

## ADMINISTRATIVE PANEL DECISION

Regional Publishers Pty Ltd ABN 20000014700 v.  
Australianews.com.au Pty Ltd ABN 97106856289  
LEADR Case No. auDRP\_10\_03

**Domain Names:** [www.southernhighlandsnews.com.au](http://www.southernhighlandsnews.com.au)  
[www.southernhighlandnews.com.au](http://www.southernhighlandnews.com.au)

**Name of Complainants:** Regional Publishers Pty Ltd

**Name of Respondent:** Australianews.com.au Pty Ltd ABN 97106856289

**Provider:** LEADR

**Panel:** RC McNally

### THE PARTIES

1. The Complainant is Regional Publishers Pty Ltd ABN 20000014700
2. The Respondent is Australianews.co.au Pty Ltd ABN 97106856289

### THE DOMAIN NAME, REGISTRAR AND PROVIDER

3. The domain names in dispute are [www.southernhighlandsnews.com.au](http://www.southernhighlandsnews.com.au) and [www.southernhighlandnews.com.au](http://www.southernhighlandnews.com.au) (“the Domain Names”).
4. The registrar of the Domain Names is Melbourne IT Limited (“the Registrar”).
5. The provider in relation to this administrative proceeding is LEADR (“the Provider”).

### PROCEDURAL HISTORY

6. The complaint was submitted for decision in accordance with the auDRP Policy (“the Policy”), the auDRP Rules (“the Rules”) that were approved by auDA in 2001 and commenced operation on 1 August 2002 and the Provider’s Supplemental Rules.
7. The Provider provided a document entitled “Procedural History” which states that:
  - (a) The completed application was received from the Complainants by the Provider on 29 January 2010;
  - (b) On 2 February 2010 the Provider sent the Respondent a dispute notification letter and a copy of the complaint;

- (c) On 2 February 2010 the Registrar was requested by the Provider to lock the domain names in dispute.
- (d) On 22 February 2010 after having being contacted by the Provider the Respondent complained that it had not received the Provider's notification and requested an extension of time.
- (e) On 26 February 2010 the Provider approached the Panellist. The Panellist confirmed her availability, informed the Provider that she had no conflict issues with the parties and accepted the matter.
- (f) The Respondent did not dispute having received prior correspondence from the Complainant, (which the Complainant indicated included a copy of the Application) but claimed it had not received a copy of the Application forwarded by the Provider, as required by Rule 2(a).
- (g) The Respondent requested additional time within which to prepare and lodge a Response.
- (h) On 2 March 2010, the Respondent was granted an extension of time within which to lodge its Response with the Response then due on 18 March 2010 for reasons previously delivered to the parties, which included the fact that one of the addresses shown in the application as an alternative delivery addresses for the Respondent was incomplete and incorrect.
- (i) No response was received from the Respondent by the due date of 18 March 2010, and nor has one since been received.

## **FACTUAL BACKGROUND**

- 8. The Complainant is Regional Publishers Pty Ltd which is a subsidiary of Fairfax Media Limited.
- 9. The Complainant owns and publishes a newspaper called "The Southern Highland News".
- 10. The Complainant says that the newspaper was first published in 1958 and has been known as "The Southern Highland News" since 1961.
- 11. The Complainant says that The Southern Highland News is the biggest selling and only paid circulation paper in the Southern Highlands district of New South Wales, this district being, it says, the only one in Australia commonly known as the "Southern Highlands".
- 12. The Complainant says The Southern Highland News is a well-established, well known, active and trusted brand in the Southern Highlands district and beyond and that the Complainant has spent and continues to spend large amounts of resources in the development and promotion of the Southern Highland News brand.

13. The Complainant says that that it has common law rights in the name "Southern Highland News" as a result of its long-standing use of the name.
14. In support of its application the Complainant provided evidence of its use of the name "Southern Highlands News" in the form of newspaper covers for years between from 1961 to 2010, together with circulation statistics and a Trade Mark application for "Southern Highland News" which has been lodged by the Complainant with IP Australia and is awaiting registration.
15. The Domain Names were registered by the Respondent (previously called Ocean Storm Corporation Pty Ltd) on 5 October 2007.

### THE POLICY

16. Pursuant to Rule 15 of the Rules, a Panel is required to decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that the Panel deems applicable.
17. Paragraph 4(a) sets out those matters that are required to be established by a complainant, being that:
  - (i) [the Respondent's] domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights; and
  - (ii) [the Respondent 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."
18. All of the elements of 4(a)(i), (ii) and (iii) must be met and the complainant bears the onus of proof in this respect.

### DELIBERATIONS

#### **As to whether the Domain Name is identical or confusingly similar to a name, trademark or service mark in which the Complainants have rights (Para 4(a)(i))**

19. The Complainant asserts that the Domain Names are, for the purposes of Paragraph 4 of the Policy, either identical to or confusingly similar to the name of the Complainant's newspaper, "The Southern Highland News" in respect of which the Complainant has legal rights and considerable reputation.
20. The Complainant submits the Domain Names incorporate "southernhighlandsnews" and southernhighlandnews" and are likely to be accessed by internet users under the presumption that they

will be directed to a website associated with "The Southern Highlands News" newspaper.

21. The Panellist accepts that the Domain Names are identical to and/or confusingly similar to the Complainant's newspaper, "The Southern Highland News" which is owned by the Complainant and to which the Complainant has rights.

**As to whether the Respondent has any rights or legitimate interests in respect of the Domain Name (Para 4(a)(ii))**

22. The Complainant submitted that the Respondent has no right or legitimate interests in the Domain Name because:
- (a) The Complainant owns the rights to and has common law rights in the name "Southern Highland News" as a result of its longstanding use of the name;
  - (b) The Domain Names do not reflect the Respondent's company or trading name;
  - (c) The Respondent does not conduct any business under the name Southern Highland News or Southern Highlands News and (says the Complainant) there is otherwise no connection with the Respondent.
23. The Complainant has also provided in its submissions evidence that the Respondent is in the process of being voluntarily struck off the Register of Companies as no longer carrying on business, notice of which appeared in the ASIC listing of company deregistrations on 25 January 2010.
24. Paragraph 4(c) of the Policy sets out how a respondent might, if they wished to do so, demonstrate their rights or legitimate interests to the domain name however nothing has been received in this respect from the Respondent.
25. I am satisfied from the Complainant's material (and there being no material provided by the Respondent) that the Respondent has no right or legitimate interest in respect of the Domain Names.

**As to whether the Domain Name has been registered by the Respondent or subsequently used by the Respondent in bad faith (Para 4(a)(iii))**

26. The Complainant has submitted that the registration and/or the use of the Domain Name by the Respondent was done in bad faith for the purposes of clause 4 of the Policy.
27. Paragraph 4(b) sets out various circumstances which will, if found to be present, constitute evidence of the registration and/or use of a domain name in bad faith.

28. The Complainant says that it can be inferred from the Respondent's conduct that the Domain Names were registered in bad faith for the purpose of selling one or both to the complainant; and/or for the purpose of diverting trade from the Complainant's business; and/or in the case of [www.southernhighlandsnews.com.au](http://www.southernhighlandsnews.com.au), as a misspelling of Southern Highlands News in order to trade on the reputation of the Complainant's goodwill; and/or, for the purpose of preventing the Complainant for registering the Domain Names, as contemplated in Para. 4(b)(ii).
29. The Complainant submits that the Domain Name Eligibility and Allocation rules for Open 2LDs (2008-05) require that the domain name in the com.au 2LD must:
- (i) exactly match, acronym or abbreviation of the registrant's company or trading name, organization or association name or trademark; or
  - (ii) be otherwise closely and substantially connected to the respondent.
30. In support of the proposition that the Domain Names were registered by the Respondent and/or have been subsequently used by the Respondent in bad faith, the Complainant says:
- (a) The Respondent warranted at the time of registration that it met and would continue to meet the auDA eligibility criteria when the Respondent did not has not subsequently met either of the Eligibility and Allocation rule requirements (set out in para. 29 above) in that
    - i. There is a lack of nexus between the Respondent and the Domain Names;
    - ii. The Domain Names do not reflect the Respondent's company or trading name;
    - iii. That the Respondent does not conduct any business under the name Southern Highland News or Southern Highlands News and there is no connection between the Respondent and the Southern Highland News newspaper, which is owned by the Complainant.
  - (b) The Domain Names do not direct the user to an active website;
31. Further in support of the proposition that the Domain Names were registered by the Respondent and/or has been subsequently used by the Respondent in bad faith, the Complainant points to the conduct of the Respondent since it was contacted by the Complainant in 2009, which conduct has included a failure to respond to the Complainant's correspondence (which included a formal legal demand and subsequently a copy of the Application)

and subsequent steps taken by the Respondent, including the voluntary company deregistration process.

32. I find that there are circumstances indicating that the Respondent registered the Domain Names for purposes that did not reflect a legitimate use by the Respondent of the Domain Names and that the Domain Names were registered by the Respondent for the purpose of selling one or both to the Complainant and/or for the purpose of diverting trade from the Complainant's business;
33. Those circumstances, having been found to be present, are evidence of the registration of the Domain Names in bad faith for the purposes of Para 4(b).
34. The Complainant says, in the alternative to other subsections of Para 4(b) that it can also be inferred that the Domain name was registered or used to intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement (as referred to in Para 4(b)(iv)).
35. In support of this contention the Complainant says:
- (a) Internet users looking for the Complainants' website in connection with "The Southern Highlands News" would be easily and mistakenly directed to the Domain Names;
  - (b) There is no association between the Respondent and either the Domain Names or "The Southern Highland News" newspaper;
  - (c) The Domain Names do not direct the user to an active website.
36. I also find that there is sufficient in the material before me to indicate that the Respondent intended to and/or has subsequently used the Domain Names to attract for commercial gain, Internet users to a website or other online locations by creating a likelihood of confusion with The Southern Highland News newspaper brand; as contemplated by Para 4(b)(iv).
37. Those circumstances, having been found to be present, are evidence of the use of the Domain Names in bad faith for the purposes of Para 4(b).

## **SUMMARY**

38. I am satisfied that the Complainants have made out each of the elements of Paragraph 4 of the Policy.

**RELIEF**

39. The Complainants have sought alternative remedies, being either that:
- (a) the Domain Names be transferred to it pursuant to Clause 6.1(b) of the Policy; or
  - (b) the Respondent's registration of the Domain Names be cancelled.

**DECISION**

40. I direct that the Respondent's registration of the Domain Names be cancelled.

Date: 29 March 2010



RC McNally  
Sole Panelist