

ADMINISTRATIVE PANEL DECISION

SawStop Holding LLC v. Mokse Pty. Ltd.

Case No. DAU2024-0011

1. The Parties

The Complainant is is SawStop Holding LLC, United States of America (“United States”), represented by TraskBritt, P.C., United States.

The Respondent is Mokse Pty. Ltd, Australia, internally represented.

2. The Domain Name and Registrar

The disputed domain name <sawstop.com.au> is registered with Domain Directors Pty Ltd (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 27, 2024. On March 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 1, 2024, 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 April 3, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was April 23, 2024. On April 23, 2024, the Respondent requested an extension to the Response due date. On May 4, 2024, the Center confirmed that the due date for Response was extended to May 7, 2024. The Response was filed with the Center on May 7, 2024. On May 10, 2024, the Complainant submitted supplemental filing. On May 17, 2024, the Respondent submitted supplemental filing.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on May 23, 2024. 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

According to its website at "www.sawstop.com", the Complainant is a manufacturer and distributor of table saws, woodworking, metalworking and related products, and claiming to be the leader in at least the United States market.

The affidavit of David Fanning filed in support of the Complaint states that he has been employed by the Complainant, as its General Counsel since 2000. The affidavit further states that the Complainant and its subsidiary, SawStop, LLC, began using "the SAWSTOP marks" in August 2002 and, since then has spent significant time and money promoting their products under those marks around the world.

The Complaint includes evidence that the Complainant, or its subsidiary, owns a number of registered trademarks. It is sufficient to note:

- (a) United States Registered Trademark No. 2,691,384, SAWSTOP, which was registered in the Principal Register on February 25, 2003, in respect of power-operated woodworking machinery in International Class 7 and safety systems for woodworking machines in International Class 9. First use in commerce was claimed as August 22, 2002;
- (b) Australian Registered Trademark No. 2335218, SAWSTOP & circular saw device, which has been registered with effect from February 16, 2023 in respect of table saws and related equipment in International Class 7; and
- (c) European Union Trademark No. 017979811, SAWSTOP & circular saw device, which was registered on March 6, 2019 in respect of woodworking and metalworking machines and a range of power tool in international class 7.

For completeness, the Panel notes the Complainant's subsidiary also holds United States Registered Trademark No. 7,319,838 for SAWSTOP which was registered in the Principal Register on March 5, 2024 and expands the range of goods in International Class 7 for blades for power saws and a number of named power tool accessories. There are also a number of registrations in other countries, the earliest of which was filed in 2009.

The Respondent points out that in December 2007 the Complainant's subsidiary applied to register in Australia Trademark Application No. 1215765, SAWSTOP, in respect of a range of goods in International Classes 7 and 9 but that application was refused and never registered.

According to the Registrar, the disputed domain name was first created on November 4, 2006. According to the Respondent, he was the registrant at that time. The Registrar is unable to confirm that but does confirm that the Respondent was the registrant of the disputed domain name when the registration was transferred to Registrar on August 17, 2017.

When the Complaint was filed, the disputed domain name did not resolve to an active website and the Respondent had registered the business names, Excellence IT, Excellence Cloud, Excellence Host, and VIZ-X.

According to the Response, the Respondent is an information technology services company providing, amongst other things, cybersecurity services. The Response includes a partial image of a brochure from 2017, “Be Ahead of Cyber Security Threats”, which shows SAWSTOP being used as an acronym or mnemonic for “Safety At Work Stand Think Observe Proceed.”

Captures of the website by the Wayback Machine at “www.archive.org” disclose captures in 2013 and 2014 of webpages offering Parallels software.

On October 4, 2016 headed:

“Safety At Work: STOP and protect your business. There are many threats today to a business and safety at work is now a top priority.”

Beneath this heading is a listing of services apparently being offered by the operator of the website and another list of threats a business might be exposed to in the digital environment such as phishing, key logging, and so on. The website captures of this page date continue through to May 2019.

The last two captures by the Wayback Machine were in 2020. The captures were a type of Error page:

“Sorry! If you are the owner of this website, please contact your hosting provider: [...]@sawstop.com.au”.

After the filing of the Complaint, the Respondent restored the “Safety At Work: STOP” page to the website and also registered the business name Safety at Work Stand Think Observe Proceed.

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, 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.

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. Supplemental Filing

Apart from documents requested by the Panel pursuant to paragraph 12 of the Rules, neither the Policy nor the Rules expressly provide for supplemental filings. Their admissibility is therefore in the discretion of the Panel bearing in mind the requirements under paragraph 10 of the Rules to ensure that the proceeding is conducted with due expedition and both parties are treated equally, with each party being given a fair opportunity to present its case. See, e.g., auDA Overview of Panel Views on Selected auDRP Questions, Second Edition (“auDA Overview 2.0”), section 4.6.

The Complainant’s unsolicited supplemental filing contests numerous factual allegations alleged in the Response and seeks to call out what are said to be misrepresentations of fact. The Respondent’s unsolicited supplemental filing responds to many of those claims and provides some additional evidence. As a result, a clearer picture of the parties’ cases does emerge. In the interests of fairness to both parties, therefore, the Panel admits both into the record.

B. 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, a name, trademark, or service mark, in which the Complainant has rights.

As noted in section 4 above, the Complainant, or its subsidiary, has registered trademarks for the word mark SAWSTOP and also for SAWSTOP & device.

As the Complainant wholly owns its subsidiary, and the materials filed by the Complainant treat the two companies interchangeably or as a collective, the Panel proceeds on the basis that the Complainant has standing to assert the relevant rights including those owned by the Complainant's subsidiary. auDRP Overview 2.0, section 1.4. In the result, nothing turns on this.

For the purposes of this requirement under the Policy, it does not matter that the Complainant's registrations of the plain word mark are in the United States or overseas. 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 trademarks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd.*, WIPO Case No. [DAU2002-0001](#).

In comparing the disputed domain name to the Complainant's trademark(s), it is permissible to disregard the Second Level Domain, ".com.au", as a functional component of the domain naming system. See for example auDA Overview 2.0, section 1.11.1. It is also usual to disregard the design elements of a trademark 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.

On this basis, the disputed domain name is identical to the Complainant's trademark.

The Respondent contends that the trademark consists of two ordinary English words and the parties are in very different fields. As all that is required is a straightforward visual and aural comparison, however, those matters are not relevant at this stage of the inquiry. They may be relevant and are more appropriately considered under the other elements of the Policy.

Accordingly, the Panel finds that the disputed domain name is identical to the Complainant's trademark and the Complainant has established the first requirement under the Policy.

C. Rights or Legitimate Interests

The second requirement the Complainant 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 or 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 trademark 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 trademark 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., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

Contrary to the Respondent's submissions, the Complainant's earliest trademark in the United States, No 2,691,384 which was registered in 2003, predates the earliest registration date of the disputed domain name in 2006.

The Complainant points to the significant time and money it says it has spent building up an established reputation in its trademark around the world. As a result, it contends that the use of the disputed domain name would represent the user was the Complainant or in some way associated with the Complainant.

It is not in dispute between the parties that the Respondent is not associated with the Complainant in any way.

The Complainant further points out that the disputed domain name is not derived from the Respondent's name and the Respondent does not own any registered trademarks from which the disputed domain name could be derived.

As there was no active website when the Complaint was filed, the Complainant contends that the disputed domain name is not being used in connection with a good faith offering of goods or services.

Further still, as the disputed domain name is not derived from the Respondent's name or trademark and was not being used between at least 2020 and the filing of the Complaint in March this year, the Complainant contends the Respondent was not entitled to be registered as the holder of the disputed domain name when the registration was renewed in November 2023. .au Domain Administration Rules: Licensing ("Licensing Rules"), Policy 2019-01¹ at paragraph 2.14 and see *Discovery Holiday Parks Pty Ltd. v. B2B Network Pty Ltd*, WIPO Case No. [DAU2021-0027](#).

The Respondent denies any knowledge of the Complainant or its trademark before receiving notice of the dispute.

The Panel does not consider there is sufficient evidence to reject the Respondent's claim that it was unaware of the Complainant's trademark when registering the disputed domain name. It will be recalled that was in 2006. The Complainant did have a registered trademark in the United States by then. Its website, if it was operational at that time, would have been accessible by the Respondent then. But the question arises, "Why?".

First, there is no evidence before the Panel that the Respondent is a domainier.

Secondly, the Respondent claims that it operates in a very different field to the Complainant. There is no evidence before the Panel to contradict that claim.

¹ <https://www.auda.org.au/policy/au-domain-administration-rules-licensing>

Thirdly, however, the Complainant does claim to have an established reputation. Accepting that claim at face value,² there is no evidence of the scale and scope of the Complainant's activities in 2006. Further, apart from the fact that it filed a trademark application in Australia in 2007, there is no evidence about the nature and scope of the Complainant's activities, if any, in Australia before the disputed domain name was registered.

Fourthly, the Respondent contends that the trademark consists of two ordinary descriptive words. That is true, but the Panel is not sure their combination is such that they lack distinctiveness. On the other hand, the Complainant's trademark application in Australia lapsed after receiving a notice of objection during examination.

According to the Respondent, it has been continuously using the acronym SAWSTOP in connection with the cybersecurity services provided by its Excellence IT business since at least 2017.

Having pointed out that there is no positive obligation to use a domain name and, further, that a domain name may be in use even though it is not being used for a publicly accessible website, the Respondent says such use often includes backend processes such as email services, database management, and application hosting. On this, the Response and the Respondent's supplemental filing are somewhat confusing. The Respondent appears to be claiming that it uses the disputed domain name in connection with specialized services provided directly to clients and which often involve integration into the clients' environment.

In the Response, in addition to the webpage and brochure, the Respondent claims to have continuous operation of essential services like email communications. In response to the Complainant's supplemental filing pointing out that evidence of these activities has not been provided, the Respondent's supplemental filing did not include example emails but did include SecurityTrails' historical A and TXT data reports which show that the disputed domain name has been continuously configured and "operational" (the Respondent's term) since at least early to mid 2018. The supplemental filing also includes some traffic statistics related to the disputed domain name but only for the preceding 30 days.

There are certainly some discrepancies in the Respondent's account. For example, the Panel is not prepared to accept without further elaboration the Respondent's claim that the website was merely under maintenance from 2020 to 2024.

It is also not entirely clear to the Panel what the historical A and TXT reports disclose. Noting how quickly the Complainant filed its unsolicited supplemental filing, however, the Complainant has not challenged the Respondent's claim that they show the disputed domain name is "operational".

So far as the evidence shows, nonetheless, the Respondent appears to have been offering cybersecurity services via the website to which the disputed domain name resolved between at least 2016 and 2019. There was also a brochure apparently being used in support of that service. In addition, there is also some technical evidence showing that the disputed domain name has been continuously "operational" since at least 2018.

The Panel therefore accepts that it appears the Respondent has been using the disputed domain name continuously in connection with its SAWSTOP cybersecurity services since at least 2016. This is a very remote field from the Complainant's field. There is also no evidence that the Respondent has sought to register third parties' trademarks as domain names. In addition, there is no evidence that the Respondent has sought to target the Complainant or its trademark.

² As to which, see auDRP Overview 2.0, section 1.3 in the context of establishing a claim to common law rights or an unregistered trademark.

In that connection, there was an exchange of correspondence between the parties in about January 2024, before the Complaint was filed. Neither party has placed that correspondence before the Panel. It appears, therefore, the Complainant does not rely on it as showing some form of targeting or opportunistic behaviour apart from the fact of the resemblance of the disputed domain name to the Complainant's trademark.

In these circumstances, the Panel considers with some degree of hesitation that the Respondent has demonstrated the circumstances identified in paragraph 4(c)(i) of the Policy.

As the Respondent appears to be continuing that conduct, the facts in *Geek Group Pty Ltd v. SG Corporate Services Pty Ltd.*, WIPO Case No DAU2019-0009, which the Complainant invokes, are very different and it is unnecessary to comment on that decision.

It is also necessary, however, to consider the Complainant's allegations based on the Licensing Rules. As the Complainant notes, prior panels have found that rights or legitimate interests cannot be found where the registrant is not eligible to hold the disputed domain name under the Licensing Rules. See *Discovery Holiday Parks Pty Ltd. v. B2B Network Pty Ltd*, WIPO Case No. [DAU2021-0027](#).

Paragraph 2.14.1 of the Licensing Rules requires that a person wishing to renew a domain name licence must continue to be eligible to hold the domain name under the Licensing Rules at the time of renewal.

Under those eligibility rules, paragraph 2.4.4.1 requires that the renewing person must be a commercial entity – which, as a company incorporated under the Corporations Act 2001 (Cth), the Respondent is. Under paragraph 2.4.4.2, the domain name itself must satisfy one or more criteria establishing a connection between the domain name and the name or some rights or interests held by the person renewing the domain name.

Noting that the Respondent appears to be providing in good faith a service or services under the SAWSTOP acronym or mnemonic, it appears that the disputed domain name satisfies the requirement that the disputed domain name is a match or synonym for the name of a service the Respondent provides. Licensing Rules, paragraph 2.4.4.2(f)(i).

Accordingly, the Panel finds the Complainant has failed to establish that the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complaint must fail.

D. Registered or Subsequently Used in Bad Faith

As the Complaint must fail, no good purpose would be served by considering this requirement under the Policy in any detail; the Panel would however note that the same ground set out above would tend to support a finding of lack of targeting or bad faith generally.

7. Decision

For all the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: June 6, 2024