

## **ADMINISTRATIVE PANEL DECISION**

Discovery Holiday Parks Pty Ltd v. Ed Keay-Smith, The Short Course  
Company Pty Ltd  
Case No. DAU2021-0026

### **1. The Parties**

The Complainant is Discovery Holiday Parks Pty Ltd of Australia, represented by Minter Ellison, Australia.

The Respondent is Ed Keay-Smith, The Short Course Company Pty Ltd of Australia represented by DBR Domain Brokerage.

### **2. The Domain Name and Registrar**

The disputed domain name <gday.com.au> (the “Disputed Domain Name”) is registered with Drop.com.au Pty Ltd (“the Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2021. On June 21, 2021, the Center transmitted by email to Drop.com.au Pty Ltd a request for registrar verification in connection with the Disputed Domain Name. On June 23, 2021, 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 June 30, 2021. In accordance with the Rules, paragraph 5(a), the due date for Response was July 20, 2021. The Response was filed with the Center on July 20, 2021. The complainant submitted a supplemental filing on July 29, 2021. The Respondent submitted a supplemental filing on August 4, 2021.

The Center appointed Nicholas Weston, Warwick A. Rothnie and The Hon Neil Brown Q.C. as panelists in this matter on September 30, 2021. 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 proprietary company based in Adelaide, South Australia established in 2004, that operates a caravan, holiday and resort park business in Australia with more than 280 branded destinations and a property portfolio worth over AUD 1 billion. The Complainant holds a portfolio of registrations for the trade mark G'DAY, and variations of it, in Australia including Trade Mark Registration No. 1896646, for example, registered on December 21, 2017 in classes 16, 35, 41, 43.

The Respondent is an Australian company incorporated in Western Australia in 1982 operating under its present name since 1999.

The Disputed Domain Name <gday.com.au> was registered on June 1, 2021 and resolves to a pay-per-click ("PPC") parking webpage promoting links that include that includes terms such as "Adelaide Australia", "Australia Accommodations", "Australia Flights", "Australia Hotels".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant cites seventeen Australian trade mark registrations including No. 1896646 registered on December 21, 2017 and numerous other registrations in Australia, for the mark G'DAY and variations of it as, *prima facie*, evidence of ownership.

The Complainant submits that its rights in the mark G'DAY predate the Respondent's registration of the Disputed Domain Name <gday.com.au>. It submits that the Disputed Domain Name is identical or confusingly similar to its trade mark, because the Disputed Domain Name incorporates in its entirety the G'DAY trade mark and that identity is not removed by the addition of the Second-Level Domain Suffix ("ccTLD") ".com.au".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it resolves to a PPC webpage and submits that "the Respondent's use of the Disputed Domain Name ... for the purpose of generating revenue via pay-per-click advertising links, is not a *bona fide* use or legitimate non-commercial use." The Complainant also contends that the Respondent has no other rights or legitimate interests in the Disputed Domain Name.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and Rules and submits that "As further evidence of the Respondent's knowledge of the Complainant's business, it is noted that the landing page for the Disputed Domain Name specifically includes links to searches for 'Adelaide, Australia' (where the Complainant is headquartered) and 'Australia Hotels' and 'Australia Accommodations'. The Complainant submits that this is clear evidence that the Respondent is aware of the Complainant and its business, and has tailored its pay-per-click advertising links accordingly."

##### **B. Respondent**

The Respondent submits that "(the Complainant does not have any trade marks confusingly similar to the Disputed Domain Name."

The Respondent submits that the term “‘g’day’ effectively means ‘hello’ and is one of the most basic, fundamental and widely-generically used words in the Australian vocabulary and has been since the early colonisation of Australia in the late 1700s.”

On the issue of Rights or Legitimate Interests, the Respondent submits that it legitimately purchased the DDN for AUD10,000 from a public drop catch auction, and “it was parked using default Registrar parking options”. It submits that it “paid a significant amount of money, namely AUD10,000...further confirming the *bona fide* nature of its business activities” and that demonstrable preparations to use the Disputed Domain name occurred on or by June 10, 2021.

On the issue of Registered or Used in Bad Faith, the Respondent denies that the Disputed Domain Name was registered or is being used in bad faith. On the issue of Registration in bad faith the Respondent submits that the Complainant does not have a reputation in the word G’Day and denies knowledge of G’Day Parks, the Complainant’s business, before commencement of the dispute. On the issue of use in bad faith, the Respondent denies use in bad faith and submits, *inter alia*, that “the (Disputed Domain Name) is being used correctly according to auDA’s Licensing Rules, in particular as ‘a service providing a referral to another provider which relates to services used by the public’.”

The Respondent also submits that the conduct of the Complainant in bringing the proceeding amounts to Reverse Domain Name Hijacking.

## **6. 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.

### **A. Supplemental filings**

Both parties have tendered additional submissions for the Panel, in its discretion, to consider. Paragraph 10(b) of the Rules gives the Panel the power to “determine the admissibility, relevance, materiality and weight of the evidence.” Paragraph 12 states: “In addition to the complaint and the response, the Panel may request or permit, in its sole discretion, further statements or documents from either of the Parties.” Generally, Panels will only accept supplementary filings in “exceptional” circumstances (see *The E.W. Scripps Company v. Sinologic Industries*, WIPO Case No. D2003-0447).

In this proceeding, the Complainant’s supplementary filing offers evidence that the Complainant could not reasonably have anticipated would be necessary or relevant at the time it originally filed the Complaint. The majority of the Panel finds that the additional evidence addresses the Respondent’s contention to have made demonstrable preparations to use the Disputed Domain Name, which is not something the Complainant could reasonably have known in advance. The Respondent’s supplemental filing addresses matters raised in the Complainant’s supplemental filing.

In these circumstances, the majority of the Panel has accepted and considered both parties’ supplementary filings.

### **B. Identical or Confusingly Similar**

The Complainant has produced sufficient evidence to demonstrate that it has registered trade mark rights in the mark GDAY in Australia. In particular, while a number of the Complainant’s registered trade marks are

for G'DAY plus some other word(s) – for example G'DAY PARKS, G'DAY REWARDS, G'DAY EVENTS, Registered Trade mark No. 1896646, is for the word G'DAY alone. The majority of the Panel finds that the Complainant has established trade mark rights in the word G'DAY in respect of Registered Trade Mark Nos 1896646 (G'DAY) and 1896659 (for the word "G'Day" in a figurative style). The threshold requirement of the first element for purposes of the Policy is therefore, *prima facie*, met (see auDA Overview of Panel Views on Selected auDRP Questions First Edition ("auDRP Overview 1.0"), section 1.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the G'DAY trade mark, the Panel observes that the Disputed Domain Name comprises: (a) an exact reproduction of the Complainant's trade mark G'DAY (b) without the apostrophe; and (c) followed by the ccTLD ".com.au".

The relevant comparison to be made is with the third-level portion of the Disputed Domain Name, specifically: "gday". It is well-established that the Second Level Domain, .com.au used as the technical part of a domain name may be disregarded (see auDRP Overview 1.0, section 1.2).

It is also well established that, where a domain name incorporates the entirety of a trade mark, the domain name will normally be considered confusingly similar to that mark for purposes of auDRP standing (see: *Discovery Holiday Parks Pty Ltd. v. B2B Network Pty Ltd*, WIPO Case No. DAU2021-0027 ("The disputed domain name incorporates the Complainant's G'DAY trade mark with only the apostrophe removed. The mere removal of the apostrophe (which in any event is not possible to display in a domain name) does not eliminate the overall impression of that the trade mark and the disputed domain name are similar").

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy lists ways that the respondent may demonstrate that it has rights or legitimate interests in the disputed domain name but these are examples only. Moreover, the Policy also places the burden on the complainant to establish the absence of respondent's rights or legitimate interests in the disputed domain name. Because of the inherent difficulties in proving a negative, previous Panels generally accept that the complainant need only put forward a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If the complainant makes out a *prima facie* case, the burden of production then shifts to the respondent to rebut that *prima facie* case (see *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. DAU2002-0001).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the Respondent:

- “(a) has acquired no Australian trade mark or service rights relating to the Disputed Domain Name;
- (b) has acquired no Australian company name or business name relating to the Disputed Domain Name;
- (c) uses the Disputed Domain Name as a parked/passive domain, for the purpose of generating revenue via pay-per-click advertising links and so is not *bona fide* use or legitimate non-commercial use;
- (d) directly or indirectly operates a business used for investing and reselling domain names, and services relating to monetisation of domain names, such that the use is not *bona fide* in connection with the supply of goods and services, but is instead use in bad faith;
- (e) the Respondent is not and has never been commonly known as "GDAY" nor has the Respondent ever utilised the term "GDAY" or other derivatives of that term in any of its business offerings;
- (f) the term "GDAY" is not a match or synonym for any goods or services offered by the Respondent; and

(g) the Complainant has never authorised the use of its registered G'DAY Trade Marks in the Disputed Domain Name and there is no indication that the Respondent or any of its goods or services are commonly known by the term "GDAY".

There is no evidence that the Complainant has authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the Complainant's trade mark. Furthermore, the Disputed Domain Name is not derived from the Respondent's name or any name by which it or those behind it were commonly known before registering the Disputed Domain Name. The Disputed Domain Name is a common Australian word but is also a trade mark registered by the Complainant. Moreover, the Disputed Domain Name was registered as a domain name by the Respondent on May 31, 2021, three years and six months after the Complainant's registered trade mark, G'DAY, took effect on December 21, 2017. The Panel finds there is a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. It is the Respondent's burden to produce evidence to rebut this presumption.

Against this, the Respondent contends that it has rights or a legitimate interest in the disputed domain name on the basis of its demonstrable preparations to use the Disputed Domain Name in connection with its plans to launch a business under the name G'Day Marketing. Thus, the Respondent says it has engaged in demonstrable preparations for a good faith offering of goods or services, particularly having regard to common usage of the term "g'day" as a form of greeting in Australia. According to the Respondent that common usage is reflected in the number of trade marks which have been registered by various parties that include the expression.

It is uncontroversial that a domain name investor, or anyone else, can register a commonly used word as a domain name and hold it provided that the circumstances do not indicate illegitimate conduct or bad faith.

It is also uncontroversial that the word "g'day" is a common form of greeting in Australia. It is also apparent that the Complainant's Registered Trade Mark Nos 1896646 and 1896659 (for the word "G'Day" in a figurative style) do not extend to advertising and marketing services generally in contrast to other trade marks registered by the Complainant such as No. 1896651 (G'DAY REWARDS) and 1896654 (G'DAY MAGAZINE).

In support of its claim, the Respondent has provided evidence of steps taken to have a logo designed by a graphic designer and the registration of the business name of the proposed business. On the evidence before the Panel, the graphic designer was engaged and performed her work between June 4 and 10, 2021. That is, before the Complaint was filed. The business name was not registered when the Complaint was filed but several weeks later.

When the Complaint was filed and at least until June 30, 2021, the Disputed Domain Name resolved to a parking page which included PPC links many of which connected to advertisements for accommodation services provided by businesses other than the Complainant. These services appear to fall directly within the scope of the Complainant's two registered trade marks for G'DAY.

According to the Respondent, these links were automatically generated by the Registrar or domain name hosting service.

Some time after June 30, 2021, the Disputed Domain Name ceased to resolve to the PPC landing page. It now resolves to a page which features one of the G'day Marketing logos prepared by the graphic designer and the words "Gday Marketing coming soon".

Under the Policy, as under the Uniform Domain Name Dispute Resolution Policy ("UDRP"), the use of a domain name to host a parked page with PPC links does not represent a good faith offering of goods or services where the links compete with or capitalise on the complainant's trade mark. See e.g., WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 2.9 and auDA Overview of Panel Views on Selected auDRP Questions First Edition ("auDRP Overview 1.0"), section 2.6.

Generally, a respondent cannot avoid liability for such PPC advertising unless the respondent can show it took steps actively to prevent such targeting.

This case is rather different to the typical cases involving PPC advertising as the Respondent has also advanced evidence which provides some corroboration of its claim that it registered and intends using the Disputed Domain Name in connection with a new marketing business to be called “G’day Marketing”.

The evidence is not extensive. It is, however, supported by statutory declarations by some of the persons involved and evidence of the preparation of and payment for logos to be used in the business. As mentioned above, that work was commissioned and undertaken before the Complaint was filed.

Bearing in mind the widespread use of “g’day” as a greeting particularly in Australia and the limited nature of the Complainant’s registrations for G’DAY alone (compared to its other trade marks), the Panel considers it is not appropriate to go behind the Respondent’s declarations about its intended purpose in registering the Disputed Domain Name.

As the Respondent’s supplemental filing points out, disregarding this evidence requires putting to one side evidence given under statutory declaration and requires a finding that it is a fabrication; in effect, a fraud. It is true that the graphic designer is employed by and closely connected with people and entities associated with the Respondent. On the other hand, that is not altogether surprising given the nature of the services and the so-called “gig economy”. The truth, or otherwise, of the claims cannot be tested properly in a proceeding on the papers such as the essentially summary proceedings under the Policy.

As a result, the majority of the Panel considers the PPC parking page does not exclude a good faith offering in the circumstances of this case where there is evidence of demonstrable preparations to use the Disputed Domain Name in connection with a good faith offering of services and the PPC use appears to have been removed promptly.

Accordingly, the Panel finds that the Complainant has not established the Respondent does not have rights or a legitimate interest in the Disputed Domain Name. The concurring Panelist draws the same conclusion as the majority albeit by another approach.

As a result, no good purpose would be served by considering the third requirement under the Policy.

#### **D. Reverse Domain Name Hijacking**

The Respondent has requested that the Panel make a finding of Reverse Domain Name Hijacking (“RDNH”). The majority of the Panel decline to make a finding of RDNH.

The Disputed Domain Name closely resembles the Complainant’s registered trade marks. When the Complaint was filed, the Disputed Domain Name was being used to resolve to a parking page with PPC links which competed with services covered by those registered trade marks. The Respondent has only avoided liability under the Policy by providing evidence of demonstrable preparations to use the Disputed Domain Name in connection with a good faith offering of goods and services which was known only to the Respondent and not publicly available.

Further, when the Complainant investigated the claims advanced in the Response, grounds emerged which raised legitimate questions about the Respondent’s claims. Those questions were addressed and explained, at least for the purposes of a summary proceeding on the papers, only in the Respondent’s supplemental filing.

In these circumstances, the majority of the Panel considers a finding of reverse domain name hijacking is not warranted.

## 7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel unanimously orders that as to the Disputed Domain Name <gday.com.au> the Complaint is denied.

*/Nicholas Weston/*  
Nicholas Weston  
Presiding Panelist

*/Warwick Rothnie/*  
Warwick Rothnie  
Panelist

*/The Hon. Neil Brown Q.C./*  
The Hon. Neil Brown Q.C.  
Panelist  
Date: October 25, 2021

### SEPARATE OPINION BY PANELIST BROWN FOR DISMISSING THE COMPLAINT ON SEPARATE AND ADDITIONAL GROUNDS

This case is one where a trademark owner is seeking to deprive a domain name registrant of a domain name that is a generic and descriptive word and a word that is in common and dictionary use, over which no-one has exclusive rights and which the owner intends to use in a legitimate business, as is its right and in accordance with the regulatory framework intended to govern the registration of domain names to ensure that the trademark owner's rights are not impugned. The trademark owner in this case has a trademark for the word G'DAY, which must be, particularly in Australia, the most generic word in daily use, meaning "hello" in any context and accounting for probably millions of uses each day. The domain name holder acquired a domain name using essentially the same word, "gday", with no other words added to it, and has used it to prepare for starting up a marketing business which will rely on the colloquial meaning of the word "gday", for that is its name. The basis for the trademark owner's claim that the domain name should be prised from the Respondent and transferred to the Complainant under this summary procedure, where none of the evidence is subjected to the scrutiny it would receive in a court, is that any use of the same word in the trademark and the domain name must be an abuse of the trademark owner's rights. That erroneous view overlooks entirely the assessment made by Mr. Justice Stephen in *Hornsby Building Information Centre Limited v. Sydney Building Information Centre Limited* (1978)140 CLR 216 which is in effect that where a trademark owner itself chooses a word that is in common use and open to universal meaning and use, it must accept that there will be some overlap between the various uses that can be made of the word; to give monopoly rights to any side is plainly wrong and should not be countenanced. If that analysis is accepted, as it should be, the result in the present case should be that the Complainant is entitled to its trademark and to its complete protection and use and the Respondent is entitled to its domain name, provided it does not undermine or harm the trademark owner; they can live in harmony with each other. Moreover, in the present case, the Respondent, so far as can be ascertained from the record, has complied with all of the requirements expected and required of domain name owners: it bought the domain name at auction in a process approved by auDA<sup>1</sup>; the name does not invoke the Complainant's or any other name as it is so generic; it could not conceivably confuse the commercial or general community; the word "gday" is so generic and in such universal use that it is just as appropriate for use with the Respondent's marketing business as it is with the Complainant's caravan and parks business; and, most importantly of all, the Respondent has not tried to

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<sup>1</sup> <https://www.auda.org.au/au-domain-names/domain-name-help/official-domain-name-drop-list>.

pass itself off as the Complainant, has not promoted any competing goods and services and has done nothing to disparage the Complainant or its business. For a short time, links to other commercial enterprises appeared on the webpage to which the domain name resolved, although through no act of the Respondent. Virtually none of those links could realistically be regarded as transgressing on the Complainant's trademark or competing with it or being of the slightest interest to users looking for the Complainant's website, as they deal with entirely different goods and services and different areas of commerce from those of the Complainant.

On every point, the Respondent should succeed and be entitled to retain its domain name.

### **Supplementary Submissions**

The first question that arises is whether the Complainant should be permitted to file a supplementary submission. The Respondent has opposed that application and submits that if it is granted, the Respondent should in turn be permitted to file a supplementary submission by way of reply. It has in fact done this in anticipation. It might therefore be said that the Respondent has had an opportunity to reply to all of the Complainant's submissions and that the matter may as well go ahead with two submissions from each party. However, it is a matter of principle whether leave to file a supplementary submission should be granted and that issue should be decided by the Panel. It is this panelist's view that leave should not be given and that the matter should be decided on the Complaint and the Response without the proposed supplementary submissions.

However, there should be an exception in the case of Part V1 of the Complainant's proposed submission which deals with Reverse Domain Name Hijacking. The Complainant should be permitted to file and serve that part of its submission and the Panel should take it into account in its deliberations.

The reasons for this panelist's submission are as follows.

First, it is well understood that these proceedings are supposed to be non-legalistic, concise, economical and conducted on the basis of a Complaint and a Response alone, because they are concerned only with clear cases of cybersquatting. It is for that reason that the parties may make only one statement to the panel. If there are likely to be contested matters of fact and law which arise or become more apparent during the proceeding, a party is not prohibited from pursuing them, but they are expected to go to a national court which will resolve them by having resort to the forensic powers that courts possess to resolve such issues and which a domain name panel does not.

However, those who drew the UDRP and in the present case the auDRP, realised that there may be cases where the panel itself feels the need for further statements from the parties. In the case of the UDRP, the panel was therefore given a discretionary power in the current Rule 12 to "request" additional statements or documents on its own initiative. Thus, only the panel could initiate that process. In the case of the auDRP, the panel was given a discretionary power under the current Rule 12 to "request or permit" additional statements or documents. Thus, an auDRP panel may initiate the process itself by making a request or it can accede to a request from a party and then grant the permission. It is the latter process that the Complainant has sought to activate in the present case.

There is no doubt that the panel has this discretionary power to permit additional statements. But in view of the nature of the proceedings mentioned above and, in any event, because it is common sense, the intention of those who drafted the rules was clearly that granting permission to file further statements would be the exception rather than the rule. Thus, as has been said in decisions by many courts and tribunals such as *Viacom International v. Mahon*. WIPO Case No D2000-1440, relied on persuasively by counsel for the Respondent, a party will be expected to show "exceptional circumstances" before being permitted to file a supplementary submission.



Thus, permission should not be granted as the complainant has not shown that there are exceptional circumstances for permitting additional statements on any of the issues it has raised, or even that the application is based on exceptional circumstances. Rather, the Complainant wants permission to file its further submission because it wants to “correct” the Respondent on several issues and expand and elaborate on others. None of that amounts to exceptional circumstances. Those issues may be looked at in turn.

### **(1) Demonstrable preparations**

The Complainant says that the Respondent’s claim that it made “demonstrable preparations” to use the domain name for a *bona fide* purpose “could not have been anticipated by the Complainant”. The Panel should not accept that submission. One could ask rhetorically how a party in a defended domain name case could **not** have anticipated that the Respondent would raise the defence of demonstrable preparations. It is an obvious and frequently raised issue and is not exceptional or surprising in any way. If the Complainant had told the panel why it could not have anticipated this issue, it may well have been different. But the complainant has not told the panel why it could not have anticipated the issue. Accordingly, to argue not only that it did not anticipate the issue but that it “**could** not” have anticipated it, for no reason given, is singularly unpersuasive and should not persuade the Panel. Finally, at the same time as this proceeding has progressed, the Complainant has had underway other proceedings to claim the domain name <gday.net.au>, another domain name the Complainant had failed to obtain by its own efforts: see *Discovery Holiday Parks Pty Ltd. v. B2B Network Pty Ltd*, WIPO Case No. DAU2021-0027 decided as recently as August 19, 2021. A fair reading of that decision shows that the Complainant must have been on alert that an issue in such proceedings went to the actual use the registrant was making of the domain name; indeed, the Complainant raised the issue itself, namely that the Respondent had no right or legitimate interest in the domain name because of “the lack of *bona fide* use of a domain in connection with offering goods or services”.<sup>2</sup> Accordingly, it is difficult to see how the complainant “could not have” anticipated this issue when the Complainant itself had raised it in the *B2B Network Case*.

### **(2) Descriptiveness of the word “G’Day”.**

On this issue also the Complainant has not shown any “exceptional circumstances” and, unless the regular and established practice is to be abandoned, the Complainant’s request should be rejected. First, any astute observer, especially an Australian, seeking the transfer of a domain name starting with the word “gday” would appreciate that a respondent under attack for registering such a domain name would certainly argue that the domain name was an idiomatic figure of speech which the whole world has the right to use. The complainant must have known when it started this proceeding that this argument would be made and it should come as no surprise that it was raised. If the Complainant did not know this, it should have known it. There is certainly nothing exceptional about it and nothing new, as the meaning of the word has not changed since the proceeding commenced.

In any event, this issue was also an issue in the companion proceeding to recover the domain name <gday.net.au>, *Discovery Holiday Parks Pty Ltd. v. B2B Network Pty Ltd*, WIPO Case No. DAU2021-0027, brought by the same complainant and filed on the same day as the current proceeding. As the panelist pointed out in that decision, a specific issue in the proceeding was that “the word “G’Day” is generic”<sup>3</sup> as it was “a salutation commonly used by Australians.” The Complainant could not therefore have been surprised at the issue being raised in the present proceeding.

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<sup>2</sup> [https://www.wipo.int/amc/en/domains/search/text.jsp?case=DAU2021-0027&utm\\_source=WIPO+Newsletters&utm\\_campaign=fff0d1e7cc-EMAIL\\_CAMPAIGN\\_2021\\_09\\_21\\_03\\_21&utm\\_medium=email&utm\\_term=0\\_bcb3de19b4-fff0d1e7cc-254544833](https://www.wipo.int/amc/en/domains/search/text.jsp?case=DAU2021-0027&utm_source=WIPO+Newsletters&utm_campaign=fff0d1e7cc-EMAIL_CAMPAIGN_2021_09_21_03_21&utm_medium=email&utm_term=0_bcb3de19b4-fff0d1e7cc-254544833)

<sup>3</sup> [https://www.wipo.int/amc/en/domains/search/text.jsp?case=DAU2021-0027&utm\\_source=WIPO+Newsletters&utm\\_campaign=fff0d1e7cc-EMAIL\\_CAMPAIGN\\_2021\\_09\\_21\\_03\\_21&utm\\_medium=email&utm\\_term=0\\_bcb3de19b4-fff0d1e7cc-254544833](https://www.wipo.int/amc/en/domains/search/text.jsp?case=DAU2021-0027&utm_source=WIPO+Newsletters&utm_campaign=fff0d1e7cc-EMAIL_CAMPAIGN_2021_09_21_03_21&utm_medium=email&utm_term=0_bcb3de19b4-fff0d1e7cc-254544833)

In any event, the Complainant is not seeking leave so that it can put evidence before the Panel. Its argument is that the issue of the descriptiveness of the word “gday” is “irrelevant” and it wants to advance an argument on that. That is simply wanting to reargue an issue that could have been and was dealt with in the parties’ submissions. Thus, leave to file further statements should not be allowed simply to pad out and elaborate on a party’s arguments.

### **(3) Complainant’s rights and reputation in the G’Day brand.**

The Complainant’s request under this heading is no more than a request for the complainant to have a second go and expand its own argument about its trademarks, which speak for themselves. The issue is not new and there is no justification for allowing the Complainant to argue about what the trademark record shows and what it does not show, as the record is there for everyone to see. Making new submissions in this way cannot conceivably be due to any exceptional circumstances or as a surprise. Moreover, new submissions on such an issue can do nothing but turn the proceeding into the legalistic process it was designed to avoid.

### **(4) Reverse Domain Name Hijacking (RDNH)**

The Respondent has asked for a finding of RDNH, as respondents frequently do. The Complainant opposed this on the ground that the Respondent is “incorrect” and that the Complainant wants to correct the record. The excuse that a party needs to be “corrected” has never been a ground for allowing supplementary submissions. It may well be more accurate to say that it would be exceptional if a request for RDNH were *not* made.

Nevertheless, the Panel needs to know the Complainant’s response to the Respondent’s request for a finding of RDNH and the Complainant could not have known of the request until the Response was filed. The Complainant should therefore have leave to file the part of its present statement giving its response to the request for the finding of RDNH, namely Part V1 and only that part. As the Panel now knows the attitude of both sides to the request, there is no need for any further submissions on this issue.

### **Conclusion on Supplementary Submissions**

Supplementary submissions should therefore not be allowed, except in the manner described above and relating to RDNH.

If the proposed supplementary submissions on the other issues are allowed by the Panel, which would be a departure from the usual practice in this field, this Panelist would make the following observations on the three grounds that the Complainant must establish under the auDRP to succeed in this proceeding and would find for the Respondent on the significant issues.

### **IDENTICAL OR CONFUSINGLY SIMILAR**

The Complainant alleges that it has 18 trademarks of various forms which it describes as “an extensive suite” and a “family” of G’DAY trademarks. It has not proved them in the usual way, by exhibiting copies of the registration certificates, but searching them all in the registry of IP Australia reveals that they are not as extensive a suite as might be thought when reading the claim made by the Complainant. More importantly, they are not a family of G’DAY trademarks as is alleged.

When an examination of the records is conducted it is seen that the Complainant in fact has, not 18, but two valid trademarks for G’DAY and a series of other trademarks that are not for G’DAY, but for G’DAY with varying additions showing that the Complainant’s trademark in those cases is not G’DAY but G’DAY REWARDS, G’DAY PARKS and G’DAY CONFERENCING which are entirely different. Many of the trademarks relied on are also mere applications for trademarks and have not been registered as trademarks. Nevertheless, it is clear that the Complainant has two trademarks for G’DAY, which the registry says were entered on March 30, 2021, although their priority was of course from the time they were filed.

The Complainant has to show that the domain name is identical or confusingly similar to a trademark or service mark in which it has rights. The domain name is identical to the two trademarks for G'DAY, but it is not identical to any of the pending trademarks nor to any other of the Complainant's registered trademarks.

Nor is the domain name confusingly similar to either of the registered trademarks for G'DAY, as no internet user would think that the "gday" of the domain name was invoking the G'DAY trademark of the Complainant which, like the domain name itself, could be referring to anything.

In particular, and contrary to what is alleged, the domain name is not confusingly similar to any of the composite trademarks such as G'DAY REWARDS, G'DAY PARKS and G'DAY CONFERENCING. No internet user would think that such a widely and so frequently used word as "gday", which casts such a wide net, was invoking any of those trademarks which are confined to specific fields such as reward programs or conferencing.

This panelist therefore would not deny the Complainant's standing to bring the claim, as the domain name is identical to its two trademarks consisting solely of G'DAY. But to suggest that the Respondent has registered a domain name that is confusingly similar to any trademarks of the Complainant and that the Respondent was therefore generating confusion with the trademark, or with anything else, is an unnecessary exaggeration and plainly wrong.

Moreover, it should be noted that, on the evidence, the Complainant has made little use of its G'DAY trademark and has long adopted, not G'DAY but DISCOVERY as its brand, which it is today. Today, on both of its websites "www.discoveryparks.com.au" and "www.discoveryholidayparks.com.au", its brand, name and logo are for Discovery Parks, and the websites make it plain, under the clear "Discovery" logo, that the brand traded under is Discovery. The websites certainly make occasional use of the word "g'day" in the generic and popular sense of extending a greeting, and for example it uses the exhortation to potential customers to "say g'day to the great Australian holiday". But it makes it plain that its brand is Discovery and that it wants to be known as Discovery when, for example, it announces on its website that "Discovery hosts Jimmie as he waltzes Australia." It is plainly so, on its very words, that Discovery and not G'Day is the brand of the business retaining that entertainer as part of its business.

But on the strictly limited basis described above, the Complainant has established its standing.

## **RIGHTS AND LEGITIMATE INTERESTS (RLI)**

The Complainant relies on a series of grounds <sup>4</sup> to show that the Respondent has no rights or legitimate interests in the domain name, including the astounding propositions that to use a domain name to generate advertising revenue is not *bona fide* and is in bad faith and that to invest in and sell domain names is "use in bad faith". Where these precepts rely on so-called precedents and authority, which they are not, they are frequently decisions that were undefended and where there was no serious analysis of the issues at all. For example, it is asserted that the reason why such generation of revenue is not *bona fide* is to be found in four decisions, two of which cannot be read where they are cited and in two of which no Response was filed and the issue was not debated. In any event, the grounds relied on by the Complainant are of no substance, are not based on any provision in the Policy and simply seek to restrict the arbitral duty conferred on the panel by the Policy to examine the evidence and measure it against the plain words of the Policy, raising a serious issue whether a panel that departs from that process even has jurisdiction to do so.

In any event it seems clear that the Respondent has brought itself within paragraph 4(c)(i) of the Policy because it has made "demonstrable preparations to use... the domain name ... in connection with an offering of goods or services..." and that this was *bona fide*.

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<sup>4</sup> Paragraph 36 of the Complaint

The domain name was bought on May 31, 2021. The Complaint was filed on June 21, 2021 which seems to have been the first the Respondent would have known of the dispute. It therefore had limited time to make demonstrable preparations to use the domain name for a *bona fide* offering of goods or services. It is also unreasonable to expect the Respondent to have made every conceivable preparation to use the domain name for a *bona fide* offering of goods and services in such a limited time. But in the limited time available to it, its conduct is consistent with demonstrating that it wanted to keep the domain name and to use it to offer its services as a marketing business. The Complainant may not like the way the Respondent went about this, and clearly feels that it is appropriate to disparage the Respondent for using the professional advisers it chose, but there is nothing wrong at all in using those providers or the work that they did.

In this regard the question is not whether the Complainant approves of the demonstrable preparations made or approves of the providers of those preparations. The question is one of evidence and whether the Respondent can demonstrate the preparations it made in the time it had to make them. That test has clearly been satisfied. Neither the Policy, the Rules or commercial practice or propriety should negate what seems to be the obvious conclusion from the evidence, namely that the Respondent was in the early stages of preparing to use the domain name in its business and was engaging providers to contribute to that work and paying them.

Indeed, the totality of what the Respondent did after it acquired the domain name shows that it had and has both a right and a legitimate interest in the domain name. It bought it at auction under a process approved by auDA. It was entitled to do so. There is no evidence that it conspired against the Complainant and it is inherently improbable that it was doing so. There is no evidence and again it seems highly unlikely that it was preying on the Complainant, doing anything to harm it or even that it had a disposition to do so. Nor has it done anything to deny the Complainant a domain name for "gday" as the Complainant has the domain name <gday.net.au>. One might reasonably ask, what else was the Respondent expected to do, short of not buying the domain name?

It seems therefore entirely unjustified for a panel to find that the conclusion to all of this is that the Respondent simply had no right to acquire the domain name and has no legitimate interest in it.

The Complainant says in effect that all of this can be set to one side because of the links on the Respondent's website, and that they negate any suggestion that the Respondent is *bona fide*. The links are to various services, virtually none of which are in the Complainant's field. The Complainant has claimed from the beginning of this proceeding that it is in the business of "caravan, holiday and resort parks", not hotels or booking services, or even flight bookings (as the Discovery market is clearly one based around driving to the holiday parks), and its websites bear this out. But the links that were for a short time on the webpage, and clearly not activated by the Respondent, are not in those fields, but are links such as to swim spas, holiday packages, a casino, software, debt relief, hotels, flight bookings, defence jobs, employment in child care, regional food and wine, business networking, health retreats, regular hotels, Qantas and removalists, none of which, according to the Complainant, are services that it provides. The Complainant's business is not in those fields. The only one that comes close is the one not mentioned by the Complainant, namely accommodation for travelling workers for which there is one advertisement. It is wrong to allege that using a domain name to promote these services is improper or untoward or that it should be held against the Respondent in any way. Indeed, the advertisements show that the Respondent was probably not interested in the Complainant's activities in the slightest and are consistent with its evidence that it had never heard of the Complainant before this dispute. The latter is almost certainly true, as the Complainant seems on the evidence to have been remarkably coy itself about using the name G'DAY as a brand or trademark, preferring to use the brand DISCOVERY, as is seen from its extensive use of that name and prominent logo on its websites.

In any event the Respondent was doing no more than use the word "g'day" in the same generic manner as the Complainant used it, i.e., meaning "hullo". The short term links were all consistent with that use.

There is therefore no justification for denying the Respondent's right to and interest in the domain name. The substance of the evidence is that the Respondent was perfectly entitled to buy the domain name to use in its business and to prepare it for that use, as it has done.

## THE ELIGIBILITY RULES

The Complainant, however, does raise one serious issue that should be addressed, which is whether the domain name can give rise to an RLI in the light of the new auDA Eligibility and Allocation Licensing rules that restrict who is entitled to register an Australian domain name and who is not.

This panelist's view is that under those rules, the Respondent was entitled to register the domain name.

The Respondent has made out a good case in the Response as to why it has complied with those Rules. The strength of this position is seen from a closer examination of the rules.

Clause 2.4.4 of the Eligibility and Allocation Licensing rules in effect provides that a ".com.au" domain name may be registered if it comes within one of the criteria set out in one of two distinct and separate groups of criteria. The Complainant clearly agrees with the same dichotomy, as is seen from paragraph 28 (on page 7) of its proposed supplementary submission. The two distinct categories are:

(i) Sub-paragraphs (a)– (e) of 2.4.4 of the rules, covering the first category, is that the domain name must be a match or acronym of the applicant's company, business, statutory or personal name, or of the applicant's trademark, body corporate, partnership or trust;

(ii) Sub-paragraph (f) of 2.4.4 of the rules is that the domain name must be a match or synonym of the applicant's goods or services.

The Respondent may be able to bring itself under several of those provisions, but for present purposes there is at least one of them that makes it clear that the domain name meets the requirements of the new rules, thus making the Respondent eligible to register the domain name. In the present case, sub-paragraph (a) applies because the domain name is a match of the Respondent's business name, meaning that the Respondent has a right or legitimate interest in the domain name. That comes about in the following way.

All of the criteria in (a)–(e) compare the domain name with the name of entities, such as a business name associated with the applicant. The domain name must be a match or acronym of one of those entities.

After a gap in the text after the group of (a)–(e) is set out, sub-paragraph (f) then sets out the criteria in a new group of tests which relate not to names associated with the applicant, which was the case with (a)–(e), but to the services that the applicant provides. This group requires there to be a match or synonym between the domain name and the goods and services the applicant provides, for example e.g., an event the applicant sponsors.

The Respondent must pass muster by coming within at least one criteria in either group. As has been indicated, the view of this panelist is that the Respondent passes muster because its domain name is a match of its registered business name. Here it is important to note that the word "match" is defined in the rules in the following way:

*"Match* means that the domain name being applied for is identical to **one**, some or all of words or numbers used in the Person's legal name, business name or Australian Trade Mark. The domain name must use the words or numbers in the same order as they appear in the Person's legal name, business name or Australian Trade Mark and must not include any additional words or numbers. The following are not included:

1. commercial status identifiers such as 'Pty Ltd';
2. DNS identifiers such as com.au;
3. punctuation marks such as an exclamation point or an apostrophe;

4. articles such as 'a', 'the', 'and' or 'of'; and
5. ampersands.

NOTE: A Person with a business name 'Forexample Publishing' would be able to register forexample, forexamplepublishing, forexample-publishing, and publishing as domain names. (Emphasis added)."

The "person" referred to is the person applying for the licence which in the present case is the Respondent.

The applicant for the domain name is the Respondent, which has registered a business name. The business name is in evidence, as is its registration certificate, which is attached to Mr. Keay-Smith's statutory declaration. That evidence has not been challenged. The domain name is "gday", omitting "com.au" as directed by the above rule. It is one of the words of the business name "gday marketing". The domain name does not include any additional words and numbers.

The example given in the above rules makes this clearer. If the business name is Forexample Publishing, then "forexample" may be registered as a domain name. The business name in the present case is "gday marketing", and one of the words in the business name is "gday". That word may therefore be registered as a domain name, as it has been.

This brings the Respondent squarely within the meaning of paragraph 2.4.4 of the Licensing Rules. Thus, far from the rules denying the Respondent a right or legitimate interest in the domain name, they actually create that right.

### **The time when the applicant must qualify**

The only question that can remain is when the match must exist between the domain name and (in the present case) the applicant's business name.

The domain name was acquired on May 31, 2021. The Respondent obtained its business name registration on August 2, 2021. There are three reasons why this gives an RLI to the Respondent.

First, the expression "business name" is also defined. The definition provides:

*"Business name* means a name used **or to be used**, in relation to a business and is recorded on the Business Names Register established under the Business Names Registration Act 2011(Cth)." (emphasis added).

In other words, if a comparison between the domain name and the business name of the applicant is to be made, as in the present case, the business name must be registered and it must be either the name used by the applicant for its business or the name the applicant intends to use for its business in the future. That is clearly the situation here, for it must be unequivocal on the evidence that G'Day Marketing was chosen as the name "to be used" by the applicant as its business name.

Secondly, such a view is also soundly based and consistent with common sense, because parties starting a business would sensibly acquire the domain name they wanted and register it as a domain name if it was the name "to be used" as the business name. If that can be done, they would then register the domain name as their business name. They would hardly acquire a domain name and then start a business with a different name.

Thirdly, the same conclusion is reached by the way the rules set out the various criteria. As noted above, Clause 2.4.4 of those rules provides that a ".com.au" domain name must be:

(a)–(e) a match or acronym of the applicant's company, business, statutory or personal name, or of the applicant's trademark, body corporate, partnership or trust.

After the gap in the text, sub-paragraph (f) sets out a new group of tests which relate not to any of the names associated with the applicant, but to the services that the applicant provides. This group requires there to be a match or synonym between the domain name and, e.g., an event the applicant sponsors. The rule then includes the statement:

“and which that Person is providing at the time of the application.”

In other words, if it is said that the domain name is a match of goods or services being provided by the applicant, they must have been provided at the time of the application. That requirement applies only when something is being “provided” by the applicant. With respect to the whole of (a)-(e), nothing is being provided and the requirement on time therefore does not apply. A proper reading of the rules shows that this was the intention of those who drafted the rules as there is a clear distinction being drawn between the criteria in (a)-(e) on the one hand and (f) on the other hand; the time limit applies only to the later, (f) and not to any of the criteria in (a)-(e)

For all of those reasons, the Respondent has registered a domain name that is a match of its business name.

The Respondent has thus shown a right or legitimate interest in the disputed domain name.

It has also shown that when it represented and warranted that it was eligible to register the domain name, that its representation and warranty were complete and accurate and the Respondent was not in breach of Paragraph 2 of the auDA Policy.

The Complainant has thus not made out the second of the three elements that it must establish.

## **BAD FAITH**

This panelist would find that the Respondent has neither registered nor used the disputed domain name in bad faith. That is so for the following reasons.

### **Alleged registration in bad faith**

1. As the proper finding on rights and legitimate interests (RLI) is that the Respondent has such an RLI, the Respondent had every right to acquire the domain name. That would make it, in the absence of cogent evidence, unlikely that the Respondent was acting in bad faith in registering or using the domain name.

2. The Complainant relies on the provision in paragraph 4 (b)(v) of the Policy that it is evidence of registration or use of the domain name in bad faith that the registrant’s representations or warranties as to eligibility were or became false or misleading.

(a) The Respondent was eligible to register the domain name because it was and is a match of its business name.

(b) As has been explained, “business name” is defined in the relevant rules as a name “used or to be used” in relation to a business and recorded on the register. The evidence is that the Respondent registered the domain name for its proposed new business G’day Marketing and that it registered that business name. The intention that the domain name would be used for a business of that name was clearly formed prior to the acquisition of the domain name as it was the reason for the acquisition. It was therefore a name to be used in relation to a business. The rules were drawn in a workable and practicable way because it is the common experience that a business proprietor would naturally ensure that it had been able to acquire an appropriate domain name before committing itself by registering the business name. That is what the Respondent did and it is exactly what the auDA rules contemplated would happen. There was nothing false or misleading in the Respondent’s representation.

(c) The Complainant also relies on Paragraph 4 (b)(i) of the Policy to argue that the Respondent acquired the domain name primarily to sell or rent it to “another person”. It is clear from the Complaint that the other person the Complainant has in mind is itself. There is a lot of speculation on this from the Complainant, on which it would be wrong for the Panel to act, as there is no evidence at all that this was the intention of the Respondent and nothing from which such an inference could be drawn. The Respondent has made no admissions to that effect and it is surely clear that the last thing the Respondent wanted was to divest itself of the domain name. The Respondent has given an explanation for why it bought the domain name which should be accepted.

(d) The Complainant also draws attention to the links on the Respondent’s website to various enterprises and argues that they show the improper motivation of the Respondent. That conclusion is entirely unjustified. The links in this case are outside the scope of the Complainant’s business on its own admission and its own description of its business. The Complainant itself tells us that it is an “operator of caravan, holiday and resort parks” although it clearly works also in “workstay parks” for workers on construction sites and suchlike (operated under the name and logo of Discovery Parks, not G’Day Parks). But the links that were for a short time on the webpage are not in those fields at all, but are links such as to swim spas, holiday packages, a casino, software, debt relief, hotels, flight bookings, defence jobs, employment in child care, regional food and wine, business networking, health retreats, regular hotels, Qantas and removalists, none of which, according to the Complainant, are services that it provides (although there is one link to “workforce lodgings”). The question should be: what is the substance and real nature of the links? It is apparent that they are not in any practical sense services that are in competition with those of the Complainant.

(e) No case is made out to support the Complainant’s other ground of bad faith, namely that the Respondent wanted to disrupt the Complainant’s business within the meaning of paragraph 4(b) (iii) of the Policy. There is no reason advanced by the Complainant as to why that conclusion is justified and no evidence to support it. It is clear that the Respondent was intending to work in an entirely different field from the Complainant and no reason why its evidence on that issue should be rejected. In any event, it must be clear that if the Respondent retains the domain name, it will have no effect on the Complainant at all; the Complainant runs its business through the domain names <discoveryparks.com.au> and <discoveryholidayparks.com.au> and it has just acquired <gday.net.au> as a result of the decision in *Discovery Holiday Parks Pty Ltd. v. B2B Network Pty Ltd*, WIPO Case No. DAU2021-0027.

### **Alleged use in bad faith**

None of the Complainant’s arguments or evidence justifies the conclusion that the domain name has been used in bad faith. The Panel should inquire as to what in fact the Respondent has done and make its own judgement on whether that conduct amounts to bad faith. The domain name is the most classic example of a commonly used word which the Respondent has a right to use, as does anyone else, provided that it does not target a trademark owner, mislead or confuse the market or engage in some other inappropriate manner. The Respondent, on the evidence, has done none of this. It has bought a domain name at auction, in keeping with auDA’s policy on that process in every respect. It has neither referred to the Complainant, tried to pass itself off as the Complainant, advertised competing goods or services except in the most tangential and peripheral way or done anything at all to harm the Complainant. To describe its conduct as bad faith would be completely unjustified.

The Complainant has thus not made out the third of the three elements that it must establish.

### **REVERSE DOMAIN NAME HIJACKING**

The Complainant must have realised that it was filing a completely unmeritorious claim and one which should not succeed, in view of the highly generic nature of the domain name. It must also have appreciated that the Respondent had done nothing wrong in acquiring the domain name. Moreover, the Complainant, so far as the evidence goes, did little itself to acquire the domain name by means that were available to all



potential buyers to acquire it. Nevertheless, it went ahead with this claim which, in the opinion of this panelist, is completely baseless. That justifies a finding of Reverse Domain Name Hijacking.

*/The Honourable Neil Anthony Brown QC/*

The Honourable Neil Anthony Brown QC

Panelist

Date: October 25, 2021