



## **ADMINISTRATIVE PANEL DECISION**

**Perth GP Pty. Ltd.**

**v.**

**Beyond Community & Health Foundation, trading as Beyond the Bell Inc.**

**auDRP\_19\_03**

**<willageemedicalcentre.com.au>**

### **1. The Parties**

The Complainant is Perth GP Pty. Ltd., of South Lake, Western Australia, represented by Spyker Legal of Willetton, Western Australia.

The Respondent is Beyond Community & Health Foundation, of Kardinya, Western Australia, trading as Beyond the Bell Inc.

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

The disputed domain name is <willageemedicalcentre.com.au> ("the Domain Name"). The Registrar of the Domain Name is Web Address Registration Pty Ltd.

### **3. Procedural History**

This is an administrative proceeding pursuant to the 2016-01.au Dispute Resolution Policy published by auDA on April 15, 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").

The Complaint was received by Resolution Institute ("RI") via email on Monday 13 May 2019 and acknowledged on Thursday 16 May 2019. That day a copy of the Complaint was emailed to the Registrar with a request to clarify the Respondent's details and to lock the Domain Name pending the final decision in this proceeding. On Friday 17 May 2019 the Registrar confirmed via email that the Domain Name has been locked. That day RI advised auDA of the Complaint via e-mail and, by email and express post, notified the Respondent of the Complaint lodged against it. These notifications were copied to the Complainant. The due date for a Response was Thursday 6 June 2019. No Response has been received. On Tuesday 11 June 2019, RI approached the Panellist, who on Wednesday 12 June 2019 confirmed his availability, informed RI that he has no conflict issues with the parties and accepted the matter. The case file and relevant correspondence was forwarded to the Panellist on Thursday 13 June 2019.

#### **4. Factual Background**

Both parties operate medical clinics from adjacent premises in Willagee, Western Australia, the Complainant under the business name Willagee Medical Centre, the Respondent under the business name Caralee Medical Centre.

The Respondent registered the business names Willagee Medical & Community Centre on July 15, 2016; Caralee Medical & Community Centre on July 19, 2016; Caralee Medical Centre on March 6, 2018; Beyond Community & Health Centre on October 3, 2018; and Willagee Health Centre on March 22, 2019.

It is unclear when the Respondent registered the Domain Name <willageemedicalcentre.com.au>. This is discussed below.

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

##### **Complainant**

The Complainant says the Domain Name is identical to its business name Willagee Medical Centre, under which the Complainant has carried on business and become commonly known since registering that name with the Australian Securities & Investments Commission ("ASIC") on February 9, 2016; the Respondent has no rights or legitimate interests in the Domain Name and does not presently operate any business under the name "Willagee Medical Centre". It operates a medical practice clinic under the name "Caralee Medical Centre" adjacent to the Complainant's medical practice clinic, in competition with the Complainant. The Respondent's maintenance of the Domain Name is for commercial gain and/or to divert customers away from the Complainant's business and toward the Respondent's business. Prospective clients are likely to be misled or deceived into thinking that the Respondent is associated with the Complainant because the Domain Name is an exact replication of the Complainant's business name.

In around February 2017 the Domain Name redirected to the Respondent's website at "www.carelee.org.au". Following a demand from the Complainant in around March 2017, the redirection was disabled and a disclaimer appeared on the website. In around March 2019 the redirection to the "www.carelee.org.au" website was again enabled. The Domain Name does not currently resolve to a website.

Despite demand, the Respondent has failed to deregister the Domain Name and/or transfer it to the Complainant.

##### **Respondent**

As mentioned, the Respondent did not respond to the Complaint.

#### **6. Discussion and Findings**

The Panellist has jurisdiction to determine this dispute pursuant to Paragraph 2.1 of the auDRP:

“All domain name licences issued or renewed in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP. At the time of publication, the open 2LDs are as.au, com.au, id.au, net.au and org.au.”

Further, RI is an approved Provider under Paragraph 3 of the auDRP and the Panellist has been duly appointed by RI.

Paragraph 15(a) of the Rules instructs the Panel as to the principles it is to use in determining this dispute:

“A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the auDRP requires the Complainant to prove each of the following three elements:

- (i) the Domain Name is identical or confusingly similar to a name (Note 1), 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 Domain Name (Note 2); and
- (iii) the Domain Name has been registered *or* subsequently used in bad faith.

**Note 1**

For the purposes of this policy, auDA has determined that a “name ... in which the complainant has rights” refers to:

- (a) the complainant’s company, business or other legal or trading name, as registered with the relevant Australian government authority; or
- (b) the complainant’s personal name.

**Note 2**

For the purposes of this policy, auDA has determined that “rights or legitimate interests in respect of the domain name” are not established merely by a registrar’s determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration.

**Identity**

The Complainant relies on its business name Willagee Medical Centre (ABN 55 162 175 340) which it registered with ASIC on February 9, 2016. The Complainant clearly has rights in that business name pursuant to Paragraph 4(a)(i) and Note 1 of the auDRP.

The Domain Name is identical to the Complainant’s business name, save for the inconsequential ccTLD “.com.au”, which may be ignored.

The Complainant has established this element.

## Legitimacy

Paragraph 4c of the auDRP provides:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the subject matter of the dispute, your bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that you have acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue.

There is no evidence to suggest that the Respondent has been commonly known by the Domain Name. The Respondent’s registration of the Domain Name does not establish entitlement to the name as shown in Note 2 to Paragraph 4(a)(ii) of the auDRP.

For the reasons set out below in relation to the element of bad faith, the Panel finds that the Respondent’s use of the Domain Name has not been bona fide and that the Respondent’s use is intended, for commercial gain, misleadingly to divert consumers.

The Complainant has established this element.

## Bad faith

The Complainant invokes Paragraph 4b(iv) of the auDRP which provides:

“...the following circumstances, in particular but without limitation...shall be evidence of the registration and [sic] use of a domain name in bad faith:

- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location.

The words “medical centre” are ordinary descriptive words and “Willagee” is a regional prefix.

The following well-known passages from the judgment of Stephen J in the High Court of Australia in *Hornsby Building Information Centre v. Sydney Building Information Centre Ltd* (1978) 140 CLR 216 at 229 are apposite:

“There is a price to be paid for the advantages flowing from the possession of an eloquently descriptive trade name. Because it is descriptive it is equally applicable to any business of a like kind, its very descriptiveness ensures that it is not distinctive of any particular business and hence its application to other like businesses will not ordinarily mislead the public. In cases of passing off, where it is the wrongful appropriation of the reputation of another or that of his goods that is in question, a plaintiff which uses descriptive words in its trade name will find that quite small differences in a competitor’s trade name will render the latter immune from action (*Office Cleaning Services Ltd. v. Westminster Window and General Cleaners Ltd.* (1946) 63 RPC 39, at p 42, per Lord Simonds). As his Lordship said (1946) 63 RPC, at p 43, the possibility of blunders by members of the public will always be present when names consist of descriptive words – “So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some members of the public will be confused whatever the differentiating words may be”. The risk of confusion must be accepted, to do otherwise is to give to one who appropriates to himself descriptive words an unfair monopoly in those words and might even deter others from pursuing the occupation which the words describe.” (At p229).

“There was evidence before the Industrial Court about the antecedents and activities of the Hornsby Centre from which it could have concluded that those concerned with that Centre's activities were intent to benefit from the good repute which the Sydney Centre had, over the years, created for the particular kind of services, unique of their kind, which it had offered as the only building information centre in the Sydney area. However to say this is not to suggest any wrongdoing on their part. Neither the concept of such a centre nor its conduct is anything for which a monopoly can be claimed, any more than it could be claimed for, say, an art gallery. **If the first commercial art gallery in a city meets with an enthusiastic response from the public, competitive galleries are likely to be attracted to the field. They will be free to enter it and to describe themselves as art galleries, that being the descriptive name appropriate to their business; and this despite the fact that the pioneer gallery might have chosen also to style itself "art gallery", prefixed by a regional name. For competitors' conduct to be misleading and deceptive they would have to have adopted as their names the same or a similar regional prefix followed by "art gallery". A quite distinct regional prefix, followed by "art gallery" would neither mislead nor deceive** (at p231). [Emphasis added].

This administrative proceeding is not a passing off case nor, unlike *Hornsby Building Information Centre*, a case of alleged misleading or deceptive conduct in contravention of competition and consumer law. Nevertheless, the Domain Name, being identical to the Complainant’s business name, maintaining the words in the same order and using the same distinct regional prefix, is likely to render Internet users confused as to whether there is a connection between the two. The critical issue is the intent of the Respondent in registering or using the Domain Name.

The parties provide competing medical services from adjacent clinics in Willagee. The Respondent registered the business name Willagee Medical & Community Centre some 5 months after the Complainant registered and started to use its business name Willagee Medical Centre.

Although the date on which the Respondent registered the Domain Name is not apparent from the auDA Whois website and is not stated in the Complaint, the Panel infers that the Domain Name was registered after the Respondent registered the Willagee Medical & Community Centre business name. This is because Under Schedule C of the 2012-04 - Domain Name Eligibility and Allocation Policy Rules

for the Open 2LDs, to be eligible for a domain name in the com.au 2LD, registrants must be an Australian registered company or trading under a registered business name in any Australian State or Territory. Further, domain names in the com.au 2LD must be an exact match, abbreviation or acronym of the registrant's name or trademark or otherwise closely and substantially connected to the registrant, in accordance with the categories of "close and substantial connection" set out in the Guidelines on the Interpretation of Policy Rules for the Open 2LDs.

Here the Domain Name is an abbreviation of the Respondent's Willagee Medical & Community Centre business name and the Respondent would not have been eligible to register the Domain Name prior to registration of that business name.

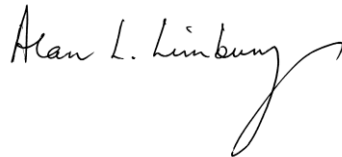
Under these circumstances, the conclusion is inescapable that the Respondent must have been aware of the Complainant and its Willagee Medical Centre business name when it registered the Domain Name. The Respondent has twice used the Domain Name to resolve to its "www.carelee.org.au" website in order intentionally to attract, for commercial gain, Internet users to that website by creating a likelihood of confusion with the Complainant's name as to the source, sponsorship, affiliation, or endorsement of that website or of the services on that website.

The Complainant has established this element.

## **7. Decision**

The Complainant having established all three elements required to entitle it to relief and being eligible to register the Domain Name, the Panel orders that the Domain Name <willageemedicalcentre.com.au> be transferred to the Complainant.

Dated this 21st day of June, 2019.

A handwritten signature in black ink that reads "Alan L. Limbury". The signature is written in a cursive style with a long, sweeping tail on the letter 'y'.

Alan L. Limbury, Panellist