

**.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE**

Decision of Independent Specialist

Case Number: 732

1. The Parties:

Complainant:	Niall Joseph Murphy
Registrant:	Jason Barry

2. The Domain Name(s):

tallowhealthcentre.ie, tallowfamilypractice.ie	("the Domain Names")
---------------------------------------------------	----------------------

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

The procedural history is as follows:

Action	Comment / date
Dispute received	30 th April 2024
Complaint validated	30 th April 2024
Notification of complaint sent to Complainant	2 nd May 2024
Notification of complaint sent to Registrant	6 th May 2024
Forum Opened	2 nd May 2024
Complaint Form received	21 st June 2024
Response received	27 th June 2024
Forum Closed	31 st July 2024
Adjudication Started	1 st August 2024
Adjudication Decision Posted	2 nd August 2024
Adjudication Decision accepted / rejected	
Specialist Decision published	2 nd August 2024

4. Factual Background

The Complainant is a medical doctor and general practitioner in Tallow, Co. Waterford, who has practised with his partner Dr. Joe O’Keeffe under the title Tallow Family Practice from May 2021. The title was registered as a business name in March 2023. That practice did not have a website until July 2024, and now has a website on the domain tallowfamilypracticegp.ie. The Registrant is a medical doctor and general practitioner who previously worked for that practice before setting up her own practice in Tallow in July 2023, under the title Tallow Family and Women's Clinic. The Registrant’s website is hosted under the domain tallowfamilyandwomensclinic.ie. She also registered three further domains in 2023:

1. tallowfamilypractice.ie
2. tallowhealthcentre.ie
3. tallowfamilypractice.com

On 2 May 2024 Domains 1 and 2 redirected to the Registrant’s website at tallowfamilyandwomensclinic.ie. On the date of this decision, 2 August 2024, Domain 1 displayed a generic landing page stating “This domain is reserved by a client of Irish Domains” while Domains 2 and 3 continued to redirect to the Registrant’s website at tallowfamilyandwomensclinic.ie.

The Complainant has contacted the Registrant asking for the transfer of these domains, which the Registrant has refused.

5. Parties’ Contentions

Complaint

A summary of the Complaint is as follows:

The Complainant alleges that Domains 1, 2 and 3 are confusingly similar to the name of the practice (Domains 1 and 3) and to the physical address of the practice (Tallow Health Centre) (Domain 2).

The Complainant states that: “Our premises is the Health Centre building in Tallow - there is only one Health Centre in Tallow. Our GP practice has been operating out of this building for over 16 years. We are registered as such with the Companies Registration Office and have been known as 'Tallow Family Practice' since 1st May 2021.” The Complainant also states that “We have to send post to her practice as the postman delivers it to us. She is gaining patients who are looking for our practice via online search, being directed to her practice, and then registering with her, thinking they are joining us. Her name does not appear on her practice website so people may assume it is part of our practice.” [I note, however, that as of 2 May 2024 the Registrant’s name and photograph appeared on the practice homepage along with text stating that it is a “female-owned, female-led clinic”.]

.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE

The Complainant alleges that this confusion is exacerbated by the Registrant's domains having a higher search rank than its own domain on searches for "Tallow Family Practice" and "Tallow Health Centre".

The Complainant also alleges that the Registrant is "cyber squatting" by taking these names out of general use and denying them to the Complainant.

Response

A summary of the Response is as follows:

The Registrant states that:

- "In establishing our clinic, and as part of broad and comprehensive digital strategy, a trademark search was first performed on many potential domain names including those referred to in the complaint. The term 'Tallow Family Practice' is not a registered trademark. The term 'Tallow Health Centre' is not a registered trademark. These domains were not registered and were available for purchase. Purchase of non-registered domains adjacent to a primary domain is normal practice and does not meet the criteria for cybersquatting was not done in Bad Faith. It is merely part of an impactful strategy to establish a digital footprint and drive traffic to our site. It should also be known that those domains have been available for many, many years and no one thought to purchase them until we established our business.
- "A favourable site ranking is due to an SEO strategy performing as designed using all legitimate strategies available to do so and has nothing to do with the substance of the complaint."
- "The issue of the post direction is not relevant."

.ie Alternative Dispute Resolution NETNEUTRALS DISPUTE RESOLUTION SERVICE

6. Discussions and Findings

This decision relates only to the .ie domains involved in this dispute, tallowfamilypractice.ie and tallowhealthcentre.ie.

Under paragraph 4.1 of the Alternative Dispute Resolution Policy (“ADRP”) the burden of proof is on the Complainant who must prove three elements, specifically that:

- A. the Complainant would ordinarily be eligible to register the domain name in question if it was not already registered by the Registrant, and
- B. the Complainant
 - (i) has rights in the domain name or in marks or identifiers very similar to it, or
 - (ii) the Complainant’s rights have been negatively impacted by the registration, and
- C. the registration of the domain should be revoked as it has been registered or used abusively or in bad faith.

A. Complainant Eligibility to Register the Domain Name

The Complainant is an Irish business and would be eligible to register the domain name if it was not already registered.

B. Complainant’s Rights in the Domain Name

(i) Rights in the domain name or in marks or identifiers very similar to it

Paragraph 4.1.B(i) of the ADRP defines the term “right”, as far as relevant to this case, by providing that:

Any legal or other enforceable right can be considered, including but not limited to:

- Unregistered rights acquired through use.

Unregistered rights acquired through use

To establish an unregistered right, a complainant must show that it would be entitled to bring an action for passing off in relation to the disputed domain name. This requires that the complainant runs a business on the island of Ireland and has goodwill in this business, and that the unregistered trade mark is a distinctive identifier of that business. (See Case No. DIE2013-0002, *Budget Energy Limited (Budget Energy ROI) and Budget Energy Limited (Budget Energy NI) v. Prepay Power Limited.*)

For guidance regarding whether there is the necessary goodwill and whether an unregistered trade mark is a distinctive identifier the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) can be taken into account except where the .IE policy or Irish law differ (see e.g. Case No. DIE2019-0001, *Puma SE v. Stephen Connell, Puma Transport Ireland Limited*).

Paragraph 1.3 of the WIPO Overview 3.0 provides as follows:

.ie Alternative Dispute Resolution NETNEUTRALS DISPUTE RESOLUTION SERVICE

What does a complainant need to show to successfully assert unregistered or common law trademark rights?

To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

(Particularly with regard to brands acquiring relatively rapid recognition due to a significant Internet presence, panels have also been considering factors such as the type and scope of market activities and the nature of the complainant's goods and/or services.)

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.

The Complainant has provided evidence that it has operated under the practice name Tallow Family Practice since May 2021 and that patients and businesses associate that name with the practice. The Registrant has not challenged this evidence or argued that the term Tallow Family Practice is generic or not inherently distinctive. I accept the Complainant's evidence and find that the term Tallow Family Practice has the necessary goodwill and is a distinctive identifier so that consumers in the relevant market would associate the term with it.

In relation to the term Tallow Health Centre, the Complainant has provided evidence that it has operated from that address for over 16 years, that it uses the term on its letterhead, that it is the only medical practice at that address, and that patients associate the term with the practice. On balance, therefore, I accept that the Complainant has not established that it has rights in that term.

(ii) Complainant's rights negatively impacted by registration

It is not necessary to consider the alternative ground that the Complainant's rights have been negatively impacted by the domain registration.

C. Domain Used or Registered Abusively or in Bad Faith

Under paragraph 4.1 of the ADRP the Complainant must in every case prove that "the registration of the domain should be revoked as it has been registered or used abusively or in bad faith". These terms are defined in paragraph 1 of the ADRP which provides that:

.ie Alternative Dispute Resolution

NETNEUTRALS DISPUTE RESOLUTION SERVICE

“Abusively registered” refers to a domain name which was registered or used to take unfair advantage of or was unfairly detrimental to the Complainant's Rights; [and]

“Bad Faith” means a domain name which was registered or used without legitimate intent, and/or to engage in deceptive conduct [...]

Paragraph 4.1.C of the ADRP includes a non-exhaustive list of examples of abuse and bad faith, and as far as is relevant to this case provides that:

A Complainant can demonstrate that the domain has been registered or is being used Abusively or in Bad Faith by the Registrant if it can provide evidence that [...]

- The domain name was registered or is being used with the primary purpose of preventing the Complainant registering a name or mark in which the Complainant has rights, or
- The domain name was registered or is being used with the primary purpose of unfairly disrupting or interfering with the Complainant's business, or
- The domain name is being used in a way that is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant, or [...]

In this case the Complainant first argues that the domain names were registered by the Registrant in bad faith and to prevent the practice from registering the domain names itself. In support of this the Complainant notes that the domains were registered by the Registrant while working for the practice. The Complainant next argues that the Registrant has used the domain names in a way which is likely to confuse those who search on the term Tallow Family Practice into believing that her site is affiliated with his practice. In particular the Complainant argues that new patients are registering with the Registrant on the basis of this confusion.

The Complainant has also argued that the Registrant's website does not prominently display her name but has not provided any screenshot showing this. However I note that the homepage displayed her name and photograph as of 2 May 2024, before the filing of this dispute was notified to the Registrant.

The Registrant states that “[p]urchase of non-registered domains adjacent to a primary domain is normal practice”, and argues that a higher placement in search results is not proof of bad faith or confusion.

This is not an entirely clearcut case, and I note from the Complainant's own submission that there may be confusion independently of the domain names on the basis that “We have patients asking if her practice is an extension of ours because she used to work for us.” I also accept the Registrant's submission that confusion regarding postal address does not itself show confusion resulting from the domain names. Nevertheless the Complainant makes a strong argument that the domain names were purchased during the Registrant's time working for the first practice precisely because of their association with that practice, and on balance I accept that the domain names are being used in a way that is likely to confuse people or businesses into believing that the domain names are registered to, operated or authorised by, or otherwise connected with the Complainant.

**.ie Alternative Dispute Resolution
NETNEUTRALS DISPUTE RESOLUTION SERVICE**

7. Decision

For the foregoing reasons the Complaint is upheld and I direct that the domain names be transferred to the Complainant.

Signed: Dr. TJ McIntyre

Dated: 2 August 2024
