



Resolution Institute

Administrative Panel Decision (single panellist)

The University of Wollongong (ABN 61 060 547 686) vs John Macquarie Capp t/a “Campus Dental” under Business Name “UOWDENTAL”

Disputed Domain Name: <www.uowdentist.com.au>

Matter Number: auDRP_24_2

1. The Parties

The Complainant is The University of Wollongong, c/- Adam Malouf (COO and VP Operations), located at: L4, Building 36, University of Wollongong, NSW 2522.

The Respondent is Dr. John M Capp, t/a Campus Dental, located at Suite 3, L2, 118 -126 Princes Highway, Fairy Meadow, NSW 2519.

2. The Domain Name and Registrar

The disputed domain name <uowdentist.com.au> is registered with Web Address Registration Pty Ltd.

3. Procedural History

| Document/ Correspondence | From | To | Mode & Date of Submission |
|---|-------------|-------------|--------------------------------------|
| Domain Name Dispute Complaint dated Monday, 24 January 2024 | Complainant | Provider | Email Wednesday, 31 January 2024 |
| Acknowledgement of receipt of the complaint | Provider | Complainant | Email Friday, 2 February 2024 |
| Registrar Notification of Domain Name Dispute Complaint dated 24 January 2024 | Provider | Registrar | Email Friday, 2 February 2024 |

Domain Name Dispute: <uowdentist.com.au>

| Document/ Correspondence | From | To | Mode & Date of Submission |
|---|------------|---|--|
| Registrar response with registrant details and confirmation of lock on Domain Name | Registrar | Provider | Email Monday, 5 February 2024 |
| Notification to respondent of Domain Name Dispute Complaint | Provider | Respondent (copy to Complainant, Registrar & auDA) | Email Wednesday, 7 February 2024 |
| Response due Tuesday, 27 February 2024 | | | |
| Response received | Respondent | Provider (and copied to complainant) | Email Tuesday, 27 February 2024 |
| Confirmation of receipt of response and advice to parties that provider will proceed to appoint a panellist | Provider | Parties (and copied to auDA & Registrar) | Email Wednesday, 28 February 2024 |
| Panellist statement of independence & impartiality issued | Provider | Panellist | Email Friday, 8 March 2024 |
| Case File issued | Provider | Panellist | Email Tuesday, 12 March 2024 |
| Notice of nomination of panellist | Provider | Parties (and copied to auDA & Registrar) | Email Tuesday, 12 March 2024 |
| Decision Published | Panellist | Parties (and copied to auDA & Registrar) | Email Friday, 15 th March 2024 |
| Decision due Tuesday, 26 March 2024 | | | |

4. Factual Background (per submissions)

4.1 Complainant (per submission)

The complainant in this administrative proceeding is The University of Wollongong, NSW, Australia.

The University of Wollongong ("UOW") is an Australian public research university located in the coastal city of Wollongong, New South Wales, approximately 80 kilometres south of Sydney (per Wikipedia). UOW represents itself as a "world class university" (ranked 70th for social and economic impact per UN; 162nd in the world and 12th in Australia, per QS World University Rankings 2024, as at 28th June 2023).

Domain Name Dispute: <uowdentist.com.au>

UOW lists a number of related entities, all named "UOW ...". Located in Australia, Hong Kong, Dubai, Malaysia, and "Global".

UOW is generally accepted, in Australia at least, as a serious tertiary education and research organisation with a clear brand and a strong reputation.

Grounds for Complaint (per submission):

The Complainant is the owner of the word mark 'UOW' (Number 1321344).

This trade mark is registered for, amongst other things, advertising and promotional services. The Complainant has built up a considerable reputation in the trade mark within the Illawarra region, across Australia, and internationally.

The domain name 'uowdentist' incorporates the Complainant's trade mark. It is trade mark infringement to use a sign as a trade mark where that sign is substantially identical with, or deceptively similar to, a registered trade mark in relation to the same or closely related services (section 120 of the *Trade Marks Act 1995* (Cth)). The Federal Circuit Court's decision in *Lamont v Malishus Ltd (NZ) (No 4)* [2019] FCCA 3206 further establishes that infringement of a registered trade mark may be made out where a party registers another party's trade mark as a domain, and uses that domain in connection with a website to distinguish their goods or services.

Further, the Complainant is concerned that the use of the domain name will mislead and confuse consumers into believing that there is some affiliation, sponsorship, or other connection between the Complainant and the Respondent's business.

4.2 Respondent (per submission):

The Respondent is a dentist operating a private dental clinic called "Campus Dental", in connection with the contested domain: <uowdentist.com.au>.

The essence of his defence is that:

1. UOW is trying to extend its undisputed right to protect the word mark "UOW" beyond the valid legal boundaries of word mark protection by claiming that "UOW" cannot form part of a larger word.
2. "UOW" is itself used by at least 16 other universities worldwide.
3. "UOW" is used as an acronym (or representation) for a wide variety of other purposes totally unrelated to UOW.
4. "UOW" is used by the respondent as an acronym for "Universal Oral Welfare" on his own website.
5. The Respondent only uses "UOW" as part of larger words including "UOWDENTIST" and "UOWDENTAL" (the latter being a business name he claims to own, registered with ASIC).

6. The Respondent is not in direct or indirect competition with any (dental or related health) services operated by UOW.
7. The Respondent's "Campus Dental" website does not contain any words, reference or form of association (other than geographic proximity) with UOW.
8. UOWDENTAL has been operating continuously, as a dental practice, for over 45 years.

5. Remedy Sought

The Complainant requests cancellation of the Disputed Domain Name.

6. Parties' Contentions

Under the Rules, the Complainant must succeed ***on all three bases*** of complaint:

- (A) The Disputed Domain Name is identical or confusingly similar to various marks in which the Complainant has prior exclusive rights and reputation; ***and***
- (B) The Respondent does not have legitimate rights or interests in respect of the Disputed Domain Name; ***and***
- (C) The Disputed Domain Name was registered, or has been subsequently used, in bad faith.

(A) The Disputed Domain Name is identical or confusingly similar to, various marks in which the Complainant has prior exclusive rights and reputation. (Policy, Schedule A, para, 4(a)(i))

6.1 Complainant (per submission)

The Disputed Domain Name incorporates the Complainant's protected trade mark in such a way as to render it identical with, or deceptively similar to, a registered trade mark in relation to the same, or closely related services.

The Disputed Domain Name will mislead and confuse consumers into believing there is some affiliation, sponsorship, or other connection between the Complainant and the Respondent's businesses.

6.2 Respondent (per submission)

The Disputed Domain Name is neither identical, nor confusingly similar to the Complainant's protected word marks.

The Respondent's business does not compete with the Complainant's business in any way.

The Respondent's website, to which the Disputed Domain Name points, does not suggest any form of affiliation with UOW (other than geographic proximity) by clearly stating that "UOW" relates to Universal Oral Welfare, as the basis for a 45 year old dental practice called UOWDENTAL (which is a registered Business Name).

6.3 Considerations and Decision

The disputed domain name incorporates the whole of the Complainant's acknowledged trademark "UOW", and adds the descriptive word "dentist", as part of a single, constructed word.

The first test under the Policy of whether a disputed domain name is "*identical or confusingly similar*" is designed to be an initial threshold test based on commonsense: on balance of probabilities, is a reasonable internet user (ie: an ordinary person who finds themselves in the website linked to the Disputed Domain Name as a result of their self-directed internet activities) likely to be confused as to the owner and operator of the business represented by that website, by similarities between the site they've arrived at, and the legitimate owner of "*various marks in which the Complainant has prior exclusive rights and reputation?*"

This is not a complicated legal concept about infringement of rights, it's rather a practical test of whether an "ordinary" internet user is likely to be confused into believing that a site they've been directed to could reasonably be expected to confuse them as to who, or with what entity, they're actually dealing.

Finding: The reasonableness test applied by this panellist finds that the addition of the word "dentist" to a mere acronym that's in wide use indicates a very low probability that an average consumer will be confused, and potentially misled, as to who, or with what entity, they're actually dealing. Universities and dentists are very different entities and a minor linguistic association is not likely to create confusion in the minds of ordinary people.

Decision: Accordingly, the Panel considers the disputed domain name is not confusingly similar to a mark in which the Complainant has rights pursuant to paragraph 4(a)(i) of the Policy. The complaint fails on this point, at the outset of the claim.

To complete my reasoning for rejecting this complaint I address the other tests, below:

(B) The Respondent has no legitimate rights or interest in respect of the Domain Name (Policy, Schedule A, para 4(a)(ii))

6.4 Complainant (per submission)

The Complainant does not argue that the Respondent has no legitimate rights or interests in the Disputed Domain name. Instead, it relies on holding an overriding entitlement to exclusive use and protection of its word mark "UOW", under any circumstances.

6.5 Respondent (per submission)

The Respondent explains how and why the Disputed Domain Name relates to a 45 year old business he has operated and in which he owns a relatable Business Name.

Finding: In the absence of any attempt to establish the required argument on this point, and with no submission denying the Respondent's positive contentions, the Panel finds the Respondent does have legitimate rights and interests in respect of the Disputed Domain Name, pursuant to paragraph 4(a)(ii) of the Policy.

Decision: The complaint fails on the second criteria.

(C) The Disputed Domain Name was registered, or has been subsequently used, in bad faith (Schedule A. Paragraph 4 (b)).

6.6 Complainant (per submission)

Paragraph 4(b) of the Policy includes the following criteria as evidence of bad faith registration and/or use of a domain name:

“... (iii) [the Respondent has] registered the domain name primarily for the purpose of disrupting the business or activities of another person; or

(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 of a product or service on that website or location.”

The Complainant does not argue that the Respondent registered, or has subsequently used the Disputed Domain name in bad faith, relying instead on holding an overriding entitlement to exclusive use and protection of its word mark “UOW”, under any circumstances.

6.7 Respondent (per submission)

The Respondent has explained how and why the Disputed Domain Name relates to a 45 year old business he has operated and in which he owns a relatable Business Name.

Finding: The Panel finds no evidence that the Disputed Domain Name has been used in bad faith, pursuant to paragraph 4(b) of the Policy.

Decision: The complaint fails on the third criteria.

7. Decision

Because it fails on all 3 critical criteria, the Complaint is rejected.

The Respondent is entitled to retain ownership and continue its legitimate use of the Disputed Domain Name <UOWdentist.com.au>.



Jon Kenfield (single Panellist)

Published: 15th March 2024