



ADMINISTRATIVE PANEL DECISION

Myca Australia Pty Ltd
v.
Dr Peter H Cole Surgical Pty Ltd

auDRP_21_03

<hellohealth.com.au>

1 The Parties

The Complainant is Myca Australia Pty Ltd [ACN 60 623 783 988] of Aldinga Beach, South Australia. It is represented in the proceedings by Ms Donna vonBlanckensee.

The Respondent is [Dr] Peter H Cole Surgical Pty Ltd [ACN 28 069 297 918], of Wheelers Hill, Victoria. It is represented by Associate Professor Peter H Cole of the Department of Health Sciences at Bond University and the Griffith University School of Medicine in Queensland.

2 The Disputed Domain Name and Registrar

The Disputed Domain Name is <hellohealth.com.au>. The registrar of the Disputed Domain Name is Netregistry Pty Ltd, a member of the Webcentral Group (formerly known as Melbourne IT).

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 29 January 2021. This was forwarded to the Registrar the same day with a request that the registration particulars be confirmed, and the Disputed Domain Name be locked. On 1 February 2021 RI received an email from “Melbourne IT” purporting to

confirm the accuracy of the named registrant and contact particulars and advising that the Disputed Domain Name had been server locked. auDA and Assoc Prof Cole were notified of the Complaint on 2 February 2021.

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) – in this case, 2 February 2021. Accordingly, the due date for a Response was 22 February 2021.

Following receipt of a Response on 22 February 2021, RI approached the Panel and, following the Panel’s Declaration of Independence and Statement of Impartiality, the parties were notified of the Panel’s appointment later that day.

Save for a technical deficiency in the Complaint, addressed below, all other procedural requirements in relation to the proceedings appear to have been satisfied.

4 Factual Background

The Disputed Domain Name was created on 17 October 2003 on which date it was registered by an entity called “Dr Peter H Cole Surgical Pty Ltd” with an ABN of 28 069 297 918. On that same day that entity became registered proprietor of the following word mark in class 41 of the Australian Trade Marks Register:

Hello Health. The smoking cessation programme for the business-minded

This registration lapsed on 17 October 2013 due to non-payment of the renewal fee.

With effect from 29 May 2018 the Complainant has been the registered proprietor of the following trade mark:

hellohealth

in classes 9, 35, 38, 41, 42 and 44.

Hello Health Inc based in Quebec, Canada is the registrant of <hellohealth.com>. The Complainant makes use of the subdomain <au.hellohealth.com> for its webpage and as its email domain. The relationship between the Complainant and Hello Health Inc is not disclosed. The WhoIs record for <hellohealth.com> shows that Hello Health Inc has been the registrant of that domain name since it was created on 7 June 2004.

5 Correct respondent

The WhoIs information accompanying the Complaint clearly shows the registrant to be “Dr Peter H Cole Surgical Pty Ltd” with an ABN of 28 069 297 918. According to the Australian Business Register that ABN belongs to an entity called “Peter H Cole Surgical Pty Ltd”. The ABN history does not record that entity as ever having included the “Dr” prefix. The Panel does not have access to the historical ASIC records of the entity having ACN 069 297 918 but notes that it is currently recorded without the “Dr” prefix. The entity with that ACN was first registered in Queensland on 5 May 1985.

The Response purports to be lodged on behalf of an entity named “Dr Peter H Cole Surgical Pty Ltd”.

The Panel is unable to reconcile the publicly available ABR and ASIC records, all of which omit the “Dr”, with the inclusion of “Dr” in the name of the registrant from the time of creation of the Disputed Domain Name to date, and the adoption of that name by Assoc Prof Cole in the Response that has been filed.

Technically, the only respondent to an auDRP Complaint can be the registrant, namely, Dr Peter H Cole Surgical Pty Ltd. Accordingly, the Panel will use that form in the title of the proceedings.

6 Parties’ Contentions

Complainant

The Complainant asserts that it has taken the last 2.5 years to develop an electronic medical record for use within Australian general practice. It says that “the platform” will be used by general practitioners to record patient encounters, generate prescriptions, request pathology and imaging requests, record immunisations, and integrate with Medicare for billing purposes.

The Complaint also records that “in 2018 Hello Health [sic] entered into a marketing agreement with the Royal Australian College of General Practitioners (RACGP) that included Hello Health being a major sponsor at its National conference for GP18 (2018), GP19 (2019) and GP20 Virtual Conference (2020)”, that “Myca [sic] has invested considerable effort and expense in developing the HELLO HEALTH brand internationally and in Australia”, and that “Hello Health initiated the [Australian] Trademark application in May 2018”.

The Complainant then submits that “Given the size of the potential market there is significant risk that enquiries made by general practitioners/practice managers will be directed away from Hello Health Australia”. It then refers to its <au.hellohealth.com> subdomain as being poor for search engine optimisation purposes “because it always links to the primary domain, in this case to Hello Health US”. In substance the Complainant explains that the best domain name for “Hello Health Australia” is the Disputed Domain Name.

The Complainant then recites the 2013 expiration of the Respondent’s above trade mark registration and its own HELLOHEALTH trade mark registration since May 2018 and submits that:

- a) the Disputed Domain Name is not an exact match, abbreviation or acronym of the registrant’s entity or brand name as they no longer hold the trademark; and
- b) Peter H. Cole Surgical Pty Ltd are also “not able to hold the domain for monetisation purposes as they are not presenting any website in which the domain is related”.

The Complaint then simply seeks as a remedy that the Disputed Domain Name be transferred to the Complainant “as we are confident that we are eligible to hold the domain name under the relevant policy rules”.

Respondent's Response

Given the Panel's findings below it will suffice to summarise the Respondent's extensive submissions and supporting annexures as follows:

- a) The Complainant is a start-up company staking a claim for what has been a totally legitimate use of a legally obtained domain name which is of my [sic] designing, for a continuous period of 18 years beginning in 2003, just because they paid for a trademark with the same name as my domain, after my Trademark of the same name had ended, and a misguided assumption they are missing out on internet traffic because my domain hellohealth.com.au has an advantage because of the ccTLD and theirs did not;
- b) It is self-evident that a domain name which has been indexed by every search engine for 18 years belongs to the owner and can't be usurped on any grounds. My ownership should be respected and the value of content hosted on the domain over the past 18 years has to be acknowledged. My future plans must also be respected as part of my ongoing educational endeavours to help prospective Australian medical practitioners;
- c) The Respondent's [company] name "is still a registered Business name and functioning, and consequently I continue to have legitimate ownership of the" Disputed Domain Name;
- d) In response to the Complainant's denial of the Respondent's right to use the Disputed Domain Name for domain monetisation the Respondent provides evidence of the use of the site to sell a book recording testimonials of lung cancer patients upon whom Dr Cole had successfully operated;
- e) The Respondent does not have a website using the Disputed Domain Name "because around 2015 the site was hacked and I wasn't sure how to fix it";
- f) The Respondent is considering two alternative new uses for the Disputed Domain Name: i) as a site for Dr Cole's wife's newly acquired general practice on the Gold Coast; or ii) a new site altogether "in response to feedback I've got from Chinese Doctors who I was tutoring on the internet" in medical English as well as general English; and
- g) "All in all, I have spent a lot of time and an estimated \$20,000 at least, on my education, website construction, book writing, publishing ,internet conferences and hosting in the last 18 years because of a passion of mine for helping people. Everybody has told me I should do something with all my medical knowledge since retiring, and this is the way I plan to do it, by using the domain hellohealth.com.au and hosting a website to promote one-on-one teaching by me with Chinese speaking medical practitioners".

7 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.

Clause 3(b)(ix) of the Rules requires a Complaint to “describe, in accordance with the Policy, the grounds on which the complaint is made”. Here the Complaint does not advert explicitly to the Policy at all.

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 at least on the balance of probabilities.

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

The uncontested evidence shows that the Complainant is the registered owner of the Australian trademark HELLOHEALTH. Ignoring the 2LD designators “.com.au”, as is appropriate in these cases, the Panel finds that the Disputed Domain Name is identical to that registered trademark in which the Complainant has rights as the registered proprietor.

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

Whilst the Complainant does not, in terms, address the second limb of the Policy, the Panel infers that it relies on the expiration of the Respondent’s former trade mark to make it ineligible to hold the Disputed Domain Name because it no longer meets the eligibility criteria. The Panel notes that vulnerability under auDA’s Complaints Policy is not automatically the same as having no right or legitimate interest *in respect of* the Disputed Domain Name for the purposes of the auDRP.

Assoc Prof Cole has provided more than ample evidence of the legitimate and *bona fide* historical use of the Disputed Domain Name by entities with which he has been associated. Similarly credible are his plans to resume use of the Disputed Domain Name, even though his ability to maintain the registration is now exceptionally fragile given that he appears to have allowed an incorrect entity name to remain as registrant and has allowed to lapse the trade mark on which eligibility for the Disputed Domain Name was grounded. **The Respondent would do well to seek urgent legal advice on what options are available to remedy the likely fatal deficiencies in its current registration.**

In the Panel’s view the Respondent retains a plausible current legitimate interest in respect of the Disputed Domain Name. Whilst its right to retain it may require the Respondent to change its name, or to mount a successful challenge to the Complainant’s registration of the HELLOHEALTH trade mark, or at least endorsement of a legitimate prior or honest concurrent use of that term, the Complainant’s strident submissions of no possible right or legitimate interest are untenable.

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 Complaint makes no reference to that limb of the Policy either in terms or elliptically.

As noted above, Assoc Prof Cole has provided more than ample evidence of the legitimate registration and *bona fide* historical use of the Disputed Domain Name by entities with which he has been associated. Similarly, despite the technical deficiencies of the current registration both by reason of the lapsing of its 2003 trade mark and the discrepancy between the formal name of the Respondent in ASIC and ABR records with

its form in the WhoIs record and in the Response, and therefore the Respondent's likely ineligibility to hold the Disputed Domain Name unless the technical deficiencies can be overcome, those deficiencies cannot be categorised as bad faith conduct on the part of the Respondent.

8 Order

The Complainant has made out neither the second nor the third limb of the Policy. 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 Disputed Domain Name be removed.

Dated this 7th day of March 2021

P Argy

Philip N Argy
Panellist