

ADMINISTRATIVE PANEL DECISION

GitHub, Inc v. Anna Dutton, Bean Media Group (Australia) Pty Ltd
Case No. DAU2022-0045

1. The Parties

The Complainant is GitHub, Inc, United States of America, represented by Golja Haines & Friends, Australia.

The Respondent is Christopher Dutton, Australia.

2. The Domain Name and Registrar

The disputed domain name <github.com.au> is registered with Domain Directors Pty Ltd. (the Registrar).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 23, 2022. On December 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 4, 2023, the Registrar transmitted by email to the Center its verification response disclosing:

- (a) it is the registrar for the disputed domain name; and
- (b) 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 January 4, 2023, 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 January 9, 2023.

The Center verified that the Complaint together with the amendment to 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”).

On January 4 and 10, 2023, the Center received emails from the Respondent requesting that correspondence be sent to a different email address specified in the emails.

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 January 11, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was January 31, 2023. On February 1, 2023, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on February 3, 2023. 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 an Internet hosting service for software development and version control. It operates its business under the name and trade mark GITHUB from a website at "www.github.com".

The Complainant registered the domain name <github.com> on October 9, 2007.

According to the Complaint, the Complainant has been using the name and trade mark GITHUB since 2008.

The Complaint includes screenshots of the website obtained from the Wayback Machine at "https://archive.org" dating from as early as November 11, 2008. These screenshots show prominent use of the name "Github" as a trade mark as well as use of the domain name.

Since its launch, the Complainant's user base in Australia has grown to over one million users.

The Complaint includes evidence that the Complainant owns two registered trade marks in Australia. For present purposes, it is sufficient to record Australian Registered Trade Mark No. 1866628, GITHUB, which has been registered since June 23, 2017, in respect of a range of goods and services in International Classes 9, 25, 35, 41 and 42.

The disputed domain name was registered on June 13, 2013.

The Registrar's records do not enable it to identify who was the registrant at that time as it became the Registrar only in 2020 when the registration was transferred into its service.

Initially, following its registration, the disputed domain name was simply parked at the then Registrar's parking page.

From February 2016 until August 2017, the disputed domain name resolved to an online gambling site.

From August 2017 until May 2018, the disputed domain name resolved to a website promoting the "67 Step Program to the Good Life" and better health, wealth, love and happiness.

Since May 2018, the disputed domain name has not resolved to an active website. When entering the disputed domain name into a web browser, the browser returns a "DNS_PROBE_FINISHED_NXDOMAIN" error message.

The Respondent did have a registered business name, General IT Hub (GitHub), from March 20, 2015 until June 1, 2017, when it was cancelled.

5. Discussion and Findings

No formal response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules. In particular, the Panel notes that the email notifications sent by the Center included both the email accounts provided by the Registrar and also the email address notified in the emails received on January 4 and 10, 2023.

Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present their case.

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.

A. The Respondent

As noted above, the Registrar disclosed additional contact details than were included in the Complaint. When transmitting such additional contact details to the Complainant, the details were incorrectly identified as belonging to the "Registrant", despite belonging to the "Registrant Contact".

In its amendment to the Complaint, the Complainant added the "Registrant Contact" as a co-Respondent, while maintaining that "Christopher Dutton" was the true "Registrant".

In view of paragraph 1 of the Rules, "Respondent" means the registered holder of the domain name against which a Complaint is initiated. Further, the auDA Published Policy No 2014-07, Whois Policy, defines the "Registrant Contact" as the "name of a contact person for the registrant".

Accordingly, in light of the Registrar's confirmation of the "Registrant" and in view of the Complainant's arguments, the Panel considers the Respondent is Christopher Dutton. The Panel notes that the Center also transmitted the Notification of Complaint and the case materials to the Registrant Contact so that they also were on notice and had an opportunity to address the Complaint and the Respondent's claim to be the registrant as well as the technical contact.

B. 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 name or trade 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 trade mark.

The Complainant has proven that it owns the registered trade mark, GITHUB, 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.

Accordingly, the Panel finds that the disputed domain name is identical with the Complainant’s trade mark and the Complainant has established the first requirement under the Policy.

C. 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 or 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.

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](#).

The Complainant has not authorised the Respondent to use its trade mark or to register the disputed domain name. Nor is the Respondent otherwise associated with the Complainant.

There is no evidence that the disputed domain name is currently being used in connection with a good faith offering of goods or services or any other kind of use. Nor is there any evidence of demonstrable preparations for such use. Accordingly, the circumstances in paragraph 4(c)(i) and (iii) are inapplicable.

The disputed domain name is not derived from the name of the Respondent. The Respondent does not hold a registered trade mark or pending trade mark application for GITHUB. (The Respondent does own two registered trade marks for HELLO TIGER, Trade Mark No. 2138356 and 2234183.)

The Respondent did hold a registered business name for “General IT Hub (GitHub)” from March 20, 2015 to

June 1, 2017. That name was registered some years after the disputed domain name was first registered. It has also been cancelled and, as that indicates the name is not being used to carry on any business, cannot provide a basis for rights or legitimate interests at the time the Complaint was filed.

Further, being in mind it was registered some seven years after the Complainant commenced using its trade mark and the Complainant's trade mark appears to be an invented or coined term, some explanation of how the Respondent derived the name is required – all the more so since, as discussed below, the disputed domain name does not appear to have been used for anything that might fall within the description of a "general IT hub".

The disputed domain name, however, was first registered before the Complainant registered its trade mark.

While it is not clear when the disputed domain name was first registered in the Respondent's name, that prior registration does not confer rights or legitimate interests in this case. Taking the first registration of the disputed domain name on June 13, 2013 as the relevant date, the Complainant has submitted uncontested evidence that it has been using its trade mark in Australia since 2008.

In Australia, a person using a trade mark may acquire rights in it at common law through use, even though it has not been registered. Moreover, bearing in mind that the trade mark is an inventive and distinctive term, it cannot be simply assumed the disputed domain name was adopted without knowledge of the Complainant's trade mark, especially given the (now cancelled) business name registered by the Respondent.

After an initial period of almost three years in which the disputed domain name appeared to be dormant, it was then used for 18 months to resolve to an online gambling site. It then resolved to a lifestyle or wellness site.

In neither case, was there any reference to or use of "Github". Nor, plainly, did either site have anything to do with some activity which may fairly be described as a "general IT hub". In these circumstances, the Complainant plausibly argues that the disputed domain name was simply being used to take advantage of the Complainant's reputation in its trade mark and direct traffic to those websites for commercial gain. That kind of opportunistic taking advantage of the Complainant's trade mark also does not qualify as a good faith offering of goods or services.

Taking all these matters into account, the Panel finds that the Complainant has established the required *prima facie* case. The Respondent has not attempted to rebut that *prima facie* case.

Accordingly, the Panel finds that the Complainant has established the second requirement under the Policy.

D. Registered or Subsequently Used in Bad Faith

In contrast to the Uniform Dispute Resolution Policy, the Complainant must establish that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent under the third requirement of the Policy. The requirements of registration in bad faith and use in bad faith are disjunctive, not conjunctive. The Complainant must establish only one is present to succeed. 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](#) which, given the correspondence of paragraph 4(b) to the wording under the Uniform Domain Name Dispute Resolution Policy, the Panel considers appropriate to apply in this case.

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 trade mark owned by (usually) the complainant.

In the present case, assuming in the Respondent's favour that the relevant date is June 13, 2013, the disputed domain name was registered some five years after the Complainant began using its trade mark.

Further, the Complainant's trade mark is an invented or coined term and distinctive.

Further still, there does not appear to be any association between the Respondent and the way the disputed domain name has been used that would explain the adoption of the term "Github". The Respondent has not sought to provide such an explanation.

In these circumstances, the Panel accepts the Complainant's contention that it should be inferred the disputed domain name was registered to take advantage of the Complainant's trade mark.

In regard to the Respondent's actions, that inference is reinforced as it appears he has, or has in the past held, other business name registrations or trading names including "KickStarter Business Solutions", "Tumblr Australia", and "Pokerstars.com.au", all names with significant Internet reputations or businesses. (The KickStarter business name was cancelled on the same date as the General IT Hub business name.)

Further, the use of the disputed domain name to resolve first to the online gambling site and then the lifestyle site, which were wholly unrelated to and did not use "Github", constitutes use in bad faith. See e.g. paragraph 4(b)(iv) above. Further still, the Panel accepts that the passive holding of the disputed domain name apparently based on an invented and distinctive term is an appropriate case to find use in bad faith. See e.g. *Telstra Corporation Limited v Nuclear Marshmallows* WIPO Case No [D2000-0003](#).

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

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, <github.com.au>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: February 24, 2023