

ADMINISTRATIVE PANEL DECISION

The Brooklyn Brewery Corporation, and Lion – Beer, Spirits & Wine Pty Ltd.
v. Tony Bennett, Advanced Radiology Clinics Pty Ltd
Case No. DAU2022-0024

1. The Parties

The Complainants are The Brooklyn Brewery Corporation, United States of America (“United States”) and Lion – Beer, Spirits & Wine Pty Ltd., Australia, represented by CSC Digital Brand Services Group AB, Sweden (the Complainants are hereinafter referred to as “the Complainant”).

The Respondent is Tony Bennett, Advanced Radiology Clinics Pty Ltd, Australia.

2. The Domain Name and Registrar

The disputed domain name <brooklynbrewery.com.au> (the “Disputed Domain Name”) 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 20, 2022. On September 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 23, 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 received an amended Complaint from the Complainant on September 30, 2022.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), 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 October 3, 2022. In accordance with the Rules, paragraph 5(a), the due date for Response was October 31, 2022. The Center received email communications from the Respondent on October 3, October 5, and October 7, 2022. The proceeding was suspended on October 13, 2022, and was reinstated on October 21, 2022. The Center notified the commencement of Panel appointment process on November 1, 2022.

The Center appointed Nicholas Weston as the sole panelist in this matter on November 7, 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, The Brooklyn Brewery Corporation, (“Brooklyn Brewery”) is a United States incorporated company that operates a business that offers a range of alcoholic and non-alcoholic drinks in over 30 countries. Brooklyn Brewery holds registrations for the trade mark BROOKLYN BREWERY and variations of it in several countries, including United States Registration No. 3186503 for the mark BROOKLYN BREWERY, registered by that Complainant on December 19, 2006 in class 32, Australian Registration No. 1387041 for the mark B BROOKLYN BREWERY Registered on July 19, 2010 in class 32, and Australian Registration No. 1770360 for the mark BROOKLYN Registered on May 12, 2016 in class 32.

The Complainant, Lion–Beer, Spirits & Wine Pty Ltd (“Lion”), is an Australian incorporated company that is authorized to use those trade marks under an exclusive licence from Brooklyn Brewery on a range of alcoholic and non-alcoholic drinks.

Brooklyn Brewery is also the owner of the domain name <brooklynbrewery.com> which is the address of its main website.

The Disputed Domain Name was registered on May 30, 2017. The Complainant has provided evidence that the Disputed Domain Name is inactive and that the Respondent has made to it a written offer to sell the Disputed Domain Name for AUD 5,000.

5. Parties’ Contentions

A. Complainant

The Complainant cites its trade mark registrations of the trade mark BROOKLYN BREWERY, and variations of it, in various countries, as *prima facie* evidence of ownership.

The Complainant claims that the Disputed Domain Name was transferred to the Respondent in or around April, 2018.

The Complainant submits that the mark BROOKLYN BREWERY is distinctive and that its rights in that mark predate the registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trade mark, because the Disputed Domain Name “is identical to” the BROOKLYN BREWERY trade mark and that any confusing similarity is not alleviated by “the “.com.au” country code Top-Level Domain (“ccTLD”).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the Respondent has no trade mark rights in, or license to use, the BROOKLYN BREWERY mark. The Complainant contends that “the pertinent WhoIs information identifies the Registrant as “Tony Bennett / Advanced Radiology Clinics Pty Ltd,” which does not resemble the Disputed Domain Name in any manner. Further, the Complainant looked up the ABN details of the Respondent’s organization which seems to be in the medical field of radiology, not related to the Complainant’s business” and that [the Respondent] “has not demonstrated any attempt to make legitimate use of the domain name and website.”

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith. On the issue of registration, the Complainant contends that the Respondent must

have had the BROOKLYN BREWERY trade mark in mind when it registered the Disputed Domain Name “[g]iven Respondent’s self-proclaimed “strong interest in the brewing industry.”

On the issue of use, the Complainant has supplied evidence that the Disputed Domain Name resolves to an inactive webpage, and claims that “[u]pon receiving Complainants’ cease and desist letter, Respondent offered to sell the Disputed Domain Name” ...”for AUD 5,000, an amount that far exceeds the Respondent’s out-of-pocket expenses in registering the domain”.

B. Respondent

The Respondent sent email communications before this proceeding.

On March 29, 2021, the Respondent sent an email (in response to the Complainant’s cease-and-desist letter) that stated: “Thank you for contacting me I also want this to be amicably, but i have also have been offered money for this domain on more than one occasion which i have declined. I have a strong interest in the brewing industry, particularly craft beer.

Out of pocket costs do not include my time which is expensive and something i can not get back, and it doesn’t take into consideration many other things that you are not wanting to compensate by offering me out of pocket expenses. My interest in this domain and when i purchased it, did not violate any laws. As i know, Lion only came to this an agreement as per below in 2018.

“Kirin-owned Lion has announced it has signed an agreement with Brooklyn Brewery to take over the marketing, sales and distribution of Brooklyn Brewery beers in Australia. The new agreement will commence on 17 December 2018 with Brooklyn Brewery stock will be available for trade to order through Lion from that date.”⁶

I am happy to sell the domain as i have mentioned. I believe this would save us both time and money in the long run.”

On March 31, 2021, the Respondent sent an email that stated: “Thanks for the reply \$5,000 is not a unreasonable amount to pay for the domain considering i have been offered this amount previously and rejected it. I also am not concerned about any of this being made public, i didn’t do anything illegal at the time of purchasing the domain and my intentions can be shown and proven. But as i have said, i believe \$5,000 AUD is reasonable for us both”.

On October 2022, the Respondent sent informal email communications stating that : “I am not requesting a huge amount to pass this domain over to you. I do not believe it is fair the offer you have made. I am happy to negotiate a price if you are happy to make an offer that is not insulting thanks.”

6. Discussion and Findings

6.1 Preliminary Matters

Consolidation and common control

A complaint is allowed to proceed with multiple complainants against a single respondent where the parties each have standing to file an auDRP complaint. Paragraph 10(e) of the auDRP Rules grants a panel the power to consolidate multiple domain name disputes.

Brooklyn Brewery and Lion entered a Brewing and Distribution Agreement on January 1, 2019. Pursuant to this Agreement, the trademark holder, Brooklyn Brewery has granted Lion an exclusive, non-transferable, non-assignable, royalty-free license to use the BROOKLYN BREWERY trademark and to recover the Disputed Domain Name <brooklynbrewery.com.au>.

The Panel finds that, as the owner of Australian Registered trade marks, Brooklyn Brewery meets the alternative eligibility requirements set out in paragraph 1(e) of Schedule C to the .auDA Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs. The Panel observes that the authorised user of those trade marks in Australia, Lion, is an Australian registered company, and therefore this Panel finds that Lion meets also the eligibility requirements set out in note 1 of the auDRP (and paragraph 1(a) of Schedule C to the Eligibility Rules.

The Panel accordingly concludes that it is fair and equitable for the Complaint to proceed in the name of both Complainants since both Complainants have a common legal interest in the trade mark rights on which the Complaint is based and it is procedurally efficient to proceed in a single Complaint.

6.2 Substantive Matters

Paragraph 4(a) of the Policy provides that, for the Complainant to succeed, it has the burden of proving 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.

A. Identical or Confusingly Similar

The Complainant must first establish that the Disputed Domain Name is identical with, or confusingly similar to, the Complainant's name, trade mark or service mark by demonstrating that it has rights in a trade mark at the date the Complaint was filed and, if that is the case, the Disputed Domain Name must also be identical or confusingly similar to the trade mark.

This Panel finds that the Complainant has rights in the BROOKLYN BREWERY trade mark acquired through use and registration.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the BROOKLYN BREWERY trade mark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant's trade mark BROOKLYN BREWERY; (b) followed by the ccTLD ".com.au".

It is well established that the ccTLD used as technical part of a domain name may be disregarded (see: *BT Financial Group Pty Limited v. Basketball Times Pty Ltd*, WIPO Case No. [DAU2004-0001](#)). The comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "brooklynbrewery".

This Panel observes that the Australian Registered variations of the trade mark in which the Complainant has rights, including B BROOKLYN BREWERY and BROOKLYN are also recognisable in the Disputed Domain Name. It is also well established that, where a domain name incorporates the entirety of a trade mark, the domain name will normally be considered confusingly similar to that mark for purposes of auDRP standing.

Accordingly, the Panel finds that the Complainant has established the first element of paragraph 4(a) 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 a list of non-exhaustive circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the 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 organisation) has been commonly known by the disputed domain name even if the Respondent has acquired no trade mark 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 trade mark or service mark at issue.

The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the BROOKLYN BREWERY trade mark. The Panel finds on the record that there is therefore a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name, and the burden is thus on the Respondent to produce evidence to rebut this presumption, see: *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

The Respondent has failed to submit a formal Response and so has not shown that it has acquired any trade mark rights in respect of the Disputed Domain Name or that the Disputed Domain Name is used in connection with a *bona fide* offering of goods or services. In the absence of a Response, the Panel finds that the Complainant has prior rights in the BROOKLYN BREWERY trade mark which precede the Respondent's registration of the Disputed Domain Name by approximately 12 years.

Against this, the Respondent's correspondence seeks to suggest that it has rights or a legitimate interest in the Disputed Domain Name on the basis of its "strong interest in the brewing industry, particularly craft beer". However, it has provided no evidence of demonstrated preparations to use the Disputed Domain Name. The evidence is that the Disputed Domain Name resolves to an inactive webpage. In the circumstances, such use does not amount to a *bona fide* offering of goods or services under the Policy.

There has been no evidence adduced to show that the Respondent has been commonly known by the Disputed Domain Name, nor does any of the evidence demonstrate that the Respondent is making legitimate non-commercial or fair use of the Disputed Domain Name.

The Panel therefore finds that the Complaint fulfils the second condition in paragraph 4(a)(ii) of the Policy.

C. Registered or Subsequently Used in Bad Faith

The third element of the Policy that the Complainant must also demonstrate is that the Disputed Domain Name has been registered or subsequently used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both.

It is uncontroversial that a domain name investor, or anyone else, can register a commonly used word as a domain name and hold it provided that the circumstances do not indicate illegitimate conduct or bad faith.

However, the evidence is that the Respondent has registered or used the Disputed Domain Name in bad faith. The *onus* is on the Respondent to make the appropriate enquiries when registering a domain name. Paragraph 2 of the Policy clearly states: "It is your [domain-name holder's] responsibility to determine whether your domain name registration infringes or violates someone else's rights." A simple Internet search

would have alerted the Respondent to the Complainant's prior rights, the Respondent's registration of the Disputed Domain Name incorporating the Complainant's trade mark could not be attributable to pure coincidence and creates a presumption of bad faith. The Panel finds that the Respondent must have been aware of the relevant trade mark. The Panel's finding is reinforced given the Complainant's use of the domain name <brooklynbrewery.com> and the Respondent's stated "strong interest in the brewing industry, particularly craft beer".

The Respondent's non-use or passive holding of the Disputed Domain Name would not prevent a finding of bad faith registration or use under the Policy.

Further, this Panel accepts the Complainant's evidence that the Disputed Domain Name has been offered for sale to the Complainant on March 31, 2021, for AUD 5,000. In the absence of evidence from the Respondent in relation to its expenditure associated with the Disputed Domain Name, the Panel finds that the Respondent has registered the Disputed Domain Name for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to another person for valuable consideration likely in excess of the Respondent's reasonable documented out-of-pocket costs directly related to the Disputed Domain Name, contrary to paragraph 4(b)(i) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

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 <brooklynbrewery.com.au> be transferred to the Complainant Lion – Beer, Spirits & Wine Pty Ltd.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: November 9, 2022