

RESOLUTION INSTITUTE DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL**auDRP_15_11****Single Panellist Decision****ProCare Health Pty Ltd****v****Procure Consulting Pty Ltd****procare.com.au****The Parties**

1. The Complainant identifies itself as ProCare Health Pty Ltd, ABN 20 121 307 426, a private company limited by shares and domiciled in New South Wales. It is a wholly-owned subsidiary of the Carewell Trust. Its representative is Mr Jason Falinski, a trustee of the Carewell Trust.
2. However, as noted by the Respondent, and confirmed by both an online check of the ASIC website and the Complainant's supplementary submission, that company's name was changed, in October 2008, to Nelson Shiatsu Pty Ltd, having the same address as the Complainant. No explanation has been given as to why this complaint is brought in the former name of a company. This matter will be examined in more detail below.
3. The Respondent is Procure Consulting Pty Ltd, a private company limited by shares, registered in New South Wales in October 1999, ABN 66 089 821 858, but de-registered in January 2014. Its representative, and the registered owner of the domain name in dispute, is Mr Tony McMahon.
4. The domain name in dispute is procare.com.au . The Registrar is Melbourne IT.

Chronology

5. In October 1999, the entity Procure Consulting Pty Ltd was registered, being allocated ACN 089 821 858. I have been given no evidence as to its original shareholders, directors or purposes. A document tendered by the Complainant suggests that, at least in the period 2011-2013, it offered "advice and consulting services to the parking, tourism and rural industry across Australia".

6. In March 2000, Mr McMahon registered the domain name procare.com.au with Melbourne IT. It is common ground that the domain has not been used as an internet presence, but the Respondent maintains that the domain name has been in continuous use since 2000 for the purposes of e-mail addresses for himself and other members of his company.
7. Some time in 2004, the Carewell Trust established another entity, CareWell Health, with the domain name carewell.com.au, the same street address and fax number as the Complainant, and now using the same 'ProCare with Turtle' logo as described below.
8. In August 2006, ProCare Health Pty Ltd was registered by its parent entity Carewell Trust, and allocated ACN 121 307 426. At or about the same date, the Business Name ProCare Health was registered in New South Wales. This business name was cancelled in November 2009.
9. In October 2008, ProCare Health Pty Ltd changed its name to Nelson Shiatsu Pty Ltd, retaining the same ACN and ABN.
10. In May 2010, Mr Falinski registered a Trade Mark, consisting of the word ProCare and a turtle with a greek cross on its back and its front legs in a circle (TM 1359919). It was allocated to ASIC Class 44 – hospital nursing home services and nursing homes.
11. In May 2013, Nelson Shiatsu (formerly ProCare Health) changed several of its company details with ASIC. I have no evidence as to what those changes were.
12. In January 2014, Procure Consulting Pty Ltd was de-registered, and presumably no longer trades. Its domain name, however, continues in use.
13. On 7 May 2015, Georgina Koch, now said to be an employee of the Complainant, but not then identifying herself as such, sent an e-mail to Mr McMahon, noting that the domain name did not appear to be being used, and asking if he would be prepared to sell it to ProCare Health (which, as noted above, had ceased to trade under that name by 2009).
14. After further e-mail exchanges, in which the Respondent suggested a selling price of at least \$20,000 and the Complainant offered \$1,000, the Complainant initiated this Complaint with service provider Resolution Institute on 19 November 2015, requesting a decision by a single panellist. The completed Complaint was received on 9 December 2015. A copy was forwarded to the Registrar on 11 December, and the Registrar confirmed on the same day that the domain name had been locked.
15. Resolution Institute forwarded the Complaint to the Respondent on 14 December, giving a due date for the Response of 3 January 2016. The

Response was received on 1 January. On 4 January, Resolution Institute asked me, Alan Kenneth Chuck, to act as sole panellist, and I accepted on 5 January.

16. I have been given a bundle of material, consisting of the procedural history, the Complaint and the Response. The Complainant made one supplementary submission dated 8 Jan 2016, copied to the Respondent. This was largely a rebuttal of the Respondent's Response, but also confirmed the change of Complainant's name described above. There has been no supplementary submission from the Respondent.
17. I now proceed to determine this matter on the basis of the evidence before me.

Test to be satisfied

18. The test which the Complainant must satisfy in order to succeed is set out in the .au Dispute Resolution Policy (auDRP) Schedule A, which may be summarised as follows:
 - (i) the domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
 - (ii) [the Respondent has] no rights or legitimate interests in respect of the domain name; and
 - (iii) the domain name has been registered or subsequently used in bad faith.

In such an administrative proceeding, the Complainant bears the onus of proof. Note that the limbs are additive, not alternative, ie all three must be satisfied.

Identical or confusingly similar

19. The essential element of the domain name is the word-equivalent "procare". A simple search of the ASIC website shows that over 50 Australian entities have procare (with various combinations of upper and lower case letters) in their names, and an internet search turns up over 500,000 hits worldwide. As the Respondent has noted, there is no evidence that the Complainant has instigated actions against any other of those entities. Nor is there evidence that others using this word have made a complaint against the domain name owner.
20. Therefore, while the keyword of the domain name is, *prima facie*, identical to one word of the Complainant's name, and to the only word in the registered

trade mark to which it claims it has rights, this does not give rise to a valid claim, as:

- (a) The word was chosen by the Complainant after it had already been registered as a company name, and as a domain name, by the Respondent; and
 - (b) The Complainant has since changed its own name; and
 - (c) The Complainant and the Respondent operate businesses in distinctly different fields; and
 - (d) Any confusion arises from the Complainant's own conduct.
21. The Complainant's case therefore fails at the first hurdle. However, should I be wrong on this point, I shall proceed to examine the second and third limbs.

No rights or legitimate interests

22. The Respondent has rights in the domain name, for the simple reason that he registered it first. He was, at the time, carrying on, or planning to carry on, business under that name, and it is his evidence that he has used the domain name for the purposes of e-mail addresses, and continues to do so.
23. I take notice of the decision of the Panel in the matter of Deutsche Post AG v N J Domains¹, in which the Panel states:

The Panel concludes that the use of the domain name by the Respondent for the email address business referred to above shows that he had and has a legitimate interest in the domain name.

In that case, the Respondent had offered the e-mail addresses to third party subscribers on a commercial basis, but I find no reason to distinguish the present matter, where the e-mail addresses are used in-house.

24. I am satisfied that use of a domain name for e-mail purposes, even if the corresponding home page is blank or unused, represents a valid use of the domain name.
25. I therefore find that the second limb of the Complaint fails.

Used in bad faith

26. *Good faith* has been defined as "An act carried out honestly."² There is no corresponding definition of *bad faith*, so I must interpret it to mean "an absence of good faith", or "dishonesty".

¹ WIPO Case D2006-0001 at §B

27. The Complainant's evidence is that, in a series of e-mail exchanges, Georgina Koch approached the Respondent, enquiring as to whether he had any intention of using the domain name, and, if not, whether he would be prepared to relinquish it. The Respondent maintains that, as the e-mail dated 7 May 2015 came from a gmail address unknown to him, and not identifying the Complainant by name, he assumed it to be "a scam" and dismissed it in his response of 8 May, with the words: "I had previously been offered \$20,000. If you are interested in paying above this, send a return e-mail."
28. On 19 May 2015, Ms Koch sent another e-mail to the Respondent, again using her generic gmail address and not identifying her principal, queried the offer of \$20,000, and instead offered \$1,000, together with an offer to host the Respondent's e-mail addresses. There is no record of a reply from the Respondent.
29. On 29 Jun 2015, Georgina Koch again wrote to the Respondent, this time identifying herself as a representative of "a brand and company called ProCare", and again asking that the domain name be transferred. The Respondent's reply was a terse "no thanks", with no elaboration.
30. While the Respondent's conduct might be described as flippant or cavalier, it is not in my opinion dishonest, and I do not accept that the Respondent has, at any time, acted in bad faith in the matter of the domain name. The Respondent established the domain name some six years before the Complainant sought to register either a Business Name or a Company containing the keyword procare.
31. I therefore find that the third limb of the Complaint fails.

² Osborn's Concise Law Dictionary 8e

Decision

32. I therefore determine that the Complaint be dismissed.

DATE: 18 January 2016

Alan K Chuck

Panellist