



**Domain Name:** *australianpenthouse.com.au*  
**Name of Complainant:** *Horwitz Publications Pty Ltd*  
**Name of Respondent:** *Majella Gai Gall*  
**Provider:** *LEADR*  
**Panel:** *Anthony Alder*

### **1. The Parties**

- 1.1 The complainant in this proceeding is Horwitz Publications Pty Ltd of Lvl 6, 55 Chandos Street, St Leonards, NSW, 2065 (the "Complainant").
- 1.2 The respondent in this proceeding is Majella Gai Gall of 24 Elizabeth Street, Tamworth, NSW, 2340 trading as "Heavenly Angels" (the "Respondent").

### **2. The Domain Name, Registrar and Provider**

- 2.1 The domain name subject to this proceeding is "australianpenthouse.com.au" (the "Domain Name").
- 2.2 The registrar of the Domain Name is Enetica Pty Ltd of Suite 101, 74 Burwood Rd, Burwood, NSW 2134 (the "Registrar").
- 2.3 The provider in this proceeding is LEADR of Level 9, 15 - 17 Young Street, Sydney, NSW, 2000, AUSTRALIA (the "Provider").

### **3. Procedural Matters**

- 3.1 This proceeding relates to the Complaint submitted by the Complainant in accordance with:
  - i) the .au Dispute Resolution Policy No. 2002-22 (the "auDRP") published on 25 July 2002 which includes: Schedule A ("auDRP Policy") and Schedule B ("auDRP Rules"); and
  - ii) the Provider's Supplemental Rules for au Domain Name Dispute Policy.
- 3.2 The Provider supplied the Panel with a summary document entitled "Procedural History". According to this document, the Complaint was lodged with the Provider on 15 September 2006.
- 3.3 The Provider sent copies of the Complaint to Respondent via email and express post on 15 September 2006.

- 3.4 Copies of the Complaint emailed to the Respondent were undelivered and automatically returned to the Provider by the Respondent's email server with the error message stating "No Such user".
- 3.5 A copy of the Complaint was emailed on 18 September 2006 and express posted on 15<sup>th</sup> September 2006 to the Registrant's Technical Contact, namely Conexim Australia Pty Ltd.
- 3.6 The Registrar was notified, by email, of the Complaint on 15th September 2006 and the Registrar subsequently confirmed that the website associated with the Domain Name was locked.
- 3.7 The Panel was appointed by the Provider on 15th September 2006 and the Complaint was received by the Panel on 11<sup>th</sup> October 2006.

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

##### **Facts alleged by the Complainant**

- 4.1 The Complainant is the exclusive licensee of the trade marks AUSTRALIAN PENTHOUSE and PENTHOUSE in the jurisdiction of Australia and New Zealand based on two agreements both dated 10 May 2006.
- 4.2 The trade marks are owned by General Media Communications Inc, which is a US Corporation and have been used under license for a period of over 20 years.
- 4.3 The Complainant currently uses the trade marks PENTHOUSE and AUSTRALIAN PENTHOUSE in relation to magazines in Australia.
- 4.4 The Complainant is the registered owner of the business name "Australian Penthouse", registered number BN98198690, registered on 16 February 2006.
- 4.5 The Domain Name was registered by auDA in the name of the Respondent on 20 June 2005.
- 4.6 The Complainant believes the Domain Name to be registered by the Respondent in bad faith for the purpose of disrupting business or activities of the Complainant and intentionally attempting to attract for commercial gain internet users to a website that is likely to give rise to confusion with the Complainant's legitimate rights.
- 4.7 On 6 July 2006, the Complainant wrote to the Respondent regarding the Domain Name and received no reply to this letter.

##### **Facts alleged by the Respondent**

- 4.10 The Provider has not received any response from the Respondent in relation to this Proceeding.
- 4.11 The Panel is satisfied that reasonable attempts were made by the Provider to contact the Respondent in this Proceeding and the Respondent was given a reasonable opportunity to respond to the Complaint.

- 4.12 The Respondent is in default in this Proceeding and the Panel has the authority to make inferences based on the failure of the Respondent to reply to the Complaint in accordance with paragraph 5(e) of the Policy.

## 5. Discussion

### Jurisdiction

- 5.1 Paragraph 2.1 of the auDRP states:  
“All domain name licenses issued in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP.”
- 5.2 The Domain Name is an open 2LD within the scope of the aforementioned Paragraph. It was registered with the Registrar on 20 June 2005. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP.
- 5.3 The Panel did not consider nor made any determination relating to possible trade mark infringement or possible common law actions such as passing off by the parties mentioned in this Proceeding.

### Basis of Decision

- 5.3 Paragraph 15(a) of the Rules state:
- “A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy (auDRP Policy), these Rules and any rules and principles of law that it deems applicable.”*

- 5.4 Paragraph 4(a) of the Policy provides that a person is entitled to complain about the registration or use of a domain name where:
- i) *the domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and*
  - ii) *the respondent to the complaint has no rights or legitimate interests in respect of the domain name; and*
  - iii) *the respondent’s domain name has been registered or subsequently used in bad faith.*

The Panel notes that all three the components of Paragraph 4(a) are required to be proven for any Complaint to be upheld.

#### **i) Domain Name is identical and confusingly similar to trade marks**

- 5.5 The Domain Name is substantially identical and confusingly similar to the unregistered common law trade mark AUSTRALIAN PENTHOUSE and the registered trade mark PENTHOUSE both owned by General Media Communications Inc. Both trademarks have been used extensively in Australia and would be generally considered as being well-known trade marks in relation to magazines. The trademark PENTHOUSE has been used for over twenty years and the Complainant is the current licensee of these rights in Australia.

- 5.6 The Complainant also owns a registered NSW business name for the AUSTRALIAN PENTHOUSE. The Panel notes that the business name was registered after the Domain Name was created and therefore has limited relevancy in this Proceeding.
- 5.7 The Panel finds that the Domain Name is so similar to aforementioned trademarks that Paragraph 4(a)(i) of the Policy must be regarded as being satisfied.
- ii) Respondent has no legitimate rights in respect of the Domain Name**
- 5.8 The Respondent has no legitimate rights to the aforementioned trade marks owned by General Media Corporation, Inc, as the exclusive licensee in Australia is the Complainant.
- 5.9 AUSTRALIAN PENTHOUSE and PENTHOUSE are generally well known trademarks in Australia and it is likely the Respondent would have been aware of these trade marks at the time of registration given the high profile nature of these trade marks and the extensive usage.
- 5.10 The Respondent has not presented any *bona fide* reason for the registration of the Domain Name. Additionally, the Domain Name was not being used by the Respondent at the time of or immediately prior to this Proceeding.
- 5.11 The Panel is of the opinion that the Respondent has no legitimate rights or interest to use or register the Domain Name and Paragraphs 4(a)(ii) and 4(c) of the Policy are satisfied by the Complaint.
- iii) Domain Name was registered in Bad Faith**
- 5.12 The Complainant has stated that the Respondent sought the “registration of the Domain Name for the purpose of disrupting the business or activities of another person”. The Panel has interpreted that the reference to “another person” may include both the Respondent and General Media Communications Inc.
- 5.13 The Panel infers, from the fact that the Respondent failed to reply to the Complaint, that the Respondent has purposely sought to disrupt the business of the Complainant and General Media Communications Inc. This is further confirmed by the well-known nature of trademarks involved and that it is unlikely that the Respondent registered or used the domain name in a *bona fide* manner.
- 5.14 The Panel rejects the arguments of the Complainant suggesting that the Respondent was intentionally attempting to attract internet users to their website for commercial gain, as the website to which the Domain Name was associated lacks any form of profit driver or commercial interest..

5.15 The Panel finds that the Complaint has successfully satisfied the Paragraphs 4(a)(iii) and 4(b) of the Policy that the Domain Name has been registered in bad faith by the Respondent. The Panel draws particular attention to Paragraphs 4(b)(ii) and 4(b)(iii) which relate the Respondent's actions in registering the Domain Name to disrupt legitimate business activities or to prevent the legitimate owner from registering a domain name corresponding to their trademarks.

## **6. Decision**

- 6.1 The Complainant is a potential eligible registrant for the Domain Name and satisfies the eligibility requirements in accordance with the rules set out in auDA's Domain Name Eligibility and Allocation Rules for Open 2LDs (2002-07).
- 6.2 The Complainant has satisfied all of the requirements for the Complaint to be upheld and they have requested that the Domain Name be transferred to them.
- 6.3 For the abovementioned reasons, the Panel directs and orders that the Domain Name be immediately transferred to the Complainant.

Dated this 24<sup>th</sup> October 2006

Anthony Alder  
Panellist