

## **ADMINISTRATIVE PANEL DECISION**

SAP SE, SAP Australia Pty Ltd v. Namewise Pty Ltd  
Case No. DAU2023-0025

### **1. The Parties**

The Complainants are SAP SE, Germany and SAP Australia Pty Ltd, Australia, represented by Baker & McKenzie, Australia.

The Respondent is Namewise Pty Ltd, Australia.

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

The disputed domain name <sap.net.au> is registered with Fluccs - The Australian Cloud Pty Ltd (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 12, 2023. On May 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 15, 2023, 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" 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 May 22, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was June 11, 2023. The Respondent did not submit a response by this date. Accordingly, the Center notified the Respondent's default on June 13, 2023. On the same day after the Center's email, the Respondent sent an email to the Center stating that the Respondent wishes to respond and claiming that the Complainant's lawyers had a conflict of interest.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on June 22, 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.

In response to the Respondent's email, the Panel issued Panel Order No.1 inviting the Respondent to submit a supplemental filing by July 11, 2023, setting out:

- (a) whether or not a complaint about the alleged conflict has in fact been filed, when and with whom;
- (b) a detailed explanation of how the conflict is alleged to arise;
- (c) the Panel's powers in light of *R&M Italia SpA, Tycon Technoglass Srl v. EnQuip Technologies Group, Inc.* WIPO Case No. [D2007-1477](#) and *Symphony Holdings Limited v. Jaimie Fuller, Fuller Consultancy F.Z.E.* WIPO Case No. [D2019-2887](#);
- (d) what other, if any, matters the Respondent wishes to be heard on including a full explanation of why the Respondent failed to submit its Response, or raise the alleged conflict, before June 11, 2023.

The Respondent did not submit a supplemental filing or any other communication.

#### **4. Factual Background**

The Complainant (and its corporate group) provides information technology solutions for enterprises including ERP systems, CRM solutions, financial and other database and communications solutions.

According to the Complaint, the First Complainant was formed in 1972 in Germany. In 1988, the First Complainant was publicly listed on the Frankfurt and New York stock exchanges. Currently, it (including members of its corporate group) has more than 100,000 employees in more than 140 countries. The group's total revenue for FY 2021 was 27.84 billion Euros.

The Second Complainant is a wholly owned subsidiary of the First Complainant. The Second Complainant was first incorporated in Australia in 1988 under the name Revine Holdings Pty Ltd. From January 1989 to June 1994, its corporate name was SAP Australia Systems Applications and Products in Data Processing Pty Limited. Since June 1994, the Second Complainant's corporate name has been its current name, SAP Australia Pty Ltd.

The Second Complainant installed its first SAP branded system to a customer site in Australia in 1988. By 2010, the Complainants' business had over 92,000 customers. From 2015 to 2021, revenues generated by the Second Complainant rose from AUD 933,000,000 to AUD 1.167 billion. The Complaint includes some evidence of billboards and print ads published in March and July 2002. The Complainants also incurred over 1 million Euros in marketing and advertising expenditures in 2020.

The Complainants have also organized or sponsored a number of conferences related to the IT industry in Australia. These include the 1997 SAPPHIRE conferences in 1997 and 1999 at which over 2,000 users of the Complainants' SAP systems attended, an annual conference of the SAP Australian Users Group for each year since 1998 and sponsorships and promotional efforts at the 2018 World Business Forum Conference in Sydney, the 2019 Asia Pacific Cities Summit & Mayors Forum in Brisbane and the 2019 Gartner IT Symposium with some 2,000 attendees.

The Complaint also includes numerous examples of references to the Second Complainant and the Complainants' products in press and media articles in the period 2005 to 2010. The Panel notes most of the articles refer to "SAP Australia" but often include references to "SAP" products and services.

The Complainants have also been operating the Sapient College in Australia since 1998 in conjunction with a number of Australian colleges and universities to provide training and skills in the Complainants' products. This was the first SAP-specific college worldwide.

Amongst other things, the Second Complainant is the holder of the domain name <sap.com.au>. From about 2000, this domain name redirected to “www.sap.com/australia” and then “www.sap.com/australia/index”. That is still the case.

The Complaint includes evidence that the First Complainant owns a number of registered trade marks in Australia. For present purposes, it is sufficient to note:

- (a) Registered Trade Mark No 815843, SAP, which was filed and registered with effect from December 1, 1999, in respect of goods and services in International Classes 9, 16, 41 and 42; and
- (b) Registered Trade Mark No 865560, SAP superimposed over a black trapezium, which was filed and registered with effect from February 9, 2001 in respect of goods and services in the same International Classes.

Webcaptures by the Wayback Machine show that the trade mark in the figurative form of Trade Mark No 865560 appeared prominently on the website to which the domain name <sap.com.au> redirected at least between 2001 and 2010.

According to the Registrar, the disputed domain name was first created in May 2005 by an unknown previous registrant. However, the Registrar’s records show that the Respondent became the registrant of the disputed domain name on December 13, 2010.

The disputed domain name does not currently resolve to an active website. Captures by the Wayback Machine show that for a period in April 2018, at least, the disputed domain name resolved to a parking page which featured pay-per-click (PPC) links to “SAP Solutions”, “IT Consulting”, “SAP Training”, “Business Management”, “Software Solutions”, “SAP Software” and “On Demand Solutions”. The other “captures” between 2013 and March 2022 did not capture an active webpage or generated an Error Message.

## **5. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainants 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. Alleged conflict of interest**

In its email on June 11, 2023, the Respondent claimed it was in the process of filing a complaint with “a law institute”<sup>1</sup> against the Complainant’s legal representative on the basis of an alleged conflict of interest on the grounds that the legal representative had acted for the Respondent over a number of years.

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<sup>1</sup> By “a law institute”, the panel understands the Respondent to be referring to a representative body for solicitors in one or other State or Territory which has a role in, amongst other things, maintaining professional and ethical standards for the practice of law. In some States and Territories, this body is named a “Law Society”.

As noted above, the Respondent has not provided any further details about this allegation.

In *R&M Italia SpA, Tycon Technoglass Srl v. EnQuip Technologies Group, Inc.* WIPO Case No. [D2007-1477](#), Sir Ian Barker addressed a similar allegation. In that decision, the learned panelist said:

“Unlike a Court, the Panel has no jurisdiction or control over the legal representatives of parties to a dispute under the Policy. The most the Panel can do is what it did in this case – draw the Respondent’s views to the attention of the Complainant. Having considered the responses of both parties to the Procedural Order, the Panel does not express a view on the alleged conflict of interest and proceeds to deal with the Complaint on the merits.”

Subsequently, a three-member panel accepted a similar approach in *Symphony Holdings Limited v. Jaimie Fuller, Fuller Consultancy F.Z.E.* WIPO Case No. [D2019-2887](#).

Whether or not the Complainant’s legal representative does in fact have a conflict of interest is not something the Panel is in a position to resolve. The Complainant and its legal representatives have been put on notice of the Respondent’s allegations and have not seen any reason to withdraw. Nor is there any evidence before the Panel that the Respondent has in fact made the foreshadowed complaint let alone the appropriate regulatory body making a determination that there is in fact a conflict. In circumstances where the Respondent has not taken up the opportunity to provide details of its bare allegation and address the Panel’s powers under the Policy, it is not appropriate for the Panel to depart from the position taken in such long standing decisions.

Accordingly, the Panel will deal with the Complaint on its merits.

## **B. Identical or Confusingly Similar**

The first element that the Complainants must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainants’ name, trade mark or service mark.

There are two parts to this inquiry: the Complainants must demonstrate that they (or one of them) has rights in a name, trade mark or service 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 mark.

The Complainants have proven that the First Complainant owns at least the two registered trade marks for SAP referred to in section 4 above, noting that Trade Mark No 865560 is for a figurative mark.

The Complainants also contend that they have a reputation in SAP in Australia sufficient to confer rights in that term under the Policy as a common law or unregistered trade mark. The materials in the Complaint establish the existence of the reputation when the Complaint was filed.

While the Complaint does not include statistics for the number of customers or revenues or promotional expenditures in Australia immediately prior to 2010 when the Respondent registered the disputed domain name, such proof is not strictly necessary under this requirement of the Policy.<sup>2</sup> However, the Panel considers the information provided sufficiently establishes the Complainants’ claim for the purposes of the Policy at that earlier date also. In that connection, the Panel is aware that the Federal Court of Australia found that the Complainants had a considerable favourable reputation in SAP as the supplier of ERP software and related products in Australia in 1999. See *SAP Australia Pty Ltd v Sapient Australia Pty Ltd* [1999] FCA 1821 at [28]. The materials in the Complaint provide a sufficient basis to infer that reputation continued to subsist and develop after that date continuing through to today.

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 Complainants’ trade marks: see for example,

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<sup>2</sup> Overview of Panel Views on Selected auDRP Questions, Second Edition (“auDRP Overview 2.0”), section 1.3.

*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, “.net.au”, as a functional component of the domain naming system. See for example auDA Overview of Panel Views on Selected auDRP Questions Second Edition (“auDRP Overview 2.0”), section 1.11.

It is also usual to disregard the design elements of a trade mark under the first element as such elements are generally incapable of representation in a domain name. See for example, auDRP Overview 2.0, section 1.10.

The disputed domain name therefore consists of the First Complainant’s registered trade marks and the Complainants’ common law trade mark. 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.

### **C. Rights or Legitimate Interests**

The second requirement the Complainants 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.

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.*, auDA Overview 2.0, section 2.1.1.

In the present case, the Respondent registered the disputed domain name well after the Complainants’ acquired their registered and common law rights.

Further, the disputed domain name is not derived from the Respondent’s name or any other name of which there is evidence showing the Respondent is commonly known by. Nor does it appear that the Respondent

holds any trade mark rights in or from which the disputed domain name can be derived. Mere registration of the disputed domain name does not confer such rights without use.

Further still, the Respondent is not associated with the Complainants, or their corporate group, and has not been authorised by the Complainants to register or use the disputed domain name.

Yet further still, there is no evidence of any use of the disputed domain name in connection with a good faith offering of goods or services, or of some legitimate non-commercial or other fair use, or of demonstrable preparations for such use.

The only evidence of use before the Panel is the period when the disputed domain name resolved to a PPC page. The PPC page included links to products and services which were not the Complainants' services and potentially competitive with the Complainants. While "sap" is a dictionary word, the use in connection with IT and business management services has nothing to do with the ordinary meaning of that word. In these circumstances, the use does not qualify a good faith offering of goods or services under the Policy. See e.g. auDA Overview 2.0, section 2.9.

These matters are sufficient to raise a strong *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent has not sought to rebut that *prima facie* case. Accordingly, the Panel finds the Complainants have established the second requirement under the Policy also.

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

Under the third requirement of the Policy, the Complainants must establish that the disputed domain name has been either registered or subsequently used in bad faith by the Respondent. In contrast to the Uniform Domain Name Dispute Resolution Policy, the requirements of registration or use are disjunctive. It is necessary for the Complainants to establish only one or the other.

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.

The evidence of the Complainants' substantial reputation in Australia referred to above provides a basis for inferring the Respondent was aware of the Complainants' trade mark when registering the disputed domain name.

The Complainants also point out that the Respondent has been found to have engaged in abusive registrations targeting third parties' trade marks in two prior decisions: *Mayne Pharma International Pty Ltd. v. Namewise Pty Ltd*, WIPO Case No. [DAU2012-0001](#) and *L'Oreal / L'Oreal Australia Pty v. Namewise Pty Ltd. / Nicholas Bolton*, WIPO Case No. [DAU2013-0009](#). In addition to the domain names in issue in those cases, the panelist in the second of those decisions pointed out:

"the Complainant has provided damning evidence that the Respondent has been involved in a pattern of abusive registration, infringement and cybersquatting. Whois entries show that the Respondent has registered many domain names incorporating famous and distinctive trademarks such as "BLACKBERRY", "CHANEL", "FACEBOOK", "HOTMAIL", "MACBOOK", "MARVEL", "MTV", "NINTENDO", "STAR-WARS" and "TWITTER". The Panel accepts that this constitutes a "pattern of conduct" of both the registration and use of a domain names to prevent the owner of that name, trademark or service mark from reflecting that name or mark in a corresponding domain name."

The disputed domain name does consist of a three letter, dictionary word. As noted above, however, there is no suggestion that the Respondent has purported to use the disputed domain name in connection with its dictionary meaning.

On the contrary, so far as the record in this proceeding shows, the Respondent has used the disputed domain name only in connection with PPC links to businesses in competition with the Complainants. That use was not a good faith offering of goods or services under the Policy but, on the contrary, constitutes use in bad faith.

The use for PPC links may have been for a short period only and appears to have ceased. However, it is well-established that passive holding of a domain name does not prevent a finding of bad faith. See *e.g.*, auDA Overview 2.0, section 3.3.1. In the present case:

- (a) the Complainants' trade mark is well known;
- (b) the Respondent has not provided credible evidence of any actual or contemplated good faith use;
- (c) the Respondent has engaged in pattern of registering others' trade marks as domain names; and
- (d) the Respondent has attempted, at least for a period, to exploit the disputed domain name as a link farm with PPC links.

Accordingly, the Panel finds that the Respondent has at least used the disputed domain name in bad faith contrary to the Policy.

Therefore, 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 disputed domain name, <sap.net.au>, be transferred to the Second Complainant.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: July 17, 2023