or subsequent registration. Generally, it would be necessary to show that the Complainant did not intend to use the trade mark in good faith in a commercial way. And, so far as the evidence in this proceeding goes, the Complainant does appear to be using its trade mark to offer for sale gutter guard products and services. It is also noticeable that, while the Respondent did oppose the Complainant’s trade mark application which included the word “leafscreener”, it did not oppose the registration of the trade mark which the Complainant relies on in this proceeding.

Accordingly, the Panel finds that the disputed domain name is identical to the Complainant’s trade mark and the Complainant has established the first requirement under 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 you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

² In view of the derivation of the Policy from the Uniform Domain Name Dispute Resolution Policy (the “UDRP”) and the similarity of the concepts, the Panel considers that reference to decisions under the UDRP may be legitimately made in appropriate cases.

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](#).

It is apparent from the Complaint that the Complainant has not authorised the Respondent to register and use the disputed domain name and is not otherwise associated with the Complainant.

The Respondent was not commonly known as “Complete Leaf” before the Respondent registered the disputed domain name. Nor was it known by a name which would naturally suggest the disputed domain name or from which the disputed domain name could conventionally be derived.

As the disputed domain name diverts to the Respondent’s own commercial website, the circumstances identified in paragraph 4(c)(iii) are inapplicable.

The Respondent appears to contend that it has rights or a legitimate interest in the disputed domain name because it secured the registration when it “dropped”. When it did so, however, it was well aware that the Complainant had been using the disputed domain name for some time in respect of gutter guard products and services.

As the Respondent contends, the Complainant has not explained how it came to be using the disputed domain name following the deregistration of the former holder in 2009. The Panel accepts that the materials in the Complaint are inadequate to explain how the Complainant came to be using the disputed domain name, why the registration of the disputed domain name was still in the name of the defunct company and what steps, if any, the Complainant took to defend the eligibility proceedings being conducted by auDA.

As outlined in section 4 above, however, it is clear that the Complainant had been using the disputed domain name for a number of years before auDA ordered its cancellation on June 19, 2020. The date from when the Complainant started doing so is not clear but the objective evidence in the form of the Wayback Machine print-outs indicates it was at least 2014. The form of use by the Complainant was capable of constituting trade mark use and building up some sort of reputation. The successors to the company deregistered in 2009 (if not the Complainant) had more than enough time to have challenged the Complainant’s use if they were so minded and given the passage of time have clearly abandoned the trade mark. It is also noteworthy that the Respondent does not claim rights in the disputed domain name derived from the former holder, the company deregistered in 2009.

Importantly, the Respondent became the registrant of the disputed domain name only after the effective date of the Complainant’s registered trade mark. Moreover, the manner of the Respondent’s use of the disputed domain name appears to be in direct conflict with the rights conferred by that registration. The Respondent has not disclosed when it became aware of that application but, given the context, the Respondent was plainly on inquiry if not actual notice.³

Accordingly, the record in this proceeding discloses that the Complainant has prior rights over “COMPLETE LEAF” to the claims of the Respondent both through the registration of its trade mark and prior use.

³ See e.g. *Flexopack SA Plastics Industry v Flexopack Australia Pty Ltd* [2016] FCA 235; (2016) 118 IPR 239 at [107] – [118].

It is well established under the Policy that the use of a competitor's trade mark to attract customers and potential customers to one's own goods and services does not qualify as a good faith offering under the Policy.

Accordingly, the Panel finds that the Complainant has established the Respondent does not have rights or legitimate interests in the disputed domain name under the Policy.

C. Registered or Subsequently Used in Bad Faith

Paragraph 4(b) of the Policy provides that:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location; or

(v) if any of your representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

The instances of bad faith set out in paragraph 4(b) of the Policy are examples only, intended to illustrate types of conduct which is caught by the Policy. See *Do The Hustle, LLC v Tropic Web* WIPO Case No. [D2000-0624](#).

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.

For the reasons set out in section 5B above, there can be very little, if any, doubt that the Respondent was well aware of the Complainant's prior use of the disputed domain name and trade mark application.

Further, for those reasons, the Panel also finds that the Respondent registered the disputed domain name for at least one or more of the purposes set out in paragraph 4(b)(ii) to (iv) above.

In these circumstances, the Panel finds that the Respondent registered the disputed domain name in bad faith and, still further, its use to redirect to the Respondent's competing website at "www.leafscreeener.com.au" is use in bad faith.

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

D. Reverse Domain Name Hijacking

As the Complainant has succeeded, there is no basis for a finding of reverse domain name hijacking as requested by the Respondent.

6. 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 domain name, <completeleaf.com.au>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: November 7, 2022