

Resolution Institute    **auDRP\_15\_08**

Domain Name Administrative Panel

**NICOLE SYKES** on behalf of ORTHOPAEDICS SA PL Complainant

and

Dr TONY SPRIGGINS Respondent

Three member panel

**Determination re: orthopaedicssa.com.au**

**Introduction**

This decision is in two parts. Part 1 is the decision of the majority of the Panel, Gregory Burton SC (Chair) and Jennifer Scott. Part 2 is the decision of the minority of the Panel, The Honourable Neil Anthony Brown QC.

**Part 1.**

**Decision of the majority**

**Procedural History and summary of outcome**

1.(a) The complaint was submitted to Resolution Institute (RI) on 25 September 2015 for decision in accordance with the .au Domain Name Dispute Resolution Policy

("the auDRP" or "the Policy"). The Policy was approved by auDA in 2001, commenced operation on 1 August 2002 and was most recently approved by the auDA Board and published as Policy 2010-05 on 13 August 2010. The Policy includes the Rules for .auDRP ("the Rules") and the LEADR (now RI) Supplementary Rules for .auDRP ("the Supplemental Rules"). The complainant requested determination of the complaint by a single-member panel.

(b) On 28 September 2015, RI acknowledged receipt of the complaint.

(c) On 28 September 2015, RI transmitted by email to TPP Wholesale Pty Ltd a request for registrar verification and to lock the domain name during proceedings. The registrar confirmed locking of the domain name on 29 September 2015.

(d) On 30 September 2015 RI notified auDA of the complaint and also sent the respondent a copy of the complaint by email and post, confirming that the due date for response was 20 October 2015.

(e) On 19 October 2015 RI received the response from the respondent's solicitors together with a request for a three-member panel. Procedures for nominating and appointing a three-member panel were completed between 20 October 2015 and 2 November 2015.

(f) On 4 November 2015 RI forwarded the case file to the appointed panel comprising Gregory Burton SC (Chair), Jennifer Scott and The Honourable Neil Anthony Brown QC. The panel finds that it was properly constituted. All members of the panel have submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by RI to ensure compliance with the Rules, paragraph 7.

(g) On 3 November 2015 the complainant's recently-appointed legal representative foreshadowed provision of supplementary material within two business days, namely, on or before close of business 5 November 2015. The supplementary material was received by RI and forwarded to the panel on 11 November 2015. On

12 November 2015 RI received and forwarded to the panel the respondent's procedural objection to the supplementary material. On 13 November 2015 at the panel's request RI emailed the parties that the panel was considering the procedural request and at present did not require from the respondent a response on the substantive matters in the supplementary material.

(h) **Summary of outcome:** For reasons appearing below, a majority of the panel is minded to grant permission to the complainant to lodge further material in the current circumstances. However, it expressly states that a belated decision to obtain expert assistance (including legal representation) is not of itself a reason for the grant of permission for lodging supplementary material.

(i) For reasons appearing below, the panel does not require the respondent to lodge any further response it may be advised to produce on the substantive matters in the supplementary material. A majority of the panel is of the view that the supplementary material by the complainant, taken with the original material by both parties, fails to make out the complaint. In the circumstances of a mandatory administrative proceeding with no right of appeal, it would be an unnecessary use of resources to require a further response from the respondent to the complainant's supplementary material. The minority of the Panel is of the view that the Complaint fails because the Complainant's supplementary submission should not be admitted, the complaint should be adjudicated on the original Complaint, and, on that material, the claim fails to make out a valid case against the Respondent, for the reasons given in the opinion of the minority in Part 2.

### **Outline of parties' contentions**

#### **Complainant**

2. ' The complainant relies upon the following matters (summarised) in support of its application to have the domain name transferred to it, with material in the supplementary lodgement being identified:

2.1. Orthopaedics SA has been the complainant's registered business name and trading name since 1997. The respondent registered as a sole trader and orthopaedic surgeon in 2004. The supplementary material clarifies that the complainant is the company with the corporate name Orthopaedics SA Pty Ltd and changed to that name in 1998. The supplementary material corrects and expands upon the original material in the following manner. First, the complainant relies upon its corporate name and not a registered business name and says the substantive part of its corporate name is identical to the disputed domain name. Secondly, it relies upon Orthopaedics SA as the trading name since 5 May 2000 of a trust for which the complainant is the trustee (the trust being called "Adelaide Orthopaedics Trust"). Thirdly, it asserts that since May 2001 it has used an unregistered trademark "Orthopaedics SA Bone & Joint Specialists" together with its company name on all of its marketing, stationery and signage, and provides in support one large advertisement in a 2001 issue of the professional journal for the AMA (SA Branch). Although not mentioned in argument, the supplementary material also indicates, from 25 May 2015, a business name OSA Bone & Joint Specialists. The complainant states a broad range of orthopaedic services and substantial revenue as one of the largest groups of orthopaedic surgeons in South Australia.

2.2 On discovering the domain name recently (it appears by inference about mid-2015) the complainant sought to have the domain name transferred to the complainant. The supplementary material asserts that the respondent only registered the disputed domain name to take financial benefit from capturing potential patients and the reputation of the name established by the complainant and refers to, without elucidation of its application or a citation, *ESPN Inc v IMCO Corporation PL*.

2.3 The test in auDRPSch A para4a(iii) is said to be satisfied, with or without the aid of paras 4b(iii) and (iv) of auDRP Sch A. In addition to relying upon

the matters in 2.2 in this respect, the complainant says that the respondent initially agreed to consider transferring the domain name to the complainant and requested a follow-up letter outlining the details. A follow-up letter was sent. After receipt of that letter the respondent indicated that he had changed his mind. The supplementary material says that, by date of initial registration of the disputed domain name on 5 September 2005, the complainant already had a substantial reputation in the same words as the domain name. The fact that the respondent, being the main competitor in South Australia of the complainant, must have been aware of the complainant's existence and its unregistered trade mark, plus absence of choice of an alternative domain name that would have avoided confusion, infers a choice because of the connection with the complainant's name and hence relevant bad faith. *University of Melbourne v Union Melbourne* was cited in support of the choice argument, without citation or detailed elucidation.

## **Respondent**

3. The respondent makes the following answers (again in summary) to the original complaint:

- 3.1 It is unclear who is the complainant. "Orthopaedics SA", the way the complainant refers to itself, is not registered under the *Business Names Registration Act 2011 (Cth)*. The complainant refers to an ACN for Orthopaedics SA Pty Ltd. The complainant also refers to a trust called "Adelaide Orthopaedic Trust Trading as Orthopaedics SA" (the trust name) as the name on which the complaint is based.

- 3.2 The complainant has supplied no evidence that the trust name is registered as a company, business or other legal trading name or as a trade mark. The respondent's searches (provided) do not establish such registration. The complainant has not identified any use of the trust name.

3.3 The trust name is not identical to the domain name. When considered as a whole, the overall impression of the trust name is substantially different from the domain name, incorporating a prefix of five extra words, so there is no confusing similarity.

3.4 The disputed domain name is part only of the complainant's alleged name and that part is both professionally (orthopaedics) and geographically (SA) generic; reference is made to the auDA Overview para 1.2 and *WOW Audio Visual Superstores PL v Comonoz PL* WIPO DAU2007-0003.

3.5 If the short form "Orthopaedics SA" is (contrary to the statements on the complaint) accepted as the alleged registered ABN and trading name for the complainant, then a search (provided) does not bear out that it is currently such a registered business name, nor does a trade mark search (provided) bear out that it is the subject of a trade mark registration.

3.6 The complaint does not assert rights because the words form part of the complainant's corporate name.

3.7 There is no sales and revenue data or other information provided to support reliance upon use as an unregistered trade mark by the complainant, only a single screenshot of a website: para 1.7 of the auDA Overview is referred to. The short form name is a collocation of two "entirely descriptive words". There is no material to demonstrate displacement of the geographical significance of "SA" by long and extensive usage which is distinctive in favour of the complainant: *Discover Tasmania* WIPO DAU 2003-0001 is referred to. There is no evidence to meet the requirement of auDRP para 3(b)(viii) that the relevant goods or services with which the mark is used are to be described.

3.8 For the foregoing reasons concerning the generic nature of the name or of the relevant words in the trust name, there is no reason that the respondent

would not have rights or legitimate interests in a corresponding domain name. The complainant has not asserted to the contrary. In any event, prior to notice of the subject matter of the dispute, the respondent had linked by redirection visitors to the disputed domain name to the respondent's primary website [www.sprigginsorthopaedics.com.au](http://www.sprigginsorthopaedics.com.au) and this has continued following the complaint. The respondent is an orthopaedic surgeon offering his services in South Australia who has practised in South Australia since 1992. His primary website offers information concerning his professional services as such. The respondent has an established professional reputation (not only by practice but also by publication) which fits with his use of the generic domain name in dispute. Paragraph 2.1A of the auDA Overview is referred to. A redirection link is not of itself a barrier to a finding of right or legitimate interest.

3.9 The complainant has not discharged its onus of establishing bad faith in registration or use of the disputed domain name. There is no material on registration of the domain name such as awareness of the complainant's asserted rights at time of registration, or that such asserted rights existed at time of registration, even in the form of the complainant's current corporate name. The respondent's first registration of the domain name was on 5 September 2005.

3.10 In the absence of material on the nature of the goods or services offered by the complainant and the lack of clarity in the complainant's identity, the respondent's conduct of his practice as part of Sportsmed SA PL does not establish any inference of intent to create a likelihood of confusion with the complainant's name or mark in connection with a particular web site. Even if Sportsmed SA and the complainant were in direct competition, the complainant has provided no material demonstrating relevant confusion. There is no branding other than Sportsmed SA on the respondent's primary website, which is reached either directly or by re-direction from the disputed domain name. This has been the active position for many years prior to the

complaint.

3.11 The prior discussions are not in themselves evidence of bad faith let alone bad faith in the use of the disputed domain name. They indicate a preparedness to consider, when approached by the complainant, a transfer of the domain name which resulted in a decision not to do so after such consideration. The respondent did not register the disputed domain name, or create the link, then offer it for money to the complainant.

#### **The auDRP requirements to be proven by the complainant**

4. The matters which the complainant is required to establish are set out in paragraph 4a of the Policy:

“(i) the domain names are identical or confusingly similar to a name (Note 1), 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 names (Note 2); and

“(iii) the domain names have 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.”

- The panel will deal with each of those requirements in turn. On each of them, and overall, the complainant bears the onus.
5. As paragraph 4a(ii) of the Policy requires it to be established that the respondent has no rights or legitimate interests in respect of the domain names, it should also be noted that paragraph 4c of the Policy provides that “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 rights or legitimate interests to the domain name for purposes of para 4(a)(ii):
- (i) before any notice to the respondent of the subject matter of the dispute, the respondent’s 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 he has acquired for the purpose of selling, renting or otherwise transferring); or
  - (ii) the respondent (as an individual, business, or other organisation) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
  - (iii) the respondent is 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.”

6. In respect of paragraph 4a(iii) of the Policy (bad faith), the complainant can take advantage of any findings on the matters set out in paragraph 4b(i)-(iv) which, if found, constitute evidence of the registration and use of the domain name in bad faith. Those factors are :

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

\* (ii) you have registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or

(iii) you have 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 web site 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 web site or location or of a product or service on that web site or location.”.

#### **Discussion and decision on each auDRP requirement**

7. \* As to the first auDRP requirement, the complainant did not, as the respondent says, properly identify in its original material which name it relies upon for its complaint, nor establish rights in any of the alternatives, nor establish the required degree of identity or confusing similarity by appropriate material. This has been rectified in the supplementary material. It is at least clear in that material that the substantive part of the complainant's corporate name is identical to the disputed domain name.

8. The test under para 4(a)(i) of the Policy is one of simple comparison and *prima facie* is made out on the supplementary material but not on the original material. The mere fact that the complainant's corporate name and the domain name are identical is sufficient for the first auDRP requirement, irrespective of the generic or descriptive quality of the words in question. In the context of domain name registration and use, such matters go towards establishing a right or legitimate interest in the domain name, to the potential exclusion of others from a right or legitimate interest. Absent such matters, another person has the right to register and to use a domain name using generic or descriptive words or a generic or descriptive phrase *per se*, even without a nexus to that other person's corporate or business name or to any mark to which that person is entitled under the general law or by statutory registration, and can maintain such registration and usage if it intends to use same as part of its business in the generic or descriptive field and demonstrates a carrying out of that intention.
9. Turning to the second requirement of the Policy, it is now well established that the onus is on the complainant to make out a *prima facie* case on that issue and that the onus then moves to the respondent to rebut the *prima facie* case if it can. But in the final analysis the obligation is on the complainant to establish this element under paragraph 4a(ii) of the Policy.
10. In that regard, the decision that the disputed domain name met the eligibility requirements for registration as a domain name, a decision that was made in the present case but on the circumstances of which the panel has no material before it, does not of itself affect rights to challenge the use by that registrant (the respondent) of the domain name: refer Note 2 to paragraph 4a(ii) of the Policy.
11. Secondly, whether or not the respondent has a right to or legitimate interest in the disputed domain name depends essentially on whether or not it can bring itself within the provisions of paragraph 4c(i)-(iii) of the Policy, which sets out

three bases on which a registrant is deemed to have a right or legitimate interest in the domain name. Those criteria, however, are non-exclusive and it is always open to a respondent to rely on other factors showing that it has the right or legitimate interest referred to.

12. The respondent in the present case relies on two grounds to establish that it has a right or legitimate interest in the domain name which rely upon matters such as we have mentioned in para 8 above. It submits, first, that the domain name is descriptive and generic. Secondly, as a separate but related ground, it submits that the facts bring the case within the provisions of paragraph 4c(i) of the Policy, namely, that before the dispute came to its notice, it was using the domain name for a *bona fide* offering of goods and services.
13. The majority of the panel agrees with both grounds. In the opinion of the majority of the panel, none of the matters raised by the complainant in its original or supplementary material is sufficiently supported so as to negate the respondent's right to register and use a domain name that employs generic or descriptive words, which is essentially what the respondent has done, and to link that website to another website that expands upon the services provided by the respondent, apparently for many years before either party sought a domain name.
14. Turning to the third auDRP requirement, when taken with the material that has led to our conclusion on the second auDRP requirement, we consider that the complainant has not established the third requirement with any additional material of sufficient evidentiary weight. In particular, the material before us does not establish the required purpose or intent to make out paragraph 4b(iii) or (iv) of the Policy.

#### **Concluding matters on substance of the complaint**

15. In the result, the majority of the panel does not find the complaint made out on

the material before us, irrespective of whether or not the complainant's supplementary material is taken into account. This is a compulsory administrative proceeding with no right of appeal from our decision within the bounds of the mandatory auDA Policy. The complainant retains the opportunity to initiate legal proceedings. In those circumstances it is unnecessary to have the respondent incur further expense in this process by dealing with the substance of the supplementary material.

#### **Submission of further material from each party**

16. The complainant submitted further material dated 11 November 2015. The complainant justified the submission of further material on the ground of recent representation by new professional legal advisers who provide apposite material missing from the original material. The respondent, by further material dated 12 November 2015, challenged the complainant's right to submit the further material.
17. The panel has clear power to permit either or both parties to put further material before it, in writing and/or in a hearing: auDRP 2010-05 Sch B rules 10(b), 12, 13. However, the usual course is that the complaint is determined on the material provided in the first instance by each party: auDRP Sch B para 15. The policy of administrative determination within tight time parameters and minimal cost, with the parties left to their curial rights if dissatisfied, would not be served by too easy a dispensation from the usual course which is known to the parties when they file their material. Of itself, better thoughts and preparation after late engagement of professional legal advisers would, and should, not lead to favourable exercise of the power.
18. In the present circumstances a majority of the panel is minded to permit the complainant to rely upon the supplementary material for two reasons. The primary one is that the original material was so defective that it could potentially mean that, if a supplementation was ignored, the requirements of

Sch B rule 10(b) were not fulfilled. The secondary reason is that, even with the supplementary material, the complaint is not made out so that the respondent's extra effort is minimised by the supplementation. (The panel was originally minded, prior to the respondent's procedural response on the supplementary material, to consider the position without initially troubling the respondent for such material.)

Part 2.

### **Decision of the minority**

#### **OPINION CONCURRING ON THE RESULT BUT FOR DIFFERENT REASONS**

I concur that the Complaint should be denied, but for different reasons from those of the majority. These reasons go to some basic questions about the auDRP process and what is expected of parties who commence proceedings under the auDRP. In summary, I agree with the submission of the Respondent that the Complainant's Supplemental submission should not be admitted and that this proceeding should be adjudicated on the basis of the Complainant's original Complaint and the Response. On that basis, the Complaint should fail.

#### **Complainant's Supplemental Submission**

The first issue that arises is whether the Panel should admit the Supplemental Submission of the Complainant and take it into account in reaching its decision. The majority has decided that the Panel is minded to admit the Supplemental Filing. My opinion is that it should not be admitted and that the case should be decided on the original Complaint and the Response. My reasons for so deciding are as follows.

There is no doubt that the Panel has power to permit filings in addition to the Complaint and the Response. That power is conferred by Rule 12 of the Rules which provides that the Panel "may" permit additional statements, thus giving the Panel the discretion to do so. Clearly, that discretion must be

exercised on proper principles and, in particular, having regard to the nature of the proceedings. Proceedings under the auDRP, as with proceedings under the Uniform Domain Name Dispute Resolution Policy (“the UDRP”) are intended to be a summary process with limited formality, tight time lines and limited remedies, namely transfer or cancellation of the disputed domain name or the denial of the complaint. For those reasons, proceedings under the UDRP and the auDRP have, since the inception of the process, been conducted on the basis of the Complaint and the Response alone, with permission to rely on other submissions being granted only sparingly and in very limited circumstances.

That approach has been consistently reflected in the Overview of the process respectively issued by both auDA and WIPO, a major provider of arbitration services under the UDRP and under the auDRP. Thus, the WIPO and auDA Overviews say the party seeking permission to file a supplemental submission must show “exceptional circumstances”. The WIPO Overview notes that the party seeking permission must show “...why it was unable to provide that information in the complaint or response” and the auDA Overview notes that “exceptional circumstances” require a showing that the new material “was unanticipated as relevant” or was “unavailable, at the time of the original filing.”

This approach has also consistently been reflected in decisions by panelists under both of the UDRP and the auDA Policies. Thus in *Delikommat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner* WIPO Case No. D2001-1447 , a decision under the UDRP, the panel noted that “...under the expedited process provided under the Policy and Rules, each party is given one opportunity to put forward all the material on which it wishes to rely and is expected to do so.” Additionally, in a decision a under the auDRP cited by the Respondent, *Clark Equipment Company v. AllJap Machinery Pty Ltd* , WIPO Case DAU2011-0042 , the panel concluded:

“There is no provision for a right of reply on the part of either party. Unless a compelling reason is presented, such as new facts relevant to the determination, that requires a response, it would be contrary to the objectives of the Policy and the Rules, that is to ensure a speedy and inexpensive determination of the relevant issues, to invite or allow supplementary pleadings and evidence. Each party is given a single opportunity to present everything of relevance and, if it fails to do so, there must be very compelling reasons to invite further contributions ...”

Again in *PRODUCTREVIEW.com.au Pty Ltd v Jobsearch Business Systems Pty Ltd*, IAMA3763, also cited by the Respondent and where a supplemental filing by a complainant was rejected, the panel noted:

*“...this [issue] could and should reasonably have been anticipated... That was the type of material central to the issues in the complaint which could reasonably have been anticipated by the complainant to have been advanced in a contest and could have been fully provided by the complainant in seeking to prove its case. “*

Accordingly, although all cases depend on their own facts and circumstances, these sources make it clear that additional submissions will generally be accepted if there is a showing of “a compelling reason”, “very compelling reasons”, an “exceptional circumstance”, or the material “was unanticipated as relevant “or “unavailable, at the time of the original filing”, but will not be accepted where the new material “could reasonably have been anticipated...”.

\* The question then is whether the grounds relied on by the party seeking the permission satisfy any of those tests. In my opinion they are not exceptional



circumstances and there is no compelling reason to admit the new submission.

### **The Grounds Relied on by the Complainant**

The grounds relied on by the Complainant do not justify the admission of its new submission. Those grounds are “a lack of information and error”, as the Complainant “lodged the application without legal advice and accordingly did not appreciate the significance of the additional information”.

To find whether the proposed supplemental submission meets any of the recognised tests, it is necessary to see what the Complainant put by way of the original Complaint and what it wants to put now, by way of the new submission.

### **The original Complaint**

The Complainant in its original Complaint made a series of allegations, which were as follows:

1. Its name was Orthopaedics SA .
2. Orthopaedics SA was a registered Business Name. In support of this, it attached a certificate of registration of that body, not as a Business Name, but as a company
3. It relied on a trademark described as ADELAIDE ORTHOPAEDIC TRUST TRADING AS ORTHOPAEDICS SA.
4. The grounds on which the Complaint was based were the obligation of registrants of domain names not to violate other peoples' rights and an allegation of bad faith against the Respondent.
5. It did not allege that the disputed domain name was identical or confusingly similar to the trademark relied on.
6. Nor did it allege that the Respondent had no rights or legitimate interests in the domain name.

### **The Supplemental Submission**

The Complainant now wants to file a supplemental submission which abandons virtually all of the foregoing allegations and makes new allegations, namely:

1. Its name is "Orthopaedics SA Pty Ltd as trustee of 'Adelaide Orthopaedic Trust (*sic*)".
2. It relies, not on the trademark cited in the Complaint, but on two common law trademarks for ORTHOPAEDICS SA BONE & JOINT SPECIALISTS and ORTHOPAEDICS SA.
3. It alleges that the disputed domain name is identical to the Complainant's "name", which is said to be "Orthopaedics SA".
4. It does not allege that the domain name is identical or confusingly similar to the trademark relied on in the Complaint or either of the two common law trademarks now raised.
5. It alleges that the Respondent has no rights or legitimate interests in the domain name and that the domain name was (apparently, both) registered and used in bad faith.

This recital of the old and new series of allegations makes it clear that the proposed supplemental submission is not supplemental, but is virtually an entirely new claim. In particular, it changes the name of the Complainant, apparently abandons the trademark relied on in the Complaint, relies on two new common law trademarks but, having alleged their existence, does not use them to base its case on any of the trademarks, but on the quite different basis that the domain name is identical to the company's name. It is equally clear that none of the new material could conceivably be described as "unanticipated" or "unavailable, at the time of the original filing"; but it is certainly material that "could reasonably have been anticipated...". The Complainant must have known of all of the material it now wants to include in the Supplemental Submission at the time of the original Complaint and it could have provided all of that material at that time. The material is therefore well outside the material that panels and the arbitration providers have allowed to be admitted in a supplemental submission. Indeed, it would be strange if panelists had allowed complainants to use the power to have supplemental submissions for the purpose of recasting their claims and having a

second go, which is what the Complainant wants to do in the present case. Nor has the Complainant shown “a compelling reason” or “exceptional circumstances” why it should be allowed to have a second go and rectify the defects in the Complaint. The grounds relied on are “a lack of information and error”, as the Complainant “lodged the application without legal advice and accordingly did not appreciate the significance of the additional information”. None of the grounds relied on is persuasive and they are, at least in part, inaccurate, as the Complainant must have had, at the time of the original Complaint, all of the information on which it now wants to rely. Certainly, deciding not to use a lawyer to prepare the Complaint is not an “exceptional circumstance” but is more a matter of a conscious decision having been made by the Complainant. There are additional reasons why the supplemental submission should not be admitted. The proposed new submission does not help to clarify the case at all, but adds confusion to the basic issue of whether the Complainant is relying on some similarity between the domain name and its trademark or with its name. It also raises a new dispute whether any common law trademark exists at all and, if so, what it is. Allowing the new submission also has potential for an injustice to be done to the Respondent, for it is not treating the parties with equality to require the Respondent, which has already had to face the time and cost of replying to the Complaint and giving its defence, now to be required to answer a new and different complaint. Finally, to allow a complainant to have a second go on such a flimsy basis would set a bad precedent for future cases, namely that a complainant may allege a case, without using a lawyer, but after seeing the Respondent’s defence may then retain a lawyer and present a second and different case.

Accordingly, for those reasons I would not allow the proposed Supplementary Submission to be accepted. The result is that the proceeding should be decided on the basis of the original Complaint and the Response alone.

### **Deciding the Case on the original Complaint and Response alone**

As has already been pointed out, the Complaint made several allegations in the original Complaint. But it also omitted other allegations that should have been made, but which were not. Notably, the Complaint alleged that the Complainant was a business name, but proved that it is a company. It did not allege that the disputed domain name was identical or confusingly similar to a trademark or a name as it is defined in the Policy, which is the first of the 3 elements that it must prove. It did not prove the trademark on which it apparently relied, ADELAIDE ORTHOPAEDIC TRUST TRADING AS ORTHOPAEDICS SA and it did not advance any evidence or argument to show that the domain name was identical or confusingly similar to that trademark. These shortcomings mean that the Complaint must fail, because the first of the 3 elements that the Complainant must prove has not been proved or alleged.

- The Complaint is also deficient on the second element it must prove. The Complaint nowhere alleges that the Respondent does not have a right or legitimate interest in the domain name, which is pivotal in the proceeding. As a result the Complaint must fail, as that element also must be proved and there has been no attempt to prove or even allege it.

As to the third element, bad faith, it is true that the Complainant alleges that the domain name was registered or used in bad faith, but it is little more than a bald assertion with no evidence or submissions that might show that such an allegation could be proved.

Indeed, there must be some doubt as to whether there is any valid complaint alive at all in this case which the Respondent must disprove or that there is jurisdiction to hear it. That is so because the Policy in Clause 4 requires a respondent who has registered a domain name to submit to the mandatory administrative proceeding only where a complainant has asserted the 3 elements referred to above, which is the basis of auDRP and UDRP

proceedings. The Complaint in the present case asserted only one of the three elements required and consequently, in all probability, the Complaint was wrongly filed.

Accordingly, I would have rejected the Complainant's Supplemental Submission and dealt with the case only on the basis of the original Complaint and Response and I would have then dismissed the Complaint for the above reasons. I would thus have denied the relief sought.

#### **Determination**

**The complaint is determined against the complainant. Accordingly, the disputed domain name remains registered with the respondent.**

23 November 2015

Determining Panel

Gregory Burton SC (Chair)



Jennifer Scott



The Honourable Neil Anthony Brown QC



Liability limited for each panel member (where relevant) by schemes approved under Professional Standards Legislation in addition to under the auDRP.