

THE  
INSTITUTE of  
ARBITRATORS & MEDIATORS  
——  
AUSTRALIA  
.au Dispute Resolution Provider

ADMINISTRATIVE PANEL DECISION

**Advanced Medical Institute Pty Limited v. World Wide Internet Services (Aust.)  
Pty Limited**

Case No. 3021

**1. The Parties**

The Complainants are Advanced Medical Institute Pty Limited and AMI Australia Holdings Pty Limited of Alexandria, New South Wales. The Respondent is World Wide Internet Services (Aust.) Pty Limited of Surry Hills, New South Wales.

**2. The Domain Names and Registrar**

The disputed domain names are:

advancedmedicalinstitute.com.au  
australianmedicalinstitute.com.au  
impotencyanonymous.com.au  
healthservicesformen.com.au  
australianmomentumhealth.com.au

All of the disputed domain names are registered with Anchor Systems Pty Ltd.

**3. Procedural History**

The Complaint was filed with the Institute of Arbitrators and Mediators Australia ("IAMA") on October 25, 2006. IAMA considered that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the "Policy"), the Rules for .au Dispute Resolution Policy (the "Rules"), and the IAMA Supplemental Rules for .au Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), IAMA formally notified the Respondent of the Complaint, and the proceedings commenced on November 1, 2006. In accordance with the Rules, paragraph 5(a), the due date for Response was November 21, 2006.

IAMA appointed Alan L. Limbury as sole panelist on November 13, 2006, before the due date for the Response. Since the informal response, when submitted, did not seek the appointment of a 3-member panel, the Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by IAMA to ensure compliance with the Rules, paragraph 7.

On November 13, 2006, IAMA notified the Complainants of a deficiency in the Complaint, namely the absence of the statement required by the Rules, paragraph 3(b)(xiv), which the Complainants rectified by submitting an amended Complaint.

The Respondent submitted an informal response on November 18, 2006, which the Panel has taken into account.

The language of the proceedings is English.

#### **4. Factual background**

Since 1993 the Complainants have conducted businesses treating men for erectile dysfunction and premature ejaculation. They market nasal sprays for these conditions. They have registered in New South Wales the business names Australian Momentum Health (No. BN97806251); Health Services for Men (No. BN97806259); Impotency Anonymous (No. BN97806256) and On Clinic (No. BN97806253).

The disputed domain names all presently resolve to websites promoting nasal sprays for erectile dysfunction and premature ejaculation. The evidence before the Panel and a WHOIS search conducted by the Panel do not reveal when the disputed domain names were registered by the Respondent but a search by the Panel at [www.archive.org](http://www.archive.org) reveals the first webpages for the first, third and fifth domain names listed above as having been displayed in mid-August 2006.

#### **5. Parties contentions**

##### **A. Complainants**

In addition to the business names mentioned, the Complainants rely on pending registered trademark applications for 'Advanced Medical Institute', 'AMI - Advanced Medical Institute of Australia (words and device)' and on the registered trademark 'On Clinic (words and device)'. They say they have no association with the Respondent's websites and have not authorized or permitted use of their business names or trade marks.

The Complainants contend that the domain name <[australianmedicalinstitute.com.au](http://australianmedicalinstitute.com.au)> is deceptively similar to, and that the other disputed domain names are identical to, a business name, company name or common law trademark owned by the Complainants.

The Complainants say that, following correspondence from their lawyers, the Respondent agreed to transfer the disputed domain names to them but that this has not occurred.

## **B. Respondent**

So far as it contains relevant contentions, the informal response concedes that the Respondent registered the disputed domain names. It says the Complainants have had over 12 years within which to register domain names regarding their products but have not cared to do so. The disputed domain names were chosen because they were relevant to the Respondent's business and were ordinary English words not registered by anyone else. The Respondent has pending trademark applications for AMI NASAL SPRAY relevant to its product Australian Medical Intrnasal [sic] Spray; Intranasal Spray and other names relevant to its products. The Complainants do not appear to have any relevant names pending in regards to the names they are claiming. The Complainants could have registered many other names than those they are now seeking from the Respondent.

## **6. Discussion and findings**

Paragraph 4(a) of the Policy requires a Complainant to establish three elements:

1. The Complainant has rights in a name, trademark or service mark, with which Respondent's domain name is identical or confusingly similar (Paragraph 4(a)(i)); and
2. The Respondent has no rights or legitimate interests in respect of the domain name (Paragraph 4(a)(ii)); and
3. The Respondent registered or is subsequently using the domain name in bad faith (Paragraph 4(a)(iii)).

### **A. Rights**

The Complainants have rights in the company names Advanced Medical Institute Pty Limited and AMI Australia Holdings Pty Limited and in the business names Australian Momentum Health, Health Services for Men, Impotency Anonymous and On Clinic. The latter is also a registered trademark. Pending registered trademark applications do not confer rights. There is before the Panel no evidence of use which would establish any common law trademark rights.

### **B. Identity or confusing similarity**

The domain name <australianmedicalinstitute.com.au> is not identical to any of the Complainants' business or company names. Each of the other disputed domain names is identical to one of the Complainants' registered business names, since the ccTLD 'com.au' is inconsequential and must be disregarded. The

domain name <advancedmedicalinstitute.com.au> is also identical to the first Complainant's company name, the suffix 'Pty Limited' likewise being inconsequential and to be disregarded. None of the disputed domain names is identical or confusingly similar to the business name and registered trademark 'On Clinic'.

In considering whether <australianmedicalinstitute.com.au> is confusingly similar to any of the Complainants' business or company names, the descriptive character of the words comprising that domain name must be borne in mind. The only name of the Complainants with which the domain name could possibly be thought to be confusingly similar is the business and company name Advanced Medical Institute. Does the word 'Australian' instead of 'Advanced' render the domain name confusingly similar to that business/company name? The Panel thinks not, for the reasons given by Stephen J in *Hornsby Building Information Centre Pty Ltd v. Sydney Building Information Centre Ltd* (1978) 140 CLR 216 at 229:

"There is a price to be paid for the advantages flowing from the possession of an eloquently descriptive trade name. Because it is descriptive it is equally applicable to any business of a like kind, its very descriptiveness ensures that it is not distinctive of any particular business and hence its application to other like businesses will not ordinarily mislead the public. In cases of passing off, where it is the wrongful appropriation of the reputation of another or that of his goods that is in question, a plaintiff which uses descriptive words in its trade name will find that quite small differences in a competitor's trade name will render the latter immune from action (*Office Cleaning Services Ltd. v. Westminster Window and General Cleaners Ltd.* (1946) 63 RPC 39, at p 42, per Lord Simonds). As his Lordship said (1946) 63 RPC, at p 43, the possibility of blunders by members of the public will always be present when names consist of descriptive words - "So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some members of the public will be confused whatever the differentiating words may be." The risk of confusion must be accepted, to do otherwise is to give to one who appropriates to himself descriptive words an unfair monopoly in those words and might even deter others from pursuing the occupation which the words describe."

Accordingly, the Panel finds that the Complainants have not established this element with respect to the domain name <australianmedicalinstitute.com.au>. The complaint concerning that domain name must be dismissed. The Complainants have established this element with respect to the other disputed domain names. What follows relates solely to those other disputed domain names.

### **C. Legitimacy**

Apart from the (uncontradicted) assertion that the Complainants have not authorized or permitted the Respondent to use their names, the Complainants have provided no

evidence under this heading. As is the case under the UDRP, that assertion is sufficient, however, to shift the burden of proof to the Respondent to demonstrate legitimacy. See for example *Cassava Enterprises Limited, Cassava Enterprises (Gibraltar) Limited v Victor Chandler International Limited*, WIPO Case No. D2004-0753.

Paragraph 4(c) of the Policy provides that any of the following circumstances, without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, is to be taken to demonstrate the Respondent's 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.

There is no evidence that the Respondent has been commonly known by any of the disputed domain names. The websites to which the domain names resolve are conducted for commercial gain. Accordingly sub-paragraphs (ii) and (iii) do not apply.

As to sub-paragraph (i), the Respondent received notice of this dispute by letter from the Complainants' lawyers dated October 13, 2006. The Respondent was by then conducting business at the websites in question, under the name Bade Medical Institute, promoting nasal sprays for the treatment of erectile dysfunction and premature ejaculation.

The Respondent says the disputed domain names were chosen because they were relevant to the Respondent's business and were ordinary English words not registered [as domain names] by anyone else.

Preparations for developing a business that could logically be marketed under a certain domain name can constitute legitimate preparations for use, even if the proposed business has no need to use the exact name at issue. Where however, the complainant and the respondent are competitors or in closely related fields, it is unlikely that a respondent can develop a legitimate interest in using a domain name confusingly similar to the complainant's name or mark: see *Goldline International, Inc. v. Gold Line*, WIPO case D2000-1151.

Although each of the four disputed domain names presently under consideration, taken in isolation, may be regarded as apposite to the kind of business in which the Respondent is engaged, and as sufficiently descriptive or suggestive as to give rise to a finding of legitimacy when used in connection with such a business, the Panel cannot accept that all four domain names were registered by the Respondent without any awareness of the Complainants and their previously established competing businesses conducted under those same names. The combination of all four registrations cannot be attributed to coincidence. The Panel accordingly infers such awareness on the part of the Respondent. This casts doubt upon the bona fides with which the domain names have been used in furtherance of the Respondent's business and leads the Panel to conclude that the Respondent has not demonstrated that it has rights or legitimate interests in those domain names.

The Complainants have established this element.

#### **D. Bad faith registration or use**

Paragraph 4(b) of the Policy provides that, 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 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.

Given the Panel's conclusion that the Respondent registered the four domain names presently under consideration with knowledge of the Complainant and its business and company names and has been using those domain names in a business directly competitive with those of the Complainants, the Panel finds those domain names to have been registered in bad faith under the Policy, paragraph 4(b)(ii) and (iii) and, despite disclaimers on its websites, which cannot dispel 'initial interest confusion', to

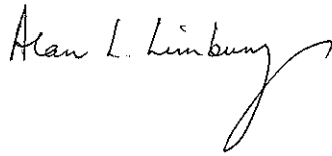
have been used in bad faith under paragraph 4(b)(iv) Any one of these findings is sufficient to establish this element.

The Complainants have established this element of their case.

## 7. Decision

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the complaint in relation to the domain name <australianmedicalinstitute.com.au> be dismissed and that the domain names <advancedmedicalinstitute.com.au>, <impotencyanonymous.com.au>, <healthservicesformen.com.au> and <australianmomentumhealth.com.au> be transferred to the Complainant Advanced Medical Institute Pty Limited unless, within 10 days of being notified of this decision, the Complainants inform the Registrar that they wish any of those domain names to be transferred to AMI Australia Holdings Pty Limited and satisfy the Registrar that that company is eligible to register them in its name, in which case the Panel orders that any such domain names be transferred to AMI Australia Holdings Pty Limited

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Alan L. Limbury  
Sole Panelist

Dated: December 11, 2006