

ADMINISTRATIVE PANEL DECISION

Eight Advisory v. Huang, Tongli
Case No. DAU2023-0044

1. The Parties

The Complainant is Eight Advisory, France, represented by Cabinet Regimbeau, France.

The Respondent is Huang Tongli, Australia, self-represented.

2. The Domain Name and Registrar

The disputed domain name <8advisory.com.au> 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 29, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 5, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent (HUANG, Tony) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 13, 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 amended Complaint on October 17, 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 October 18, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was November 7, 2023. The Respondent sent no formal response but did send an informal communication on October 23, 2023. Accordingly, the Center notified the commencement of panel appointment process on November 8, 2023. The Respondent sent another informal communication on November 9, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on November 13, 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 a French company that provides financial, operational, and strategic consulting services. Its company name "Eight Advisory" is registered with the Tribunal de Commerce de Paris. The Complainant holds multiple trademark registrations, including the following:

- International trademark registration number 1042821 for a semi-figurative mark featuring the numeral 8 in a square and the words "Eight Advisory", registered on April 21, 2010, designating multiple jurisdictions, including Australia, where it was entered on the register on November 22, 2010 under trademark number 1373112, specifying services in classes 35 and 36; and

- International trademark registration number 1050812 for 8 ADVISORY, registered on April 21, 2010, designating multiple jurisdictions, including Australia, where it was entered on the register on February 14, 2011 under trademark number 1388232, specifying services in classes 35 and 36.

The above trademark registrations are current. The Complainant also registered the domain name <8advisory.com> on July 31, 2009 that it uses in connection with a website where it provides information about itself and its services.

The Respondent, Huang Tongli, also known as Tony Huang, is a public practising accountant and registered tax agent. According to information provided by the Registrar from the Australian Securities and Investments Commission ("ASIC") database, Mr. Huang is the registrant of the business names "Success Mobile Bookkeeping" (since 2011) and "success bookkeeping services" (since 2016). He submits that he incorporated the Australian company named "8 Advisory Pty Ltd", which was registered with ASIC on October 18, 2018.

The disputed domain name was registered on September 27, 2018. The disputed domain name resolves to a website titled "8 Advisory" for a "boutique accounting and advisory practice with a passion and focus on helping small to medium sized business" based in Perth, Western Australia. The homepage prominently displays a logo featuring the numeral 8 in a circular figure alongside the word "Advisory" and, in smaller font underneath, the words "Accountants & Advisors". The director is Tony Huang. The website displays the logos of various professional bodies, including CIMA (the Chartered Institute of Management Accountants), the Institute of Public Accountants, and the Tax Practitioners Board.

The Complainant sent a cease-and-desist letter by email to the Respondent on November 15, 2022. The Respondent replied by email on December 6, 2022 from an address using the disputed domain name. The Complainant sent a reminder on December 12, 2022, and the Respondent replied by email the following day, advising that he had forwarded the letter to his lawyer for review.

5. Parties' Contentions

A. Complainant

The disputed domain name identically reproduces the Complainant's prior rights in the denomination 8 ADVISORY and the Complainant's prior domain name <8advisory.com>.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has no connection with the Complainant in any way. It is not an authorized dealer, distributor or licensee of the Complainant and has not been permitted by the Complainant to make any use of its prior rights. The Respondent does not have prior rights on the term "8 Advisory" nor is it commonly known under this name, whether as an individual, as a company or as another organization. The disputed domain name is used to provide services identical to those of the Complainant. The Respondent has violated the Registration Agreement as he did not take reasonable steps such as an Internet search that would inform him of the Complainant's prior rights.

The disputed domain name was registered and is being used in bad faith. The Complainant is a well-known and worldwide company, present in over 30 countries, including Australia. The Respondent should have clearly been aware of the Complainant's prior rights on the 8 ADVISORY trademark and domain names. The Respondent had actual knowledge of the Complainant's prior rights because 8 ADVISORY has been identically reproduced in the disputed domain name. The disputed domain name is used with a website providing services identical to those of the Complainant. Both Parties provide financial and related services.

B. Respondent

The Respondent submits that he registered the company name 8 Advisory Pty Ltd and the disputed domain name in 2018. He did not have any issues registering this company name with ASIC. He operates a small family business based in Perth. The company name and disputed domain name "8 Advisory" is quite different from the French company name "Eight Advisory". The Respondent does not think he has any disputes regarding the disputed domain name, because the nature and scope of the Complainant's services are totally different from the scope of his work. The Complainant is also based in France and does not provide any services to Australian companies.

6. Discussion and Findings

Paragraph 4(a) of the auDRP provides that a complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a name, trademark 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.

The burden of proof of each element is borne by the Complainant.

A. Identical or Confusingly Similar

Based on the evidence presented, the Panel finds that the Complainant has rights in the 8 ADVISORY mark.

The Complainant also bases its claim on its French company name "Eight Advisory". The Respondent submits that the disputed domain name is quite different from that company name. The Panel recalls that, according to Note 1 to the auDRP, a "name ... in which the complainant has rights" may refer to the complainant's company, business or other legal or trading name where such name is registered with "the relevant Australian government authority". In the present case, the Complainant's company name is registered with the Tribunal de Commerce de Paris, which is not an Australian government authority. Nothing on the record indicates that the company name is registered with any Australian government authority. Accordingly, the Panel does not consider that the Complainant's company name is a name in which it has rights for the purposes of the first element of paragraph 4(a) of the auDRP.

The Complainant also bases its claim on its own domain name <8advisory.com>. However, the Complainant does not assert that it has used its domain name as a trading name, nor does it allege that its domain name functions as an unregistered mark. Accordingly, the Panel does not consider that the Complainant's own domain name is a name in which it has rights for the purposes of the first element of paragraph 4(a) of the auDRP.

The disputed domain name wholly incorporates the Complainant's 8 ADVISORY mark. The only additional element is the extension ".com.au", which may be disregarded in the comparison between a disputed domain name and a trademark for the purposes of the auDRP. See *BT Financial Group Pty Limited v. Basketball Times Pty Ltd*, WIPO Case No. [DAU2004-0001](#).

Therefore, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the auDRP.

B. Rights or Legitimate Interests

Paragraph 4(c) of the auDRP sets out circumstances which, without limitation, if found by the Panel to be proven based on its evaluation of all evidence presented, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the auDRP:

- (i) before any notice to [the respondent] of the subject matter of the dispute, [the respondent's] *bona fide* use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with an 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) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark 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 trademark or service mark at issue.

As regards the first and third circumstances set out above, the Respondent uses the disputed domain name to resolve to a website that offers accounting and advisory services. The disputed domain name comprises the Complainant's 8 ADVISORY mark with only the extension ".com.au", giving the impression that it will resolve to an Australian website affiliated with, or operated or endorsed by, the Complainant. The website prominently displays a logo that features the numeral "8" alongside the word "Advisory" which, although different from the Complainant's logo, is likely to cause confusion at least as to whether the website is affiliated with, or endorsed by, the Complainant. Yet the Complainant submits that the Respondent has no connection to it in any way. In the Panel's view, these circumstances indicate that the Respondent is not making a *bona fide* use of the disputed domain name in connection with an offering of goods or services, nor is it making a legitimate noncommercial or fair use of the disputed domain name.

As regards the second circumstance set out above, the Respondent's name is listed in the Registrar's Whois database as "Huang Tongli" and he is introduced on his website "Tony Huang", which is also how he signs correspondence. Mr. Huang has also registered two Australian business names. However, none of these names resembles the disputed domain name.

Based on the above, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Respondent replies that he registered the Australian company name "8 Advisory Pty Ltd" in 2018. The Panel has verified that this company name is current and is willing to accept at face value that the

Respondent is a director of that company.¹ While 8 Advisory Pty Ltd may be under the effective control of the Respondent, the mere fact of a name registration does not demonstrate that any party is “commonly known” by that name within the terms of paragraph 4(c)(ii) of the auDRP. Nothing on the record indicates that the Respondent has used his company name, even on his website. Moreover, information provided by the Registrar indicates that the Respondent has registered two business names different from the company name, which he may use instead. Based on this record, the Panel is unable to conclude that the Respondent (as an individual, business, or other organization) is commonly known by the disputed domain name.

The Respondent also submits that the nature and scope of the Parties’ respective services are different. However, the Panel notes that the Parties’ services are both in the financial sector and, if not quite the same, they are at least similar. In any case, the incorporation of the Complainant’s mark in the disputed domain name with only the extension “.com.au” creates a high risk of implied affiliation even before an Internet user reaches the Respondent’s website.

The Panel has taken note that the word “advisory” in the disputed domain name and on the Respondent’s website is descriptive of his services. However, the combination of the numeral “8” with that word is not descriptive but rather distinctive.

Accordingly, the Panel finds that the Respondent has not rebutted the Complainant’s *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the auDRP.

C. Registered or Subsequently Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

(iv) by using the domain name, [the respondent has] 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.

The disputed domain name was registered in 2018, years after the Complainant obtained its trademark registrations, including in Australia, where the Respondent is based. The combination of the numeral “8” with the word “Advisory”, as in the trademark, is distinctive. The Complainant does not substantiate its assertion that it does business in Australia, which the Respondent disputes, but the Complainant does show that it has a considerable online presence. The disputed domain name (excluding the extension) is an exact match with the Complainant’s trademark, incorporating eight as a numeral, like the trademark and also like the Complainant’s domain name. Further, the Parties both operate in the financial sector, albeit with different business models, which increases the likelihood that the Respondent was aware of the Complainant and its mark prior to registering the disputed domain name. The Respondent provides no alternative explanation for his choice to register the disputed domain name. Nor does he provide any explanation for his choice to register the corresponding company name three weeks later, other than that it was available. In these circumstances, the Panel considers it more likely than not that the Respondent had the Complainant’s mark in mind at the time when he registered the disputed domain name.

As regards use, the disputed domain name wholly incorporates the Complainant’s 8 ADVISORY mark with nothing more than the “.com.au” extension. The associated website offers accounting and advisory services

¹The Panel notes its general powers articulated *inter alia* in paragraph 10 of the Rules and has searched the publicly available ASIC Australian company database in order to verify the Respondent’s reference to this company name. The Panel considers this process of verification useful in evaluating the merits of this dispute.

that are in the same sector as those that the Complainant offers, for commercial gain. Although the Respondent's website does not display the Complainant's logo or its name (Eight Advisory), the website prominently displays a logo that features the constituent elements of the Complainant's mark, i.e., the numeral 8 alongside the word "Advisory". Instances of actual consumer confusion are not essential to demonstrate the Respondent's intention. In view of all these circumstances, the Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's mark as to the affiliation or endorsement of that website or of the services on that website within the terms of paragraph 4(b)(iv) of the auDRP.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) of the auDRP.

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, <8advisory.com.au>, be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: November 24, 2023