INSTITUTE of ARBITRATORS & MEDIATORS ——————— AUSTRALIA

.au Dispute Resolution Provider

ADMINISTRATIVE PANEL DECISION

Domain Name Dispute: lullabyconceptions.com.au

between

Lullaby Conceptions Pty Ltd
and
Neverscope Pty Ltd

Reference: IAMA 3064

1 THE PARTIES

- 1.1 The Complainant is Lullaby Conceptions Pty Ltd (ACN 110 428 665), whose principal place of business is located at 8 Vista Close, Kings Langley, New South Wales 2148 ('the Complainant').
- 1.2 The Respondent is Neverscope Pty Ltd (ACN 114 575 898), whose principal place of business is located at 3 Palm Court, Albany Creek, Queensland 4035 ('the Respondent').

2 DOMAIN NAME AND REGISTRAR

2.1 The domain name in dispute is www.lullabyconceptions.com.au, currently registered by the Respondent. The Registrar is NetRegistry Pty Ltd, Level 1, 97 Rose Street, Chippendale, New South Wales 2008. It is agreed by the parties that the domain name was registered on 19 January 2007.

3 DISPUTE RESOLUTION PROVIDER AND PANEL

3.1 On or about 7 June 2007, the Complainant submitted its Complaint to the Institute of Arbitrators & Mediators Australia ('IAMA') for resolution under the rules of the .au Dispute Resolution Policy ('the Rules') in Schedule A of that Policy. IAMA is a Dispute Resolution Provider approved by auDA. The Complainant elected to have the dispute determined by a Panel comprising a single member.

- 3.2 On or about 25 June 2007, the Respondent submitted its Response to IAMA. The Respondent agreed to have the dispute determined by a Panel comprising a single member.
- 3.3 By instrument dated 25 June 2007, IAMA appointed Robert William Hunt as arbitrator, to comprise the Panel to determine the Dispute.
- 3.4 By instrument dated 25 June 2007, Robert William Hunt accepted appointment as Panelist in accordance with the Rules, and the IAMA Supplemental Rules to the .au Dispute Resolution Policy.

4 RULES OF THE .AU DISPUTE RESOLUTION POLICY

- 4.1 Relevantly, the Rules provide as follows:
 - '4. Mandatory Administrative Proceeding. This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative dispute resolution service providers listed on the auDA website at http://www.auda.org.au/policy/audrp (each, a "Provider").
 - **a.** Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure that:
 - (i) your domain name is identical or confusingly similar to a name [Note 1], trademark or service mark in which the complainant has rights; and
 - (ii) you have no rights or legitimate interests in respect of the domain name [Note 2]; and
 - (iii) your domain name has been registered or subsequently used in bad faith.

In an administrative proceeding, the complainant bears the onus of proof.

- **b.** Evidence of Registration or Use in Bad Faith. 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.

- c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. When you receive a complaint, you should refer to Paragraph 5 of the auDRP Rules in determining how your response should be prepared. 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.'
- 4.2 At the outset, it is necessary to consider whether the sub-paragraphs of paragraph 4a of the Rules are to be read conjunctively or disjunctively. If they are to be read disjunctively, a complainant would only need to prove one of (i), (ii) and (iii) whereas, if they are to be read conjunctively a complainant would need to prove each of (i), (ii) and (iii).
- 4.3 Applying settled principles of construction of documents I consider that the better view is that the sub-paragraphs of paragraph 4a of the Rules are to be read conjunctively, more particularly because it would seem contrary to the Policy if a complainant could succeed if it established only that the domain name is 'identical or confusingly similar to a name, trademark or service mark in which the complainant has rights'. I note that this interpretation of paragraph 4a of the Rules is consistent with other published decisions under the Rules and is also consistent with decisions published by the WIPO Arbitration and Mediation Centre for disputes under similar rules in the ICANN Uniform Domain Name Dispute Resolution Policy (see, for example, Document Technologies Inc. v International Electronic Communications Inc. Case No. D2000-0270).
- 4.4 A consistent approach is desirable so that parties using the Policy can have a high level of confidence that the Rules will be interpreted in a particular way regardless of the identity of the Panel appointed in a particular dispute.

5 THE COMPLAINT

5.1 The Complaint is set out in an 8 page document and Annexures A to P to that document.

- 5.2 The factual background is set out in part 6 of the Complaint, as follows:
 - '6.1 The Complainant is an Australian company which was registered in New South Wales on 9 August 2004. A copy of the historical company extract of the Complainant obtained from the Australian Securities & Investments Commission on 11 May 2007 is provided at Annexure D.
 - 6.2 The Complainant has been operating an online service offering fertility, conception and pregnancy related products and information under the name "Lullaby Conceptions Pty Limited" since August 2004. The online service provides consumers throughout the world with access to information relating to conception and pregnancy and the latest products available to assist with same. A copy of the printouts from a number of blogs and forums in Australia and the United States of America is provided at Annexure E. These printouts demonstrate the reputation built by the Complainant.
 - 6.3 This service is accessible via a website on the domain name lullabyconceptions.com. This domain was registered by the Complainant on 11 August 2004. A copy of the printout of the WhoIs database search conducted on 11 May 2007 is provided at Annexure F.
 - 6.4 From the date of the launch of lullabyconceptions.com in August 2004, to the date of the Complaint, the Complainant's domain name lullabyconceptions.com has received over 86,945 unique site visitors, with approximately 53,790 (62%) of these visitors from Australian IP addresses.
 - 6.5 The Respondent is an Australian company which was registered in Queensland on 2 June 2005. The Respondent does not appear to be trading. A copy of the current company extract of the Respondent obtained from the Australian Securities & Investments Commission on 11 May 2007 is provided at Annexure B.
 - 6.6 As set out in Annexure B, Clarissa Michelle Swiac is a shareholder of the Respondent, holding 50% of the shareholding in the Respondent.
 - 6.7 Clarissa Michelle Swiac is also the registered owner of the trading name FertilityNaturopath.com ABN 26 442 063 457. The trading name was registered on 16 June 2004 by Clarissa Michelle Wells. Ms. Wells later changed her surname to Swiac and registered her new surname in relation to the trading name on 25 July 2005. A copy of a printout of the Australian Business Register database search results for FertilityNaturopath.com ABN 26 442 063 457 conducted on 11 May 2007 is provided as Annexure G.
 - 6.8 The current company extract provided at Annexure B shows that the residential address of Ms. Swiac is the same residential address of the sole director and remaining 50% shareholder of the Respondent, Mr. Slawomir Tomasz Swiac. This is also the principle place of business of the Respondent.

- 6.9 FertilityNaturopath.com is the main online competitor of the Complainant and conducts business through the domain name fertilitynaturopath.com.au. A copy of the printout of the entry page of fertilitynaturopath.com.au and the WhoIs database search conducted on 11 May 2007 is provided at Annexure H.
- 6.10 At the date of this Complaint, the Respondent has not registered the business name Lullaby Conceptions in any State or Territory of Australia. A copy of a printout of the Australian Business Register database search results for the words "lullaby conceptions" conducted on 11 May 2007 is provided as Annexure I. This printout demonstrates that the business name Lullaby Conceptions is not currently registered in any State or Territory of Australia.
- 6.11 On 19 January 2007, the Respondent registered the Disputed Domain Name. At the date of this Complaint, the Disputed Domain Name does not point to an active website. A copy of the printout obtained on 11 May 2007 of the notice displayed at the Disputed Domain Name appears in Annexure J.
- 6.12 On 13 February 2007, upon becoming aware of the registration of the Disputed Domain Name, the Complainant lodged an Application with IP Australia for registration of its common law trade mark "Lullaby Conceptions". The trade mark application (no. 1160876) has been accepted by IP Australia and is awaiting advertisement in the Australian Official Journal of Trade Marks. This trade mark has been in use by the Complainant in connection with its business since August 2004. A copy of the printout obtained on 11 May 2007 from IP Australia's ATMOSS database appears in Annexure K.
- 6.13 On 19 February 2007, the Complainant sent a letter to the Respondent noting the registration of the Disputed Domain Name and requesting cancellation of same. The Respondent failed or refused to respond to the letter. An unsigned copy of the letter appears in Annexure L
- 6.14 On 25 February 2007, the Respondent lodged an Application with IP Australia for registration of "Lullaby Conceptions". The trade mark application (no. 1162923) is awaiting examination by IP Australia. A copy of the printout obtained on 11 May 2007 from IP Australia's ATMOSS database appears in Annexure M.
- 6.15 On 26 February 2007, the Respondent lodged an Application with IP Australia for registration of "Preseed". The trade mark application (no. 1163185) is awaiting examination by IP Australia. "Preseed" is a product currently sold by the Complainant and the Respondent is not authorised to sell the product. A copy of the printout obtained on 11 May 2007 from IP Australia's ATMOSS database and a copy of a letter from the manufacturer of Preseed stating that the Respondent is not an authorised seller appears in Annexure N. This demonstrates the Respondent's attempts to obstruct the business of the Complainant.
- 6.16 On 29 March 2007, the Complainant lodged an Application with IP Australia for registration of the "Lullaby Conceptions" logo (Application no. 1168936). The trade mark has been in

- use since August 2004 and is awaiting examination by IP Australia. A copy of the printout obtained on 11 May 2007 from IP Australia's ATMOSS database appears in Annexure O.
- 6.17 On 23 March 2007, the Complainant's authorised representative, Truman Hoyle Lawyers, sent a letter of demand to the Respondent in relation to the domain name dispute and the trade mark dispute. The Respondent failed to respond to the letter. A copy of the letter appears in Annexure P.'
- 5.3 The grounds for the Complaint are set out in part 7 of the Complaint, as follows:
 - '7.1 Pursuant to Rule 3(b)(ix) the Complainant makes its complaint of (sic) the following grounds:
 - (a) the Disputed Domain Name is identical or confusingly similar to a name and trade mark in which the Complainant has rights (Rule 4(a)(i));
 - (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name (Rule 4(a)(ii)); and
 - (c) the Disputed Domain Name has been registered and subsequently used in bad faith (Rule 4(a)(iii)).'

A. Identical or Confusingly Similar

- 7.2 The Disputed Domain Name is identical to a name in which the Complainant already has rights, being Lullaby Conceptions. As set out above, the Complainant is an Australian corporation which was established in August 2004 under the name "Lullaby Conceptions Pty Limited". Since its inception, the Complainant has traded under the name "Lullaby Conceptions Pty Limited" and has not traded under any other name. A copy of the ASIC company extract in relation to "Lullaby Conceptions Pty Limited" appears in Annexure D.
- 7.3 The Disputed Domain Name is identical to a trade mark in which the Complainant has rights. In this regard, the Complainant has used the "Lullaby Conceptions" trade mark in the course of its online business since August 2004. The Lullaby Conceptions mark is highly distinctive and consumers would be likely to think that there is an association between that mark and the disputed domain lullabyconceptions.com.au. The Complainant has lodged an application with IP Australian to register the trade mark. The application has been approved and is awaiting advertisement in the Australian Official Journal of Trade Marks. A copy of the printout obtained on 11 May 2007 from IP Australia's ATMOSS database appears in Annexure K.
- 7.4 The Disputed Domain Name is identical to the Complainant's domain name, lullabyconceptions.com, expect for the addition of the ".au". It is well established that the insertion of a country code top-level domain is without legal significance in determining how identical or confusingly similar a domain name is to a trademark.

7.5 In light of the above, the Complainant submits that the Disputed Domain Name is identical to the Complainant's existing company name, trade mark and domain name.

B. Rights or Legitimate Interests

- 7.6 At the date of this Complaint there is no evidence that shows that the Respondent has used the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services.
- 7.7 The only evidence that the Respondent has made preparations to use, or has any intention of using, the Disputed Domain Name is that the Respondent has applied to register an Australian trade mark for "Lullaby Conceptions". However, this application was made shortly after the Complainant lodged its own application to register its common law trade mark which has been in use since August 2004. Accordingly, the Complainant submits that the Respondent cannot assert that before any notice to it of the subject matter of the dispute, it had made demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name.
- 7.8 The Complainant submits that there is no evidence that the Respondent is commonly known by "Lullaby Conceptions" or "lullabyconceptions.com.au". In this regard, the Respondent has not established a corporation in Australia that includes Lullaby Conceptions in its name and has not registered any State business name for or relating to Lullaby Conceptions.
- 7.9 The Complainant further submits that any use by the Respondent of the Disputed Domain Name could not be bona fide as the Respondent is aware of the Complainant's business. In this regard, the Complainant notes the relationship between a 50% shareholder of the Respondent and the Complainant's main online competitor in Australia as set out in paragraph 6.6 6.9 above.
- 7.10 In addition, the Complainant submits that the Respondent does not have any rights or legitimate interests in the Disputed Domain name because the Respondent has no connection with the Complainant and is not licensed or authorised to use the Disputed Domain Name.
- 7.11 In light of the above, it appears that the Respondent never intended to operate a legitimate business under the Disputed Domain Name and registration was designed to obstruct the Complainant's business.

C. Registered and Used in Bad Faith

- 7.12 Section 4(b) of the Policy provides a non-exhaustive list of factors which indicate registration and use in bad faith. In particular, the Complainant submits that the Respondent's conduct constitutes both registration and use in bad faith pursuant to sections 4(b)(iii) and 4(b)(iv) of the Policy as follows:
 - (a) In relation to section 4(b)(iii) of the Policy, as set out in paragraphs 6.6 6.9 above Ms. Clarissa Michelle Swiac is a 50% holder in the Respondent and the

Complainant's sole proprietor of the online competitor, FertilityNaturopath.com. Ms Swiac also resides at the same address as the sole director of the Respondent. This address is also the registered business address of the Respondent. The Complainant submits that as a 50% shareholder of the Respondent is the sole proprietor of the Complainant's competitor, it would be an unlikely coincidence if the Respondent happened to independently devise such a distinctive business name and trade mark and use it in a domain name for products and services relating to fertility, conception and pregnancy related products. This evidences the Respondent's intention of disruption the business activities of the Complainant.

(b) In relation to section 4(b)(iv) of the Policy, at the date of this Complaint a notice at the Disputed Domain Name states, "Welcome to our new look website. The site is currently undergoing maintenance and will be back online shortly". A copy of the printout obtained on 11 May 2007 of the notice displayed at the Disputed Domain Name appears in Annexure J. This appears to be a deliberate attempt by the Respondent to mislead and/or deceive visitors to the Disputed Domain Name by creating the impression that the website has been redesigned and will be relaunched shortly. Such conduct is misleading to consumers by diverting internet traffic away from the Complainant's website. In actual fact, the website located at Disputed Domain Name has never been active. In addition, as set out in paragraphs 6.6 – 6.9 above, the Complainant submits that the Respondent is aware of the reputation built by the Complainant and intends to benefit by registering the disputed domain name to divert internet traffic away from the Complainant to the Disputed Domain Name. In light of this, by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website by creating a likelihood of confusion with the Complainant's name and website which have been in use since August 2004.

The Complainant further submits that the Complainant has acquired a reputation in the "Lullaby Conceptions" mark within a short period of time in many jurisdictions including Australia. This is evidenced by the online discussions, blogs and forums in which the Complainant is mentioned, examples of which are provided in Annexure E. The Respondent is intentionally attracting internet users to the Disputed Domain Name by creating a likelihood of confusion with the Complainant's Lullaby Conceptions mark as to the source, sponsorship, affiliation or endorsement of the Disputed Domain Name.

7.13 The Complainant further submits that the name Lullaby Conceptions is unusual and distinctive. In light of this, and given that the Complainant has used the Lullaby Conceptions trade mark since August 2004 and is a competitor of FertilityNaturopath.com, it is unlikely that the Respondent independently devised the disputed domain name. Rather, the Complainant submits that the Respondent was aware of the Complainant's business and domain name prior to registration of the

Disputed Domain Name and registered the Disputed Domain name in order to prevent the Complainant from reflecting the Lullaby Conceptions mark in a corresponding domain name in Australia.

6 THE RESPONSE

- 6.1 The Response is set out in a 6 page document and Annexures A to L to that document.
- 6.2 The factual background is set out in part 3 of the Response, as follows:
 - '3.1 The Respondent has been operating a baby product distribution business since July 2005. The products include, baby bottles, baby monitors, baby creams and gels. A copy of the product range currently available is included in Annexure A. These printouts demonstrate the line of business the respondent is in and clearly shows that they do not distribute any fertility, pregnancy and conceptions products as does the complainant.
 - 3.2 On 25 August 2005, the respondent began distributing its Lullaby Concepts Baby Monitor. Image of which is included in Annexure B.
 - 3.3 On 19 January 2007, the Respondent registered the Disputed Domain Name.
 - 3.4 On 04 February 2007, he Respondent launched a single page website describing the company and upcoming new products. A printout is included in Annexure C.
 - 3.5 On March 29 2007, the Respondent updated the disputed domain home page to the printout the complainant provided with its complaint. This is included in Annexure D.
 - 3.6 On 25 February 2007, the Respondent lodged an Application with IP Australia for registration of "Lullaby Conceptions". The trade mark application 1162923 has been approved by IP Australia. A copy of the printout obtained on 20 June 2007 from IP Australia's ATMOSS database appears in Annexure E.'

I note that the Respondent does not take issue with the factual background set out in part 3 of the Complaint.

6.3 The Respondent's response to the material in part 7 of the Complaint are set out in part 4 of the Response, as follows:

'A Identical or confusingly similar response

4.1 The respondent has also lodged an application with IP Australia to register the trade mark "Lullaby Conceptions" This application has been approved as shown in Annexure E. This clearly shows that the respondent is entitled to the "Lullaby Conceptions" trade mark as IP Australia has themselves approved it. The complainant does not in fact have a registered trade mark but has a "Pending" trade mark as has the Respondent.

4.2 Furthermore the Respondent's trade mark has been accepted by IP Australia under Class 9
Educational products for children including educational software and music recordings. The
Complainant trade mark has been accepted under a completely different class in the form of
Class 35 Retail services (Annexure E). This shows that the trade marks are not identical by
the fact that they both have been accepted by IP Australia. If the two trade marks were
indeed identical or confusingly similar IP Australia would never have approved both trade
marks.

B Rights or legitimate interests response

- 4.3 As stated in Paragraph 4.2 above the respondent has had its trade mark "Lullaby Conceptions" approved by IP Australia. This demonstrates a legitimate interest in the disputed domain name.
- 4.4 The final website has been under development since February 2007 and a print out of the home page is attached in Annexure F. Clearly this demonstrates the bona fide offering of goods and services in development by the respondent. The respondent is not able to develop a whole website within a few days or weeks as the complainant is expecting. A general page was uploaded when the domain was registered. This went offline temporarily and a new home page was then uploaded that the complainant has printed off.

C Registered or used in bad faith response

- 4.5 The complainant has not indicated why they consider a business operated by a shareholder of the respondent to be its competitor. At no time has there been any reasons for making such a claim apart from the fact that the shareholder also operates a sole trader business. It is a very loose claim that a third party has some kind of competitive relationship with the complainant.
- 4.6 The respondent is not a competitor of the complainant. The complainant has alleged that: "it would be an unlikely coincidence if the Respondent happened to independently devise such a distinctive business name and trade mark and use it in a domain name for products and services relating to fertility, conception and pregnancy related products." The respondent in actual fact has not devised a business name or trade mark and used it in a domain for products and services relating to fertility, conception and pregnancy related products. This is clearly shown in the trade mark classification of "Educational products for children including educational software and music recordings" (Annexure E) As well as in the printout of the website that the complainant has provided from 11 May 2007. (Annexure D). At no time has the respondent planned or developed a website to provide products and services relating to fertility, conception and pregnancy related products.
- 4.7 Even though the complainant has not given any reasons for claiming that a shareholder of the respondent is the complainant's competitor we believe it should be responded to.

- 4.8 Fertilitynaturopath.com is not a competitor of the complainant as the site is based on providing naturopathic advice to couples trying to conceive. A printout from 22 June 2007 of some of the hundreds of pages of advice that have been provided is included in Annexure G. The products it does sell range from vitamins to fetal dopplers for pregnant women. The complainant sells their own ovulation and pregnancy test products that they have approval for with the Therapeutics Goods Administration (TGA) as described on their website and included in Annexure H. A search of the Australian Registered Therapeutics Goods (ARTG) database for the complainant name shows a range of listings (Annexure I) printed on 22 June 2007. A search for Neverscope Pty Ltd, Fertilitynaturopath.com, Clarissa Swiac or Slawomir Swiac shows no results (Annexure I). This is because the respondent or the so called competitor of the complainant does not have any TGA listed products. The complainant specialises in selling their own generic medical products, Fertilitynaturopath.com or the respondent do not. Therefore, Fertilitynaturopath.com or the respondent are not competitors of the complainant as their business is in other areas. The only competitor that can be determined from online searches within Australia is a business called Downunder Home Pregnancy and Ovulation Tests who also run a domain www.downunderhptopk.com.au. This business like the complainants has their own TGA approved ovulation and pregnancy tests which are sold generically. A print out of this site is included in Annexure L along with ARTG search for the business revealing listed products similar to the complainants. The respondent has no affiliation with Downunder Home Pregnancy and Ovulation Tests.
- 4.9 The complainant's assertion that the line in respondent's website "Welcome to our new look website. The site is currently undergoing maintenance and will be back online shortly" on 11 May 2007 is misleading has no basis. If the complainant had visited the website when it was first registered In January they would have found a small information site describing our upcoming products as shown in Annexure D. This printout also clearly shows the respondent's name at the bottom of the page. Clearly this is not deceptive. The final site is still under development but a range of pages have been printed out and included in Annexure F.
- 4.10 The respondent in no way is developing a site that is remotely similar to the complainant's site. The respondent is developing a site for educational and learning products for children from birth to 8 years. The complainant's website only sells fertility devices. There has been no commercial gain as the current home page has no links or other information related to the sale or provision of services.
- 4.11 The name Lullaby Conceptions has been derived from the respondent's own product that was distributed, namely Lullaby Concepts Baby Monitor. An image of the baby monitor is included in Annexure B
- 4.12 Finally, although the respondent's website does in no way mislead as to what the site is about and who operates it. The respondent has still added a disclaimer stating that the website is in no way affiliated with Lullaby Conceptions Pty Ltd or its products and provided a link to the complainant's website. A printout is attached in Annexure J.'

6.4 I note that, as at 8 July 2007, the material at www.LullabyConceptions.com.au now reads as follows:

Lullaby Conceptions Learning Educational Products from Birth to 8 Years

Welcome to our new look website. The site is currently undergoing maintenance and will be back online shortly.

Lullaby Conceptions Learning is in no way affiliated with www.lullabyconceptions.com or Lullaby Conceptions Pty Ltd. Click here to visit their website.

In the absence of some evidence or contention by the Respondent to the contrary, I consider it is reasonable to infer that the 'disclaimer' referred to in paragraph 4.12 of the Response was added at some time after the Respondent received the Complaint in June 2007 in an attempt to meet the contentions in part 7 of the Complaint.

7 FURTHER SUBMISSIONS

- 7.1 Clause 12 of Schedule B to the .au Dispute Resolution Policy provides that the Panel may request or permit further statements or documents from either of the Parties. In response to a request by Truman Hoyle letter dated 27 June 2007, I confirmed by e-mail dated 29 June 2007 that I exercised my discretion under clause 12 of Schedule B of the Policy to permit the Complainant to submit the further material in (and attached to) that letter.
- 7.2 The Respondent provided a letter dated 2 July 2007 in reply to the Truman Hoyle letter dated 27 June 2007, attaching a copy of a receipt from GoDaddy.com dated 17 December 2006. I have decided to exercise my discretion under clause 12 of Schedule B of the Policy to permit the Respondent to submit the further material in (and attached to) the letter dated 2 July 2007.
- 7.3 So far as relevant to my determination, I make the following findings in respect of the further material submitted:
 - (a) I am satisfied that a web hosting account for the disputed domain name was first established at or about 2.24pm AEST on 22 March 2007. I note in that regard that the receipt from GoDaddy.com dated 17 December 2006 does not refer to the disputed domain name and predates by more than one month the registration of the disputed domain name on 19 January 2007.

- (b) I accept, from an attachment to the Truman Hoyle letter dated 27 June 2007, that www.fertilitynaturopath.com is a competitor of the Complainant, contrary to what is asserted in paragraph 4.8 of the Response. I note that is not disputed in the Respondent's letter dated 2 July 2007.
- (c) I accept that Ambermex Pty Ltd is a company related to the Respondent, which holds TGA approval for ovulation and pregnancy related products. I note that is not disputed in the Respondent's letter dated 2 July 2007. I reject what is asserted in paragraph 4.8 of the Response regarding 'Downunder Home Pregnancy and Ovulation Tests' being the only competitor in Australia to the Complainant, as being both untrue and intentionally misleading.

8 DETERMINATION

8.1 Having regard to:

- (a) the submissions by the parties and the evidentiary material in the Annexures to those submissions;
- (b) the matters referred to in Parts 5, 6 and 7 above,

I find that the Complainant is entitled to the relief which it seeks, more particularly for the reasons referred to in paragraphs 8.2 to 8.17 below.

Paragraph 4a(i) of the Rules - Whether the domain name is identical or confusingly similar to a name etc in which the Complainant has rights

- 8.2 I accept that the Complainant has rights in the name 'Lullaby Conceptions' from registration of the company Lullaby Conceptions Pty Ltd in New South Wales on 9 August 2004. I note the absence of any submissions by the Respondent to the contrary.
- 8.3 I also accept that the Complainant has rights in the name 'Lullaby Conceptions' from use of the domain name www.lullabyconceptions.com since August 2004. I note the absence of any submissions by the Respondent to the contrary.
- 8.4 It is clear that the domain name www.lullabyconceptions is identical or confusingly similar to the name 'Lullaby Conceptions' as used in both Lullaby Conceptions Pty Ltd and the domain name www.lullabyconceptions.com. It appears to me that a reasonable person in the market for products of the type offered by the Complainant and the Respondent may be confused from the similarity in the name. I note the absence of any submissions by the Respondent to the contrary.
- 8.5 Accordingly, I find that the Complainant has satisfied the requirements of sub-paragraph (i) of paragraph 4a of the Rules.

Paragraph 4a(ii) of the Rules - Whether the Respondent has no rights or legitimate interests in respect of the domain name

- 8.6 I note what is said in paragraph 4c of the Rules regarding a respondent demonstrating rights to, or legitimate interests in, the domain name in dispute. While paragraph 4a of the Rules provides that a complainant bears the probative onus of establishing its case, it is reasonable to proceed on the basis that a respondent which relies on paragraph 4c of the Rules bears an evidentiary onus in respect of matters it seeks to demonstrate under sub-paragraphs (i), (ii) or (iii) of paragraph 4c.
- 8.7 I am not satisfied from the evidence that the Respondent has demonstrated its rights or legitimate interest in the domain name www.lullabyconceptions.com.au, by establishing the matters in subparagraph (i), (ii) or (iii) of paragraph 4c, namely:
 - '(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.'

8.8 In particular:

- (a) I do not accept that there was any bona fide use (or demonstrable preparations for use) of the domain name www.lullabyconceptions.com.au by the Respondent before notification of the dispute by letters dated 19 February and 23 March 2007 (Annexures L and P of the Complaint). I reject the Respondent's submissions to the contrary.
- (b) I reject the submission in paragraph 4.11 of the Response that '(t)he name Lullaby Conceptions has been derived from the respondent's own product that was distributed, namely Lullaby Concepts Baby Monitor'. In my opinion, a reasonable person would understand the words 'Conceptions' and 'Concepts' as referring to quite different things.
- (c) I find that the Respondent has not been commonly known by the name 'Lullaby Conceptions' either before or after registration of the domain name www.lullabyconceptions.com.au on 19 January 2007. I note the absence of submissions and evidence by the Respondent to the contrary.
- (d) I do not accept that the Respondent was making a legitimate non-commercial or fair use of the domain name <u>www.lullabyconceptions.com.au</u>, either before or after registration of that domain name on 19 January 2007. I am satisfied that the conduct of the Respondent was

intended to misleadingly divert consumers and/or to trade on the Complainant's use of the name 'Lullaby Conceptions' in its business.

- 8.9 I note that the auDA 'Guidelines for Accredited Registrars on the Interpretation of Policy Rules for Open 2LDs (2005-02)' were in force when the disputed domain name was registered in about January 2007. Having considered those Guidelines, more particularly the provisions of paragraphs 10.1 to 10.7 and the examples of close and substantial connection set out in Table C, I am not satisfied that the Respondent satisfied the criteria for 'close and substantial connection' in registering the domain name www.lullabyconceptions.com.au. I note in that regard that, in paragraph 4.10 of the Response, the Respondent says that '(t)he Respondent is developing a site for educational and learning products for children from birth to 8 years', which appears to lack a 'close and substantial connection' to the disputed domain name.
- 8.10 Accordingly, I find that the Complainant has satisfied the requirements of sub-paragraph (ii) of paragraph 4a of the Rules.

Paragraph 4a(iii) of the Rules - Whether the domain name has been registered or subsequently used in bad faith

- 8.11 I find that 'the name "Lullaby Conceptions" is unusual and distinctive' and that 'it is unlikely that the Respondent independently devised the disputed domain name', as contended in paragraph 7.13 of the Complaint.
- 8.12 I am satisfied that, before and after registration of the disputed domain name on 19 January 2007, the Respondent, its directors and shareholders:
 - (a) were aware of the Complainant's business, under the name 'Lullaby Conceptions', and were aware of the reputation built by the Complainant in conducting its business under that name, as contended in paragraph 7.12(b) of the Complaint;
 - (b) conducted no business in Australia or elsewhere under the name 'Lullaby Conceptions';
 - (c) registered the disputed domain name with the intention of obtaining commercial benefit by diverting internet traffic away from the Complainant's website www.lullabyconceptions.com, as contended in paragraph 7.12(b) of the Complaint, and 'preventing the Complainant from reflecting the Lullaby Conceptions mark in a corresponding domain name in Australia', as contended in paragraph 7.13 of the Complaint.
- 8.13 I accept the Complainant's submissions that the conduct of the Respondent in registering and subsequently using the disputed domain name was in bad faith.
- 8.14 I reject the submissions in paragraphs 4.5 to 4.9 of the Response as demonstrating that the disputed domain name was not registered or subsequently used in bad faith. The absence of bona fides is well demonstrated by the Respondent's lack of frankness in respect of its connection with a company (Ambermex Pty Ltd) and a domain name (www.FertilityNaturopath.com) which compete,

or seek to complete, in the market in which the Complainant operates what appears to be a very successful business.

8.17 Accordingly, I find that the Complainant has satisfied the requirements of sub-paragraph (iii) of paragraph 4a of the Rules.

9 DECISION

- 9.1 As indicated in paragraphs 8.1 to 8.17 above, the Panel finds that the Complainant has established each of the three elements which it must satisfy pursuant to sub-paragraphs (i), (ii) or (iii) of paragraph 4a of the Rules, such that the Complainant's claim for relief should be upheld.
- 9.2 The Complainant appears to satisfy the eligibility requirements for registration of the domain name www.lullabyconceptions.com.au, which are set out in the auDA 'Domain Name Eligibility and Allocation Rules for Open 2 LDs (2002-07)' and 'Guidelines for Accredited Registrars on the Interpretation of Policy Rules for Open 2LDs (2005-02)'.
- 9.3 Accordingly, the domain name www.lullabyconceptions.com.au should be transferred from the Respondent to the Complainant.

Robert Hunt

Sole Panelist

9 July 2007