

## **ADMINISTRATIVE PANEL DECISION**

Eastern Garage Doors Pty Ltd v. Arthur Martin, Romulo Martin, AGG Doors Pty Ltd

Case No. DAU2023-0006

### **1. The Parties**

The Complainant is Eastern Garage Doors Pty Ltd, Australia, represented by Davies Collison Cave, Australia.

The Respondents are Arthur Martin (the “First Respondent”), Romulo Martin (the “Second Respondent”), and AGG Doors Pty Ltd (the “Third Respondent”), all of Australia.

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

The disputed domain names <easterngaragedoorrepairs.com.au> (the “First Disputed Domain Name”) and <southeasterngaragedoorrepairs.com.au> (the “Second Disputed Domain Name”) are 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 January 23, 2023. On January 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 25, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondents are listed as the registrants and providing the contact details. The Complainant filed an amended Complaint on January 30, 2023.

The Center verified that the Complaint together with the amended 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 February 2, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was February 22, 2023. The Center received email communications from the First Respondent on February 21 and February 23, 2023. The Center notified the commencement of Panel appointment process on February 26, 2023.

The Center appointed Andrew F. Christie as the sole panelist in this matter on March 6, 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 operates a business installing, maintaining and repairing garage doors and automated gates, and selling garage door automation accessories, remotes and controls. The Complainant says it began in October 1998, and has over 32,000 individual customers, many of whom are return customers since the first years of the Complainant's business operations.

The Complainant registered the business name "EASTERN GARAGE DOOR SERVICES" on October 28, 1998. However, the Complainant failed to state that this business name registration was cancelled on October 28, 2004, and that this business name was not re-registered by the Complainant until March 19, 2020.

The Complainant is the registrant of the domain name <easterngaragedoors.com.au>. The Complainant did not specify when it registered that domain name, but says that it has used that domain name for a website in connection with its goods and services from March 23, 2005, and then later that its services have been continuously offered and promoted on this website from as early as 2007.

The Complainant is the owner of Australian Trade Mark Registration No. 2139083 (filed on November 26, 2020, and entered on the register on August 23, 2021) for the word trademark EASTERN GARAGE DOORS, and Australian Trade Mark Registration No. 2139084 (filed on November 26, 2020, and entered on the register on August 23, 2021) for the stylized EASTERN GARAGE DOORS trademark.

The Third Respondent is a privately owned Australian company. According to the Australian Securities and Investments Commission ("ASIC") records provided by the Complainant, the Second Respondent is a Director and the Secretary of the Third Respondent. The Complainant said that the First Respondent is the Marketing Manager of the Third Respondent.

The First Disputed Domain Name was registered by the First Respondent on July 10, 2018. The Complainant has provided an undated screenshot, which it said was taken on January 18, 2022, showing pages of a website, which it said resolved from the First Disputed Domain Name. The Complainant said that this website "features the mark Eastern Garage Door Repairs". However, there is nothing in the screenshot establishing that to be so. Rather, the website shown in the screenshot contains the banner heading "AGG DOORS Providing Eastern Suburbs Garage Door Repairs", the statement "Servicing Garage Doors and Gates in the Eastern Suburbs", the heading "Eastern Suburbs Garage Door Repairs", and offers the services of repairing, servicing and replacing of garage doors and gates. As of the date of this decision, the First Disputed Domain Name does not resolve to an accessible site.

The Second Disputed Domain Name was registered by the Third Respondent on a date that is not certain. The Complainant says that the registration date is May 22, 2022, which is the "creation date" reported to the Complainant by the .au administrator, .au Domain Administration Ltd ("auDA"). However, the Registrar verified that the "creation date" was May 22, 2018. The Complainant has provided an undated screenshot, which it said was taken on January 18, 2022, showing pages of a website, which it said resolved from the Second Disputed Domain Name. The website shown in the screenshot contains the banner heading "AGG DOORS Providing South Eastern Suburbs Garage Door Repairs", the statement "Garage Door Openers Choose The Garage Specialists & The Best Technicians in Melbourne", the heading "Professional Garage Door Repairs and Installations in the South Eastern Suburbs of Melbourne", and offers the services of repairing, servicing and replacing of garage doors and gates. Both the contact section and the copyright notice of the website refer to "South Eastern Garage Door Repairs". As of the date of this decision, the Second Disputed Domain Name does not resolve to an accessible site.

Between December 17, 2019, and November 14, 2022, several letters were sent between the Complainant's representative and the Third Respondent's representative relating to the Complainant's concerns about the disputed domain names, and the Complainant's request that they be cancelled or transferred to the Complainant.

On August 28, 2020, the Third Respondent filed an application to register the trademark EASTERN GARAGE DOOR REPAIRS. The application was accepted on December 1, 2020. On March 17, 2021, the Complainant filed an opposition to the acceptance of the application. The Third Respondent voluntarily withdrew the trademark application, resulting in the discontinuance of the opposition proceedings, on July 5, 2022.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant made the following contentions to establish that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights. The relevant part of the two disputed domain names, namely "easterngaragedoor", is identical to the Complainant's trademarks. The addition of the country-code Top-Level Domain ("ccTLD") ".com.au" does not affect the confusing similarity or identity between the disputed domain names and the trademarks in issue. The Complainant has been known by its trading name, Eastern Garage Doors, for 24 years, and the Respondents have therefore registered domain names that are identical to the name used by the Complainant.

The Complainant made the following contentions to establish that the Respondents have no rights or legitimate interests in respect of the disputed domain names. The Respondents are not commonly known by the disputed domain names and have not acquired any trademark rights in the disputed domain names. The Complainant has not licensed, acquiesced in, or otherwise permitted, the Respondents to apply for or use any domain name incorporating the Complainant's name or trademarks, and has strongly objected to such use. By offering the same services as the Complainant, the Respondents effect the "bait and switch" system, whereby a consumer seeking the Complainant's services by reference to the disputed domain names would be presented with the promotion of the Respondents' services, and may mistake those services as coming from or being affiliated with the Complainant. The consumer may be diverted away from the Complainant's services and referred to the same services provided by the Respondents. The Respondents are maximising potential to profit by using the goodwill associated with the Complainant's business name and trademarks.

The Complainant made the following contentions to establish that the disputed domain names were registered or are being used in bad faith. The Respondents have continued to hold the disputed domain names notwithstanding the objections by the Complainant. The Respondents have demonstrated a pattern of conduct of registering domain names in bad faith, as the disputed domain names are one of several domain names registered primarily for the purpose of disrupting the legitimate business and activities of other businesses. The Respondents have attempted to attract, for commercial gain, consumers to their websites by creating a likelihood of confusion with the Complainant's name as to the source, sponsorship, affiliation, or endorsement of those websites and the products and services on those websites. The Respondents have registered 443 domain names, several of which are the registered trademarks of established businesses that manufacture garage door opener accessories, and provide garage door services. This clearly illustrates a pattern of bad faith behaviour, namely, an intention to trade on the reputations of competitors and to block those competitors from securing domain names consistent with their branding.

### **B. Respondent**

The Respondents did not submit a formal response. However, on February 21, 2023, the First Respondent (apparently on behalf of all of the Respondents) sent an email to the Center stating, amongst other things,

the following: (i) they have been getting intimidated by the Complainant for several years; (ii) that auDA had advised them not to respond to the Complainant's lawyers as "we are well within our right to use" the First Disputed Domain Name; (iii) they have been "providing Eastern Garage Door Repairs and other Services to thousands of customers in the eastern suburbs of Victoria" (presumably meant to be a reference to Melbourne) and had been doing so "for well over 20 years"; (iv) that a person from the auDA Compliance Team had informed them that they are eligible to hold the licence for the First Disputed Domain Name; and (v) that the ASIC has allowed companies like the Complainant "to register Generic Business names, which has resulted in disputes such as this one to arise". The First Respondent sent a second email to the Center on February 23, 2023, informing the Center that a lawyer previously representing them was no longer doing so.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

Once the Second-Level Domain ("2LD") ".com" and the ccTLD ".au" are ignored (which is appropriate in this case), the First Disputed Domain Name consists of the Complainant's registered word trademark EASTERN GARAGE DOORS, without the letter "s", and followed by the word "repairs". The singular version of the Complainant's trademark is recognizable within the disputed domain name. The addition of the word "repairs", which is descriptive of the Complainant's business, does not avoid a finding of confusing similarity of the disputed domain name with the Complainant's trademark.

Once the 2LD ".com" and the ccTLD ".au" are ignored (which is appropriate in this case), the Second Disputed Domain Name consists of the Complainant's registered word trademark EASTERN GARAGE DOORS, without the letter "s", preceded by the word "south", and followed by the word "repairs". The singular version of Complainant's trademark is recognizable within the disputed domain name. The addition of the word "repairs" and of the geographical word string "south" do not avoid a finding of confusing similarity of the disputed domain name with the Complainant's trademark.

Accordingly, the Panel finds that both the First Disputed Domain Name and the Second Disputed Domain Name are confusingly similar to a trademark in which the Complainant has rights.

### **B. Rights or Legitimate Interests**

Ascertaining the full, true factual background to this dispute has been hampered by the existence of numerous inconsistencies, errors and omissions in the Complaint, which are identified in section 4 above and section 6C below.

The substance of the Complainant's assertion that the Respondents have no rights or legitimate interests in the disputed domain names is that the Respondents are not commonly known by, and have no trademark rights in, the disputed domain names; that the Complainant has not licensed the Respondents to use the Complainant's trademarks; and that the Respondents offer the same services as the Complainant, and a consumer may mistake those services as coming from the same source as the Complainant, or may be diverted away from the Complainant.

Although brief and informal in nature, the First Respondent's communication asserted that the Respondents have been providing their services as "Eastern Garage Door Repairs" for well over 20 years, to thousands of customers in the eastern suburbs, from an office and a factory located in the south-eastern suburbs of Melbourne. In substance, this is an assertion that the Respondent has rights or legitimate interests in the disputed domain names because they are descriptive of the businesses conducted by the Respondents – namely, repair of garage doors in the eastern and south-eastern suburbs of Melbourne. The contents of the websites resolving from the disputed domain names, which are described in section 4 above, support this assertion.

The Complainant bears the burden of establishing, on the balance of probabilities, that the three requirements for a remedy under the Policy are satisfied. With respect to the requirement that the Respondent has no rights or legitimate interests in the disputed domain names, the Complainant is required to establish a *prima facie* case to that effect. Once such a *prima facie* case is established, the burden of production shifts to the Respondent, requiring it to provide evidence or plausible assertions demonstrating rights or legitimate interests in the disputed domain names. See auDA Overview of Panel Views on Selected auDRP Questions First Edition (“auDA auDRP Overview 1.0”), section 2.1.

It is not certain that the Complainant’s bare assertions described above are sufficient to establish even a *prima facie* case that the Respondents lack rights or legitimate interests in the disputed domain names. The disputed domain names are highly descriptive. In particular, the disputed domain names are highly descriptive of the Respondents operations. Even if the Complainant is considered to have established a *prima facie* case, the Respondents have provided plausible assertions that they have rights or legitimate interests in the disputed domain names, on the basis that the disputed domain names accurately describe the nature of their business. These plausible assertions are supported by evidence in the case file – namely, the screenshots of the Respondents’ websites that were provided by the Complainant.

Accordingly, the Panel finds that the Complainant has not established, on the balance of probabilities, that the Respondents do not have rights or legitimate interests in the disputed domain names. Thus, the Complaint fails.

### **C. Registered or Subsequently Used in Bad Faith**

Given that the Complaint fails for the reason described in section 6B above, it is not necessary for the Panel to decide on the issue of whether the disputed domain names were registered or used in bad faith. Nevertheless, the Panel makes the following observations on this issue, for completeness.

The Complainant asserted that the Respondents had registered 443 domain names, several of which are the registered trademarks of established businesses. However, the evidence provided in support of this assertion was incomplete. The evidence was a Domain Tools report listing domain names, the Whois records for which contained the string “AGG DOORS”. The Panel has reviewed the provided list, and notes that the vast majority of the listed domain names are comprised of wholly descriptive terms – of which, the following are representative examples: <24hourgaragedoor.repair>, <boomgate.services>, <commercialdoorrepairsmelbourne.com.au>, and <diygaragedooropeners.net>. While the Complainant stated that its evidence also contained “a selection of trade mark registrations owned by third parties and which are included in these domain names”, there was in fact no trademark registrations included.

In summary, the evidence provided by the Complainant does not establish its assertion that the Respondents trade on the reputations of competitors and block those competitors from securing domain names consistent with their branding.

## **7. Decision**

For all the foregoing reasons, the Complaint is denied.

*/Andrew F. Christie/*

**Andrew F. Christie**

Sole Panelist

Date: March 22, 2023