



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

The Western Australian Turf Club, trading as Perth Racing v. Websitebrokers Limited

Case No. D2007-0213

1. The Parties

The Complainant is The Western Australian Turf Club, trading as Perth Racing, Belmont, Western Australia, Australia, represented by Solomon Brothers, Australia.

The Respondent is Websitebrokers Limited, Isle of Man, United Kingdom of Great Britain and Northern Ireland, represented by Bell Dening Solicitors, United Kingdom of Great Britain and Northern Ireland.

2. The Domain Name and Registrar

The disputed domain name <perthracing.com> is registered with TierraNet d/b/a DomainDiscover.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 14, 2007. On February 14, 2007, the Center transmitted by email to TierraNet d/b/a DomainDiscover a request for registrar verification in connection with the disputed domain name. On February 16, 2007, TierraNet d/b/a DomainDiscover transmitted by email to the Center its verification response (confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, and technical contact. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on February 28, 2007. The Center verified that the Complaint (together with the amendment to the Complaint) satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform 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 March 2, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was March 22, 2007. The Response was filed with the Center March 22, 2007.

The Center appointed Sir Ian Barker, Diane Cabell and Staniforth Ricketson as panelists in this matter on April 19, 2007. The Panel finds that it was properly constituted. Each member of 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.

On April 2, 2007 (email) and on April 13, 2007 (hard copy), the Complainant sought to file Supplemental Submissions. The Complainant was advised by the Center that the Panel would decide in accordance with Paragraph 10(d) of the Rules whether to receive these submissions. The sole reason cited by the Complainant in support of its request was: "The further submissions are relevant in proving that the Complainant did not engage in reverse domain name hijacking".

On April 20, 2007, the Respondent protested at the request of the Complainant for the Panel to accept written Supplemental Submissions. The Respondent pointed out that there were 30 annexes to the Supplemental Submissions. The Respondent claimed this was an attempt to file a second Complaint and to shore up an insubstantial Complaint. According to the Respondent, the Complainant was seeking to provide further evidence to support a claim for an unregistered trademark, as well as further evidence to support an assertion that there was no *bona fide* offering of goods and services provided on the disputed domain name website, together with assertions concerning bad faith.

The Panel unanimously decided not to accept the Supplemental Submissions and caused the Center to advise the parties accordingly. Although the Panel has not viewed the Supplemental Submissions, the fact that there were 30 appendices indicates that this was more than a mere Reply. Moreover, the Panel has considered the Response and does not consider that any of the matters contained therein should have taken the Complainant by surprise.

In the interests of a speedy and efficient process, the Rules provide for one filing by each party, with further filings allowed only with the consent of or at the request of, the Panel. A prudent applicant should provide cogent reasons why the Panel might exercise its discretion favourably. The meagre reason offered here falls short of persuading the Panel to allow the further filing. This restriction against further submissions means that it behoves a complainant to cover in the complaint any matters which might realistically be raised in defence. Here, for example, it would not have been beyond the bounds of foreseeability for the Complainant to expect that references would be made by the Respondent to horse racing in the city of Perth, Scotland.

Moreover, had the Complainant wanted to rely on an unregistered mark, prior UDRP decisions and, indeed, the common law make it clear what has to be proved. The Complainant had the benefit of legal advice and its solicitors could well be expected to have known what evidence was necessary to demonstrate an unregistered trademark. There was no statement as to why the material in the Supplemental Submissions could not have been included in the original Complaint. Accordingly, the Panel sees no reason for allowing the Supplemental Submissions.

The fact that the Respondent sought a declaration of reverse domain name hijacking does not necessarily mean that a reply should be allowed. Such a counterclaim must always be likely in cases where there is no registered mark, scant evidence of a common law mark and a domain name registered before the Complainant commenced trading under the brand in question.

4. Factual Background

The Complainant, The Western Australian Turf Club, has been staging horse races in the state of Western Australia for some 150 years. It registered, under the Western Australian Business Names Act 1962, the business name "Perth Racing" on November 2, 2004. The Complainant has advertised its goods and services using the words Perthracing since January 8, 2005. It owns and operates two race courses in Perth, Western Australia, called Ascot and Belmont Park. In addition to organising race meetings, it conducts or operates associated activities such as television programmes, training facilities and function and entertainment centres. It also sells merchandise.

The disputed domain name was registered on December 15, 2004. Searches conducted by the Complainant on February 8, 2007, showed that the disputed domain name had links to a number of click-through sites offering a range of merchandise on line.

On February 15, 2007, the Complainant found that the website had changed and diverted users to a website "www.racemeetings.co.uk" which is a comprehensive website for race meetings in the United Kingdom, including reference to a race course in Perth, Scotland.

The Respondent claims that it conducts the business of corporate hospitality and related services at race meetings at various race courses throughout the United Kingdom. In the course of this activity, it provides online information relating to the main race courses in the United Kingdom, including that in Perth, Scotland. The information includes relevant details about the course, tips, accommodation advice and details about access. Each course has its own webpage.

5 Parties' Contentions

A. Complainant

The Complainant contends that it has a substantial goodwill and reputation in the name Perthracing. It owns domain names with the suffix ".au" which it claims are trademarks or service marks within the meaning of paragraph 4(a)(i) of the Policy. The disputed domain name and the name under which the Complainant trades are similar.

The Complainant says that it has given the Respondent no rights in respect of the disputed domain name. It alleges further that the Respondent has not used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods and services, nor has it made legitimate non-commercial and fair use of the disputed domain name. It is using the disputed domain name with the intent of commercial gain, misleading the consumers.

Finally, the Complainant alleges that the Respondent has shown bad faith in its registration and use of the disputed domain name. It has intentionally attempted to attract for commercial gain, internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, endorsement of the Complainant's website or location or of product or service on the website or location. In particular, the Respondent has changed from a website displaying advertising and other links to a website relating to racing, particularly racing in Perth, Scotland.

B. Respondent

The Respondent contends that the Complainant has not shown that it has a trademark or service mark as required by the Policy. There is no registered trademark or any evidence to support the claim for a common law trademark. Nor is there any documentary evidence for the assertion that the words 'PERTH RACING' give rise to a substantial reputation and goodwill in Australia.

In this regard, an examination of the Complainant's Australian website "www.perthracing.com.au" shows the PERTH RACING logo predicated by a logo with the words THE WEST AUSTRALIAN TURF CLUB. The Respondent submits that this part of the banner is more significant.

Registration of a business name is not the equivalent of a trademark, according to the Western Australian Business Names Register. Registration of a business name merely prevents any other person carrying on business under that name. It does not give the holder exclusive right to use any word or phrase in a name.

The Respondent registered the disputed domain name with Perth, Scotland in mind. That city has a race course called Perth Racecourse but there is no registered trademark associated with the course. It is not clear when the Complainant started trading under the brand "Perth Racing".

The Respondent contends further that it has rights or legitimate interests in the disputed domain name. It conducts the business of providing corporate hospitality and related services at various racecourses in the United Kingdom including Perth. Any holding page at the domain name would only have been a temporary event at the time when the Respondent's hosting company service may have failed or the system defaulted briefly beyond the Respondent's control. The Respondent produced a page from the web archive showing information supplied about meetings in Perth, Scotland racecourse in 2004.

Accordingly, before the Respondent received any notice of the dispute, it had made demonstrable preparations to use the disputed domain name or a name corresponding to it in connection with a *bona fide* offering of goods and services.

As to bad faith, the Respondent notes that it had registered the disputed domain name on January 20, 2004, while the use of the name PERTH RACING commenced no earlier than November 2004. Given that the

Complainant's rights did not subsist until after the disputed domain name was registered, the registration of the disputed domain name could not have been in bad faith because the Respondent could not have been aware of rights that did not exist at the time of registration. A number of WIPO UDRP decisions were cited in support.

The Respondent denies an assertion by the Complainant that the disputed domain name is part of a wider pattern of bad faith registrations. To the contrary, it is part of an extensive list of legitimate, racing-related domains held by the Respondent.

The Respondent says that it did not register the disputed domain name in order to prevent the Complainant from doing so. The Respondent was not, and could not have been, aware of any plans the Complainant may have had to start using the name at a later date.

The Respondent asks the Panel to make a finding of reverse domain name hijacking.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant must prove that the disputed domain name is identical or confusingly similar to a trademark or service mark in which it has rights. Normally, a complainant owns a registered trademark but if there is adequate proof, a common law mark will suffice.

In the Panel's view, mere registration of a business name is not proof of a "mark" in terms of the Policy. Indeed, the information provided by the website relating to registration of business names affirms this proposition. Nor does the registration of a domain name such as <perthracing.net.au> amount to proof of a common law mark.

Nor is there anything like the evidence normally sufficient for the Panel to find a common law mark proven. Many WIPO UDRP cases, such as *BAA Plc v. Larkin*, [WIPO D2004-0555](#) and *Julian Barnes v. Old Barnes Studios Ltd*, [WIPO D2001-0021](#), demonstrate what is required for proof of common law mark. One way of looking at the test for a common law mark is to ask whether the Respondent could successfully be sued for the tort of *passing off*. Other cases indicate the necessity for proof of trading operations using the unregistered mark for a reasonable length of time. See the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#) at [1.7](#). Relevant evidence of a 'Secondary meaning' includes length and amount of sales under the mark, the nature and extent of advertising consumer surveys and media recognition.

The evidence in this case shows that whilst the Western Australian Turf Club may well have had a long history in promoting and staging race meetings, the switch to the name 'Perth Racing' was allegedly made only in November 2004, some 10 months after the disputed domain name had been registered. The Panel further notes, as discussed below under the third element, that in some restricted circumstances, a complainant can succeed where a mark has been registered after the disputed domain name. This is not one of those occasions.

Accordingly, in the Panel's view, the Complaint can not succeed because the Complainant has not in this particular case been able to prove that it has a trademark or service mark in which it has rights.

B. Rights or Legitimate Interests

It is therefore unnecessary to consider whether the Respondent is able to prove that it had rights or legitimate interests. Certainly, it has made out a *prima facie* case that it is involved with the provision of hospitality and other services at race courses throughout the United Kingdom, including a race course in Perth, Scotland. Consequently, there would appear to be a legitimate descriptive use of the term.

C. Registered and Used in Bad Faith

The Complainant must also fail on lack of proof of bad faith registration of the disputed domain name. Bad faith registration must be proved as well as bad faith use. At the time of the registration of the disputed domain name, the Complainant was not using the name 'Perth Racing'. Therefore, it is hard to see how registration could be proved to have been made in bad faith. As is cited in the [Overview of WIPO Panel Views on Selected UDR Questions](#): "Normally speaking, where the domain name is registered before a trademark right is established, the registration of the domain name was not in bad faith as the registrant could not have contemplated the Complainant's non-existent right".

Accordingly, in the Panel's view, the Complainant has not satisfied the necessary criteria and the Complaint must be dismissed.

D. Reverse Domain Name Hijacking

In the Panel's view, this is not an appropriate case for a declaration of reverse domain name hijacking. Although there was no real prospect of a finding of a common law trademark, given the shortness of time that the Complainant had been trading under the name 'Perth Racing', there is no suggestion of bad faith by the Complainant in seeking to protect its trading name.

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 Complaint is denied.

Sir Ian Barker
Presiding Panelist

Diane Cabell
Panelist

Staniforth Ricketson
Panelist

Dated: May 3, 2007