



ADMINISTRATIVE PANEL DECISION

Carestaff Nursing Services Pty Ltd
v.
Carers Link Pty Ltd trading as Care Staff

auDRP_18_11
<carestaff.com.au>

1 The Parties

The Complainant is Carestaff Nursing Services Pty Ltd of Burleigh Heads, Queensland. It is represented in the proceedings by Troy Sweeting whose relationship with the Complainant is not stated.

The Respondent is Carers Link Pty Ltd trading as Care Staff of Wynnum, Queensland. It is represented by its Commercial Manager, Matthew Brennan.

2 The Disputed Domain Name and Registrar

The Disputed Domain Name is <carestaff.com.au>. The registrar of the Disputed Domain Name is Netregistry Pty Ltd.

3 Procedural History

This is an administrative proceeding pursuant to the .au Dispute Resolution Policy originally adopted by auDA on 13 August 2001, and subsequently amended on 1 March 2008 and re-issued on 15 April 2016 (“auDRP” or “Policy”); the auDA Rules for .au Dispute Resolution Policy (“Rules”) and the Resolution Institute Supplemental Rules for .au Domain Name Dispute Resolution Policy (“RI Supplemental Rules”).

A Domain Name Dispute Complaint Form was originally filed with Resolution Institute (RI) on 28 November 2018. On the following day RI notified the Complainant of several administrative deficiencies and sought a rectified complaint. A rectified complaint (hereafter the “Complaint”) was received by RI on 3 December 2018. The following day RI forwarded a copy of the Complaint to the Registrar and on 6 December the Registrar confirmed the registration particulars and confirmed that the Disputed Domain Name had been server locked. auDA and the Respondent were also notified of the Complaint by RI on that day. The case file is ambiguous as to whether Mr Sweeting’s cover letter was

included given that it contained parts of the rectified Complaint and submissions. The Panel has treated the cover letter and its attachment as the composite Complaint.

Under Rule 5(a) a Response was due 20 calendar days after the proceeding commenced. The Rules make no allowance for weekends or public holidays. Under Rule 4(c) the proceeding is taken to have commenced on the date on which RI completed its responsibilities under Rule 2(a) in forwarding the Complaint to the Respondent. Under Rule 2(g) times are calculated from the date a communication was first made under Rule 2(f). Accordingly, the due date for a Response was Boxing Day. In fact a Response was received on 21 December 2018.

RI approached the Panel on Christmas Eve and, following the Panel's declaration of independence and impartiality, the parties were notified of the Panel's appointment later that day.

All other procedural requirements in relation to the proceedings appear to have been satisfied.

4 Factual Background

The following background facts, taken from the Complaint and the Response, are not challenged by the Respondent:

The Complainant was incorporated on 14 July 1999. It has traded "as a Nursing Agency providing Registered, Enrolled, Assistant Nurses and 'Carestaff' since 1999". It is known to all its clients and "throughout the health/medical sector in which [it operates], simply as 'Carestaff'". The "Carestaff group of companies" includes businesses known as 'Carestaff Childcare Solutions' and 'Carestaff at Home'.

The business name CARE STAFF was registered by the Respondent on 1 April 2016.

Parties' Contentions

Complainant

The Complaint contains the following submissions and evidence, none of which specifically reference the Policy:

In addition to relying on the following registered device mark:



the Complainant relies on the fact that it is known by its clients and throughout the health/medical sector as CARESTAFF, and the fact that other businesses in its corporate group include CARESTAFF in their names.

The Complainant then refers to Schedule C to auDA's *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs*. It submits that the Disputed Domain Name does not qualify under either clause 2(a) or 2(b). It says that the Disputed Domain Name

is neither an exact match, abbreviation or acronym of the Respondent's name or trademark, nor meets the alternative close and substantial connection requirement.

It also recites paragraph 3(b) of Schedule C and submits "therefore you are required to establish that Carestaff existed prior to [when] Carers Link Pty Ltd registered the" Disputed Domain Name. It notes that it was first registered in 1999 whereas the Disputed Domain Name "to the best of our knowledge, was registered 3 years ago approx. and has never been used". It also notes the fact of registration of the above device mark.

In Mr Sweeting's cover letter that attaches the rectified Complaint he includes the following supplementary argument and submissions:

"I initially contacted Carers Link and spoke to their Commercial Manager. I advised that we have a trade mark on the term Carestaff, that we had been trading for nearly 20 years as Carestaff Nursing Services and that we sought the transfer of the Carestaff domain to ourselves. In order to facilitate this process and to minimise the financial impact to both parties, we offered an amount of \$1000 to compensate Carers Link for any inconvenience. This amount was rejected as inadequate. We then increase the offer to \$1500 and advised that we required a response within a week or we would withdraw the offer and submit an application with the appropriate authority to resolve".

Respondent's Response

The Respondent says the following in reply to the Complaint:

1. It registered the business name Care Staff with ASIC on 1 April 2016. At that time it was satisfied that it was not violating anyone else's rights and therefore proceeded to register the Disputed Domain Name, in respect of which it says:
 - a. it shares any similarity to the Complainant's company name with numerous other businesses, in support of which it attaches listings from the Australian Business Register of dozens of names which include the words "Care Staff";
 - b. it relies on its April 2016 Care Staff business name registration to validate its registration of the Disputed Domain Name; and
 - c. it denies registering or subsequently using the Disputed Domain Name in bad faith.
2. It rejects the Complainant's submissions in relation to the eligibility criteria and claims an exact match between the Disputed Domain Name and its registered business name;
3. By reference to the listing from the Australian Business Register referred to above it notes that neither the Complainant's name nor the registered device mark preclude registration of a company name that includes the words Care and Staff;
4. it disputes the Complainant's contention that its company name renders illegitimate registration of the Disputed Domain Name by anyone else and says the nexus, if any, is sufficiently remote;
5. it says the same in respect of any nexus between the registered device mark and the Disputed Domain Name, adding that the Complainant would not be able to obtain a trade mark for the two words Care Staff.

Discussion and Findings

Paragraph 4(a) of the auDRP requires the Complainant to prove that:

- (i) the Disputed Domain Name is identical or confusingly similar to a name, trade mark or service mark in which it has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and
- (iii) the Disputed Domain has been registered *or* subsequently used in bad faith.

The onus of proof is on the Complainant in relation to all three of these elements.

The Panel has to decide the case based on the evidence before it, and the Complainant must prove all of the elements of the Policy.

As noted above, the Complaint does not in terms address the specific provisions of the Policy. However, if the Panel could otherwise discern submissions apposite to provisions of the Policy it would be inclined to entertain them. Here that exercise is next to impossible. Indeed it seems to the Panel that the Complainant may have mistaken the Policy for auDA's Complaints Policy, under section 5 of which complaints may be lodged in respect of breaches of the *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs*. Nevertheless the Panel will deal with the Complaint under the Policy as best it can.

Identical or confusingly similar to a name or trademark in which the Complainant has rights

The evidence supplied by the Complainant shows that, on 12 February 2018, a joint application was made by Christopher Kennedy and Toni Kennedy as trustees of the Kennedy Family Trust, and Airduct Installations Pty Ltd as trustee for the Sweeting Family Trust, for the above device mark. The mark was advertised as accepted on 12 July 2018 and advertised as registered on 27 September 2018.

Apart from the word "Sweeting" being both the family name of the Complainant's representative in the proceedings and part of the name of a trust for which one of the registered proprietors of the trade mark is a trustee, there is no evidence to connect that trademark to the Complainant. The bare ownership evidence is certainly not enough to establish that the Complainant has rights in the registered trademark. The assertion in the Complaint that the Complainant owns the registration for the device mark is clearly erroneous and not one which the Panel can accept in light of the evidence.

The Panel is, however, prepared to accept that the Complainant is colloquially referred to as "Carestaff" by those familiar with its business. To the extent to which that confers common law trademark rights on the Complainant or establishes that it is known by that name, the Panel is prepared to make a finding to that effect for the purposes of this proceeding.

However, "care" and "staff" are ordinary English words, frequently used in juxtaposition, although usually with a space between them. That, as the Respondent itself concedes, is sufficient to establish mere similarity. But in the absence of much more compelling evidence, the Panel is unable to conclude that the Disputed Domain Name is *confusingly* similar to any name or trademark in which the Complainant has rights.

The Complainant has therefore failed to make out the first limb of the Policy to the Panel's satisfaction, and for that reason alone the Complaint must be dismissed.

No Right or Legitimate Interest in respect of the Disputed Domain Name

The Respondent's registration of the business name Care Staff in April 2016 appears to be the basis on which it claimed eligibility for registration of the Disputed Domain Name. The Panel is unable to discern in the evidence any basis on which to conclude that this was not legitimate conduct on the part of the Respondent and it declines to do so. The Complainant's reference to paragraph 3(b) of the *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs* is misconceived – there is no evidence that the Respondent is using the Disputed Domain Name for domain monetisation and, given its business name registration, the Panel cannot draw any inference to that effect.

Accordingly, the Complainant has failed to make out the second limb of the Policy.

Registered or subsequently used in bad faith

Paragraph 4(a)(iii) of the auDRP requires the Complainant to demonstrate that the Disputed Domain Name was registered *or* subsequently used in bad faith.

The Respondent has not addressed the Complainant's allegation that it has not used the Disputed Domain Name but nor has the Complainant substantiated its allegation by reference to the WayBack Machine or any other potential evidence. There is no evidence before the Panel of what use, if any, the Respondent has made of the Disputed Domain Name since it was registered. Even if the Panel assumes that the Disputed Domain Name has not been reflected in a website to which it resolves, there is no evidence of whether it was used in an MX record as an email address domain.

That leaves for consideration under this limb of the Policy the Complainant's evidence in relation to its attempts to purchase the Disputed Domain Name from the Respondent. The evidence does not reveal when the approaches referred to were made to the Respondent, but the panel infers from the language of the Complaint that it was between registration of the device trademark and the filing of the Complaint. Again, the evidence that would be needed to substantiate a finding of bad faith based on rejection of an offer of \$1,500 for what amounts to the goodwill of the Respondent's business is non-existent. Given that the Respondent appears to have traded for at least two years since it registered the Disputed Domain Name, the Panel would be slow to conclude that \$1,500 was an adequate offer and it is unable to do so.

The Complainant's allegation that the Respondent registered the Disputed Domain Name in bad faith is plainly not supported by any evidence. Given the Panel's findings in relation to the second limb of the Policy, it is also impossible for the Panel to find that the Respondent used the Disputed Domain Name in bad faith after becoming the registrant, even if it has made no use of the Disputed Domain Name. Although evidence that the Respondent had wilfully maintained the Disputed Domain Name, without having any intention of using it, so as to block the Complainant's legitimate wish to make use of it, would have given the Panel reason to find in favour of the Complainant on this limb, the Complainant has failed to adduce it.

The Complainant has therefore failed to make out the third limb of the Policy.

8 Decision

The Policy is intended to provide for a swift and inexpensive remedy against what is commonly known as cybersquatting. It is not designed for cases where the credit of witnesses needs to be tested or where more nuanced arguments and other legal principles need to be considered – the Complainant will need to resort to litigation if it believes it has sufficient evidence to demonstrate that the Respondent is doing anything unlawful.

For the purposes of these proceedings, the Complainant has failed to make out to the Panel's satisfaction any of the three grounds on which it needed to succeed. Accordingly, the Panel orders pursuant to Paragraphs 4(i) of the Policy and 15 of the Rules, that the Complaint be dismissed and that the Registry lock on the domain name *carestaff.com.au* be removed.

Dated this 31st day of December 2018

A stylized signature in blue ink, appearing to read 'P Argy'.

Philip N Argy
Panellist