

## **ADMINISTRATIVE PANEL DECISION**

**Bridgestone Mobility Solutions B.V. v. Smartfleet Management Pty Ltd**  
Case No. DAU2023-0036

### **1. The Parties**

The Complainant is Bridgestone Mobility Solutions B.V., Netherlands (Kingdom of the), represented by Bird & Bird, Australia.

The Respondent is Smartfleet Management Pty Ltd, Australia, represented by King & Wood Mallesons, Australia.

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

The disputed domain name <webfleet.com.au> is registered with Corporation Service Company (Australia) Pty Ltd (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 8, 2023. On August 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 11, 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”), 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 August 14, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was September 3, 2023. The Response was filed with the Center on September 3, 2023.

The Center appointed Andrew F. Christie as the sole panelist in this matter on September 15, 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, a subsidiary of Bridgestone Europe NV/SA, is a leading telematic solution provider specializing in fleet management, vehicle telematics, and connected car services. The Complainant provides its goods and services under, or by reference to, the Trade Mark WEBFLEET to over 50,000 customers worldwide and in more than 100 countries.

Since early 2012, the Complainant (through its predecessor in title up to 2019) has continuously and extensively provided its goods and services under, or by reference to, the trademark WEBFLEET in Australia. The Complainant has partnered with over 12 certified integration partners across Australia that provide end to end service to the Complainant's customers, including sales, installation, and in-life service care for the WEBFLEET products.

The Complainant is the owner of the trademarks WEBFLEET and WEB FLEET in over 38 designations, including Australia, New Zealand, United Kingdom, and the European Union, with the earliest trademark registration having a priority date of December 9, 1999. In Australia, the Complainant is the owner of two registrations for the word trademark WEBFLEET: (i) Australian Trade Mark No. 1538465 (entered on the Register on August 13, 2014, and registered from April 13, 2012, in classes 7, 9, 35 and 38); and (ii) Australian Trade Mark No. 2071917 (entered on the Register on September 2, 2020, and registered from November 14, 2019, in classes 9, 35, 36, 37, 38, 39 and 42).

In February 2000, the Complainant's predecessor in title obtained a licence for the domain name <webfleet.com> to promote and advertise its goods and services under the WEBFLEET trademark. Since then, the Complainant has used the domain name <webfleet.com> for the website through which it promotes, advertises, and offers for sale its goods and services under or by reference to the WEBFLEET trademark.

The Respondent is an Australian company incorporated in New South Wales on March 3, 2010. The Respondent is a provider of fleet management and other related services to Australian businesses.

In or around 2002, the Respondent's predecessor in title, Web-Ezi Pty Ltd ("Web-Ezi") commenced operation of a business under the trademark WEBFLEET, providing vehicle fleet management services. On June 11, 2002, Web-Ezi registered the disputed domain name and around that time commenced operation of a website for its business using the disputed domain name. On August 23, 2006, Web-Ezi filed Australian Trade Mark application No. 1131130 for the word trademark WEBFLEET in classes 35 and 39. The application proceeded to registration on April 2, 2007, and the trademark remained registered until August 2016, when the registration was not renewed.

By way of an asset sale agreement dated February 9, 2010, between Web-Ezi and the Respondent's ultimate holding company, the Respondent acquired all of Web-Ezi's rights, title, and interest in the WEBFLEET Trade Mark in Australia, including all associated goodwill, Australian business names, domain names (including the disputed domain name), unregistered trademarks, and registered trademarks (including Australian Trade Mark No. 1131130 for the word trademark WEBFLEET).

In 2014, the Respondent rebranded the majority of its services from WEBFLEET to SMARTFLEET AUSTRALIA. However, the Respondent continued to conduct some of its business, and maintain some of its commercial relationships under and by reference to the WEBFLEET trademark in Australia. The Respondent is the registrant of the Australian business names "Webfleet Management services" (registered since 2002) and "Webfleet" (registered since 2010).

The Complainant provided a screenshot, dated April 6, 2023, of the website to which the disputed domain name then redirected, being the Respondent's website at "www.smartfleet.com.au". As of the date of this decision, the disputed domain name redirects to that website.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant asserts that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights, contending as follows. The disputed domain name contains the Complainant's WEBFLEET trademark in its entirety. The domain denominator ".com.au" does not affect the identity of the disputed domain name with the Complainant's trademark.

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name, contending as follows. The Respondent does not have any Australian trademark registration for the trademark WEBFLEET. The Respondent's registration of the "Webfleet" business name does not, of itself, establish that the Respondent has any rights or legitimate interests in the WEBFLEET trademark. There is no relationship or affiliation between the Complainant and the Respondent. The Respondent is not using the disputed domain name in connection with the *bona fide* offering of goods or services; rather it is using the disputed domain name to automatically redirect users to its own website.

The Complainant asserts that the Respondent registered or has used the disputed domain name in bad faith, contending as follows. The Complainant, and its goods and services under the WEBFLEET trademark, are well-known in Australia and internationally. The Respondent acquired the disputed domain name almost three years after the Complainant first used and registered its WEBFLEET trademark. The Respondent ought reasonably to have been aware of the Complainant's rights in the WEBFLEET trademark. The Respondent's use of the disputed domain name to direct Internet traffic to the Respondent's website at "www.smartfleet.com.au" evidences a clear intention to disrupt the Complainant's business, to divert consumers from the Complainant's website to the Respondent's website, to mislead and deceive consumers that are looking for the goods and services provided by the Complainant under, or by reference to, its WEBFLEET trademark, and to get those consumers to transfer their business to the Respondent for commercial gain.

### **B. Respondent**

The Respondent does not deny that the disputed domain name is identical to the WEBFLEET Trade Mark in which the Complainant claims rights.

The Respondent asserts that it has rights and legitimate interests in the disputed domain name, which pre-date the alleged rights of the Complainant and which continue to this day, contending as follows. The Respondent's extant and continually maintained rights and legitimate interests in the disputed domain name date back to as early as 2002, a decade prior to the date from which the Complainant claims its earliest rights in Australia. The Respondent has at all times since it acquired its rights in the WEBFLEET Trade Mark from Web-Ezi used that trademark in the course of its business; and, accordingly, it has and maintains rights and legitimate interests in the disputed domain name. While a business name registration is not by itself evidence of ownership or of rights in a particular name, it can, and in most cases does, indicate that a business name registrant is carrying on business in Australia under that name. Due to the substantial goodwill and reputation the Respondent developed in its WEBFLEET Trade Mark in Australia, at least some of the Respondent's longstanding customers and suppliers continue to refer to the Respondent by reference to the WEBFLEET Trade Mark, and continue to access the Respondent's website via the disputed domain name. For these reasons, the Respondent has never ceded, relinquished, or otherwise abandoned its rights and interests in the WEBFLEET trademark, and has not allowed its registration of the disputed domain name to lapse.

The Respondent asserts that it did not register and has not used the disputed domain name in bad faith, contending as follows. A consideration of the totality of the facts shows that there is plainly no evidence whatsoever of any bad faith conduct by the Respondent and, on the contrary, ample evidence that it has acted at all times in good faith. The Respondent's predecessor in title registered the disputed domain name

in good faith many years before any use of, or development of alleged rights in, the WEBFLEET trademark in Australia by the Complainant. As the successor in title to the first user of the WEBFLEET trademark in Australia, the Respondent is the rightful owner of the WEBFLEET trademark in Australia. In any event, the Respondent's predecessor in title, and more recently the Respondent, has since 2002 continually used the disputed domain name in good faith in relation to its business.

## **6. Discussion and Findings**

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

Once the namespace “.com.au” is ignored (which is appropriate in this case), the disputed domain name consists solely of the Complainant's registered word trademark WEBFLEET. Accordingly, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name. While the overall burden of proof in proceedings under the Policy is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See Overview of Panel Views on Selected auDRP Questions, Second Edition (“auDRP Overview 2.0”), section 2.1.1.

The Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, by establishing that: (i) the disputed domain name is identical to the WEBFLEET trademark in which the Complainant has rights; (ii) that the Respondent does not have any Australian trademark registration for the WEBFLEET trademark; and (iii) that the Respondent does not have any relationship or affiliation with the Complainant. However, the Respondent has met its burden of production of relevant evidence which demonstrates that it does have rights or legitimate interests in the disputed domain name. The Respondent has produced evidence that it was the owner of an Australian trademark registration for the word trademark WEBFLEET, that was filed in August 2006, entered on the Register in April 2007, and which lapsed due to non-renewal in August 2016. That evidence is consistent with and supports the Respondent's assertion that it acquired the WEBFLEET trademark from Web-Ezi in 2010, along with associated goodwill and domain names (including the dispute domain name). The Respondent has also produced evidence that it used “Webfleet” as one of its trading names. While that evidence is rather slight – a provision in its “Approved repairer terms and conditions” which defines “Smartfleet” to mean “Smartfleet Management Pty Ltd (ABN 99 142 370 643) trading as Smartfleet, Webfleet and AVC Fleet” – it is consistent with and supports the Respondent's assertion that at least some of its customers and suppliers continue to refer to the Respondent by reference to its (now unregistered) WEBFLEET Trade Mark. This evidence is consistent with and supports the Respondent's assertion that it maintains business name registrations for or including the word “Webfleet” because it trades under that name.

On balance, the Panel is satisfied that the Respondent has rights or legitimate interests in the disputed domain name, which exist by virtue of the continuing reputation in the trading name “Webfleet” that has arisen from and been retained through the Respondent's use of the WEBFLEET trademark, even after its registration for that trademark was not renewed. Accordingly, the Panel finds that the Complainant has not established the second element of the Policy. The Complaint therefore fails.

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

Given the above finding, it is not strictly necessary for the Panel to make any finding on the third element of the Policy. However, it will proceed to do so because an assertion of bad faith is, as the Respondent notes in the Response, a serious allegation and the Respondent provided contentions and evidence to rebut the Complainant's case on this issue.

The Complainant's first registration and use of the WEBFLEET trademark in Australia was in early 2012, a decade after the disputed domain name was first registered (presumably by the Respondent's predecessor in title, Web-Ezi), and two years after the asset sale agreement by which the Respondent acquired the disputed domain name from Web-Ezi. Whether the date of the Respondent's registration of the disputed domain name is considered to be the date of its initial registration or the date of its acquisition from Web-Ezi, there is no basis for a finding that the Respondent registered the disputed domain name in bad faith.

Furthermore, for the reasons explained in the section immediately above, the Respondent has a continuing reputation in the "Webfleet" trading name that has survived the non-renewal of its WEBFLEET trademark. In those circumstances, the Respondent's use of the disputed domain name to redirect to its website at "www.smartfleet.com.au" is not a bad faith use of the disputed domain name.

### **7. Decision**

For all the foregoing reasons, the Complaint is denied.

*/Andrew F. Christie/*

**Andrew F. Christie**

Sole Panelist

Date: September 29, 2023