



DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

Case No .au DRP_17_06

Panelists: Alan L. Limbury (Chair)
The Hon. Neil Brown QC
Steve Lieblich

**Private Care Pty. Ltd. v. Webguide Solutions Pty. Ltd. t/a GD Net, on behalf of
Daughterly Care Pty. Ltd.**

1. THE PARTIES

The Complainant is **Private Care Pty. Ltd., (ABN 058 551 689)** of Bella Vista, New South Wales, represented by Ms. Reichel Cheslett.

The Respondent is **Webguide Solutions Pty. Limited, t/a GD Net, on behalf of Daughterly Care Pty Ltd., (ACN 097 165 109)** of Collaroy, New South Wales, represented by Cooper Mills Lawyers, Melbourne, Victoria.

2. THE DOMAIN NAME AND REGISTRAR

The domain name in dispute is **<privatecare.com.au>** ("the Domain Name"), registered with Synergy Wholesale Pty Ltd., ("the Registrar").

3. BASIS OF DETERMINATION

The Complaint was submitted for determination under the provisions of the 2016-01 .au Dispute Resolution Policy ("the auDRP"), Schedule A ("the Policy") and the Rules for .au Dispute Resolution Policy ("the Rules"). The auDRP 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 2016-01 on 15 April 2016. The Policy includes the Rules and Resolution Institute's Supplemental Rules for .au Dispute Resolution Policy ("the Supplemental Rules").

Paragraph 2.1 of the auDRP provides:

"All domain name licences issued 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 asn.au, com.au, id.au, net.au and org.au..."

The Domain Name is an open 2LD within the meaning of this provision. It was registered by Webguide Solutions Pty. Ltd. in 2008 and is therefore subject to the mandatory administrative proceeding prescribed by Paragraph 4 of the Policy and incorporated into the registration agreement between Webguide Solutions Pty. Ltd., as current registrant, and the Registrar.

4. PROCEDURAL HISTORY

The Complaint, naming as the Respondent “Webguide Solutions Pty. Limited, t/a GD Net, on behalf of Daughterly Care Pty. Ltd., (ACN 097 165 109)”, was submitted to Resolution Institute (“RI”) on April 10, 2017 for decision in accordance with the Policy. That day receipt was acknowledged and RI transmitted by email to the Registrar a request for registrar verification and that the Domain Name be locked during these proceedings.

On April 24, 2017 the Registrar confirmed that Webguide Solutions Pty. Limited is the registrant; that its contact details are at Daughterly Care Pty. Ltd. and that the Domain Name has been locked. That day RI notified auDA of the complaint via email and sent to Daughterly Care Pty. Ltd. a copy of the Complaint by email and post, confirming that the due date for Response was May 14, 2017, with a copy to the Complainant. According to the Rules, paragraph 4(c), the Commencement Date of the proceeding was April 24, 2017.

On May 13, 2017 a Response was received by RI from Daughterly Care Pty. Ltd. On May 19, 2017 the procedure for nominating and appointing the Panelists commenced and was completed on May 25, 2017.

On May 26, 2017 RI forwarded the case file to the Panelists and notified the parties of their appointment. The Panelists find that the Panel was properly constituted and have submitted the Statements of Acceptance and Declaration of Impartiality and Independence, as required by RI to ensure compliance with the Rules, paragraph 7.

5. FACTUAL BACKGROUND

Both the Complainant and Daughterly Care Pty. Ltd. provide in home care services for paying clients. The Complainant operates a website at “www.private-care.com.au”. Daughterly Care Pty. Ltd. operates a website at “www.daughterlycare.com.au”.

The Domain Name <privatecare.com.au> was initially registered on March 8, 2008 by Webguide Solutions Pty. Ltd. t/a GD Net and was purchased from it on or about January 27, 2017 by Daughterly Care Pty. Ltd. for \$16,500.00. At the time of the filing of the Complaint on April 10, 2017, the transfer of the registration to Daughterly Care Pty. Ltd. had not been recorded and the Domain Name remains registered and locked in the name of Webguide Solutions Pty. Ltd. Unless otherwise stated, the Panel will refer to Daughterly Care Pty. Ltd. as the Respondent.

The Domain Name resolves to the website of the Respondent at “www.daughterlycare.com.au” offering its in home care services.

6. PARTIES’ CONTENTIONS

Complainant

The Complainant says its registered company name Private Care Pty. Ltd. has been registered with ASIC and trading since 1993. It registered the business name Private Care on July 27, 2010 and the business names Private Care Nurses and Private Care Nursing on September 21, 2010.

The Complainant uses a logo comprising the words “private CARE” surmounted by an image of a house, which it uses on all marketing material. The logo has built longstanding trust with its community and is easily recognisable as the Complainant. This is supported by its registered trademark No. 1380124 (currently lapsed) of that logo.

The Complainant says it has better entitlement to the Domain Name; its use by the Respondent violates and infringes the Complainant's rights; the use of the Domain Name by the Respondent is identical and confusingly similar/identical in name and type of service offered to the Complainant's business name, logo and reputation; the Respondent has no right to pass itself off as Private Care Pty. Ltd. by using the Domain Name <privatecare.com.au> and redirecting traffic from this Domain Name to its home page "www.daughterlycare.com.au".

The Respondent has registered and is using the Domain Name in bad faith. Significant evidence of this to satisfy the level of proof required in accordance with paragraph 4(b) of the Policy is: the redirection of the Domain Name is an obvious attempt to deceive consumers into believing the Respondent is the company Private Care, and as the Respondent is a direct competitor offering similar services in the same field, those consumers would easily be misled into believing they have found the Complainant company. Thus the Respondent is clearly attempting to disrupt the Complainant's business by passing itself off as the Complainant and leveraging the longstanding goodwill and reputation the Complainant has built within the community.

Respondent

The correct Respondent is Daughterly Care Pty. Ltd. Because private care is a service the Respondent has offered for 21 years, it chose to purchase the Domain Name in January 2017 from Webguide Solutions Pty. Ltd., who had marketed it to numerous private care providers. Until service of the Complaint the Respondent was unaware that the change of registrant had not been completed.

The Complainant fails to point out that it was incorporated on January 5, 1993 under the name Occasional & Permanent Nannies & Housekeepers (NSW) Pty. Ltd. It changed its name to Private Care Pty. Ltd. on January 4, 2010.

The Complainant also fails to point out that trademark application 1380124 lapsed after being subject to an adverse report and the mark was never registered. The applicant was a company called PNS (Home Care) Pty. Ltd. and there is no evidence that the Complainant is a successor in title.

The term "Private Care" is a descriptive term widely and commonly used within the industry. It refers to home care for paying clients, rather than the more common government funded care services. The Complainant has not advanced any evidence of use or reputation in the term Private Care and has not shown that it has rights in a trade mark or service mark.

As to legitimacy, the overwhelming evidence shows that the Respondent has used the Domain Name in connection with a bona fide offering of private care services. The Complainant has failed to make out a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name. Alternatively, the Respondent's use of the Domain Name in connection with a bona fide offering of goods or services prevents a finding in favour of the Complainant under paragraph 4(a)(ii) of the Policy.

The Respondent denies both bad faith registration and bad faith use and each of the circumstances set out in paragraph 4(b) of the Policy, saying it simply chose the term 'Private Care' for its plain English meaning and the descriptive benefits it would have to highlight the Respondent's offering of bona fide care services from its website "www.daughterlycare.com.au", which it has operated since 2003 and which clearly identifies its operator as Daughterly Care, in a way which no-one could confuse with any other website.

The Respondent says this Complaint is an abuse of process on the part of the Complainant and is a text book case of Reverse Domain Name Hijacking.

7. DISCUSSION AND FINDINGS

Under paragraph 4(a) of the Policy, a domain name registrant is required to submit to a mandatory administrative proceeding in the event that a complainant asserts to the applicable Provider, in compliance with the Rules, that:

- (i) the domain name is identical or confusingly similar to a name [Note 1], trademark or service mark in which the complainant has rights; and
- (ii) the respondent to the complaint has no rights or legitimate interests in respect of the domain name [Note 2]; and
- (iii) the respondent's domain name has been registered or subsequently used in bad faith.

Basis of decision

Paragraph 15(a) of the Rules provides:

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

Identity or confusing similarity

Note [1] to paragraph 4(a) of the Policy reads:

"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."

The Panel finds that the Domain Name is identical to the Complainant's registered company name Private Care Pty Ltd. and to the Complainant's business name Private Care, the suffixes "Pty. Ltd." and the ccTLD ".com.au" being inconsequential. The Domain Name is also confusingly similar to the Complainant's registered business names Private Care Nurses and Private Care Nursing.

The Complainant has established this element.

Rights or legitimate interests

To succeed on this element, the Complainant must make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. As the auDA Overview of Panel Views on Selected auDRP Questions First Edition ("the Overview") paragraph 2.1 observes, after the Complainant makes out a *prima facie* case, the evidential burden falls on the Respondent:

“to provide evidence or plausible assertions demonstrating rights or legitimate interests in the domain name. [...] If the respondent does provide some evidence or plausible assertions of rights or legitimate interests in the domain name, the panel then weighs all the evidence – with the burden of proof always remaining on the complainant.”

Paragraph 4(c) of the Policy sets out examples of a number of circumstances which, if found by the Panel to be proved, demonstrate a respondent’s rights or legitimate interests. Of relevance here is:

“(i) before any notice to you [the Respondent] of the subject matter of the dispute, your bona fide use of, or demonstrable preparations to use, the domain name... in connection with an offering of goods or services.”

This is not a matter of weighing up whether the Respondent has “better” rights than the Complainant. For the Respondent to succeed under paragraph 4(c), it need only demonstrate that it has some rights or legitimate interests, once the Complainant has established a prima facie case of absence of rights or legitimate interests.

Paragraph 2.2 of the Overview addresses the question whether a respondent automatically has rights or legitimate interests in a domain name comprising dictionary words, as is the case here:

“A respondent cannot rely solely on the fact that the domain name is composed of ordinary language words to ground a claim to rights or legitimate interests in it. If the complainant makes a prima facie case that the respondent has no rights or legitimate interests in the domain name, and the respondent fails to show one of the three circumstances under paragraph 4(c) of the auDRP, or any other basis for rights or legitimate interests, then the respondent will lack a legitimate interest in the domain name even if it is comprised of a dictionary, descriptive or generic word or phrase. Where the complainant has a registered trademark to which the domain name is identical, the complainant is entitled to a rebuttable presumption that its mark is distinctive rather than descriptive.

Where the domain name is highly descriptive, the complainant must make a strong case in order to establish, prima facie, that the respondent does not have rights or legitimate interests in it. As a general principle, the less distinctive is the complainant’s mark or name, the more likely it is the respondent will have rights or legitimate interests in a corresponding domain name.

Factors that are relevant to determining if the respondent has rights or legitimate interests in a descriptive, generic, or dictionary word domain name include the distinctiveness, status and fame of the trademark or name in which the complainant has rights, the likelihood of customer confusion, and whether the respondent was aware of this likelihood prior to registering the domain name. Where the complainant’s trademark has a very considerable reputation and there is a strong likelihood of confusion between it and the domain name, the descriptive nature of the words constituting the domain name will not give the respondent rights or legitimate interests in it. Where there is evidence of actual customer confusion between the domain name and the trademark, the descriptive nature of the words constituting the domain name will not give the respondent rights or legitimate interests in it ...”

Here the majority finds that the Domain Name is highly descriptive of the services that both parties and others in the industry provide and that the Respondent is using the Domain Name to offer such services; the Respondent's website does not resemble that of the Complainant and displays the name Daughtery Care sufficiently clearly and prominently as to avoid causing any confusion as to the identity of the operator of that website or its affiliation; the Complainant has not established that it has either a registered trade mark or a common law trademark in the highly descriptive words "Private Care"; there is no evidence of customer confusion and the majority considers the likelihood of such confusion is not great; and even if the Respondent was aware of the likelihood of customer confusion prior to its purchase of the Domain Name, (as to which there is no evidence) such confusion is of the kind that must be accepted when rival businesses use highly descriptive trade names, as noted by Stephen J in *Hornsby Building Information Centre Pty. Ltd. v. Sydney Building Information Centre Ltd* (1978) 140 CLR 216 at 229:

"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."

The majority accepts the Respondent's evidence, by way of website pages, that the words "private care" are used in the industry to describe home care services paid for by the consumer and are commonly used by providers of such services to consumers.

The majority considers this case to be similar to *Peacock Media Group Pty Ltd v. Your Solar Quotes Pty Ltd.*, WIPO Case No. DAU2017-0005, in which the learned panelist said:

"The use of the term "Solar Quotes", both as a company name and descriptively is common in the industry. While there are similarities between the Complainant's and the Respondent's Websites, there are also obvious differences in design and layout and the similarities can be explained by the nature of the business offered by the Complainant and the Respondent. While the Panel accepts that there may be confusion between the Complainant and the Respondent's businesses, such confusion may arise from the fact that the term "solar quotes" has been used broadly in the relevant market."

On the evidence provided, the majority finds that the Complainant has failed to establish a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name; alternatively that the Respondent has established that it has. On either view, the Complainant has not established this element of its case. The Internet needs the free and open ability to register highly descriptive domain names on a first come, first served basis.

Registered or subsequently used in bad faith

Paragraph 4(b) of the Policy provides:

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and [*sic*] use of a domain name in bad faith:

- (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 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; or
- (v) if any of your representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

To establish this element the Complainant relies solely on the evidence that the Domain Name resolves to the Respondent's website “www.daughterlycare.com.au” and submits that the Respondent is thereby clearly attempting to mislead consumers and disrupt the Complainant's business by passing itself off as the Complainant and leveraging the longstanding goodwill and reputation the Complainant has built within the community.

It is only if the assumption is made that the words “private care” have come to distinguish the Complainant and its services from others in the industry providing the same or similar services that any such conclusion can be drawn. However, the Panel is required to be satisfied on the balance of probabilities by evidence, not mere assumptions.

The majority finds that the Complainant has failed to provide any evidence that it has built goodwill and reputation in the highly descriptive words “private care” such as to support its assertion of passing off based on the likelihood of consumer confusion. Nor is there any evidence that could support a conclusion that the price of \$16,500.00 paid by the Respondent for the Domain Name was other than its value as a highly descriptive domain name.

The words of Stephen J noted above are relevant to this element as they are to the element of legitimacy.

The majority notes that the sub-page on the Respondent's website accessed via the tab labelled "Private Care" has the sub-domain <privatecare.daughterlycare.com.au>, whereas all the other sub-pages are in the form <daughterlycare.com.au/(sub-pagedescriptor)>. The majority considers that Internet users, having reached the home page, will already appreciate that the website is that of the Respondent by the time they see the "Private Care" tab and that, having clicked on it, they would focus their attention on the sub-page to which it resolves, so that they would be highly unlikely to perceive the sub-domain address. Even if they did, they would not understand either the tab or the sub-domain address as associated with the Complainant.

Accordingly, the majority is not persuaded that this is a deliberate attempt by the Respondent to assert rights to the term "privatecare" when used in the Domain Name, despite its similarity to the Complainant's domain name <private-care.com.au> nor that this is an attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with any of the Complainant's names, including its domain name.

The majority is not satisfied that the Complainant has established any of the circumstances set out in paragraph 4b of the Policy or any other circumstances that would justify a finding of bad faith registration or use on the part of the Respondent.

Reverse Domain Name Hijacking

Under paragraph 1 of the Rules, Reverse Domain Name Hijacking is defined as:

"using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name".

Under Rule 15(e) of the Rules:

"If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

In *Futureworld Consultancy (Pty) Limited v. Online Advice*, WIPO Case No. D2003-0297 the Panelist considered that a finding of Reverse Domain Name Hijacking may be made if the Complainant "knew or should have known at the time it filed the Complaint that it could not prove that the domain name was registered or used in bad faith".

In the present case the Complainant would have been aware at the time the Complaint was filed of the highly descriptive character of the words "private care" and that the Respondent, a competitor, was engaged in the business of providing private care services in Australia through its website "www.daughterlycare.com.au". The Complainant would also have been aware that it was not providing, with its Complaint, any evidence that its use of those words had given rise to goodwill or reputation of the kind that could support the claim for passing off made in the Complaint. Further, the Complainant referred to its lapsed "registered trademark" when it knew that mark had never been registered and that the applicant was not the Complainant.

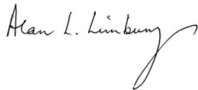
By majority, the Panel is of the opinion that the Complainant knew or should have known that it could not prove that the Respondent lacked rights or legitimate interests in the

Domain Name nor that the Domain Name was registered or subsequently used in bad faith. Therefore, the Panel finds that this is an instance of Reverse Domain Name Hijacking in that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. This conclusion is reinforced by the Complainant's statement that "its registered company name Private Care Pty. Ltd. has been registered with ASIC and trading since 1993", when the name under which the Complainant was incorporated in 1993 was Occasional & Permanent Nannies & Housekeepers (NSW) Pty. Ltd., which it changed to its present name in 2010.

8. DECISION

The Complainant having been found by majority to have failed to satisfy all the elements of paragraph 4(a) of the Policy, it is ordered that the Domain Name <privatecare.com.au> REMAIN WITH the named Respondent, Webguide Solutions Pty. Ltd. t/a GD Net so as to enable it to complete the transfer of the Domain Name to Daughterly Care Pty Ltd.

Dated: June 6, 2017



**Alan L. Limbury, Chairman
PANELISTS**



The Hon. Neil Brown QC

Dissenting Opinion

Contrary to the opinions of my learned colleagues (and therefore the majority decision of this panel), and for the reasons set out below, I'm of the opinion that the registration of the domain name www.privatecare.com.au to the Respondent should be cancelled.

Definitions

In this section ("Dissenting Opinion"), the following words and phrases shall, subject to the .au Dispute Resolution Policy No. 2016-01, have the meanings given to them as follows:

word or phrase	meaning
"C<n>"	refers to paragraph <n> of the Complaint, where "<n>" is the number of the paragraph.
"P<n>"	refers to section <n> of the Policy, where "<n>" is the number of the section.
"R<n>"	refers to paragraph <n> of the Response, where "<n>" is the number of the paragraph.
"PA<n>"	refers to section <n> of Schedule A of the Policy, where "<n>" is the number of the section.

1. Is the disputed domain name identical or confusingly similar to a name, trademark or service mark in which the complainant has rights?

I concur with my learned colleagues' finding on this matter: that **the disputed domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights.**

2. Does the Respondent have no rights or legitimate interests in respect of the domain name?

Note [2] of the Policy states that:

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 Respondent asserts that:

- "... 'private care' is a descriptive term commonly used within the industry ...[it] refers to home care for paying clients rather than the more common government funded services" [R7.A];
- it has a right and legitimate interest in the Domain Name [R7.B];
- it redirected the Domain Name to its website where it makes a bona fide offering of private care services, and it did this before ...notice of a dispute [R7.B];
- "...on the Respondent's website, 'private care' services ...have their own menu link and subdomain: *privatecare.daughterlycare.com.au...*" [R7.B, and Annexure 5];
- the Respondent's website at *privatecare.daughterlycare.com.au* says "Daughterly Care has provided private care to over 5,800 families, over the last 19 years..." [R7.B]; and
- "...the fact that the Respondent clearly and prominently displays its trade mark Daughterly Care can leave no doubt that it is making an honest bona fide use of the Domain Name without causing any confusion, or seeking to pass off as the Complainant" [R7.B].

I accept the Respondent's assertion that 'private care' is a descriptive term commonly used within the industry. However, if the Respondent is the original registrant of the Domain Name, Webguide, it is clear that it has no rights or legitimate interests in it, as evidenced by:

- the fact that (as detailed in section 3 below) it apparently registered the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the registration to another person, which it did, 9 years after the initial registration; and
- it has made no submission as to any other interest that it may claim to have.

Alternatively, if, as the Respondent asserts, the correct Respondent is Daughterly Care, then it could claim some right to that name, to the extent that all other persons and organisations in the same industry could make that claim.

Paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, the consensus view on this element of the UDRP is that

"If the complainant makes a prima facie case that the respondent has no rights or legitimate interests, and the respondent fails to show one of the three circumstances under Paragraph 4(c) of the Policy, then the respondent may lack a legitimate interest in the domain name, even if it is a domain name comprised of a generic word(s)."

Similarly, P2.2 states that

"A respondent cannot rely solely on the fact that the domain name is composed of ordinary language words to ground a claim to rights or legitimate interests in it. If the complainant makes a prima facie case that the respondent has no rights or legitimate interests in the domain name, and the respondent fails to show one of the three circumstances under paragraph 4(c) of the auDRP, or any other basis for rights or legitimate interests, then the respondent will lack a legitimate interest in the domain name even if it is comprised of a dictionary, descriptive or generic word or phrase."

Rule 4c states

How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint.

...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.

The Respondent makes no assertion that item (ii) (that the Respondent has been commonly known by the domain name) or (iii) (non-commercial or fair use) mentioned above, are applicable in this case. The Respondent's assertion is, in accordance with item (i), that it has made bona fide use of the domain name in connection with an offering of goods or services.

However, for the reasons given in section 3 below, it appears that the Respondent's sole use of the Domain Name, is for the purpose of diverting Internet traffic to its own website – traffic that may have been seeking to find the Complainant's website, which is located at an Internet domain that differs from the subject Domain Name only by the omission of one hyphen. Furthermore (as further detailed in section 3 below), on each page of the Respondent's website, the trading name "Daughterly Care" appears only in small font as part of the logo on the top LHS of the page. Each page is otherwise dominated by a headline "In Home Care", or in one case "Private Care". This increases the likelihood of confusion by the traffic to the Respondent's website that arrived by being diverted from the subject Domain Name.

I refer to paragraph 7.35 of *Informa Australia Pty Ltd v. Reed Business Information Pty Ltd*, LEADR Case No. auDRP02/09 (2009), <earthmove.com.au>, in which the panel stated that:

..an offering of goods or services is not bona fide if use of the Disputed Domain Name is likely to cause consumer confusion..."

Furthermore, in section 6B of *Bernard Janes v. L.J. Bubenicek & A. J. Main, A&L Technologies*, WIPO Case No. DAU2010-0014 (2010), <goballistic.com.au>, the panel stated that

"Although the Respondent has used the disputed domain name in connection with an offering of services, that use is not bona fide. It is true that the disputed domain name is descriptive of the services provided by the Respondent. However, that fact alone does not mean that the Respondent's use of the disputed domain name was bona fide. The Latin phrase bona fide means "in good faith". To determine whether a use of a domain name is in good faith requires a consideration of the motivation of the entity undertaking it. That, in turn, requires an evaluation of the facts and evidence contained in the case record. The record in this case supports the conclusion that the motivation of the Respondent in adopting the disputed domain name... was to use a domain name that was very similar to the business name of a competitor, and thereby to benefit from the reputation that the competitor had developed in that name."

In section 6C of the above-mentioned case, the panel found that

“The Respondent has used the disputed domain name to direct traffic to ... websites selling products competing with the Complainant. It is now well-established that the use of a parking page in this manner is strong evidence of bad faith....”

It is my opinion, that also in this subject case, the motivation of the Respondent in adopting the disputed domain name was to use a domain name that was very similar to the Complainant’s, and thereby to benefit from the reputation that the Complainant had developed in that name.

The panel in *Confo Pty Ltd v. Meridian Project Consulting Pty Ltd*, LEADR Case No. auDRP20/10 (2010), <buildercpd.com.au>, similarly found that

“The Respondent has used the disputed domain name to direct traffic to ...websites selling products competing with the Complainant. It is now well-established that the use of a parking page in this manner is strong evidence of bad faith. ... the motivation of the Respondent in adopting the disputed domain name... was to use a domain name that was very similar to the business name of a competitor, and thereby to benefit from the reputation that the competitor had developed in that name... The Respondent has used the disputed domain name as ... an attempt to attract, for commercial gain, Internet users to its website. Given the Panel’s findings that the disputed domain name is confusingly similar to the Complainant’s name, and that the Respondent’s motivation for adopting the disputed domain name was to benefit from the reputation in the Complainant’s business name, it follows that this use of the disputed domain name is an intentional attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s name.”

In *World Wrestling Federation Entertainment, Inc. v. Rift*, WIPO Case No. D2000-1499, the panel stated *“not all use prior to notice of the dispute can qualify as bona fide use”*. Further, the panel in *Madonna Ciccone p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847, noted specifically:

“We . . . conclude that use which intentionally trades on the fame of another cannot constitute a "bona fide" offering of goods or services. To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy.”

Thus I reject the Respondent’s assertion that “the Respondent ... is making an honest bona fide use of the Domain Name without causing any confusion, or seeking to pass off as the Complainant”, and arrive at the opinion that on the balance of probability, and for the purpose of this Administrative Procedure, **the Respondent has no particular rights or legitimate interests in respect of the disputed domain name.**

3. Has the disputed domain name been registered or subsequently used in bad faith?

PA4b states that:

For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(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 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; or

(v) if any of your representations or warranties as to eligibility or third party rights given on application or renewal are, or subsequently become, false or misleading in any manner.

Webguide Solutions Pty Ltd (“Webguide”) registered the Domain Name on 8 March 2008 [R6.b)]. Daughterly Care Pty Ltd (“Daughterly Care”) purchased the Domain Name on 27 January 2017 [R6.b)], paying \$16,500.00 [R, Annexure 1], submitting that it “took the opportunity to invest a significant amount of money into the domain” [R7, B].

Apparently, as evidenced by the above-mentioned transaction, 9 years after the initial registration of the Domain Name, Webguide registered 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 [its] documented out-of-pocket costs directly related to the domain name*. If Webguide is the Respondent, this would be sufficient to determine that the registration was made in bad faith, under [PA4b(i)].

The Respondent asserts that it is the “correct Respondent” although the Change of Registrant had not been effected prior to the Complaint. So, for the removal of doubt, I consider the other conditions for establishing whether PA4b can be determined.

The Domain Name is redirected to <https://daughterlycare.com.au/>. The Headline on the Home page reads “In Home Care” and the trading name “Daughterly Care” appears only in small font as part of the logo on the top LHS of the page.

The Home page provides access to the following sub-pages as follows:

TAB name	Sub-page URL
Why Choose Us	https://daughterlycare.com.au/better-alternative-to-a-nursing-home
Our Caregivers	https://daughterlycare.com.au/best-in-home-care-caregivers
Services	https://daughterlycare.com.au/our-services
24 Hour Care	https://daughterlycare.com.au/24-hour-care
Dementia	https://daughterlycare.com.au/our-services/dementia-care-specialists
Private Care	https://privatecare.daughterlycare.com.au/
Home Care Packages	https://daughterlycare.com.au/our-services/consumer-directed-in-home-care-cdc-packages
Fees	https://daughterlycare.com.au/what-does-in-home-care-cost
Free Consultation	https://daughterlycare.com.au/free-in-home-care-consultation
FAQs	https://daughterlycare.com.au/faqs

All the sub-pages have a URL of the form <https://daughterlycare.com.au/<<sub-page-descriptor>>>, **except** the sub-page accessed via the TAB labelled “Private Care”, which has the sub-domain URL <https://privatecare.daughterlycare.com.au/>.

All the sub-pages have a Headline which reads "In Home Care" and the trading name "Daughterly Care" appears only in small font as part of the logo on the top LHS of the page, **except** the sub-page accessed via the TAB labelled "Private Care", which has the Headline "Private Care" with the trading name "Daughterly Care" similarly appearing only in small font as part of the logo on the top LHS of the page.

In summary:

- the Respondent uses the Domain Name to redirect all traffic to its general web site;
- the headline on almost all its web pages is "In Home Care" and the trading name "Daughterly Care" appears only in small font as part of the logo on the top LHS of the page, thus not clearly identifying itself;
- just one page on the Respondent's website is an exception: the sub-page accessed via the TAB labelled "Private Care", which has the sub-domain URL: `privatecare.daughterlycare.com.au`, which appears to be a deliberate attempt to assert rights to the term "*privatecare*" when used in a URL (including the Domain Name), which is confusingly similar to the Complainant's registered URL; *private-care.com.au*.

These behaviours indicate to me that the Respondent has

(ii) ... 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) ... registered the domain name primarily for the purpose of disrupting the business or activities of another person; or

(iv) by using the domain name, [Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [its] website ... by creating a likelihood of confusion with the complainant's name or mark ...

Thus I arrive at the opinion that on the balance of probability, **the disputed domain name was:**

- **(originally, by Webguide) registered primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration; and**
- **(subsequently by Daughterly Care) used in bad faith to prevent the Complainant from reflecting that name in a domain name, or primarily for the purpose of disrupting the business or activities of the Complainant, or intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's name.**


Steve Lieblich
PANELIST