

LEADR DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL

auDRP_12_12

Single Panelist Decision - Scott Pettersson

**Dr Jeremy Hunt t/as
Sydney Skin Institute**

v.

**Edward Mishricky t/as
Visage Clinic**

www.sydneySkinInstitute.com.au

Procedural History

1. The Complaint was submitted for decision in accordance with the (auDRP) Policy and Rules, which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplementary Rules (LEADR is the Provider).
2. The complete application was received from the Complainant by LEADR on 26 October 2012.
3. The Respondent was issued a copy of the Complaint by LEADR on 30 October 2012 and it appears from the documents before me that the Complaint had also been provided by the Complainant. Given the uncertainty of service by the Complainant, I have used the service by LEADR as the basis for calculating a date for a response from the Respondent.
4. The domain name was locked following notification of the dispute and provision of a copy of the application and a copy of the dispute notification letter. The Registrar of netfleet.com.au confirmed the domain lock was applied and receipt of the correspondence from the Provider on 30 October 2012.
5. On 30 October 2012 LEADR issued to the Respondent, at the registered contact email address, all relevant notices of the procedure. That correspondence advised the last date for submission of a response to the Complaint was 19 November 2012.
6. Pursuant to the auDRP procedures the Respondent could, if he so elected provide a response on or before 19 November 2012. The Respondent did not elect to provide a response (frequently described as a default on response). There are some circumstances where the Panellist can exercise a discretion to allow late submissions, however, no such submissions have been provided and the relevant date has long since

passed. I am satisfied that the Complaint should be decided on the basis of the material provided before me.

7. It is relevant to note that there has been a very significant time lapse between the registration of the Complaint and advice to the parties and my appointment. I am advised this is because an earlier panellist, who had indicated a willingness to decide the Complaint, was unable to proceed and failed to provide relevant and timely advice to the auDRP Provider. While this delay is irregular, I have been unable to locate any procedural requirement that would render this decision invalid, irregular or non compliant so as to make the decision susceptible to any subsequent adverse review on this basis. However, it is appropriate to note this irregularity and to record my sympathy to the parties for what, by any measure, is an unacceptable delay in rendering a decision in this Complaint.
8. LEADR advised auDA of the Complaint on 30 October 2012 via e-mail.
9. On 5 March 2013 the Provider approached the Panellist. The panellist confirmed his availability, informed LEADR that he had no conflict issues with the parties and accepted the matter on that date.
10. The Panellist received the package containing the Complaint including submissions and attachments on the date of acceptance. The determination was due from the Panellist to the Provider on or before 19 March 2013.

Factual Background

11. The Complainant has used the domain name "sydneysskininstitute.com.au" (the domain) over a number of years and has promoted a range of services, principally in relation to dermatology, cosmetic surgery and anti-ageing treatments. The Complainant has held registration of the business (BN98073886) name since July 2004. It is uncontested that the Complainant had held and utilised the contested domain name for in the order of 12 years prior to the transfer to the Respondent.
12. The Complainant failed to renew the domain when its registration expired on 25 July 2012 and the Respondent registered the domain on 26 July 2012. The Complainant's documents evidence that the failure to renew the registration related to the malicious electronic penetration of the host registrar's records which reset the dates for renewal to year zero and thus meant renewal reminders were not issued to the Complainant and the domain name was returned to the pool of available domain names.
13. The Complainant became aware of the change in registration of the domain and wrote to the Respondent seeking to recover registration of the domain. The correspondence included an offer, but it does not appear that any responses were issued. Following

representations to various bodies a formal complaint was issued to auDA, which was rejected as the services offered by the Respondent fell within the parties' contentions.

Complainant

14. The Complainant's contentions, as they bear on resolution of this dispute, are discussed individually under consideration of the applicable elements of proof below.

Respondent

15. The Respondent has provided no submissions and has not responded, as I understand it, to any correspondence issued to him. The failure of the Respondent to participate in the process does not act to deny the efficacy of a panellist's decision. However, for the avoidance of doubt I note the obligations still rests with the Complainant to establish the facts upon which they rely. Those facts must be established on the balance of probabilities.

Discussion and Findings

16. When a person registers a domain name with any domain name registrar, the person accepts a contract that forbids "cybersquatting" – the bad faith registration of a domain name that is confusingly similar to someone else's trademark. When a trademark holder finds that someone has registered a domain name that they believe is too close to their own trademark, they can initiate an arbitration under the Policy. To prevail in such a UDRP action, Paragraph 4(a) of the Policy requires that the trademark holder – the Complainant – must prove each of the following:
- (i) *The 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 domain name has been registered or subsequently used in bad faith.*
17. Because this dispute is between two parties who are Australian citizens and would otherwise be subject to jurisdiction before Australian courts to resolve any disagreement regarding trademark infringement by the domain name in question, the Panellist concludes that pursuant to Paragraph 15(a) of the Rules, it is appropriate to apply rules and principles of Australian trademark law between the parties.

Paragraph 4(a)(i) - Identical or Confusingly Similar

18. This limb has two sub limbs, firstly that the domain in dispute is identical or confusingly similar to a service mark, trademark, business name or the like, and that the Complainant has rights in that name.

Complainant has rights in the name

19. The Complainant adopted the business name which is identical to the domain name (barring the concatenation used in the domain) in or about July 2004. That business name is registered with the Department of Fair Trading in New South Wales and is part of a broader national scheme recorded and searchable through the Australia Securities and Investment Commission. Similarly, it does not appear to be in issue and is fairly evidenced that the Complainant has also held the domain name in dispute for several years. I note a search of the internet archive displays page captures from at least 2006.
20. I am satisfied that the complainant has rights in the name Sydney Skin Institute.

Domain is identical or confusing

21. The Complainant asserts that the name is identical to the name they hold as a registered business name and the internet presence they held. Given the information establishing the identical registered Business name, I am satisfied this is established.

Conclusion

22. I am satisfied that the Complainant has shown that the domain is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights. I make this finding with particular cognisance of the note to this element as advised in the rules which states:

[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.

Paragraph 4(a)(ii) - Rights or Legitimate Interests of Respondent in domain

23. The Complainant has asserted that the Respondent has no legitimate interest or rights in the domain because:
- a. mere registration does not establish entitlement, which accords with Note 2 to the auDRP Policy
I accept this submission as a statement of the policy and intent of auDA.
 - b. The Respondent is not now or previously known as the domain.
I accept this submission and note that the Respondent has not activated any pages of the domain since it was transferred.
 - c. The Respondent is not making 'a legitimate non-commercial or fair use of the disputed domain name'
I accept this submission and accept that it weighs on the limb in issue. I do not

accept that the Respondent has used the domain and has used the domain for commercial purposes so as to accord with the purpose test¹ for a .com site

- d. The Complainant took all reasonable steps to retrieve the domain and inform the Respondent of their claim

I accept this submission and note the observation of the Complainant that the 'reasonable steps' is constituted by e-mails specifically requesting the surrender and return of the email and fair compensation. I also find that this submission weighs on my consideration of the limb.

- e. The Respondent registered the domain in order to deny the Complainant the opportunity to re-register it, or for commercial gain.

I accept the submission but it does not weigh upon my determination of the satisfaction of this limb. I do not find that they registered the domain name to deny the Complainant the opportunity to re-register it, however, I am satisfied that they registered the domain for the purpose of commercial gain, which I also observe accords with the intent of this 2LD.

24. The Respondent has made no submissions with regard to this limb.

Conclusion

25. Under this limb the onus shifts to the Respondent to establish that they have a right in the domain. The parties operate similar businesses. The Complainant is a medical practitioner operating in the eastern suburbs of Sydney while the Respondent offers similar services in the north-western suburbs of Sydney. Clearly, both parties offer similar services within the area of greater Sydney.

26. The Respondent was aware of the concerns of the Complainant within a short period of having registered the domain. The Respondent has, however, elected not to participate in the auDRP process or to actively utilise the domain.

¹ extract from the auDA policy 01-2005 states at schedule C:
ELIGIBILITY AND ALLOCATION RULES FOR COM.AU
The com.au 2LD is for commercial purposes.
The following rules are to be read in conjunction with the Eligibility and Allocation Rules for All Open 2LDs, contained in Schedule A of this document.
1. To be eligible for a domain name in the com.au 2LD, registrants must be:
a) an Australian registered company; or
b) trading under a registered business name in any Australian State or Territory; or
c) an Australian partnership or sole trader;
d) a foreign company licensed to trade in Australia; or
e) an owner of an Australian Registered Trade Mark; or
f) an applicant for an Australian Registered Trade Mark ; or
g) an association incorporated in any Australian State or Territory; or
h) an Australian commercial statutory body.
2. Domain names in the com.au 2LD must:
a) exactly match, acronym or abbreviation of the registrant's company or trading name, organization or association name or trademark; or:
b) be otherwise closely and substantially connected to the registrant.

27. The Respondent has not satisfied me that they have a right in the disputed domain.

Paragraph 4(a)(iii) - Registered or subsequently used in bad faith.

28. Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by, among other things, evaluating four (non-exhaustive) factors set forth in the Policy:

- a. *circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or*
- b. *the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or*
- c. *the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or*
- d. *by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location. Paragraph 4(b) of the Policy.*

29. The Complainant has principally relied on the second of these grounds. In support of this contention, they assert the domain has not been used and while the Respondent offers similar services they have, by securing and leaving the domain inactive, denied the Complainant the opportunity to use and benefit from its registered business name. In support, they note the Respondent is possessed of other domain names that reflect its business name (Visage Clinique and Visage Medical Centre).

30. In essence, the Complainant appears to be submitting that the Respondent has been opportunistic² in registration and stand to cause significant commercial harm as a result of the registration.

31. I accept that the 1st, 3rd and 4th elements are not evidenced in any measure. However, the 2nd element is in my view sufficiently evidenced.

32. For the sake of completeness I again record the Respondent has made no submissions with regard to this limb.

² By way of incidental observation such claims are likely to increase with the various registration watch tools available from Registrars.

Conclusion

33. The appropriate evidential level in these determinations is the balance of probabilities.

When this test is applied and the:

- a. established previous use of the domain by the Complainant,
- b. absence of the activity described as a core activity of the Respondent, and
- c. similar professions of the parties are considered,

I am satisfied that the requirements of this 3rd limb are satisfied.

Decision

34. Having read all of the submissions of both parties and for all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panellist orders that the domain name <sydneykskininstitute.com.au> be transferred to the Complainant.



Scott Pettersson

Sole Panellist