



Domain Names: *viroclear.com.au*

Name of Complainants: *Whiteley Corporation Pty Ltd*

Name of Respondent: *Bioinnovate Pty Ltd*

Provider: *Resolution Institute*

Single Member Panellist: *Dennis Liner*

1. The Parties

- 1.1 The Complainant in this proceeding is Whiteley Corporation Pty Ltd ABN 000 906 678 (“the Complainant”).
- 1.2 The Respondent in this proceeding is Bioinnovate Pty Ltd ABN 796 42 65 41 26 (“the Respondent”).

2. The Domain Name, Registrar and Provider

- 2.1 The Domain Name subject to this proceeding is **viroclear.com.au** (“the Domain Name”).
- 2.2 The Registrar of the Domain Name is Domain Directors trading as Instra (“the Registrar”).
- 2.3 The provider in this Proceeding is Resolution Institute of Suite 602, Level 6, Tower B, Zenith Centre, 821-843 Pacific Highway, Chatswood NSW 2067 (“the Provider”)

3 Procedural Matters

- 3.1 This proceeding relates to the complaint submitted by the Complainants in accordance with:
 - (i) the .au Dispute Resolution Policy no.2016-01 published 15 April 2016 (“auDRP”) which includes Schedule A (the Policy) and Schedule B (the Rules);
 - and (ii) the Provider’s supplemental rules for the au Domain Name Dispute Policy.
- 3.2 (i) The Provider was supplied with an ADR Domain Name Dispute Complaint Application Form and Complaint dated Monday 5 July 2021 by way of an email and

received by the Provider on that day (“the Complaint”). The email with the Complaint attached supporting documentation is referred to below.

(ii) On Tuesday 6 July 2021 the Provider emailed the Respondent a copy of the Complaint and written notification of the Complaint lodged against it and advised that a Response to the Complaint would be due Monday 26 July 2021.

(iii) On Friday 23 July 2021 the Provider received a Response from the Respondent by way of an email that day (“the Response”) together with attached supporting documentation which is referred to below.

(vi) I find that the making of the Complaint together with the supporting documentation and the Response together with supporting documentation comprise all the relevant matters submitted to the Panellist which the Panellist takes into consideration in making this Determination. I have perused the documents and I am satisfied that the service of the documents and the time for service of the documents complies with the Rules.

3.3 The documents supplied by the Complainants were as follow:

Domain Dispute Name Complainant by way of email to which the documents set out below were attached:

- i) Resolution Institute Domain Name Dispute Complaint Application Form dated 5 July 2021.
- ii) Complaint Submissions prepared by Owen Hodge Lawyers acting for the Applicant submitted by email together with the Application Form (the Complaint)
- iii) Annexure A: ASIC company search of the Respondent.
- iv) Annexure B: WHOIS lookup search result of the Domain Name
- v) Annexure C: WHOIS lookup search result in respect to the Registrar.
- vi) Annexure D: Copy email from auDA General advising date of registration of the Domain Name.
- vii) Annexure E: Copy Trade Mark number 604617 in respect to “VIRACLEAN”
- viii) Annexure F: Copy Trade Mark number 714478 in respect to VIRACLEAN.
- ix) Annexure G: Copy Trade Mark number 2095404 in respect to VIRACLEAN.
- x) Annexure H: Copies of various examples of advertising, media coverage, etc in respect to both the Domain Name and VIRACLEAN.

3.4 The documents supplied by the Respondent were as follows:

Response Submissions prepared by Stokes Lawyers acting for the Respondent to which the documents set out below were attached:

- i) Annexure A: ASIC searches of Plant Extracts Pty Ltd and Biologi Pty Ltd.
- ii) Annexure B: Statutory Declaration of Ross Macdougald dated 22 July 2021.
- iii) Annexure C: Search of records of IP Australia in relation to Trade Mark Application number 2117608 in respect to ViraCLEAR.

Factual background and submissions

FACTS ALLEGED BY THE CLAIMANT AND SUBMISSIONS

- 4.1 The Complainant is one of Australia's leading manufacturers of disinfectants and cleaning products in the health and industrial sectors of the Australian market. Since 1986 it has been making and selling its "VIRACLEAN" branded hospital grade disinfectants and cleaning products in Australia and overseas. As a result of the Complainant's use of the VIRACLEAN Trade Marks, it has acquired a valuable reputation in these Trade Marks.
- 4.2 The Complainant is the owner of the Trade Marks described on 3.3 (vii), (viii) and (ix) above, in respect to various classes of cleaning products and has been using VIRACLEAN to sell a range of various cleaning products for many years..
- 4.2 The Respondent has been using "ViroCLEAR" with respect to a similar cleaning product to that of the Complainant's, included in the product in Trade Mark application referred to in Annexure Trade Mark 3.4(iii). Both VIRACLEAN and ViroCLEAR products present and advertise the same idea, being that there will be no traces of the Coronavirus after using such products. Annexure 3.3(x) evidences this.
- 4.3 The Domain Name ViroCLEAR is identical or confusingly similar to that of the Complainant's Trade Mark VIRACLEAN over which the Complainant has rights and the Complainant submits:
 - (i) The Domain Name ViroClear is confusingly similar to VIRACLEAN.
 - (ii) The Domain Name contains substantially identical or deceptively similar words to the Complainant's Trade Mark. The use of the word "viro" in conjunction with the word "clear" by the Respondent compared to the Complainant's use of "vira" in conjunction with the word "clean" makes the Domain Name substantially identical or deceptively similar to the Complainant's Trade Mark.
 - (iii) As a result of the goodwill that the Complainant has established in the VIRACLEAN Trade Marks the Respondent's use of the Domain Name constituted a representation to the public that the goods and/or services it is offering are goods and/or services of the Complainant. This is likely to create confusion or deception for consumers and also likely to cause damage to the Complainant's reputation and would constitute passing off.

(iv) The Respondent's use of the Domain Name constitutes a breach of the Australian Consumer Law as it would be likely to mislead and deceive consumers into believing that the goods sold by it have been manufactured by the Complainant or that the Complainant has authorised the Respondent to sell these goods on its behalf, given that the name ViroCLEAR is a name deceptively similar to VIRACLEAN.

(v) The Domain Name does not reflect any feature of the Respondent's business which is distinguishable from the Complainant's business. The descriptions of the products of both VIRACLEAN and ViroCLEAR are identical. Both have products described as being disinfectant washes, disinfectants, etc. Such descriptions make it all that more difficult for consumers to differentiate between the two brands.

(vi) The Respondent owns no goodwill in the Complainant's name and has no registered rights in the Complainant's Trade Mark.

FACTS ALLEGED BY THE RESPONDENT AND SUBMISSIONS

- 5.1 The Respondent was incorporated on 15 July 2020 and is associated with corporations referred to in Annexures 3.4 (i) and (ii) and registered the Domain Name on 10 August 2020.
- 5.2 The Statutory Declaration referred to Annexure 3.4(iii) outlines the ways in which the Respondent markets the ViroCLEAR products such as on the Domain Name website, the news website, a television show, etc.
- 5.3 The Complainant is the registered owner of Trade Mark number 604617 for the word "Viraclean" in class 5: disinfectants including hospital grade disinfectants and cleaners for medical purposes and is the registered owner Trade Mark number 714478 for the word "Viraclean" in class 3: cleaning products.
- 5.4 In June 2020 the Complainant applied for the Trade Mark "Viraclean" in classes 3 and 5 in relation to a broader range of products in those classes.
- 5.5 The Respondent applied for Trade Mark number 21127608 on 4 September 2020 for the word "Viraclean" in class 5, to which the Claimant has opposed (see Annexure 3.4(iii)). At the time of such Application the Respondent did not know of the Complainant or its Trade Mark or its its cleaning product by the name of "Viraclean"
- 5.6 The products of ViroCLEAR and Viraclean are different. ViroCLEAR uses plant extracts, it is alcohol and ethanol free and uses a very low level of active ingredient.
- 5.7 The Respondent has made various submissions in respect to the various elements and they are referred to below.

6 Jurisdiction

6.1 Paragraph 2.1 of the auDRP states:

“All Domain Name licences issued or renewed in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP.”

6.2 The Domain Name, being “com.au”, is an open 2LD within the scope of the aforementioned paragraph. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP

6.3 In registering the Domain Name the Respondent became subject to the Policy and the Rules in respect to any dispute in regard to the Domain Name, and in registering the Domain Name under the .au process, it has agreed to be so bound. Accordingly, the panel finds that pursuant to the Policy and the Rules it has jurisdiction to determine the Complaint in respect to the Domain Name.

7 Basis of Decision

7.1 Paragraph 15(a) of the Rules state:

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

7.2 Paragraph 4(a) of the Policy provides that a person is entitled to complain about the registration or use of a Domain Name where:

i) the Domain Name is identical or confusingly similar to a name, Trade Mark 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; and

(iii) the respondent’s Domain Name has been registered or subsequently used in bad faith.

It is noted that **all three** components of Paragraph 4(a) are required to be proven for any Complaint to be upheld.

- **Domain Name is identical and confusingly similar to the name or Trade Mark in which the Complainant has rights.**

The Complainant contends that the Domain Name (ViroCLEAR) is confusingly similar to Trade Mark of the Complainant (VIRACLEAN) for the reason set out in Paragraph 4.3

The Respondent contends that as the names are not identical, the Complainant must establish that the names are confusingly similar. It further contends that the Complainant must show that consumers are in fact deceived or might be deceived by the names, and consumers are caused to wonder about the source or origin of the goods, but the Complainant has not provided any evidence of these.

In respect to the actual words, whereas the Complainant contends that the words used in conjunction are confusingly similar, that Respondent contends that each separately are different and there is no evidence to show any danger of deception or confusion

Both parties make submissions about representations to the public about the marketing of the products, description of the products and allegations about “passing off”, but these are not relevant to issues as to the argument about the actual name or Trade Mark, and these issues can be raised elsewhere if thought appropriate.

The Panel finds that the Domain Name is not identical or confusingly similar to the business name in which the Complainant has rights. Accordingly, I find that Paragraph 4(a) (i) is not satisfied.

- **Respondent has no rights or legitimate interests in respect of the Domain Name**

The Complainant submits that the Respondent owns no goodwill in the Complainant’s name and has no registered rights in the Complainant’s Trade Mark.

Pursuant to Schedule A of auDRP the Respondent is required to demonstrate its rights or legitimate interests in respect to the Domain Name by inter alia, any of the following:

- *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 domain name corresponding to the domain name in connection with an offering of goods or services(not being the offering of domain names that it has acquired for the purpose of selling, renting or otherwise transferring); or*
- *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*
- *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.*

The Respondent submits that the Domain Name was registered on 10 August 2020 and since 17 February 2021 the website has been published under the Domain Name. Also, the website was established for the purpose of selling the Respondent's ViroCLEAR products and has been used by the Respondent in connection with offering the goods for sale.

The Complainant has not submitted anything to the contrary.

Upon evaluating all the evidence provided to me and considering the facts and submissions as set out above, I find that the Respondent has demonstrated these matters. Accordingly, I find that paragraph 4(a)(ii) is not satisfied.

- **The Domain Name was registered or was subsequently used in bad faith**

Presumably, the Complainant relies upon Paragraphs 4(c), (d) and (e) as evidence of the Respondent registering or subsequently using the Domain Name in bad faith, namely that using the Domain Name would confuse consumers and would constitute passing off, and the descriptions of both the parties' products are identical and makes it difficult for consumers to differentiate between the two brands.

Pursuant to Schedule A of auDPR the following circumstances, inter alia, shall be evidence of the registration and use of a domain name in bad faith:

- (i) *circumstances indicating that the domain name has been registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for a profit; or*
- (ii) *the registration of 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) *registering the domain name primarily for the purpose of disrupting the business activities of another person; or*
- (iv) *using the domain name to intentionally attempt to attract for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website or location or of a product or service on that website or location.*

The Complainant does not make any submissions in respect to (i) and (ii) above

The Respondent refers to the Statutory Declaration in Paragraph 3.4(ii) wherein the Declarant states that the Respondent had no knowledge of the Complainant or its Trade Mark at the time of Registration of the Domain Name. Also, its products are different those of the Complainant and the Respondent did not give any false or misleading representations at the time of registering the Domain Name.

Upon the submissions, documents and evidence supplied I find that the Complainant has not shown that paragraph 4 (a)(iii) is satisfied.

8. *Decision.*

8.1 As I have found that not all elements of 4(a) have been proven, the Complainant is not substantiated.

8.2 Accordingly, for the above reasons, I direct that the Complaint be dismissed.

Dated 2 August 2021

Dennis Liner.

Panellist