

## **.nz Dispute Resolution Service**

**DRS Reference: 812**

### **International Medical Recruitment Pty Ltd v Kerry McGuinness**

Key words

*Domain Name* – imrmedical.co.nz

*Identical or similar trade mark or name* – registered marks – identical – similar

*Rights* – no legitimate or fair use

*Unfair registration* – unfair advantage of or unfairly detrimental to Complainant's rights – likely to confuse, mislead or deceive – unfairly disrupting the business of the Complainant

*Procedure* – evidence – identity of Respondent – procedural directions – remedies – transfer

#### **1. Parties**

Complainant:  
International Medical Recruitment Pty Ltd  
Level 6, West Tower  
608 St Kilda Road  
Melbourne  
Victoria 3004  
Australia

Respondent:  
Kerry McGuinness  
44 Webb Road  
Whanganui  
New Zealand

#### **2. Domain Name/s**

imrmedical.co.nz ("the Domain Name")

#### **3. Procedural history**

3.1 The Complaint was lodged by the Complainant's representative (James Orr of the Melbourne office of Hunt & Hunt, an Australian law firm). The Complaint is comprehensive. The content of the Complaint is set out in 30 detailed paragraphs. The Complaint is supported by 29 annexes comprising more than 150 pages. The electronic form and the hard copy of the Complaint were received on 3 and 6 September 2012 respectively.

3.2 The domain was locked on 3 September 2012, preventing any changes to the record until the conclusion of this case. The .nz Domain Name Commission (DNC)<sup>1</sup> notified the Respondent of the validated Complaint by letter dated 10 September 2012.<sup>2</sup>

3.3 The DNC's letter to the Respondent dated 10 September 2012 attached a copy of the Complaint and a copy of the .nz Dispute Resolution Service Policy ("the Policy")<sup>3</sup> and Procedure. The letter advised the Respondent as follows:

In accordance with the Procedure, you have 15 working days, ie until Tuesday, 2 October 2012 to respond to the Complaint. In order to be valid, your response must comply with the Procedure, and must be received by the DNC in both hard copy and electronic form.

If you respond within the deadline, the Complainant will be given an opportunity to submit a written reply, and the matter will then be referred for mediation. The Domain Name Commission makes no charge for this service. If mediation is not successful, the matter may be referred to an independent expert for a decision.

Please note that no decision has been made at this stage.

Do not ignore this letter. If you do not submit a response by the deadline, this matter may be referred to an independent expert for a decision without further reference to you, which may result in the transfer, suspension or cancellation of the Domain Name.

3.4. The DNC's letter to the Respondent dated 10 September 2012 was sent to the Respondent by courier post and email to the contact address and contact email recorded for the Respondent in the Domain Name registration details. While the courier post package was returned marked "*not known at this address*", the DNC's email and attachments (the letter dated 10 September 2012 and the copies of the Complaint and the Policy) are recorded as being sent to the Respondent's email address at 3.24pm on 10 September 2012 and no bounce or failure notification was received.

3.5 The Respondent did not respond to the DNC's letter to the Respondent dated 10 September 2012. By letter dated 4 October 2012, the DNC advised the Respondent that the Complaint would be referred to an

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<sup>1</sup> Domain Name Commission Limited is a company wholly-owned by InternetNZ (the Internet Society of New Zealand Inc) responsible for the day-to-day oversight of the .nz Domain Name registration and management system.

<sup>2</sup> While the DNC's letter is addressed to Kerry McGuinness, it mistakenly addresses him as "Ms McGuinness" in the salutation.

<sup>3</sup> Words beginning with uppercase letters in this decision include terms defined in Paragraph 3 of the Policy.

independent expert for decision if the Complainant paid the appropriate fees.

- 3.6 Mr Terence Stapleton, the undersigned, confirmed to the DNC that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties which might appear to call into question his independence and/or impartiality. Mr Stapleton was appointed to act as the independent expert in this case (“the Expert”) pursuant to paragraph 9 of the Policy.
- 3.7 When he read the Complaint and the 29 annexes, the Expert noted that the Domain Name was being used for the website of the business of Medlink International Medical Recruitment Limited (“Medlink”) at 51 Harrison Street, Whanganui. The relevant annexes are as follows:
- (a) annex 26 consists of 25 pages downloaded from Medlink’s website at [www.imrmedical.co.nz](http://www.imrmedical.co.nz) on 16 December 2011;
  - (b) annex 27 consists of 6 pages downloaded from Medlink’s website at [www.medlink.co.nz](http://www.medlink.co.nz) on 14 November 2011;
  - (c) annex 29 consists of three communications on 22 July, 29 July and 12 August 2011 between Hunt & Hunt (as the Complainant’s lawyers) and Medlink’s executive director.
- 3.8 Medlink is a New Zealand company which was incorporated under the Companies Act 1993 on 5 July 2000. From that date to 20 September 2000, Medlink’s name was ATR Haskell Medlink Limited. From 20 September 2000 to 3 June 2008, Medlink’s name was Medlink International Recruitment Centre Limited. Since 3 June 2008, Medlink’s name has been Medlink International Medical Recruitment Limited.
- 3.9 Medlink’s records on the New Zealand Companies’ Office website record that:
- (a) since 11 July 2007, the Respondent has been a shareholder in Medlink;
  - (b) since 20 September 2010, Medlink’s executive director’s address, and the Respondent’s address, has been 51 Harrison Street, Whanganui.<sup>4</sup>
- 3.10 On 9 November 2012, as the Expert considered that the circumstances set out in paragraphs 3.7 to 3.9 (inclusive) of this decision raised the issue that the Domain Name may have been registered by the

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<sup>4</sup> The Respondent appears to have failed to update his address from 44 Webb Road, Whanganui, to 51 Harrison Street, Whanganui at the last renewal of the registration of the Domain Name.

Respondent on behalf of Medlink, the Expert issued the following procedural directions:

- (a) Medlink shall have until Monday, 26 November 2012 to advise the DNC by email if the Domain Name was registered by the Registrant<sup>5</sup> on Medlink's behalf;
- (b) if Medlink advises the DNC that the Domain Name was registered by the Registrant on Medlink's behalf, then Medlink shall also email to the DNC by Monday, 26 November 2012:
  - (i) any evidence which Medlink wants to submit in support of its advice to the DNC that the Domain Name was registered by the Registrant on Medlink's behalf; and
  - (ii) any submissions which Medlink wants to make to the Expert on the issue of the identity of the Respondent in this case; and
  - (iii) a statement supplied by the DNC and signed by Ms Haskell as Medlink's executive director that Medlink agrees to be bound by and comply with all .nz Policies and Procedures;
- (c) if Medlink advises the DNC that the Domain Name was registered by the Registrant on Medlink's behalf, then the DNC shall forward all emails received from Medlink pursuant to paragraph (b) of these procedural directions to the Complainant's representative for the making of any submissions by Monday, 10 December 2012 which the Complainant wants to make to the Expert on the issue of the identity of the Respondent in this case;
- (d) the Expert shall consider and determine the issue of the identity of the Respondent in this case as soon as practicable after compliance with these procedural directions;
- (e) the DNC shall email copies of these procedural directions to the Complainant's representative, the Registrant and Medlink ([info@medlink.co.nz](mailto:info@medlink.co.nz)) as soon as practicable.

3.11 On 12 November 2012, the DNC emailed copies of the Expert's procedural directions to the Complainant's representative, the Respondent and Medlink. The DNC's email and attachments are recorded as being sent to Medlink's email address at 3.57pm on 12 November 2012 and no bounce or failure notification was received. The

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<sup>5</sup> Kerry McGuinness – the Registrant as at 9 November 2012 and the Respondent as at 14 December 2012.

DNC's email and attachments are recorded as being sent to the Respondent's email address at 3.59pm on 12 November 2012 and no bounce or failure notification was received.

3.12 Medlink and the Respondent did not respond to the DNC's emails on 12 November 2012. Medlink did not convey any advice to the DNC by email by 26 November 2012 in accordance with the Expert's procedural directions and, in particular, advise the DNC that the Domain Name was registered by the Respondent on Medlink's behalf.

3.13. On 30 November 2012, the DNC sent the Complainant's representative an email which was copied to the Respondent and Medlink and which advised as follows:

As you will be aware, the Expert made provision through a procedural direction for a response to the complaint to be lodged by Medlink. This response was due on or before 26 November 2012. No response has been received.

The Expert is therefore considering and determining the complaint and will issue his decision as soon as practicable. Once received, the decision will be sent to you and the Respondent.

3.14 The email referred to in paragraph 3.13 of this decision was sent at 10.25am on 30 November 2012. No bounce or failure notification was received.

3.15 In accordance with the contents of the DNC's email on 30 November 2012, the Expert has considered, and now issues his determination and decision in respect of, the Complaint.

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

4.1 The facts set out in part 4 of this decision are established by the evidence contained in the 29 annexes to the Complaint.

4.2 The Complainant is an Australian proprietary company which was incorporated on 14 January 2004 and which has its registered office and principal place of business at the address specified in part 1 of this decision. Corrine Nicole Taylor ("Ms Taylor") of that address is the Complainant's sole director and shareholder.

4.3 Since October 2001, the Complainant and its predecessors have operated a business in Australia and New Zealand under the name "IMR" providing recruitment and placement services for medical workers. Before the Complainant was incorporated, the business was operated by Ms Taylor and Sudhanshu Agarwal, the latter having been a director and shareholder of the Complainant from 14 January 2004 to 13 March 2012.

- 4.4 On 23 January 2004 (nine days after its incorporation), the Complainant registered the domain name [imrmedical.com](http://imrmedical.com). On 8 September 2008, the Complainant registered the domain name [imrmedical.com.au](http://imrmedical.com.au). Since those dates, the Complainant has used those domain names for the purposes of promoting and marketing its business and services through its website.
- 4.5 At the Complainant's invitation, the Expert visited its website on 31 October 2012 and 4 December 2012 at both [www.imrmedical.com](http://www.imrmedical.com) and [www.imrmedical.com.au](http://www.imrmedical.com.au). The home page of the Complainant's website contains a distinctive logo with the letters "IMR" in a circle which contains a cross in the background and the words "INTERNATIONAL MEDICAL RECRUITMENT" immediately to the right of the logo. The website invites visitors to click and download "*The Doctor's Guide to Working in Australia & New Zealand*". The home page uses the term "International Medical Recruitment" in three separate places and states "*International Medical Recruitment is the market leader for medical jobs in Australia and New Zealand*". The home page records that the Complainant is a member of the Association of Medical Recruiters Australia & New Zealand.
- 4.6 The Complainant:
- (a) promotes its services at several international trade fairs each year (annexes 6 to 11);
  - (b) presents at conferences and training and information seminars (annexes 12 to 14);
  - (c) advertises its services in third party publications and websites (annexes 16 to 21).
- 4.7 Since October 2001, the Complainant's business has increased substantially. Initially, it had two staff; it now has 20. From 2001 to 2006, the business premises were located in Richmond; they are now located in St Kilda Road and comprise 280m<sup>2</sup> of floor space.
- 4.8 Since October 2001, the Complainant has made more than 2,000 job placements for medical workers in Australia and New Zealand. Applications for positions can be made online using the Complainant's website. Since 2006, the Complainant has received more than 11,000 applications annually through its website alone. For the years 2001/2002 to 2010/2011, there have been 248 New Zealand placements, with one in the first year, 47 in 2009/2010 and 80 in 2010/2011.
- 4.9 During the time that its business premises have been at St Kilda Road, the Complainant has used the distinctive logo described in paragraph 4.5 of this decision and the "imrmedical" and "IMR" names to promote and increase its business. The logo is used on its letterhead paper,

business cards and accessories (annex 24) and on the signage and related advertising and promotional material for the matters specified in paragraph 4.6 of this decision.

4.10 Ms Taylor is the owner of the following Australian trade marks:

- (a) 1452602 for the term “IMR Medical” for recruitment consultancy services being services in class 35. The trade mark was registered on 14 October 2011 and is due for renewal on 14 October 2021;
- (b) 1452610 for the term “IMR LocumBank” for recruitment consultancy services being services in class 35. The trade mark was registered on 14 October 2011 and is due for renewal on 14 October 2021;
- (c) 1453835 for the term “IMR International Medical Recruitment” for recruitment consultancy services being services in class 35. The trade mark was registered on 22 October 2011 and is due for renewal on 22 October 2021.

4.11 In all the circumstances, the Complainant states that:

- (a) there is a strong connection between the names “imrmedical” and “IMR” and the medical recruitment services provided by the Complainant in Australia and New Zealand among a significant portion of medical workers, employers of medical workers, and other persons who deal with providers of medical recruitment services;
- (b) it has rights in New Zealand in the following names by reason of its significant use of those names in relation to the provision of medical recruitment services, primarily in New Zealand and Australia:
  - (i) the name “IMR Medical” which is identical to the Domain Name; and
  - (ii) the name “IMR” which is similar to the Domain Name.

4.12 As noted in paragraph 3.8 of this decision:

- (a) Medlink was incorporated on 5 July 2000;
- (b) from 20 September 2000 to 3 June 2008, Medlink’s name was Medlink International Recruitment Centre Limited;
- (c) since 3 June 2008, Medlink’s name has been Medlink International Medical Recruitment Limited.

4.13 On 27 September 2000 (about three months after it was incorporated), Medlink registered the domain name medlink.co.nz. By contrast, the Domain Name was not registered until 13 May 2008 (almost eight years after Medlink's incorporation), and then not by Medlink but by the Respondent at a time when the Complainant had a substantial business presence in New Zealand as indicated by the annexes to the Complaint and, in particular, the number of placements made in New Zealand to that date (99 in total and 33 in the 2007/2008 year) and subsequently (22 in 2008/2009, 47 in 2009/2010 and 80 in 2010/2011).

4.14 At the Complainant's invitation, the Expert visited Medlink's website on 31 October 2012 and 4 December 2012 at both [www.medlink.co.nz](http://www.medlink.co.nz) and [www.imrmedical.co.nz](http://www.imrmedical.co.nz). The home page of Medlink's website states "WELCOME TO MEDLINK – HOME OF MEDICAL RECRUITMENT NZ" in bold text. The home page of Medlink's website states "*We are specialists in International Medical Recruitment and we are dedicated to finding you a medical position in New Zealand*" and then states "*Here is how Medlink International Recruitment Center can help you*".<sup>6</sup>

4.15 In view of the details relating to the registration of the medlink.co.nz domain name on 27 September 2000 and the registration of the Domain Name on 13 May 2008, and in the absence of any response from Medlink and the Respondent to the Expert's procedural directions, the Expert finds that:

- (a) the medlink.co.nz domain name is being used by Medlink for the website for its business;
- (b) the Domain Name is being used by the Respondent to attract and direct internet traffic to the website for Medlink's business in which he is a shareholder and which would otherwise be attracted and directed to the Complainant's website.

## **5. The Complainant's contentions**

5.1 The Complainant contends that the registration of the Domain Name is an Unfair Registration because the Domain Name has been, or is likely to be, used by the Respondent in a manner which takes unfair advantage of or is unfairly detrimental to the Complainant's Rights, specifically:

- (a) the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses (in particular, persons who deal with providers of medical services including medical workers and employers of medical workers in New Zealand) into believing that the Domain Name is registered to,

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<sup>6</sup> The details noted by the Expert on 31 October 2012 and 4 December 2012 are identical to those contained in annex 27 – [www.medlink.co.nz](http://www.medlink.co.nz) on 14 November 2011 – and annex 26 – [www.imrmedical.co.nz](http://www.imrmedical.co.nz) on 16 December 2011 – the home pages in those annexes on those dates being themselves identical.

operated or authorised by, or otherwise connected with the Complainant;

- (b) the Respondent registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant by diverting customers and potential customers of the Complainant to the business conducted on Medlink's website in which the Respondent is a shareholder.

## **6. The Respondent's contentions**

- 6.1 As noted, the Respondent did not submit a Response to the Complaint.

## **7. Relevant provisions of Policy and elements of Complaint**

- 7.1 The determination of the Complaint is governed by the Policy. Relevant provisions of the Policy in this case are as follows:

### **3. Definitions**

**Rights** includes, but is not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business;

**Unfair Registration** means a Domain Name which either:

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR
- (ii) has been, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights;

### ***Part A – Policy***

### **4. Dispute Resolution Service**

- 4.1 This Policy and Procedure applies to Respondents when a Complainant asserts to the DNC according to the Procedure that:
  - 4.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
  - 4.1.2 The Domain Name, in the hands of the Respondent, is an Unfair Registration.
- 4.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.  
...

### **5. Evidence of Unfair Registration**

- 5.1 A non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration is set out in paragraphs 5.1.1 – 5.1.5:

5.1.1 Circumstances indicating the Respondent has registered or otherwise acquired the Domain Name primarily:

- (a) for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
- (b) as a blocking registration against a name or mark in which the Complainant has Rights; or
- (c) for the purpose of unfairly disrupting the business of the Complainant; or

5.1.2 Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised, by or otherwise connected with the Complainant;

...

**6. How the Respondent may demonstrate in its Response that the Domain Name is not an Unfair Registration**

6.1 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in paragraphs 6.1.1 – 6.1.4:

6.1.1 Before being aware of the Complainant's cause for Complaint (not necessarily the Complaint itself), the Respondent has:

- (a) used or made demonstrable preparations to use the Domain Name or a Domain Name which is similar to the Domain Name in connection with a genuine offering of goods or services;
- (b) been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- (c) made legitimate non-commercial or fair use of the Domain Name; or

6.1.2 The Domain Name is generic or descriptive and the Respondent is making fair use of it in a way which is consistent with its generic or descriptive character;

7.2 For an Expert to uphold a Complaint, the Expert must be satisfied that the Complainant has proved the following elements on the balance of probabilities:

- (a) Rights in respect of a name or mark (para 4.1.1);
- (b) identity or similarity between that name or mark and the Domain Name (para 4.1.1);
- (c) Unfair Registration in the hands of the Respondent (para 4.1.2).

## **8. Rights in respect of a name or mark**

### **8.1 It is well-established that:**

- (a) the requirement for a Complainant to prove Rights in respect of a name or mark is not a particularly high threshold test;
- (b) it is not necessary for a Complainant to prove that it holds a registered trade mark or service mark; rather, it is sufficient for a Complainant to prove that its Rights in respect of the name or mark are capable of protection, such as by proceedings for passing off or for misleading or deceptive conduct under the Fair Trading Act 1986;
- (c) while a Complainant is unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business, an otherwise descriptive name or term is not wholly descriptive of the Complainant's business if the Complainant proves that the name or term has acquired a secondary meaning designating the Complainant's business and distinguishing the Complainant's business from other businesses of the same general kind. The Complainant must prove that the name or term is distinctive of the Complainant's business.

### **8.2 In view of the facts set out in part 4 and elsewhere in this decision, the Expert is satisfied on the balance of probabilities that the Complainant has Rights in respect of a relevant name or mark, namely:**

- (a) rights in respect of the "imrmedical" name and the "IMR" name;
- (b) statutory rights in relation to the "imrmedical" name and the "IMR" name capable of protection by proceedings for misleading or deceptive conduct under the Fair Trading Act 1986;
- (c) common law rights in relation to the "imrmedical" name and the "IMR" name capable of protection by proceedings for passing off.

### **8.3 In view of the facts set out in part 4 and elsewhere in this decision, the Expert is satisfied on the balance of probabilities that the Rights set out in paragraph 8.2 of this decision existed before the registration of the Domain Name on 13 May 2008.**

### **8.4 In view of the facts set out in part 4 and elsewhere in this decision, the Expert is satisfied on the balance of probabilities that the "imrmedical" name and the "IMR" name are not names or terms which are wholly descriptive of the Complainant's business. The fact that the Australian Trade Marks Office allowed Ms Taylor's applications for the trade marks specified in paragraph 4.10 of this decision to proceed to registration (all in respect of recruitment consultancy services being services in class 35)**

is a clear indication that the Australian Trade Marks Office was satisfied about the distinctive character of the names and that they designated and distinguished the Complainant's business from other businesses of the same general kind.

## **9. Identity or similarity between the relevant name or mark and the Domain Name**

9.1 It is well-established that Rights in a name cover all conceivable forms<sup>7</sup> in which the name might be used.

9.2 The Expert is satisfied on the balance of probabilities that the facts set out in part 4 and elsewhere in this decision demonstrate that in all their conceivable forms:

- (a) the name "imrmedical" is identical to the Domain Name;
- (b) the name "IMR" is similar to the Domain Name.

## **10. Unfair Registration**

10.1 The Expert is satisfied on the balance of probabilities that, in all the circumstances, the Domain Name is an Unfair Registration because the facts set out in part 4 and elsewhere in this decision demonstrate that:

- (a) any use by the Respondent of the Domain Name will take unfair advantage of, and be unfairly detrimental to, the Complainant's Rights (para 3 of the Policy); and/or
- (b) any use by the Respondent of the Domain Name is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant (para 5.1.2 of the Policy); and/or
- (c) the Respondent registered the Domain Name for the purpose of unfairly disrupting the business of the Complainant (para 5.1.1(c) of the Policy); and/or
- (d) there is no evidence before the Expert that demonstrates that the Domain Name is not an Unfair Registration as set out in paragraphs 6.1.1 and 6.1.2 of the Policy.

## **11. Decision**

11.1 In view of the findings made in this decision, the Expert directs that the Domain Name imrmedical.co.nz be transferred to the Complainant.

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<sup>7</sup> Including upper and lower cases and singular and plural.

**Place of decision** Wellington

**Date** 14 December 2012

**Expert Name** Mr Terence Stapleton

**Signature**

A handwritten signature in black ink, appearing to read 'T. Stapleton', written over a light grey rectangular background.