

**THE INSTITUTE OF ARBITRATORS & MEDIATORS
AUSTRALIA**

ADMINISTRATIVE PANEL DECISION MATTER NO. 3167

**IVF SUNSHINE COAST PTY LTD v. FERTILITY SOLUTIONS
SUNSHINE COAST PTY LTD**

Domain Name: <ivfsunshinecoast.com.au>

Name of Complainant: IVF Sunshine Coast Pty Ltd

Name of Respondent: Fertility Solutions Sunshine Coast Pty Ltd

Provider: The Institute of Arbitrators & Mediators Australia

Sole Panelist: The Honourable Neil Anthony Brown QC

1. The Parties

(a). The Complainant in this proceeding is IVF Sunshine Coast Pty Ltd of Ground Floor, 5 Innovation Parkway, Lake Kawana Private Hospital, Birtinya Qld 4575(the “Complainant”);

(b). The Respondent is Fertility Solutions Sunshine Coast Pty Ltd of 89 Blackall Terrace, Nambour, QLD, 4560 represented by Hopgood Ganim Lawyers, of Brisbane, Qld (the “Respondent”).

2. The Domain Name, Registrar and Provider

(a). The domain name subject to this proceeding is <ivfsunshinecoast.com.au>, (the “Domain Name”) and the registrar is TPP Internet (the “Registrar”).

(b). The provider in this proceeding is The Institute of Arbitrators & Mediators Australia, Level 1, 190 Queen Street, Melbourne, VIC 3000(“IAMA”).

3. Procedural Matters

(a) The complaint was submitted for decision in accordance with the .au Dispute Resolution Policy (auDRP) and the Rules For .au Dispute Resolution Policy (auDRP Rules). The auDRP and the auDRP Rules were adapted from the Uniform Dispute Resolution Policy and Rules of the Internet Corporation for Assigned Names and Numbers (ICANN).

The Panel should say here that auDRP is described as Policy No.2008-01, it was published on March 1, 2008, its status is current and it includes the Dispute Resolution Policy itself and also the Rules under which proceedings under the Policy are brought. All of this material is set out at www.auda.org.au, the website of .au Domain Administration Limited ABN 38 079 009 340, ("auDA") the body that administers the Australian Domain Name space and which deals with such matters as the policy for the internet and domain names and the resolution of disputes about domain names.

It is apparent that the Complainant was aware at the time of the filing of the Complaint that the material was available on the internet as the Complaint contains extracts from the auDRP preceded by the statement "(from AUDA web site)".

(b) The Complaint was in the form of an email sent by the Complainant to IAMA on March 17, 2008.

(c) The Panel has not been provided with any other material relating to the procedural history of this matter. This may be because the Respondent has taken an active part in the proceedings and has made some concessions about formal matters.

(d) On May 30, 2008, Hopgood Ganim Lawyers sent by email to IAMA its submissions by way of response to the Complaint.

(e) On June 2, 2008 IAMA approached the Panelist, who confirmed his availability and on June 5, 2008 signed a Statement of Acceptance and Declaration of Impartiality and Independence. The Panel finds that it has been properly constituted.

(f) On June 3, 2008, IAMA sent to the Panelist the following documents:

- (i) a letter from IAMA to the Panelists dated June 2, 2008 confirming the Panelist's appointment;
- (ii) a letter from IAMA to the parties, confirming the appointment of the Panelist;
- (iii) letter from Hopgood Ganim to IAMA dated May 30, 2008 covering its submissions for the Respondent;
- (iv) the submissions themselves and some attachments on various evidentiary matters.

IAMA had already sent to the Panelist several emails which included the email referred to above and which was in effect the Complaint.

4. THE PARTIES' CONTENTIONS

THE COMPLAINANT

The Complainant submitted that the domain name <ivfsunshinecoast.com.au> should no longer be registered with the Respondent but should be transferred to the Complainant. In support of this claim, the Complainant submitted a concise statement. As the decision in this matter turns in part on that statement, it should in fairness to the Complainant be set out in full. The statement provides as follows:

“As I outlined briefly this morning I am basically seeking to have an arbitration performed regarding the current registration of the domain name www.ivfsunshinecoast.com.au . In order to do this I am seeking clarification of the required process.

The website for the Australian Domain Name Administrator (AUDA) indicates that disputes may be submitted to an AUDA approved dispute resolution service provider such as the Institute of Arbitrators and Mediators Australia (IAMA).

The details for the requirement for this arbitration are as follows;

a) Our company name and trading name is IVF Sunshine Coast Pty Ltd ACN 114 868 521 and was registered 21st June 2005 (please find Extract attached). This group of Specialists has actually been offering infertility treatment services since late 1997 under a slightly different Co. name i.e. IVF Qld Sunshine Coast.

b) We perform IVF and related infertility treatment services for couples from the entire Sunshine Coast, Queensland.

c) Our name has significant commercial value as the Company has been actively marketing its services to the local medical community as well as to the local population.

d) A recent local competitor, Fertility Solutions Sunshine Coast Pty Ltd ACN 123 644 422 (FSSC), was registered on 29th January 2007 (please find Extract attached)

e) They have registered the domain name www.ivfsunshinecoast.com.au and have configured it such that all traffic is directed to their actual website which is www.fssc.com.au

f) Based upon the Dispute Resolution Policy below, it would seem that FSSC have inappropriately registered this domain name as;

i) It is “identical or confusingly similar to” IVF Sunshine Coast Pty Ltd (see 4 A a i below)

ii) FSSC has “no rights or legitimate interests in respect of the domain name” (see 4 A a ii below)

iii) It would appear, given the quite intentional redirection of traffic to the real FSSC web site that the domain name “has been registered or subsequently used in bad faith” (see 4 A a iii below). The clear implication of this domain registration is either “primarily for the purpose of disrupting the business or activities of another person” (see 4 A b iii below) and/or to “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a web site 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 web site or location or of a product or service on that web site or location" (see 4 A b iv below).

(from AUDA web site)"

Thereafter follows the extract of parts of the auDispute Resolution Policy referred to above.

THE RESPONDENT

As the Complaint has been set out in full, it is only appropriate to set out in full the Response submitted on behalf of the Respondent. It provides as follows:

Submissions for Fertility Solutions Pty Ltd - Complaint Response

We acknowledge receipt of the complaint made by IVF Sunshine Coast Pty Ltd (the **Complainant**) on 7 May 2008 via the Institute of Arbitrators and Mediators Australia (**IAMA**).

We act for Fertility Solutions Pty Ltd (the **Respondent**) in this matter. On behalf of our client, we respond as follows:

1. The Respondent operates fertility clinics which offer its clients fertility programs and services, such as In Vitro Fertilisation (**IVF**) programs. Our client is based on the Sunshine Coast in Queensland, where it operates a clinic. Its registered office is at 89 Blackall Terrace, Nambour.
2. The Respondent is a private company limited by shares that was incorporated on 29 January 2007. We **attach** a company search extract.
3. The Complainant is a private company limited by shares that was incorporated on 21 June 2005. Prior to this, the Complainant contends that some of its specialists traded under another company, IVF Qld Sunshine Coast Pty Ltd. IVF Qld Sunshine Coast Pty Ltd is a distinct entity, a private company limited by shares, incorporated on 24 May 1999. We **attach** the relevant company search extracts.
4. It is common practice for businesses to register domain names that include the names of the geographical areas in which they operate and for things that generally describe their business and services. The respondent thought it sensible business practice to register several domains that customers may use, in the course of "direct navigation", to locate fertility clinics on the sunshine coast, and, which would lead those customers to its website. The respondent subsequently registered the following domains for this purpose:
 - www.fertilitysolutionssunshinecoast.com.au
 - www.ivfqueensland.com.au
 - www.sunshinecoastivf.com.au
 - www.ivfsunshinecoast.com.au
 - www.fertilitysolutionssunshinecoast.com
 - www.fertilitysolutionsivf.com

These domains were all registered by Synchronmedia Group Pty Ltd, on behalf of the Respondent, on 17 May 2007. We **attach** the relevant Invoice from Synchronmedia Group Pty Ltd and other domain searches conducted. The Respondent does direct the above domains, to its primary domain at www.fssc.com.au, for the purpose of consolidating internet search traffic onto its principal domain.

There is some literature and study on direct navigation practices that confirm its value for businesses trying to capture new clients. Our client's behaviour in registering the above domains is legitimate and sensible given its business and market.

5. It appears that between the time of its incorporation on 21 June 2005 and the Respondent's registration of the domain www.ivfsunshinecoast.com.au on 17 May 2007, the Complainant never made any attempt to register the domain. Further, until its referral to the IAMA on 17 March 2008, it would appear that no action was taken by the Complainant and no approaches were made by the Complainant to the Respondent in respect of the domain. The Complainant has continued to use its existing domain, www.ivfq.com.au. We **attach** the domain search conducted for www.ivfq.com.au.
6. The Respondent contends that representations have been made by senior personnel at the Complainant's company, to the effect that domain names were unimportant and not of commercial significance and that it was for these reasons that the domain in question was not registered sooner.
7. There are no registered Trade Marks in respect of "IVF Sunshine Coast". Indeed a Trade Mark of those words is not capable of registration because the words are not distinctive. The relevant Trade Mark searches are **attached**.
8. The Respondent responds to the Complainant's claims that it has "inappropriately registered" www.ivfsunshinecoast.com.au, pursuant to Schedule A of the auDRP, as follows:
 - (a) Pursuant to clause 4(a)(i) of Schedule A of the auDRP, the Respondent acknowledges that the domain name is identical to that of the Complainant's Company Name. However, the Respondent has legitimate interests and rights in respect to the domain name, pursuant to 4(a)(ii).

The Respondent's business is one that, like the Complainant's, operates fertility clinics and offers IVF services. It is based on the Sunshine Coast. It has a perfectly legitimate claim to register domains that reflect its business operations. The terms "IVF" and "Sunshine Coast" are generic terms but describe the services and location of the Respondent.

It is reasonable to assert that any application for a Trade Mark in "IVF Sunshine Coast" would fail, on the basis that the words are descriptive and a geographical name. It is reasonable to assert that domains should be treated in a similar way, particularly where there are numerous parties with interests in the domains. There are an abundance of domains currently registered containing generic terms that may mirror registered company or business trading names.

"IVF" is a general term used to describe a commonplace fertility treatment that both the Complainant and the Respondent employ. The Sunshine Coast is the territory in which the Complainant and the Respondent conduct business. The Complainant does not hold a Trade Mark in "IVF Sunshine Coast".
 - (b) The Complainant has asserted that the Respondent's redirection of internet traffic from several of its domains to its primary domain, constitutes evidence of bad faith pursuant to clause 4(a)(iii) of Schedule A of the auDRP. The inference of the

Complainant is that this action creates confusion or disrupts the business or activities of another.

The Respondent's conduct in directing several of its related domains to one central domain is sensible and is commonplace among many businesses possessing several domains related to its business. It makes perfect commercial sense to do so.

The Respondent has clearly not created "confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that website". The Respondent's website is vastly different from that of the Complainant and there is clearly no "passing off", nor is there a duplication of marks or names that could lead an average bystander to be confused between the separate companies. The respondent merely uses generic terms to steer people to its primary website. Conversely, the Complainant has seen fit to continue to operate with the domain www.ivfq.com.au, since its incorporation.

Summary

The Complainant erred in not registering the domain name sooner. The Complainant continues to use their existing domain, www.ivfq.com.au, consistent with their previous trading name, as their preferred domain.

The auDRP is in place to eliminate "cyber squatters" or those trying to extort or act in bad faith against third parties. Typically, they are persons with no meaningful interest in the domains. That is not the case here. The Respondent is a legitimate fertility services business that wishes to engage with its local market to its full potential. All of the domains registered by the Respondent are valuable to its operations, particularly in an era of increased "direct navigation".

The Respondent's legitimate commercial strategy would be unfairly compromised if it were ordered to transfer its domains to the Complainant. The Respondent has merely been astute and timely in registering the domains, to which it has a valid claim.

The Respondent asserts that it has registered the domain in question in good faith and without any intention of creating confusion. We are happy to answer any further enquiries the IAMA may have in relation to these matters, in making its determination.

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5. Jurisdiction

- (a). the Panel acquires its jurisdiction from the auDRP and the auDRP Rules.
- (b). The disputed Domain Name is an open 2LD and it was registered on May 17, 2007 and is therefore subject to the mandatory administrative proceedings prescribed by the auDRP.

6. Consideration of the Issues

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, i.e. the auDRP, the Rules and any rules and principles of law that it deems applicable.

In doing so, the onus is on the Complainant to make out its case and both the Policy and many UDRP and auDRP decisions have made it clear that a Complainant must show that all three elements of the Policy have been made out before any order can be made to cancel or transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the evidence.

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- A. The domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights (paragraph 4(a) (i)); and
- B. The Respondent has no rights or legitimate interests in respect of the domain name (paragraph 4(a)(ii)); and
- C. The domain name has been registered or subsequently used in bad faith (paragraph 4(a) (iii)).

It should also be noted that a footnote to the Policy provides as follows:

‘Notes:

[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.’**

Accordingly, it is sufficient under the auDRP for a complainant to prove that a disputed domain name is identical or confusingly similar, not only to a trademark or service mark in which it has rights, but to a name, which may be a registered company, business, legal, trading or personal name. In the present case, the Complainant says that the domain name is identical or confusingly similar to it's, the Complainant's, company and trading name.

The Panel will deal with each of these requirements in turn.

A. Identical or Confusingly Similar

Paragraph 4(a) (i) of the Policy.

The Panel finds that the domain name is identical to the Complainant's registered company and trading name. The name of the Complainant is IVF SUNSHINE COAST PTY LTD and the disputed domain name is <ivfsunshinecoast.com.au>. It is therefore readily apparent that the domain name is spelt the same way and would be pronounced the same way as the company name. Moreover, it has been held in many UDRP and auDRP cases that the addition of suffixes like 'com.au' and minor spelling discrepancies may not be relied on to negate identity or confusing similarity that otherwise exists, as it does in the present case. Thus, the fact that the domain name does not include the abbreviations 'Pty Ltd' which are part of the company name does not make the domain name any less identical to the company name. Even if it did, the domain name would still be confusingly similar to the company name.

Additionally, it should be noted that the Respondent has rightly conceded that the domain name is identical to the company name.

Accordingly, for all of those reasons, the Complainant has made out the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Paragraph 4(a) (i) of the Policy.

Under paragraph 4(a) (ii), the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] 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 trademark or service

Thus, if the Respondent proves any of these elements or indeed anything else that shows he has a right or interest in the domain name, the Complainant will have failed to discharge its onus and the complaint will fail.

It is also well established that, as it is put in the [Overview of WIPO Panel Views on Selected UDRP Questions](#) ('the Overview') that "...a complainant is required to make out an initial *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP".

The same principle applies by analogy to proceedings under the auDRP.

The reason why a complainant is required to make out such a *prima facie* case on this second element is that the Policy itself requires that the Complainant must prove that:

‘B. The Respondent has no rights or legitimate interests in respect of the domain name (paragraph 4(a)(ii));...’

This means that to apply that provision literally, a complainant would have to prove a negative; i.e. that the respondent had no rights or legitimate interests in the domain name. In many cases this would be difficult if not impossible to do, as a complainant may know nothing of the respondent and certainly nothing to show, one way or the other, whether the respondent had any right or legitimate interest in the domain name.

It has therefore long been felt that to distribute the burden of proof over both parties and in a reasonable way, the requirement should be that the complainant need first satisfy a comparatively low threshold of showing that, on what the complainant knows from its own information, *prima facie*, the respondent has no right or legitimate interest in the domain name, but that the respondent may then rebut that *prima facie* finding and show that it does in fact have a right or legitimate interest in the domain name.

That being the sense behind the application of this requirement, it will be seen that the Complainant in the present case has not made out a *prima facie* case and has not really made any attempt to do so.

The Panel, after considering all of the material available to it, finds that the Complainant has not made out a *prima facie* case that the Respondent has no rights or legitimate interests in the domain name. The reasons why that is so are as follows.

As has already been seen, the parts of the Complaint relating to this element are exceedingly brief. The entire submission of the Complainant is that

“ii) FSSC has “no rights or legitimate interests in respect of the domain name” (see 4 A a ii below).”

That submission is an assertion which contains no facts to support it and there is therefore no factual basis on which the Panel can conclude that the Complainant has made out a *prima facie* case. Accordingly, the Panel is unable to conclude that the Complainant has made out this element, which is an essential element that it must prove.

It might be said that a Complainant may not know that it must produce evidence in support of its assertions. However, when a party brings a proceeding such as the present one and relies on a specific Policy and Rules, it is not asking too much of that party to do what the Policy and the Rules require, which is clearly that it must produce evidence in support of its assertions.

That must be so when the procedures being used by the Complainant require, on their own words, evidence to be brought forward in support of the case being made. Reference to some of the applicable rules will make this clear.

Thus, Rule 3 (ix) requires that a Complaint shall ‘ *Describe, in accordance with the Policy, the grounds on which the complaint is made.*’

Secondly, Rule 3 (xiv) provides that a Complaint shall:

‘ *Conclude with the following statement followed by the signature of the Complainant or its authorised representative:*

... "Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good faith and reasonable argument." ; and...’

Then Rule 3 (xv) requires the Complainant to:

‘ *Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any name, trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.*’

Finally, Rule 15 provides in part that:

‘*(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.*’

The rules relied on by the Complainant thus make it clear that the procedure contemplates at least some evidence being brought forward to support the allegations being made. It is simply not enough to cite the Policy itself without showing how the Respondent has been in breach of it.

That must be particularly so when the procedure is being used by the Complainant is a fast track, administrative procedure leading to a decision that will deprive the other party of a property right, namely its entitlement to a domain name it has registered, without a full hearing with witnesses. It should not, therefore, be surprising that evidence is required before such a severe result can be obtained.

Moreover, in the present case, it is apparent that the Complainant has had access to and has been using the website of auDA and that the requirement for evidence has in fact been brought to its notice. As has already been said, the Complaint makes it clear that extracts from the Policy have been taken “(from AUDA web site)”. The website contains decisions made on complaints made under the Policy since 2002 and it would be apparent to anyone who looks at those decisions that proceedings under the Policy are made on the basis of evidence submitted. It is therefore reasonable to conclude that it is not sufficient merely to copy an allegation from the Policy without supporting it by facts or evidence.

Accordingly, the Complainant has been unable to prove this, the second of the three elements that it must establish and accordingly, the Complaint must fail.

OTHER MATTERS

The Panel has considered going on to give its opinion on the other issues that have arisen in the Complaint and the Response. The Panel will not do this, however, as it has already said sufficient to dispose of this proceeding and it is rarely helpful to go further than necessary in a decision.

DECISION

The Panel is satisfied as to the element set out in paragraph 4(a)(i) of the Policy.

The Panel is not satisfied as to the element set out in paragraph 4(a) (ii) of the Policy.

The Complaint is therefore dismissed.

Date: June 13, 2008

The Hon Neil Anthony Brown QC
Sole Panelist

