

COMPLAINT TRANSMITTAL COVERSHEET

Attached is a Complaint that has been filed against you with the World Intellectual Property Organization (**WIPO**) Arbitration and Mediation Center (the **Center**) pursuant to the .au Dispute Resolution Policy (the **Policy**) approved by the auDA Board on 13 August 2001, the Rules for .au Dispute Resolution Policy (the **Rules**), and the WIPO Supplemental Rules for .au Dispute Resolution Policy (the **Supplemental Rules**).

The Policy is incorporated by reference into your Registrant Agreement with the Registrar of your domain name, in accordance with which you are required to submit to a mandatory administrative proceeding in the event that a third party (a **Complainant**) submits a complaint to a dispute resolution service provider, such as the Center, concerning a domain name that you have registered. You will find the name and contact details of the Complainant, as well as the domain name that is the subject of the Complaint, in the document that accompanies this Coversheet.

You have no duty to act at this time. Once the Center has checked the Complaint to determine that it satisfies the formal requirements of the Policy, the Rules and the Supplemental Rules, it will forward an official copy of the Complaint to you. You will then have 20 calendar days within which to submit a Response to the Complaint in accordance with the Rules and Supplemental Rules to the Center and the Complainant. You may represent yourself or seek the assistance of legal counsel to represent you in the administrative proceeding.

- The **Policy** can be found at <http://www.ada.org.au/docs/ada-2002-22.pdf>
- The **Rules** can be found at <http://www.ada.org.au/docs/ada-2002-22.pdf>
- The **Supplemental Rules**, as well as other information concerning the resolution of domain name disputes can be found at <http://arbiter.wipo.int/domains/cctld/rules/index.html#au>
- A **model Response** can be found at <http://arbiter.wipo.int/domains/filing/au/response.doc>.

Alternatively, you may contact the Center to obtain any of the above documents. The Center can be contacted in Geneva, Switzerland by telephone at +41 22 338 8247, by fax at +41 22 740 3700 or by e-mail at domain.disputes@wipo.int.

You are kindly requested to contact the Center to provide the contact details to which you would like (a) the official version of the Complaint and (b) other communications in the administrative proceeding to be sent.

A copy of this Complaint has also been sent to the Registrar with which the domain name that is the subject of the Complaint is registered.

By submitting this Complaint to the Center the Complainant hereby agrees to abide and be bound by the provisions of the Policy, Rules and Supplemental Rules.

II. The Parties

A. The Complainant

(Rules, para. 3(b)(ii) and (iii))

[2.] The Complainant in this administrative proceeding is:

The Crown in Right of the State of Tasmania trading as “*Tourism Tasmania*”

[3.] The Complainant’s contact details are:

Address: **GPO Box 399 HOBART TASMANIA 7001
AUSTRALIA**
Telephone: **61 3 62308150**
Fax: **61 3 62308353**
E-mail: **Malcolm.Wells@tourism.tas.gov.au**

[4.] The Complainant’s authorized representative in this administrative proceeding is:

Malcolm Wells
Address: **Acting Chief Executive Officer Tourism Tasmania
GPO Box 399 HOBART 7001
AUSTRALIA**
Telephone: **61 3 62308150**
Fax: **61 3 62308353**
E-mail: **Malcolm.Wells @tourism.tas.gov.au**

[5.] The Complainant’s preferred method of communications directed to the Complainant in this administrative proceeding is:

Electronic-only material

Method: e-mail
Address: **Angus.Sprott@tourism.tas.gov.au**
Contact: **Angus Sprott**

B. The Respondent

(Rules, para. 3(b)(v))

[6.] According to *ausregistry* "Whois" database the Respondent in this administrative proceeding is:

GORDON JAMES CRAVEN of

email address: buscard@iprimus.com.au;

registered ABN: 64517410881.

Copies of the printout of the database search conducted on **23 January 2003** are provided as **Attachment 1**.

[7.] All information known to the Complainant regarding how to contact the Respondent is as follows:

Postal address: **PO Box 117 GLENORCHY TAS 7010**

Email address: **buscard@iprimus.com.au**

Telephone: **unlisted**

III. The Domain Name and Registrar

(Rules, para. 3(b)(vi) and (vii))

[8.] This dispute concerns the domain name identified below:

discover-tasmania.com.au

[9.] The registrar with which the domain name is registered is: **NetRegistry**

Address: **NetRegistry Pty Ltd**

Level 1 / 97 Rose St

CHIPPENDALE NSW 2008

AUSTRALIA

Telephone: **61 2 92996099**

Email: **dmain@netregistry.com.au**

IV. Jurisdictional Basis for the Administrative Proceeding

(Rules, paras. 3(a), 3(b)(xv))

[10.] This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The registration agreement, pursuant to which the domain name that is the subject of this Complaint is registered, incorporates the Policy. The auDA Domain Administration has advised that the domain name was created on 28 November 2002 and that the domain name licence is subject to a mandatory administrative proceeding under the auDRP (see: clause 2.1 of the .au Dispute Resolution Policy and **Attachment 2** - copy email advice from auDA Domain Administration). A true and correct copy of the domain name dispute policy that applies to the domain name in question is provided as **Attachment 3** to this Complaint.

V. Factual and Legal Grounds

(Policy, paras. 4(a), (b), (c); Rules, para. 3)

[11.] This Complaint is based on the following grounds:

A. The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;

(Policy, para. 4(a)(ii), Rules, paras. 3(b)(viii), (b)(ix)(1))

Factual background

- 1) The trading entity *Tourism Tasmania* was established by legislation (*Tourism Tasmania Act 1996*) by the Complainant for the express purpose of promoting tourism in the State of Tasmania. *Tourism Tasmania* has statutory power to:
(a) undertake destinational and product marketing; (b) carry out investigations and research into tourism in Tasmania and elsewhere; (c) act as a travel agent; (d) establish and maintain travel centres to assist travellers; and (e) carry on any business which may conveniently be carried on in conjunction with the performance of its functions.

- 2) Since 1990, the Complainant has had rights in the following registered trade marks (“TM”) under the *Trade Marks Act 1995* in relation to the promotion of Tasmanian tourism and the sale and reservation of travel to and within Tasmania:

“**TASMANIA Australia’s Best Holiday**” (TM: 532944) registered from 23 April 1990 to 2007. This mark is registered in relation to goods and services in:

Class 35: The promotion of Tasmanian tourism.

“**TASMANIA Be Tempted**” (TM: 542028) registered from 14 September 1990 to 2007. This mark is registered in relation to goods and services in:

Class 35: Promotion of Tasmanian tourism within Australia and internationally.

“**TASMANIA Discover your natural state**” (words) and **Image of Tasmanian Tiger, water and plants all grot in incomplete disc** (TM:674285) registered from 5 October 1995 to 2005. This mark is registered in relation to goods and services in:

Class 35: Tourism promotions in relation to the State of Tasmania; and

Class 39: The sale and reservation of travel to and within Tasmania.

“**TASMANIA More than you imagine**” (words) and **Image of Tasmanian Tiger, water and plants all grot in incomplete disc** (TM: 772617) registered from 9 September 1998 to 2008. This mark is registered in relation to goods and services in:

Class 35: Tourism promotions in relation to the State of Tasmania; and

Class 39: The sale and reservation of travel to and within Tasmania.

Copies of relevant reports from the Australia Trade Marks Office database are attached as **Attachment 4**.

- 3) The Complainant used the TM “**TASMANIA Discover your natural state**” **with Image** in an extensive national advertising campaign in the period March 1995 to June 1998 (see: **Attachments 5a and 5b**). Imagery depicting this TM remains on display at the Hobart International Airport.

The Complainant has used the “**Discover Tasmania**” brand to identify its services nationally and internationally since March 1995. It remains the Complainant’s most distinctive branding mark and is the central component of its promotional and sales operations.

Since 1995, the Complainant has also used for its international markets the logo "Tasmania Discover Australia's Natural State" and Image of Tasmanian Tiger, water and plants.

- 4) Since November 2000, the Complainant has been the registered licensee of the following domain names:

<discovertasmania.com>

<discovertasmania.com.au>.

The Complainant registered the domain name <discovertasmania.com.au> on 1 November 2000 (see: copy email advice from auDA Domain Administration – **Attachment 6**) and purchased the domain name <discovertasmania.com> from a Canadian domain name squatter on 7 November 2000.

The Complainant has maintained an active website at each of those addresses continuously since 15 March 2001.

The Complainant’s web addresses have been published in its advertising material since March 2001 and on all external correspondence, including email (see: **Attachment 7**).

The websites continue to promote the “**Discover Tasmania**” brand and the words appear on the title bar of **every** page of the website.

- 5) The Complainant has registered the business name *Discover Tasmania* under the *Business Names Act 1962*, the relevant State legislation (copy Business Names Extract attached as **Attachment 8**). The stated nature of the Complainant’s business is “Tourism Promotion”.

While the name was registered on 28 November 2002, the “**Discover Tasmania**” brand has been used by the Complainant, in conjunction with its trade marks, in its national and international promotional and marketing strategy since 1995 when the TM “**TASMANIA Discover your natural state**” was registered.

The Complainant sought registration of the business name *Discover Tasmania* in 2000 but at that time it was registered to another person (who was not the Respondent) and hence it was unavailable to the Complainant. As an alternative, registration of the business name *Come and discover Tasmania* was sought. That application was refused on the ground that it was too similar to the name *Discover Tasmania*. The registration of the business name *Discover Tasmania* was cancelled on 18 January 2001 enabling the Complainant to again apply for and obtain registration of that name (see: former registrations of the business name *Discover Tasmania* at **Attachment 9**).

Legal grounds

- 1) The disputed domain name is confusingly similar to the Complainant’s trade mark “**TASMANIA Discover your natural state**”. The Complainant has actively been engaged in promoting tourism in the State of Tasmania; the sale and reservation of travel to and within Tasmania; and has been identified with that trade mark and brand “**Discover Tasmania**”, since the trade mark was registered in 1995. Evidence of the use of this TM is at **Attachments 5a and 5b**.
- 2) The disputed domain name is phonetically identical and confusingly similar to the Complainant’s registered business name *Discover Tasmania*, the only difference being that the Respondent has added a hyphen between the two words, “discover” and “tasmania”. That difference is immaterial (see: *Do The Hustle, LLC v Tropic Web* WIPO Case D2000-0624 at **Attachment 10**).

At the time of registering the disputed domain name, the Respondent had considerable experience in the tourism industry in Tasmania. It is understood that he held an accommodation licence from 12 August 1993 to 3 August 1999 in respect of premises known as *Riverside Villas* in Orford in Tasmania. It is

also understood that he was the operator of the Visitor Information Centre in Orford on Tasmania's east coast between 18 January 1994 and 30 October 1997 as a member of the *Tasmanian Visitor Information Network* (TVIN) when his membership was discontinued. TVIN is an organization which is fully funded by the Complainant through Tourism Tasmania.

During this time correspondence was sent from the Complainant to the Respondent regarding tourism related matters. The TM "**TASMANIA Discover your natural state**" with Image was included on that correspondence (see: **Attachment 11**).

Also, during this period the Respondent had accommodation and visitor information published on the Complainant's website in relation to a tourist accommodation business and visitor information centre which he was operating.

Accordingly, the Complainant considers that the Respondent knew of the Complainant's rights and business reputation relating to its brand "**Discover Tasmania**". The Respondent knew of the Complainant's web addresses (see: Paragraph 6 at C. in *Wal-Mart Stores, Inc. v. Thomson Hayner d.b.a. Wireless Revolution d/b/a Latin Technologies* WIPO Case No. DAS2002-0001 at **Attachment 12**).

The Respondent has indicated to the Complainant that one of his reasons for registering the <.com> domain name was to undermine the brand values which the State was promoting worldwide (see **Attachment 12a**).

- 3) The Complainant has established a common law right to the exclusive use of the name "**Discover Tasmania**" by such use since 1995, as is described above in the factual background and supported by evidence contained in Attachments to this complaint (see: *The Board of Regents of the University of Wisconsin System v. NUCOM, Domain Name Brokers and others* WIPO Case No. D2002-0981 at **Attachment 13**).

B. The Respondent has no rights or legitimate interests in respect of the domain name;

(Policy, para. 4(a)(ii), Rules, para. 3(b)(ix))

- 1) At the time of filing this complaint, the Respondent's use of the domain name does not demonstrate that it is being used in connection with offering any goods or services for a fee or is preparation for such use. The site is under construction and while it invites the submission of advertising material, there is no indication that the site is to be used commercially.
- 2) At the time of filing this complaint the Respondent's use of the domain name for any purpose is intended to misleadingly divert the Complainant's prospective consumers to that site and to tarnish the Complainant's name and trade mark. Prior to creating the <com.au> site the Respondent established a site at <discover-tasmania.com> which was clearly intended to tarnish the Complainant's reputation and trade mark. The site still contains a defaced and disparaging version of the TM Image which is registered with the words "**TASMANIA Discover your natural state**". At the top of the title page of the Respondent's <com.au> site, a prominent direct link to the disparaging <.com> site is provided, as it is elsewhere on the site.
- 3) The Respondent has subsequently obtained a licence for the domain name <**DiscoverTasmania.au.com**>. Whilst that domain name cannot be the subject of this Complaint it is cited as evidence of the Respondent's intention to misleadingly divert potential consumers from the Complainant's site to that site and to tarnish the Complainant's name and trademark. That domain name is published on the <com.au> website.
- 4) The Respondent has not been, and is not, known by the domain name either as an individual, a business, or in any other respect and has not acquired any trade marks or other rights to the name.

Neither the Respondent's name nor the name of any business interest of the Respondent appearing on the domain name registration show any connection to the words "Discover Tasmania". Despite carrying out the relevant searches the

Complainant has found no record of the Respondent having any rights in the name.

The mere registration of a domain name does not establish any “rights or legitimate interests in respect of the domain name” (see footnote 2 to policy 4a.(ii) of the .auDRP).

In any event, at the time of such registration, the Respondent did not satisfy the eligibility and allocation rules for com.au registration as set out in Schedule C of the *Domain Name Eligibility and Allocation Policy Rules for Open 2LDs* (2002-07 approved 8 May 2001 and Current – see **Attachment 14**) on the ground that he did not have a company, business, trading, association or statutory body name with which the disputed domain name could exactly match; be an acronym or abbreviation for; or be otherwise closely and substantially connected with, for the purpose of the 2002-07 Policy Rules.

At the time of filing of this complaint the Respondent did not satisfy the eligibility and allocation rules for com.au registration.

C. The domain name was registered or is subsequently being used in bad faith.

(Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix))

- 1) The examples in Paragraph 4(b) of Policy are intended to be illustrative rather than exclusive and whether or not particular circumstances will constitute “bad faith” registration and use will depend on the analysis of the particular facts in a given case – see: Paragraph 6 at C. in *Wal-Mart Stores, Inc. v. Thomson Hayner d.b.a. Wireless Revolution d/b/a Latin Technologies* WIPO Case No. DAS2002-0001 at **Attachment 15**; and also Paragraphs 6.20-6.24 of *Do The Hustle, LLC v Tropic Web* WIPO Case D2000-0624 which cited with approval *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case NO. D2000-0003 at **Attachment 16**.

- 2) The Respondent's bad faith is demonstrated by his certain knowledge of:
 - (i) the public profile of the Complainant's trade marks, in particular the words "**TASMANIA Discover your natural state**";
 - (ii) the Complainant's rights and business reputation relating to its brand **Discover Tasmania** which it has acquired since the abovementioned TM was registered in 1995;
 - (iii) the Complainant's statutory role in promoting tourism in and for the State; and
 - (iii) the Complainant's web addresses.
- 3) The Respondent has registered and used the domain name in bad faith primarily for the purposes of disrupting the Complainant's business activities (see: **Attachment 12a**).

The Respondent first registered a .com domain name and established a web page at <discover-tasmania.com> for the express purpose of damaging the Complainant's reputation in promoting Tasmanian tourism. The site prominently exhibits a defaced and disparaging version of the TM Image which is registered with the words "**TASMANIA Discover your natural state**". That page is now linked to the <com.au> site.

The <com.au> site has a prominent link to the disparaging <.com> site.

- 4) The use of the domain name suggest that there exists an affiliation or endorsement with/from the Complainant. For example, materials published on the Respondent's website display the Complainant's TM Image and contain links to other websites of the Complainant which carrying official endorsements.

VI. Remedies Requested

(Rules, para. 3(b)(x))

[12.] In accordance with Paragraph 4(i) of the Policy, for the reasons described in Section V above, the Complainant requests the Administrative Panel appointed in this administrative proceeding issue a decision that <discover-tasmania.com.au> be **transferred** to the Complainant.

VII. Administrative Panel

(Rules, para. 3(b)(iv))

[13.] The Complainant elects to have the dispute decided by three-member Administrative Panel, and nominates the following 3 panelists:

1. Staniforth Ricketson
List D (Dever)
Owen Dixon Chambers
205 William Street
Melbourne
Victoria 3000 Australia
Fax: +613 9642 1224
Email: srickets@unimelb.edu.au

2. Mary Padbury
Blake Dawson Waldron
4th Floor/ 90 Basinghall Street
London
United Kingdom EC2V 5AY
Fax: +44 207 6000 3392
Email: mary.padbury@bdw.co.au

3. John Swinson, Esq
Partner
Mallesons Stephen Jaques
Waterfornt Place
Level 30, 1 Eagle Street
Brisbane
Queensland 4000 Australia

Fax: 61 7 3244 8999
Email: john.swinson@msj.com.au

VIII. Mutual Jurisdiction
(Rules, para. 3(b)(xiii))

[14.] In accordance with Paragraph 3(b)(xiii) of the Rules, the Complainant will submit, with respect to any challenges that may be made by the Respondent to a decision by the Administrative Panel to transfer or cancel the domain name that is the subject of this Complaint, to the jurisdiction of the courts of the State of Tasmania, the location of the domain name holder's address, as shown for the registration of the domain name in the registry database at the time of the submission of the Complaint to the Center.

IX. Other Legal Proceedings
(Rules, para. 3(b)(xi))

[15.] Nil

X. Communications
(Rules, paras. 2(b), 3(b)(xii); Supplemental Rules, paras. 3, 4)

[16.] A copy of this Complaint, together with the cover sheet as prescribed by the Supplemental Rules, was transmitted to the Respondent on 14 February 2003 by email to the Respondent at buscard@iprimus.com.au, the email address given by the Respondent for the *ausregistry* "Whois" database.

[17.] A copy of this Complaint, was transmitted to the concerned registrar, **NetRegistry**, on 14 February 2003 by email to the address **dmain@netregistry.com.au**.

[18.] This Complaint together with a "Schedule of Attachments" and sixteen (16) Attachments is submitted to the Center in electronic form (email). Seven (7) paper sets (1 original and 6 copies) of the Complaint and the "Schedule of Attachments" together with 7 CD Roms containing the "Schedule of Attachments" and the sixteen (16) Attachments are forwarded by DHL World Wide Express. In accordance with advice from Eun-Joo Min of the WIPO

Arbitration and Mediation Center sent on 13 February 2003 no paper copies of the Attachments are required unless later requested by the Centre.

XI. Payment

(Rules, para. 19; Supplemental Rules, Annex D)

[19.] As required by the Rules and Supplemental Rules, payment in the amount of Australian Dollars **\$3,000** has been made by **bank transfer**.

XII. Certification

(Rules, para. 3(b)(xiv))

[20.] The Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain name holder and waives all such claims and remedies against (a) the WIPO Arbitration and Mediation Center and Panelists, except in the case of deliberate wrongdoing, (b) the concerned registrar, (c) the registry administrator, and (d) auDA, as well as their directors, officers, employees, and agents.

[21.] The Complainant certifies that the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully submitted,



Malcolm Wells
Acting CEO Tourism Tasmania

Date: 14 February 03