



Administrative Panel Decision

Domain Name: rnbsuperclub.com.au

Name of Complainant: Arena Entertainment Pty Limited

Name of Respondent: Alex Haddad

Provider: LEADR

Panel: MJ Russell

1 THE PARTIES

- 1.1 The complainant in this proceedings is Arena Entertainment Pty Limited of 500 Oxford Street Tower, 2 Bondi Junction, NSW 1355. ("**Complainant**")
- 1.2 The respondent in this proceeding is Alex Haddad, PO Box 8, Willoughby, Sydney NSW 2068. ("**Respondent**")

2 THE DOMAIN NAME, REGISTRAR AND PROVIDER

- 2.1 The Domain name in dispute in this proceeding is "rnbsuperclub.com.au" ("**Disputed Domain Name**").
- 2.2 The registrar of the Disputed Domain Name is Enetica of Level 1, Suite 101, 74 Burwood Road, Burwood NSW 2134 ("**Registrar**").
- 2.3 The provider in relation to this proceeding is LEADR ("**Provider**").

3 PROCEDURAL MATTERS

- 3.1 The proceeding concerns a complaint ("**Complaint**") submitted in accordance with:
 - (a) the .au Dispute Resolution Policy No. 2002/22 ("**auDRP**"), which was approved by .au Domain Administrator Ltd ("**auDA**") in 2001 and which commenced operation on 1 August 2002, including:
 - (i) Schedule A ("**auDRP Policy**"); and

- (ii) Schedule B (“**auDRP Rules**”);
- (b) The Providers Supplemental Rules for au Domain Name Resolution Policy (“**LEADR Rules**”).
- 3.2 The Provider has supplied the Panel with a document titled “Procedural History – superclub.com.au”. Pursuant to this document, the Complaint was lodged on 19 May 2005 (following the correction of minor procedural flaws by the Complainant).
- 3.3 On 24 May 2005 the Respondent was sent a dispute notification letter together with a copy of the complaint by way of express post delivery. The Respondent confirmed with the Provider that a copy of the Complaint had been received by the Respondent.
- 3.4 On 24 May 2005 a copy of the dispute notification letter was posted and emailed to both the Registrar and Complainant. A copy of the Complaint was also posted to the Registrar same day.
- 3.5 On 24 May 2005 the provider notified auDA of the Complaint and the Registrar was advised to lock the Disputed Domain Name.
- 3.6 On 2 June 2005 further correspondence was received from the Complainant.
- 3.7 On 3 June 2005 further correspondence was received from the Respondent.
- 3.8 On 30 May 2005 the Panellist was approached by the Provider. The Panel finds that it was properly constituted.
- 3.9 On 31 May 2005 Matthew Russell accepted and was appointed sole panellist in this matter. The Panel was forwarded the package for adjudication on 14 June 2005. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rules, Paragraph 7.

4 FACTUAL BACKGROUND

Facts alleged by the Complainant

- 4.1 In submissions attached to its complaint, the Complainant raises a number of items, only a subset of which are detailed below:
 - (a) The Complainant has operated the business trading as “RnB Superclub” (the “Business”) since November 2001.
 - (b) The Complainant is the holder of the domain name licence to “rnbsuperclub.com” since 26 May 2003.

- (c) The Complainant is the registered owner of registered trademarks within Australia in relation to “RNB” and “RNB Superclub”.
- (d) The Complainant has registered throughout Australia various rights in relation to the business names “RNB” and “RNB Superclub” including New South Wales.
- (e) The Complainant has invested significant sums of money in building a substantial reputation in the Business.
- (f) The Business covers all operations such as those normally required in the commercial release of CD’s and DVD’s.
- (g) This release includes the commercial distribution under the title and prominent headlining of “RNB” and “RNB Superclub”.
- (h) The operations of the Business further cover such matters as the organisation of tours, promotion of artists and the distribution of music to nightclubs/hotels.
- (i) On 12 December 2004, the Disputed Domain Name was registered with the Registrar.
- (j) On 13 December 2004, various statements of fact were published upon the website represented by the Disputed Domain Name made variously against representatives employed on behalf of the Complainant.
- (k) On 1 February 2005 the Complainant’s legal representative emailed Mr Haddad and by written demand required of the Respondent:
 - (a) immediate discontinued use and withdrawal of all published content upon the website, and
 - (b) various undertakings in relation to future conduct over existing trademark rights, and
 - (c) transfer the Disputed Domain Name to the Complainant.
- (l) On 1 February 2005 the Respondent replied to the Complainant’s email refusing the general requests of the Complainant and conditioning the transfer of the Disputed Domain Name upon the payment of a lump sum in excess of reasonable out of pocket expenses.

Facts alleged by the Respondent

- 4.2 The Respondent operates and has operated a sole trading enterprise in the context of retailing music, CD’s and accessories since 1993.
 - (a) The trading entity is known as “Legends Music and Entertainment”.

- (b) A substantial interest in the sole trading entity is the retailing category of Rhythm and Blues music.
- (d) The Respondent is the holder of a registered business name "RNB Super Night Club" in New South Wales as at 16 December 2004.
- (e) The Respondent is owed a specific sum of money for previous work performed by the Respondent on behalf of the Complainant company upon undisclosed contractual terms.

5 THE PARTIES CONTENTIONS

The Complainant's contentions

- 5.1 The Complainant's submissions in summary contend;
- (a) The Disputed Domain Name is subject to auDRP Policy;
 - (b) The Disputed Domain Name is identical with and confusingly similar to trademarks that the Complainant has exclusive rights, namely; "RNB" and "RNB Superclub";
 - (c) The Disputed Domain Name is confusingly similar with the Complainant's registered business name.
 - (d) The Respondent has no legitimate interest in respect of the Disputed Domain Name.
 - (e) The Respondent had full knowledge of the operations of the Complainant prior to the registration of the Disputed Domain Name and as such cannot assert that the registration of the Domain Name was undertaken with a view to promote a legitimate cause of interest he had developed with respect to the words "rnbsuperclub".
 - (f) The Respondent has registered or subsequently used the Disputed Domain Name in bad faith.
 - (g) The Respondent has by his email dated 1 February 2005 to the Complainant's legal representative offered for sale the Disputed Domain Name in excess of calculations concerning reasonable out of pocket expenses directly related to the Disputed Domain Name.
 - (h) The Respondent has registered the Disputed Domain Name in order to prevent the Complainant from reflecting that corresponding domain name.
 - (i) The Respondent has registered the domain for the primary purpose so as to disrupt the business and activities of the Complainant evidenced by the comments published to the Disputed Domain Name website on 13 December 2004.

The Respondents contentions

- 5.2 In summary the Respondent contends:
- (a) The Respondent can demonstrate substantial involvement in the Rhythm and Blues market space over the past twelve years.
 - (b) The Respondent received full rights to acquire and use the Disputed Domain Name by virtue of being first in time registrant as at 12 December 2004.
 - (c) The Respondent asserts that the Complainants trademark is two separate words and therefore the Complainant's domain name licence should include a hyphen in order to adequately reflect this.
 - (d) The Respondent has been utilising the Disputed Domain Name for non-commercial purposes by offering the site as an open community bulletin board.
 - (e) The Respondent asserts that the website has been used to promote and operate community musical events and as an open forum for persons to place items of musical interest, all for non-commercial use.

6. DISCUSSION AND FINDINGS

Jurisdiction

- 6.1 Paragraph 2.1 of the auDRP states:
"All domain name licences issued in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP. At the time of publication, the open 2LDs are asn.au, com.au, id.au, net.au, and org.au..."
- 6.2 The Disputed Domain Name is an open 2LD within the meaning of this provision. It was registered with the Registrar on 12 December 2004. It is therefore subject to the mandatory administrative proceedings prescribed by the auDRP.

Basis of decision

- 6.3 Paragraph 15(a) of the auDRP Rules states:
(A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy [the auDRP Policy], these Rules and any rules and principles of law that it deems applicable."

Elements of a successful complaint

- 6.4 According to paragraph 4(a) of the auDRP Policy, a person is entitled to complain about the registration or use of domain name where:
- (a) The domain name is identical or confusingly similar to a name, trademark, or service mark in which the complainant has rights; and

(b) The respondent to the complaint has no rights or legitimate interests in respect of the domain name; and

(c) The respondent's domain name has been registered or subsequently used in bad faith.

6.5 It is to be noted that the three elements of a complaint under paragraph 4(a) of the auDRP Policy are cumulative; all of them must be proved if the complaint is to be upheld.

Is the Disputed Domain Name identical or confusingly similar to a name trade mark or service mark in which the Complainant has rights?

6.6 The Complainant has demonstrated to the Panels satisfaction that they are in fact the holder to the current registered trademark "RNB Superclub" in addition to other directly related trademarks and business names. No further enquiry upon this point need be made.

Does the Respondent have any rights or legitimate interests in respect of the Disputed Domain Name?

6.7 Paragraph 4 (c) of the auDRP Policy sets out the available grounds for a Respondent to demonstrate "*rights or legitimate interests to the domain name for purposes or Paragraph 4 (a) (ii).*"

6.8 Additionally, Paragraph 4 (c) (i) directs the examination of bona fides toward the Respondents conduct in the period preceding the Respondent's notification of the dispute.
4 (c) (i)

6.9 The Complainant has tendered in evidence before the Panel screenshots of the frontpage to the website located at the url designated by the Disputed Domain Name as at 13 December 2004.

6.10 Notably, the Respondent does not tender any evidence to refute either the subject-matter in relation to content appearing on this day, nor responsibility in terms of control given that the day prior he had sought (and received) holder status as registrant of the Disputed Domain Name.

6.11 The Panel also notes that the Complainant and Respondent had enjoyed some measure of prior dealings together, but for all purposes had been known to each other. In latter times it is apparent that those dealings had not been quite so 'enjoyable', but it is a comfortable inference that the Respondent knew not only of the existence of the Complainant's trademark, business name and domain name interests, but also of their importance to the continuing business integrity of the Complainant.

- 6.12 The Respondent repeatedly contends that his status as first in time registrant is determinative of these issues. However, the footnote No. 2 appearing in relation to 4 (c) of the auDRP Policy is instructive for this purpose. It is stated that such rights or legitimate interests “*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.*”
- 6.13 The Respondent also makes a number of contentions in relation to the Disputed Domain Name site usage. However, insufficient evidence is brought forward to establish these claims.
- 6.14 Accordingly, it is the Panel’s finding that the Respondent has no right or legitimate interest in the Disputed Domain Name.

Has the Disputed Domain Name been registered or subsequently used in bad faith?

- 6.13 Paragraph 4 (b) of the auDRP Policy sets out the circumstances being “*evidence of the registration and use of a domain name in bad faith*”. It is to be noted that any one of the available grounds may be sufficient of in the circumstances to demonstrate such conduct.
- 6.14 In relation to 4 (b) (ii), the Panel accepts that the Respondent has registered the domain name in order to prevent the Complainant as the owner of name and trademark rights from reflecting that name or mark in the corresponding Disputed Domain Name.
- 6.15 In this regard the Panel had recourse to the following factors:
- a. The significant investment made on behalf of the Complainant over the prior twelve month period with respect to promotion and reputation within business operations.
 - b. The status of the Complainant as long term prior holder to the domain name licence “rnbsuperclub.com”.
 - c. The level of pre-existing knowledge concerning company operations the Respondent had acquired by virtue of direct prior dealings with the Complainant.
 - d. The absence of connection between the prior business operations of the Respondent and assertions made by the Respondent as the basis for the establishment of intended activities concerning adoption of the Disputed Domain Name.

- 6.16 Given the Respondent has made various contentions in relation to d. above, namely the rights of the Respondent to engage in the promotion sale and supply of music in the Rhythm and Blues music categories, the Panel considers it appropriate to make the following additional comments:
- 6.17 It is accepted by the Panel that the Respondent can establish significant industry experience within the Rhythm and Blues music category. It is also accepted by the Panel that an increasingly common stylisation of this phrase might involve a truncation to 'RNB'.
- 6.18 However, the Panel notes deficiencies in the Respondent's evidence insofar as the trading entity during the requisite period was the Respondent's own "Legends Music and Entertainment" as the sole vehicle that actively traded Rhythm and Blues music in this capacity. This entity had established an entirely separate domain property and distinct url to that comprised and designated by the Disputed Domain Name. In particular, no evidence has been offered by the Respondent to demonstrate a trading relationship from this music category to any derivative or permutation of the words used in the Disputed Domain Name. The contentions made by the Respondent are therefore more appropriately directed towards RNB categories established under the legends-music.com domain name property, none of which is the subject of this proceeding.
- 6.19 In relation to paragraph 4 (b) (iii) of the auDRP Policy, the Panel considers that there is sufficient evidence for a finding that the Respondent has registered the Disputed Domain Name for the primary purpose of disrupting the business or activities of the Complainant.
- 6.20 The Panel accepts that elements were present in each of the other sub-paragraphs of 4 (b) of the auDRP Policy, but specifically notes that the common thread arising from the actions of the Respondent during this period was the disruptive purpose to which they were employed, namely against the business and activities of the Complainant.
- 6.21 It is therefore unnecessary for the Panel to speculate upon which point in time the Respondent held other primary purposes during the varied bases of conduct employed by the Respondent.
- 6.22 In particular the Panel notes that the Respondent had been motivated by multiple reasons of grievance against the Complainant by comments published on the website 13 December 2004, and further detailed in subsequent correspondences directed by the Respondent to the Complainants legal representative.
- 6.23 The Panel is satisfied therefore that the requirements of paragraph 4 (a) (iii) of the auDRP Policy has been satisfied.

7 RELIEF

Transfer of the Disputed Domain Name

- 7.1 The Complainant has sought that the Disputed Domain Name be transferred to the Complainant.
- 7.2 Eligibility for a domain name in the open 2LDs is governed by auDA's Domain Name Eligibility and Allocation Rules for the Open 2LDs (2002-07) ("**Eligibility Rules**").
- 7.3 The Complainant is an Australian registered company and the Disputed Domain Name forms part of the registered trade marks of which the Complainant is the legitimate holder. The Complainant therefore satisfies the Eligibility Rules.
- 7.4 The Panel orders that the disputed Domain Name be transferred to the Complainant.

8 Decision

- 8.1 The Complainant has satisfied the elements of paragraph 4(a) of the auDRP Policy.

Dated this 27th day of June 2005.

Matthew J E Russell
Sole Panellist