

## **ADMINISTRATIVE PANEL DECISION**

Prenuvo Australia Pty Ltd and Prenuvo Inc. v. The Trustee for Sherif Family Trust and Mermaid Beach Radiology Pty Ltd  
Case No. DAU2025-0011

### **1. The Parties**

The Complainants are Prenuvo Australia Pty Ltd ("First Complainant"), Australia, and Prenuvo Inc. ("Second Complainant"), United States of America ("United States"), represented by Minter Ellison, Australia.

The Respondents are The Trustee for Sherif Family Trust ("First Respondent") and Mermaid Beach Radiology Pty Ltd ("Second Respondent"), Australia.

### **2. The Domain Names and Registrar**

The disputed domain names <prenuvo.au> ("First Disputed Domain Name") and <prenuvo.com.au> ("Second Disputed Domain Name") are registered with GoDaddy.com, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 12, 2025. On March 12, 2025, the Center transmitted by email to GoDaddy.com, LLC, a request for registrar verification in connection with the disputed domain names. On March 12, 2025, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 21, 2025, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 26, 2025. On March 27, 2025, the Center received an email from Kirralee Sherif of the Respondents in response to the Center's invitation to the Complainant to file an amended Complaint, referring to communications they had with the Complainant's representative (which is discussed in section 5.B below).

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the "Policy" or ".auDRP"), the Rules for .au Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 31, 2025. In accordance with the Rules, paragraph 5(a), the due date for Response was April 20, 2025. The Respondent did not submit a formal response. The Center commenced the panel appointment process on April 25, 2025.

The Center appointed Andrew F. Christie as the sole panelist in this matter on May 5, 2025. 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 the Center to ensure compliance with the Rules, paragraph 7.

On May 7, 2025, the Center received an email from Zane Sherif of the Respondents in response to Notification of Panel Appointment, saying the Respondents had been directly contacted by the Complainants, and that the Respondents had offered to resolve the matter by transferring the disputed domain names for reasonable costs. On May 16, 2025, the Panel issued Administrative Panel Procedural Order No. 1, inviting the Complainant to comment on the Respondent's communication by May 21, 2025. Following a communication from the Complainant's representative, the Panel issued Administrative Panel Procedural Order No. 2 on June 5, 2025, suspending the proceeding until June 13, 2025, and providing that the proceeding would be re-instituted, and the Panel would proceed to issue the Decision, if the Center did not receive any further suspension request from the Complainant or jointly by the Parties by June 13, 2025. No further suspension request was received by that date.

#### **4. Factual Background**

The Second Complainant, Prenuvo Inc., is a company incorporated in Delaware, United States, in 2018, and is based in California, United States. The First Complainant, Prenuvo Australia Pty Ltd, is the wholly owned Australian subsidiary of the Second Complainant.

The Second Complainant offers management and back office administrative support services to its affiliated entities (collectively, the "Prenuvo Group"), which collectively offer healthcare, radiology and related goods and services, including partial and whole body MRI scans. The Prenuvo Group has received a significant amount of funding after conducting two funding rounds – with the funding round in 2022 raising USD 70 million to be used for investing in the Prenuvo Group's artificial intelligence (AI) team, new radiology tools, custom advanced MRI builds, and national expansion. In 2024, the Second Complainant publicly disclosed raising USD 120 million in capital fundraising and noted it has identified over 1.4 million personalized health insights across its 110,000 growing member base. In this same disclosure, the Second Complainant stated it had secured approval from the US Food and Drug Administration for its AI-powered non-invasive Prenuvo Body Composition analysis platform.

The Second Complainant publicly announced on its website its intention to expand its business offerings and open clinics in locations outside of the United States – specifically in Canada and in Australia. During various interviews in 2022, the Chief Executive Officer of the Second Complainant declared an expansion to Australia. The Second Complainant announced that clinics in Melbourne and Sydney would open in March 2025, with future plans for further expansion throughout Australia. Since 2022, the Second Complainant (and subsequently the First Complainant) have maintained a waiting list for the provision of imaging and radiology services in Australia. The waitlist for the Sydney clinic went live in 2023 and currently has approximately 7,000 individuals waitlisted. The waitlist for the Melbourne clinic launched in August 2024 and has since accumulated approximately 2,000 individual registrations.

The Second Complainant owns numerous word trademark registrations for PRENUVO in various countries, including: United States Trademark No. 6394676 (filed September 30, 2020; registered June 22, 2021); United Kingdom Trademark No. WO0000001754237 (filed August 10, 2023; registered November 10, 2023); and Australian Trademark No. 2394020 (filed March 20, 2023; registered January 24, 2024).

The First Disputed Domain Name, <prenuvo.au>, was registered on September 24, 2023, by “Prenuvo”, a registered business name. Given that a business name is not a legal entity, the Panel regards the holder of this business name to be the registrant of the First Disputed Domain Name and thus the appropriate Respondent in this Complaint in respect of that domain name. The holder of that business name is The Trustee for Sherif Family Trust, the First Respondent.

The Second Disputed Domain Name, <prenuvo.com.au>, was registered on August 10, 2023, by “Mermaid Beach Radiology”, a registered business name. Again, given that a business name is not a legal entity, the Panel regards the holder of this business name to be the registrant of the Second Disputed Domain Name and thus the appropriate Respondent in this Complaint in respect of that domain name. The holder of that business name is Mermaid Beach Radiology Pty Ltd, the Second Respondent, a proprietary company whose principal place of business is Mermaid Beach, Queensland, Australia.

The Complainants provided undated screenshots showing that both disputed domain names resolved to landing pages. As at the date of this Decision, both disputed domain names resolve to landing pages generated by the Registrar.

## **5. Parties’ Contentions**

### **A. Complainant**

The Complainants contend that they have standing to file a consolidated complaint against the Respondents on the following grounds, among others. The First Complainant is corporately related to the Second Complainant, and the Second Complainant owns two registered Australian trademarks. The Complainants have a common legal interest in the relevant rights that are affected by the Respondents registration and/or use of the disputed domain names.

The Complainants contend that proceedings against the First Respondent and the Second Respondent should be consolidated into a single complaint on the following grounds, among others. The Respondents are the same entity, or in the alternative, are under common control, because: (i) the domain names are identical, other than the Second Level Domain (“2LD”) of the Second Disputed Domain Name; (ii) based on the information identified in WhoIs, and subsequently provided by the Center, the registrant name, registrant phone, and registrant email are identical for the two disputed domain names; (iii) correspondence between the Complainant’s representative and the registrants of the disputed domain names have addressed both disputed domain names, which has not been disputed by the registrant contact; (iv) there is a pattern of conduct by the First Respondent and the Second Respondent, and the individuals controlling those entities, which is inextricably linked in relation to both disputed domain names; (v) the nature and evidence relating to each disputed domain name are inextricably linked in such a manner that complaints in relation to them would be identical, and therefore it would be inefficient to bring separate complaints in relation to them.

The Complainants contend that each disputed domain name is confusingly similar to a trademark or name in which it has rights on the following grounds, among others. The registered company names for the First Complainant and the Second Complainant contain the word “Prenuvo”. The Second Complainant owns a number of trademark registrations for the word PRENUVO. The 2LD and Top-Level Domain (“TLD”) suffixes are disregarded for the purposes of assessing identity or confusing similarity under the Policy. The disputed domain names are identical to the name, trademark, and/or service marks in which the Complainants have rights, as both comprise solely the word “prenuvo”.

The Complainants contend that the Respondents have no rights or legitimate interests in the disputed domain names on the following grounds, among others. Neither Respondent has acquired any trademark or service mark rights in PRENUVO. The Respondents are not and have never been commonly known as “prenuvo.com.au”, “prenuvo.au”, or “prenuvo”, and the Respondents do not have any official or common connection, association, affiliation or commercial arrangement with the Complainants. The Respondents have not used the disputed domain names and are not making any legitimate noncommercial or fair use of

them. There is no evidence of the Respondents bona fide use of, or demonstrable preparations to use, the disputed domain names in connection with any offering of goods or services. The First Respondent is not, and was not ever, eligible to hold the First Disputed Domain Name, and the Second Respondent is not, and was not ever, eligible to hold the Second Disputed Domain Name. Neither of the Respondents hold any registered trademarks or trademark applications in Australia in relation to the word PRENUVO. While the First Respondent is the holder of the business name registration for “Prenuvo”, the mere registration of a business name is not sufficient to establish that the Respondents have rights or legitimate interests in the disputed domain names because registration of a business name is a legislative requirement where an entity does not trade under its own personal name or company name. The disputed domain names are currently used as parked domains.

The Complainants contend that the Respondents registered and are using the disputed domain names in bad faith on the following grounds, among others. There is a competitive relationship between the Complainants and the Respondents, at minimum from the date that the Second Complainant announced its arrival and expansion through Australia. The Complainants and the Respondents are in direct competition with one another for the provision of healthcare and medical imaging services to the domestic Australian market. The Second Complainant publicly announced its expansion to Australia and began maintaining a waitlist for the provision of radiology services in Australia in 2022 and filed an Australian trademark application for the word PRENUVO on March 10, 2023. Subsequently: (i) the Respondents sought and/or secured registrations of the disputed domain names; (ii) Ms. Kirralee Jo Sherif, the sole shareholder of the Second Respondent and the organizational representative of the First Respondent, filed an Australian trademark application for the word PRENUVO; and (iii) the First Respondent applied to register a United Kingdom trademark for the word PRENUVO. The Second Complainant has promoted and offered its services via its website at “www.prenuvo.com” since 2018. Any consumer would reasonably expect that a website operated at either of the disputed domain names would be operated by the Complainants. The Respondents clearly registered the disputed domain names in bad faith, and if there has been any use of the disputed domain names that use is necessarily in bad faith. The Complainants’ authorized representative issued a letter on November 26, 2024, putting the Respondents on notice of the Complainants’ rights in the PRENUVO brand. On February 13, 2025, the Complainants’ authorized representative made a telephone call to the Second Respondent and spoke to a representative of the Respondents. The representative said that the Respondents did not intend to reply to the correspondence from the Complainants. The Complainants’ authorized representative asked whether the Respondents would be prepared to transfer the disputed domain names to the Complainants as requested, to which the Second Respondent’s representative responded “they [the Complainants] can buy it [the domain names]”.

Accordingly, the Complainants request transfer of the disputed domain names to the Second Complainant.

## **B. Respondent**

The Respondents did not formally reply to the Complaint.

However, on March 27, 2025, Kirralee Sherif of the Respondents sent an email to the Center stating, among other things, that: (i) the Respondents registered their business names and the disputed domain names before they were aware of the Complainants’ intention to enter the Australian market or their trademark registration; (ii) the Respondents have no intention of using the disputed domain names in connection with radiology and are open to transferring them to prevent any potential confusion; (iii) the Respondents intend to use the disputed domain names outside of the field of radiology, but are open to fair and reasonable compensation for the cost associated with securing the business names and disputed domain names; (iv) the Respondents are fully aware of the trademark owned by the Second Complainant and have not infringed on it; and (v) the Respondents have offered to withdraw, inter alia, their Australian trademark application for the word PRENUVO.

## **6. Discussion and Findings**

### **A. Consolidation of Complaints against the Disputed Domain Names**

Section 4.11.2 of the Overview of Panel Views on Selected auDRP Questions, Second Edition (“auDRP Overview 2.0”) states that the filing of a complaint by multiple complainants will be permitted where they have a “common grievance” against the respondent, subject to the general requirement that it is equitable and procedurally efficient to have consolidation. The most obvious case of multiple complainants having a common grievance against a single respondent is where the complainants have a common legal interest in the rights on which the complaint is based, such as being individual companies that are part of a larger corporate group or a joint venture.

In this case, the First Complainant is the wholly owned Australian subsidiary of the Second Complainant, which is the owner of the PRENUVO registered trademark on which the Complaint is based. The Panel is of the view that the Complainants have a common grievance in relation to the registration of each disputed domain name. Accordingly, the Panel considers it is permissible for the Complaint to be filed in the names of the First Complainant and the Second Complainant.

Paragraph 10(e) of the auDRP Rules grants a panel the power “to consolidate multiple domain name disputes in accordance with the Policy and these Rules”, and paragraph 3(c) of the auDRP Rules provides that a “complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder”. Sections 4.11.5 and 4.11.6 of the auDRP Overview 2.0 say that where a complaint is filed against multiple respondents, panels look at whether the domain names are subject to “common control” and whether the consolidation would be fair and equitable to all parties.

In this case, the evidence provided by the Complainants appears to show that both disputed domain names are subject to common control. In any event, neither of the Respondents has objected to the Complaint being filed in respect of both disputed domain names. The Panel is of the view that consolidation of actions in respect of the two disputed domain names into the one Complaint would be equitable and procedurally efficient and is fair to the two Respondents. Accordingly, the Panel considers it is permissible for the Complaint to be filed in relation to the First Disputed Domain Name and the Second Disputed Domain Name.

### **B. Identical or Confusingly Similar**

The Second Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. It is the owner of a number of trademark registrations, including in Australia, for the word trademark PRENUVO.

Once the 2LD and TLD are ignored (which is appropriate in this case), both of the disputed domain names consist solely of the Second Complainant’s trademark. Accordingly, each of the disputed domain names is identical to the Second Complainant’s trademark for the purposes of the Policy.

The Panel finds the first element of the Policy has been established.

### **C. Rights or Legitimate Interests**

As explained in section 2.1.1 of the auDRP Overview 2.0, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests in the domain name. The complainant will usually make out a prima facie case by establishing that none of the paragraph 4(c) circumstances are present. Once such a prima facie case is made, the burden of production shifts to the respondent, requiring it to provide evidence or plausible assertions demonstrating rights or legitimate interests in the domain name. If the respondent fails to provide evidence or plausible assertions demonstrating rights or legitimate interests in the domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the respondent does provide some evidence or plausible assertions demonstrating rights or legitimate

interests in the domain name, the panel then weighs all the evidence – with the burden of proof always remaining on the complainant.

Section 2.1.2 of the auDRP Overview explains that the mere fact that the respondent was able to register the domain name does not, of itself, establish that the respondent has rights or legitimate interests in the domain name. Note 2 of the Policy states that, for the purpose of paragraph 4(a)(ii), rights or legitimate interests in the domain name “are not established merely by a registrar’s determination that the respondent satisfied the relevant eligibility criteria for the domain name at the time of registration”.

The Complainants have asserted, and neither of the Respondents have disputed, that the Respondents have not used or made demonstrable preparations to use, the disputed domain names in connection with an offering of goods or services. Further, there is no evidence that either of the Respondents is commonly known by the disputed domain names. Thus, none of the circumstances specified in paragraph 4(c) of the Policy apply in this case.

Section 2.1.3 of the auDRP Overview states that a respondent’s rights or legitimate interests in a domain name may be demonstrated by circumstances other than those specified in paragraph 4(c). However, it will generally be difficult for the respondent to show rights or legitimate interests in a domain name that has not been used in any way.

The Respondents have not provided any assertions, let alone evidence, to support a claim to having rights or legitimate interests in the disputed domain names. This, together with the fact that the disputed domain names consist solely of the Second Complainant’s registered word trademark, lead the Panel to conclude that the Respondents have not rebutted the Complainant’s prima facie case that neither of the Respondents have rights or legitimate interests in the disputed domain names.

The Panel finds the second element of the Policy has been established.

#### **D. Registered or Subsequently Used in Bad Faith**

Paragraph 4(b)(ii) of the Policy states that evidence of the registration and use of a domain name in bad faith includes the respondent registering the domain name in order to prevent the owner of a trademark or name from reflecting that mark or name in a corresponding domain name. Section 3.1.2 of the auDRP Overview says that panels generally have found that registration of a domain name that consists solely of the complainant’s trademark or name (once the 2LD and/or the TLD extensions are ignored) has the effect of preventing the complainant from reflecting its trademark/name in a domain name – and hence is evidence of bad faith registration and use of a domain name.

In their communication of March 27, 2025, the Respondents stated that they obtained the disputed domain names “before we were aware of Prenuvo’s intention to enter the Australian market or their trademark registration”. Given that the Respondents are in the same field of activity as the Complainants and that the Second Complainant’s plans to expand to Australia were publicized, the Panel doubts the veracity of this statement. However, whether or not the statement is true, it is notable that the Respondents do not assert that they registered the disputed domain names ignorant of the existence of the Second Complainant, its business and the trademark (whether registered or not) under which it operated. Given that PRENUVO is a made-up word, and that the Complainants and Respondents are in the same field of activity, it is inconceivable that the Respondents were unaware of the Second Complainant, its business and its trademark prior to registering the disputed domain names. It seems clear that by registering the disputed domain names, which consist solely of the Second Complainant’s trademark PRENUVO, the Respondents sought to prevent the Complainants from reflecting the PRENUVO trademark in corresponding domain names. The Policy makes it clear that registration of the disputed domain names for that purpose is a registration and use of them in bad faith.

The Panel finds the third element of the Policy has been established.

## **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 domain names <prenuvo.au> and <prenuvo.com.au> be transferred to the Second Complainant.

*/Andrew F. Christie/*

**Andrew F. Christie**

Sole Panelist

Date: June 23, 2025