



## **ADMINISTRATIVE PANEL DECISION**

**InstantScripts Pty Ltd**

v

**Instant Consult Pty Ltd**

**auDRP\_21\_13**

**<instantscript.com.au>**

### **The Parties**

- 1 The Complainant is InstantScripts Pty Ltd of Level 19/644 Chapel Street, South Yarra, Victoria, Australia, 3141. It was represented by Mr Kane Richards, 'Head of Product' for the Complainant.
- 2 The Respondent is Instant Consult Pty Ltd (Instant). Instant was represented by Dr Robert Burrell of Go Trademarks of Level 27, 480 Queen Street, Brisbane, Queensland, 4000.

### **The disputed Domain Name and Registrar**

- 3 The Disputed Domain Name is <instantscript.com.au>.
- 4 The Registrar of the Disputed Domain Name is Web Address Registration Pty Ltd.

### **Procedural History**

- 5 This is an administrative proceeding pursuant to the .au Dispute Resolution Policy originally adopted by auDA on 13 August 2001, the auDA Rules for .au Dispute Resolution Policy ("Rules"), which is Schedule B of the Policy and the Resolution Institute Supplemental Rules for .au Domain Name Dispute Resolution Policy ("RI Supplemental Rules").
- 6 A Domain Name Dispute Complaint dated 5 July 2021 was lodged by the Complainant with Resolution Institute via email on 3 August 2021. An Acknowledgement of Receipt of the Complaint was emailed to the Complainant on 3 August 2021. The Complaint consisted of:

- (a) Scope of Domain Dispute V2.doc (Scope);
- (b) instantscript whois record as of 12.07.2021 4.42pm AEST.pdf;
- (c) instantscripts whois record as of 12.07.2021 4.42pm AEST.pdf (emphasis added);
- (d) Predikkta Email – Jul 1 2021 3 23 PM.PNG;
- (e) RPReplay-Final166071211.MPV;
- (f) AuDA Case\_00024443\_ref\_00D6F2VqSL\_5004a3Qyt4\_ref\_.msg; and
- (g) auDA policy.pdf

7 A copy of the Complaint was emailed to the Registrar by Resolution Institute (RI) on 3 August 2021 with a request to confirm the Respondent Registrant’s details and lock the domain name pending the final decision of the domain name dispute proceedings.

8 On 3 August 2021 the Registrar confirmed via email details of the Respondent and confirmed that the Disputed Domain Name had been locked.

9 RI advised auDA of the Complaint on 4 August 2021 via email.

10 On 4 August 2021, RI emailed the Respondent with the Notification of the Rectified Complaint lodged in respect of the Disputed Domain Name. The Complainant and the Registrar were copied in on the notification. The due date for the Response was noted to be 24 August 2021.

11 On 24 August 2021, the Respondent provided its Response, consisting of:

- (a) letter from GO Trademarks dated 24 August 2021;
- (b) submissions dated 24 August 2021; and
- (c) statutory Declaration of Ms Bianca Brown made on 24 August 2021, together with annexures A to E.

12 On 24 August 2021, the Provider approached the Panellist. The Panellist formally confirmed his availability and that he had no conflict issues with the Parties. The Panellist accepted the matter on 27 August 2021.

13 The Case file and relevant correspondence were delivered to the Panellist on Friday 27 August 2021.

- 14 The Parties to the dispute were notified of the Panellist’s allocation on 27 August 2021.
- 15 The date on which the decision is due is 14 calendar days thereafter being Friday 10 September 2021.

## **Background**

- 16 The Complainant stated that it was registered as a business on 8 October 2018. The Complainant’s domain name, <instantscripts.com.au> was registered that same day. The ‘whois’ record provided by the Complainant in respect of <instantscripts.com.au> shows the registrant of that domain name to be ‘Phonemed Pty Ltd’. The relationship between the Complainant and Phonemed Pty Ltd is not clear.
- 17 The Complainant describes itself in its application as a ‘provider of online prescriptions, Telehealth consultations with registered Australian General Practitioners, online medical certificates and online pathology requests, via the website instantscripts.com.au’.<sup>1</sup> It did not, however, provide evidence supporting this contention.
- 18 The Disputed Domain Name was registered on 3 March 2020.
- 19 The Complainant contended that Disputed Domain Name was licenced to Bianca Brown. However, the Respondent provided a statutory declaration as part of its Response. Ms Brown is a director of the Respondent. It appears from her declaration and from the ‘whois’ record provided by the Complainant, that the registrant was the respondent, rather than Ms Brown personally. Although she is identified as the ‘Tech Contract Name’ on the ‘whois’ record, there is no evidence to suggest a licence of the Disputed Domain Name.
- 20 It appears from the Response that the Respondent conducts business using the name ‘instant consult’. The domain name, <instantconsult.com.au> was registered on 12 December 2016.<sup>2</sup> Ms Brown said that the Respondent registered this domain name, although she also said that the Respondent was formed on 7 March 2017, which is after the Respondent came into existence.<sup>3</sup> However, the basis upon which the Respondent uses the <instantconsult> domain name does not fall within the scope of these proceedings. The Respondent has

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<sup>1</sup> Scope, page 1.

<sup>2</sup> Brown Declaration at [4].

<sup>3</sup> Brown Declaration at [1].

obtained an Australian trade mark, no 1820726, in connection with the expression ‘instant consult’.<sup>4</sup> The trade mark was registered on 16 August 2017.

21 Ms Brown stated that it also carries on business through the Apple App Store and Google Play. I infer that one can download an application which connects with the Respondent’s business.

22 Ms Brown declared that Respondent decided in early 2020 to register additional domain names containing descriptive words as part of its ‘overall marketing campaign’. The additional domain names included the Disputed Domain Name, and the following:

instantmedicalcertificates.com.au

onlinemedicalcertificate.com.au

instantonlinedocotr.com.au

instantescripts.com.au

instantonlineprescriptions.com.au

instantprescriptions.com.au

instantonlinemedicalcertificates.com.au

drinstant.com.au

23 The Complainant provided video evidence that the Disputed Domain Name directed users to the Respondent’s ‘instantconsult.com.au’ website. This was not disputed. Each of the domain names identified in the preceding paragraph did the same.<sup>5</sup> That was the point of the exercise.

24 Ms Brown stated that the Respondent is ‘unaware of any instances of confusion resulting from its use of’ the Disputed Domain Name.

25 I understand ‘telehealth consultations’ to mean consultations with medical practitioners which do not involve physical attendance at the medical practitioner’s premises. I infer from the extracts from the Respondent’s website<sup>6</sup> that a customer, or patient, interacts with

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<sup>4</sup> Annexure B to the Brown Declaration.

<sup>5</sup> Response at [8].

<sup>6</sup> Brown, Annexure C.

a medical practitioner via the internet (or possibly the telephone) and receives a prescription for medication or a medical certificate from the medical practitioner via the internet. I do not understand that the process is automated or involves the use of artificial intelligence to prescribe medication, although that day may not be too far off. It appears that access to the medical practitioner as part of the Respondent's business can take place via the internet or phone while the customer is in the pharmacy. It is not clear whether this is the same with the Complainant's business. The Complainant did not submit similar materials in relation to its business.

### **The Policy**

26 The Policy sets out the elements that the Complainant must establish in order to be entitled to relief in paragraph 4(a):

- (i) [the Respondent's] domain name is identical or confusingly similar to a name, 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 name; and
- (iii) [the Respondent's] domain name has been registered or subsequently used in bad faith.

27 The Complainant must establish each of the elements identified in paragraph 4(a) of the Policy. One or two is not enough to succeed. The standard of proof is the balance of probabilities.

28 I will consider each of these elements in turn.

### **Element 4(a)(i): Confusing similarity**

29 The first element, under paragraph 4(a)(i) of the Policy, has two components. First, the disputed domain name must be confusingly similar to a 'name, trademark or service mark'. Second, the Complainant must have rights in respect of that name.

30 Ignoring top level suffixes, the Disputed Domain Name is comprised of the expression 'instantscript'. The Complainant complains that the Disputed Domain Name is 'confusingly similar' to the name, 'InstantScripts Pty Ltd' and the domain name <instrumentscripts.com.au>.

31 Suffixes and ‘Pty Ltd’ are not generally material for the purposes of paragraph 4(a)(i) of the Policy.

32 The Disputed Domain Name and ‘InstantScripts’ are not identical expressions.

33 However, the Disputed Domain Name is clearly confusingly similar to the company name, ‘InstantScripts Pty Ltd’ and to the domain name, <instantscripts>. The presence of an ‘s’ at the end of the domain name is not a substantial difference, and one that would be readily omitted or added by a user of the web. The Complainant’s name and domain name capitalise the first ‘s’ in ‘Scripts’. This is an immaterial difference. Searches for the name are not case sensitive.

34 The Respondent contended that the Complainant did not have a trade mark in respect of the expression ‘instantscript’ and that it had not shown any reputation or good will in that expression sufficient to establish a common law trade mark. Those contentions may be accepted. However, note 1 to the Policy states that ‘name’ in paragraph 4(a)(i) includes a name in which an entity has rights by virtue of its registered company name.

35 I am satisfied, therefore, that the Complainant has rights to the name ‘InstantScripts’ and that the Disputed Domain Name is confusingly similar to that name.

**Element 4(a)(ii): Right or legitimate interest**

36 Paragraph 4(a)(ii) requires the Complainant to establish that the Respondent has “no rights or legitimate interests in respect of the domain name”.

37 The Respondent did not argue that it has any specific rights in relation to the Disputed Domain Name. It argued that it has a legitimate interest in its use because the operative part of the Disputed Domain Name, ‘instantscript’ was ‘entirely’ descriptive of the services which the Respondent provided.

38 A starting point for considering this issue is paragraph 4(c) of the Policy. It provides a non-exhaustive list of circumstances in which a Respondent will be taken to have a ‘right or legitimate interest’ in the domain name. Paragraph 4(c)(i) provides:

- (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);

39 The Respondent did not satisfy this paragraph, because it requires that there be use or preparation for use of the domain name. While the Respondent carried on business before these proceedings were initiated, that business does not appear to have involved the Disputed Domain Name. The Respondent's business used 'instantconsult'. While the Disputed Domain Name was registered before these proceedings were commenced, I do not consider merely registering a domain name which diverts users to a 'primary' website, amounts to 'bona fide use' for the purposes of paragraph 4(c)(i).

40 The Response quoted a passage from the 'auDA Overview of Panel Views on Selected auDRP Questions':<sup>7</sup>

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

41 I accept this general principle. However, in the present case, there are two components to the Disputed Domain Name, 'instant' and 'script'. The use of the expression 'script' does relate directly to the Respondent's business, which involves provision of pharmaceutical scripts. However, the word, 'instant', it is less directly descriptive than other expressions. Of the various expressions identified in paragraph 22 above, 'online' perhaps relates to the Respondent's business than 'instant'. The script is not, literally, 'instant'. The process is still mediated by a medical practitioner. It is certainly not the only word that could be used to describe the Respondent's business.

42 I consider that the scope of a *legitimate* interest under paragraph 4(b) should have regard to the scope of paragraph 4(c)(i) of the Policy, that is, where the domain name closely reflects the name or style under which the respondent's business is actually carried on. The link between the Disputed Domain Name and the Respondent's actual business is not sufficiently close to give rise to a legitimate interest in the use of the name.

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<sup>7</sup> [auDRP Overview 2014-linked \(auda.org.au\)](http://auda.org.au)

43 I consider, however, that the Respondent does not have a right or a legitimate interest in the use of the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy.

### **Bad faith**

44 The third element which the Complainant must establish is that the Respondent registered or subsequently used the Disputed Domain Name in bad faith.

45 Paragraph 4(b) provides a non-exhaustive list of circumstances in which there will be found to have been bad faith registration and use of the domain name.

- (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.

46 I will deal with each part of paragraph 4(b) in turn.

47 In the Overview on page 1 of the Scope, the Complainant sought an appeal ‘in respect of the licensing rights for the domain name that is currently licensed to ‘Bianca Brown’. However, as indicated above, it appears that the Disputed Domain Name is not registered in the name of Bianca Brown. It is registered in the name of the Respondent. Consequently, the question of licensing does not arise. There is no basis to conclude that the Respondent registered the Disputed Domain Name for the purpose of allowing someone else to use it, by selling it, renting it or otherwise transferring it. It has registered and retained the Disputed Domain Name. Paragraph 4(b)(i) is not made out.

- 48 The Disputed Domain Name was not registered for the purpose of preventing the Complainant reflecting its name in a corresponding domain name because, by the time the Disputed Domain Name was registered, the Complainant had already registered its own domain name. Paragraph 4(b)(ii) does not apply.
- 49 Paragraph 4(b)(iii) is less clear cut.
- 50 It involves the contention that the Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business of another person, in this case, the Complainant.
- 51 The Respondent gave evidence that the Disputed Domain Name was registered ‘as part of an overall marketing campaign and not for the purpose of directing traffic away from users who are specifically looking for the Complainant’s or any other business’. There was no direct evidence that the Respondent had any other motive. It is relevant that the Respondent registered several domain names at about the same time. The new domain names were not ‘targeted’ at the Complainant’s name or domain name. Each of the additional domain names were, to some extent, descriptive of the activities of the Respondent. This supports the contention that registration of the Disputed Domain Name was a general marketing strategy to advance its interests, rather than conduct targeting the Complainant.
- 52 It might be possible to draw an inference that the Respondent intended to disrupt the Complainant’s business by diverting customers away from the Complainant, if the Complainant had provided detail about the nature of its business and evidence of the extent of its business activities and of a substantial reputation. Evidence that the Complainant was a well-known competitor of the Respondent might have assisted in drawing the inference that registration of the Disputed Domain Name was for the purpose of disrupting the business of the Complainant, rather than simply attracting persons interested in obtaining a pharmaceutical script online. The Complainant did not provide this information.

53 It may be that information of this nature can be gleaned from the Complainant’s website. Paragraph 4.5 of auDA Overview of Panel Views on Selected auDRP Questions First Edition July 2014 (auDA auDRP Overview 1.0)<sup>8</sup> says

Panels have undertaken limited factual research into matters of public record where it has considered this necessary to reach the right decision. This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent and the use of the domain name, consulting an Internet archive repository in order to obtain an indication of how a domain name may have been used in the past, reviewing dictionaries or encyclopedias to determine any common meaning of words, or discretionary referencing of online trademark registration databases. A panel may also rely on personal knowledge.

54 The WIPO Jurisprudential Overview 3.0<sup>9</sup> is to similar effect. The WIPO Overview refers to paragraphs 10 and 12 of the UDRP Rules. Those Rules correspond to Rules 10 and 12 of the auDRP Rules. However, Rule 15(a) of the auDRP Rules provides:

- (a) 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.

Rule 15(a) leads me to the conclusion that a panel decision should generally be based on the materials provided by the Parties and that a Panel should not make independent inquiries to resolve substantive matters in controversy between the parties. Whether the Complainant had a substantial reputation in connection with the name ‘instantscripts’ was a matter in dispute between the parties. It is complex matter involving questions of judgment and degree. It is dissimilar to ascertaining a matter of public record, such as the date that a company was registered.

55 While it may have been possible to provide the Complainant with the opportunity to provide further material, it would have been necessary to provide the Respondent with the opportunity to reply. The Policy contemplates that proceedings will be conducted with ‘expedition’ and a decision will be made within 14 days, except in ‘exceptional’ cases.<sup>10</sup> The Complainant had the opportunity to include material of this nature in its Complaint.

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<sup>8</sup> Andrew F. Christie with assistance from James Gloster, Jeffrey Kadarusman and Daniel Lau. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition at 4.8 is to similar effect.

<sup>9</sup> <https://www.wipo.int/amc/en/domains/search/overview3.0> at [4.8].

<sup>10</sup> Rule 10(c).

56 Consequently, I am unable to conclude that the Respondent registered the Disputed Domain Name to disrupt the business of Complainant within paragraph 4(b)(iii), rather than to positively advance its own business.

57 For a similar reason, I am unable to conclude that the Respondent has intentionally attempted to attract internet users to its business by creating a likelihood of confusion between its business and the Complainant's business within paragraph 4(b)(iv). This would involve a finding that the Complainant had a reputation that was known to internet users, so that they accessed the Disputed Domain Name thinking that they would be dealing with the Complainant and were mistaken. Given the nature of the Disputed Domain Name and in the absence of evidence that the Complainant had a substantial reputation, the inference to be drawn is that internet users who accessed the Disputed Domain Name sought to obtain a particular type of service, namely a prescription via the internet, rather than to obtain a prescription issued by Complainant in particular. In short, users wanted an 'instant script' but they didn't care whether it was issued through the Complainant or the Respondent.

58 There was no evidence that any representations or warranties as to eligibility or third party rights were given or became false, within paragraph 4(b)(v).

59 The Complainant alleged that there had been 'passing off' and sought relief on that basis. The Complainant noted that the tort of passing off is concerned with misappropriation of a trader's reputation or goodwill. However, as the Respondent pointed out, there was no evidence of the Complainant's reputation or goodwill.

60 Consequently, I am not satisfied that the Complainant has established that the Respondent registered or used the Disputed Domain Name in good faith.

**Decision**

61 For the foregoing reasons, in accordance with paragraph 4(a) of the Policy and paragraph 15 of the Rules, the Complaint must be dismissed.



DS Ellis

Sole Panelist

Date: 10 September 2021