

ADMINISTRATIVE PANEL DECISION

Dukes Weight Loss Pty Ltd v. Ollority Pty Ltd
Case No. DAU2023-0047

1. The Parties

The Complainant is Dukes Weight Loss Pty Ltd, Australia, represented by Norton Rose Fulbright LLP, Australia.

The Respondent is Ollority Pty Ltd, Australia.

2. The Domain Name and Registrar

The disputed domain name <dukes.com.au> is registered with Micron21 Data Centre Pty Ltd (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 24, 2023. On October 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 31, 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 October 31, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was November 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 21, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on November 23, 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.

Subsequently, on November 23, 2023, the Center received an email from the Respondent requesting an extension of time to file a Response due to the hospitalisation of the Respondent's sole director. The email foreshadowed that the Respondent intended to defend the Complaint based on holding the disputed domain name for more than 20 years.

On November 24, 2023, the Panel issued Administrative Panel Order No. 1 providing the Respondent with an extension of time to file a Response until December 8, 2023, and any supplemental filing from the Complainant by December 15, 2023.

On December 8, 2023, the Center received an email from the Respondent referring to its attached Response. There was no attachment however – as pointed out by the Complainant in response to the Respondent's email.

In the absence of any further communication from the Respondent, on December 14, 2023, the Center sent an email to the Respondent informing it that, if it wished a Response to be taken into account by the Panel, it should be forwarded by reply. In the event, the Center received the Respondent's Response (apparently dated December 8, 2023) on December 18, 2023.

In view of the delay in receiving the Response, on December 19, 2023, the time for the Complainant to submit any comments was extended at the Complainant's request to December 23, 2023. A supplemental filing was received from the Complainant on December 22, 2023.

4. Factual Background

The Complainant was founded in Sydney, Australia in February 2022.

It operates an Australian-made and owned weight-loss system for both men and women. It promotes its products and services from a website at "www.dukesweightloss.com.au".

In February 2022, the Complainant registered 35 domain names based on "duke" or "dukes" such as <dukeclub.com.au>, <dukesshakeclub.com.au>, and <dukesshake.com>. The Complainant registered the domain name <dukesweightloss.com.au> on May 16, 2023, along with 24 other "duke" or "dukes" + "weight" formative domain names.

On September 29, 2022, the Complainant filed an application to register a trade mark in Australia, No. 2304279, DUKES SHAKE CLUB in respect of a range dietary and nutritional supplements products and services in, respectively, International Classes 5 and 44.

On October 21, 2022, the Complainant filed an application to register as a trade mark in Australia, No. 2309548, DUKES, in respect of dietary food supplements; dietary nutritional supplements; nutritional meal replacements including powders; beverages and dietary supplements for weight loss in International Class 5.

Both applications were entered on the Register of Trade Marks in July 2023 on the basis of the provisions of section 44(3)(b) of the Trade Marks Act 1995. That is, in the exercise of the Registrar's discretion on the basis of "other circumstances" making it proper to allow registration in the face of some prior conflicting registration or application.

The Complainant also has two other pending applications including Application No. 2356292, which is a divisional application from Trade Mark No. 2304279, and specifies dairy based beverages and powders, substitutes and non-alcoholic beverages and the like in International Classes 29 and 32 and retail and wholesale services, advertising and business management services in International Class 35.

The Complainant also claims unregistered rights in DUKES arising from its continuous use of the name “for the last 1.5 to 2 years” and the resulting reputation.

The Respondent claims it registered the disputed domain name on April 16, 2006. In support of that claim, the Respondent has submitted a report from auDA’s Domain Creation Date request service which states that the disputed domain name was created with the current Registrar on April 16, 2007.

According to the Response, the disputed domain name has resolved to webpages of many different iterations over the years from “full websites to default hosting pages to parking and pay-per-click domain monetisation pages (as it is today).”

When the Complaint was filed, the disputed domain name resolved to a page headed “DUKES.COM.AU”. Under this heading there were a number of “related searches”: “Shipstation Alternatives”, “Incident Mgmt”, and “Royalty”. (The page is partially truncated).

There is also a header at the top of this page in small type “Contact domain owner – This domain may be available for sale, lease or JV opportunity”. Clicking on this text resulted in a form headed “DUKES.COM.AU If you want to buy this domain, please fill out this form”.

Following the filing of the Complaint, the “This domain may be for sale” link has been removed from the website. The links on the page under related searches are to “Royalty”, “Duke of Cambridge”, and “Duke of Edinburgh”.

5. Discussion and Findings

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.

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. 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, 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 Complainant has proven that it owns the registered trade mark for DUKES, Australian Registered Trade Mark No. 2309548. “Dukes” is also part of its corporate name and Australian Registered Trade Mark No. 2304279 for DUKES SHAKE CLUB but, given Trade Mark No. 2309548, neither advances the Complainant’s position materially.

Typically and as is appropriate in this case, it is permissible to disregard the Second Level Domain (2DL), “.com.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.

Accordingly, the Panel finds that the disputed domain name is identical with the Complainant’s trade mark.

The Respondent disputes this conclusion pointing out that “duke” is an ordinary English word. The Respondent also points out that there are more than 80 trade marks registered in Australia for DUKE or which include the word “duke”. In addition, there are more than 200 current, active Australian Business Numbers for names which are, or include, “Dukes”. Accordingly, the Respondent contends that the Complainant does not have exclusive rights in “dukes” and, further, that the Complainant’s rights are limited to a very narrow field.

These matters are true but mistake the nature of the inquiry under the first requirement of the Policy which is essentially a standing requirement. 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.

Accordingly, the Complainant has established the first requirement under the Policy.

B. Registered or Subsequently Used in Bad Faith

In the circumstances of this case, it is appropriate next to consider the third requirement under the Policy.

Under the third requirement of the Policy, the Complainant 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 (“UDRP”), the requirements of registration or use are disjunctive. It is necessary for the Complainant to establish only one or the other. See auDA Overview 2.0, section 3.1.

Whether the disputed domain name registered in bad faith

In the present case, there can be no real suggestion that the Respondent registered the disputed domain name in bad faith. The uncontested evidence in this case is that the Respondent registered the disputed domain name in at least April 2007 (if not earlier). That is at least 15 years before the Complainant was founded and also before the Complainant started using DUKES as a trade mark in any form. In these circumstances, there is simply no basis for a finding that the Respondent registered the disputed domain name to take advantage of the Complainant’s trade mark.

The Complainant seeks to avoid this conclusion by pointing out that paragraph 4(b)(i) of the Policy is different to the corresponding provision under the UDRP as paragraph 4(b)(i) of the Policy requires only evidence indicating that the respondent registered or 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 out-of-pocket expenses directly related to the domain name. Paragraph 4(b)(i) of the UDRP, however, refers to transfer to “the Complainant” or “a competitor of the Complainant”. In its supplemental filing, the Complainant also points out that the Respondent appears to be the registrant of more than 8,000 domain names.

First, the Panel notes that paragraph 4(b) of the Policy, like paragraph 4(b) of the UDRP is not an exhaustive listing of the circumstances which may constitute registration and/or use in bad faith.

Secondly, the Respondent does contend that the disputed domain name has resolved over the years to various iterations of websites including “full websites to default hosting pages to parking and pay-per-click domain monetisation pages (as it is today)”. However, the Respondent has not provided evidence of these different types of websites. The only evidence before the Panel is the screenshot submitted by the Complainant and the current website.

On the other hand, that evidential gap applies equally to the Complaint. The Complainant has submitted evidence of the situation in October 2023. It has not provided evidence of the situation in 2007 or any of the 15 intervening years. This “gap” assumes significance in the present case for a number of reasons. First, assuming in the Complainant’s favour that the link “This domain may be for sale” is an offer of sale by the Respondent (as to which see auDA Overview 2.0, section 3.1.1), there is no evidence that the Respondent was “offering for sale” the disputed domain name when it registered the disputed domain name – to the Complainant or otherwise. On the contrary, the Respondent denies it was doing so, pointing out that registration for resale was prohibited under the auDA’s policy¹ when the disputed domain name was registered.

Next, as the Respondent points out, the eligibility requirements for registering a domain name in the “.com.au” 2LD expressly contemplated registration for domain “monetisation” purposes. Domain monetisation is defined for these purposes as “registering a domain name in order to earn revenue from a monetised website”.² This could be, for example, through conduct such as pay-per-click (“PPC”) advertising.

When the disputed domain name was registered and at least for many years subsequently, domain monetisation was permissible on two conditions where the disputed domain name was not otherwise closely and substantially connected with the name or trade mark of the registrant. The first condition required that “the content on the website to which the domain name resolves must be related specifically and predominantly to subject matter denoted by the domain name”. The second condition required that “the domain name must not be, or incorporate, an entity name, personal name or brand name in existence at the time the domain name was registered”.

There is no evidence before the Panel directed to either requirement and, for reasons already indicated, the Complainant’s own rights do not provide a basis for a finding of registration in bad faith.

That is not an end to the matter, however, since, as already noted, a finding in favour of the Complainant may be made where there has been use in bad faith even if the disputed domain name was not registered in bad faith.

Whether the disputed domain name has subsequently been used in bad faith

The evidence about the manner of use when the Complaint has been submitted has already been described. It must be said, the Panel has considerable difficulty accepting that links to “Shipstation Alternatives” or “Incident Mgmt” can be described as directed to the subject matter of “dukes”. That tends towards a finding of use in bad faith.

Against that, the Respondent denies knowledge of the Complainant and its trade mark. For reasons already given, that is an entirely credible claim at the time when the disputed domain name was registered.

While the Complainant does claim rights in “Dukes” as an unregistered trade mark, on its own admission it has been using the trade mark only for 1.5 to 2 years. There is no evidence about how extensively it has been used such as sales revenues or advertising expenditures or visitors to its website or similar metrics. In these circumstances, the Panel cannot find that the Complainant’s trade mark is so well known that the Respondent’s denial of knowledge of the Complainant should not be believed.

¹ 2005-02 5 Guidelines For Accredited Registrars On The Interpretation Of Policy Rules For Open 2LDS, paragraph 10.8 and 2005-05 Clarification of Domain Name License-Prohibition on Sale of Domain Name, section 2.

² For example, 2008-10 Guidelines on the Interpretation of Policy Rules for the Open 2LDs, paragraph 2.1 and 2012-05, section 11.

Further, there is no evidence that the Respondent has been using the disputed domain name to target the Complainant or its trade mark. So far as the record in this proceeding discloses, the Complainant's business is directed to weight loss products and programs. The PPC links on the page submitted by the Complainant or observed by the Panel in preparing this decision do not appear to have any relevance or application to such a business.

According to the Complainant, following the link on the Respondent's website for "This Domain may be for sale" leads to a webpage or communication that requires a minimum offer of USD 10,000 and so is an offer to sell the disputed domain name for more than the Respondent's out-of-pocket costs.

The screenshots included in Annex 4 to the Complaint do not include a requirement of a minimum offer of USD 10,000. In any event, the Respondent has submitted evidence of offers submitted to it before the Complaint was filed in which the offeror offered to pay USD 10,000 for the disputed domain name. It does not follow, however, that an offer to sell the disputed domain name for at least USD 10,000 indicates an attempt to take advantage of the disputed domain name's resemblance to the Complainant's trade mark when regard is paid to the nature of the disputed domain name as an ordinary English word, the large number of businesses in Australia whose names are or include "Duke" or "Dukes", the limited nature of the Complainant's business and the amounts of the apparently unsolicited offers.

The Complainant further contends that a finding of bad faith should follow within the meaning of paragraph 4(a)(iii) of the Policy on the basis that the Respondent's holding of the disputed domain name disrupts the Complainant's business. According to the Complainant:

"the Complainant is clearly conducting business in Australia and has both registered and unregistered rights in the DUKES trade mark and name. In this case, registration of the Domain Name clearly disrupts the Complainant's business in Australia by creating the potential for confusion amongst consumers. Intention to divert trade from the Complainant, in bad faith, can be inferred from the fact that the DUKES Mark and the Domain Name are identical".

The Complainant cites *Bernard Janes v. L.J. Bubenicek & A. J. Main, A&L Technologies*, WIPO Case No. [DAU2010-0014](#), in support of this proposition. That case, however, is a very different case to the present. The complainant in that case had been using its trade mark in the United Kingdom for a number of years prior to the registration of the disputed domain name and, amongst other things, the respondent in that case was associated with a United Kingdom competitor of the complainant and was seeking to establish a business in Australia under that competitor's trade mark, not the complainant's trade mark.

That is simply not this case. The disputed domain name is an ordinary dictionary word and, for the reasons already discussed, there is no basis on the record presented by the Complainant to find that the Respondent has been targeting the Complainant or its trade mark.

Finally, the Panel accepts that a finding that a respondent does not have rights or legitimate interests in a disputed domain name will often, if not usually, lead to a finding that the respondent has registered and/or used the domain name in bad faith.

The Panel makes no finding either way about rights or legitimate interests in this case. Instead, as the Complainant contends, such a conclusion typically follows from a finding that there is a lack of any credible explanation for the respondent's choice of the disputed domain name. That is especially the case where the disputed domain name incorporates a distinctive trade mark. But that is not this case. The Complainant's argument fails to address the fact that the disputed domain name was registered many years before the Complainant's trade mark was adopted; it fails to address the fact that the disputed domain name is also an ordinary dictionary word, and it fails to show that there has been any attempt to trade on the significance of the resemblance of the disputed domain name to the Complainant's trade mark.

For all of these reasons, the Panel finds that the Complainant has not established that the disputed domain name has been registered or used in bad faith.

Accordingly, the Complainant cannot establish all three requirements under the Policy.

C. Rights or Legitimate Interests

In light of the findings above, no useful purpose would be served by considering this requirement under the Policy.

D. Reverse Domain Name Hijacking

The Respondent contends that the Complaint has been brought in bad faith and, accordingly, the Complainant should be sanctioned by a finding of reverse domain name hijacking.

Paragraph 15(e) of the Rules provides, in part:

“If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.”

Paragraph 1 of the Rules defines “Reverse Domain Name Hijacking” to be “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name”.

The fact that a Complaint has failed is not in itself sufficient to warrant a finding of reverse domain name hijacking. The length of time the disputed domain name has been registered by the Respondent before the Complainant even came into existence let alone started using its trade mark is a very strong factor in favour of a finding of reverse domain name hijacking. On the other hand, the Panel has already referred to the difficulty in finding that the Respondent was using the disputed domain name in connection with its descriptive subject matter when the Complaint was filed. With more than a degree of hesitation, on balance, the Panel is not prepared to make a finding of reverse domain name hijacking in this case.

6. Decision

For all the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: January 5, 2024