

Domain Name: *sohohouse.com.au*

Name of Complainant: *Harrphil Pty Limited as trustee of the Harrphil Trust*
Trading as Soho House

Name of Respondent: *Nick Sheridan*

Provider: *Resolution Institute*

Single Member Panellist: *Dennis Liner*

1. The Parties

- 1.1 The Complainant in this proceeding is Harrphil Pty Limited as trustee of the Harrphil Trust trading as Soho House (“the Complainant”).
- 1.2 The Respondent named in this proceeding as Nick Sheridan. However, the Domain Name is registered to Nicoff Investments Pty Ltd ACN 143 129 097, of which, according to the Company Extract provided by the Complainant, the sole Director is Nicholas Joseph Sheridan (“the Respondent”).

2. The Domain Name, Registrar and Provider

- 2.1 The Domain Name subject to this proceeding is “*sohohouse.com.au*” (the Domain Name”).
- 2.2 The Registrar of the Domain Name is Netregistry Pty Ltd (“the Registrar”).
- 2.3 The provider in this Proceeding is Resolution Institute of Level 2, 13-15 Bridge Street, Sydney, NSW 2000 (“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.2016-01 published 15 April 2016 (“auDRP”) which includes Schedule A (Policy) and Schedule B (Rules); and
 - (ii) the Provider’s supplemental rules for the au Domain Name Dispute Policy.

3.2 The Provider was supplied with a copy of a non-compliant ADR Domain Name Dispute Complaint Application Form dated 11 January 2019 by way of an email and received by the Provider on Saturday 12 January 2019. A notification of Non-Compliance dated Tuesday 15 January 2019 was issued to the Complainant. A Rectified Complaint was received by the Provider via email on Tuesday 22 January 2019. Such document is accepted by the Panel as constituting the Complaint in this matter. The email with such Complaint attached supporting documentation referred to below.

The Provider was supplied with a Response of the Respondent lodged by way of an email Monday 11 February 2019. The email with such Response attached supporting documentation referred to below.

I find that the making of the Complaint and the Response together with the supporting documentation referred to below comprise all the relevant matters submitted to the Panellist. I have perused the documents and I am satisfied that the service of the documents and the time for service of the documents complies with the Rules.

3.3 The documents supplied by the Complainant were as follows:-

ADR Domain Dispute Application Form comprising the email letter of the Complainant to which the documents set out below were attached:

- i) Resolution Institute Domain Name Dispute Complaint Application Form dated 11 January 2019.
- ii) Complaint headed "Resolution Institute Domain Name Dispute Complaint" ("the details of Complaint") dated 18 January.
- iii) ASIC Record of Registration for Business Name for "Soho House".
- iv) ASIC Current Company Extract for Nicoff Investments Pty Ltd
- v) Advice from Netregistry Pty Ltd and The Internet Archive.

3.4 The document supplied by the Respondent was as follows:-

Response by way of email to which the documents set out below were attached:

- i) "Respondent Reply to Notification of Complaint Lodged" dated 11 February 2019
- ii) ASIC database search for Harrphil Pty Ltd ACN 610399561.
- iii) Netregistry Certificate of Registration of "sohohouse.com.au".
- iv) IP Australia Trade Mark Search for "soho house".
- v) ABN Search of "The trustee for NJS Trust No.1 "

4 Factual background

FACTS ALLEGED BY THE CLAIMANT

- 4.1 The Domain Name has been in existence since 4 July 2013 and Document 3.3.v referred to above evidences that the Domain Name has been, and still is, a “parked domain” as the owner thereof has not yet pointed it to a website or online content.
- 4.2 The Complainant is the registered owner of the business name “Soho House”. Such business name was registered by the Complainant at the time it purchased properties at 169-173 Victoria Road, Kings Cross (“The Kings Cross Properties”). Such properties had been occupied by “Soho Night Club” in excess of 20 years before closing in 2015 and were known as “Soho House”.
- 4.4 The Complainant is in the process of redeveloping the Kings Cross Properties into multiple dwellings, retail and licensed premises and upon completion will continue to trade as “Soho House”. An extensive team of consultants have been engaged to design the redevelopment and lodge the relevant applications for approval.
- 4.5 The Complainant states:
- (i) the Domain Name is identical with or confusingly similar to the registered business name of the Complainant “Soho House”)
 - (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name
 - (iii) the Domain Name has been registered in bad faith and has not been used or pointed to a website or online content.
- 4.6 The Respondent has no rights or legitimate interests in respect of the Domain Name as it has no active business and does not use the Domain Name, it does not have a registered Australian Business Number (ABN), is not making any bona fide offering of goods or services in connection with the Domain Name or making any legitimate or fair use of the Domain Name. The Domain Name is well known in the entertainment and licensed premises as being connected with the Kings Cross Properties owned by the Complainant and is therefore misleading to potential customers and users of the Kings Cross Properties.
- 4.7 The Respondent is not commonly known by the Domain Name or similar, has not made any use of the Domain Name, does not supply goods or services in connection with the Domain Name and Netregistry has classified it as a “Parked domain”.
- 4.8 “Soho” is not a descriptive or generic word and there are no obvious reasons for the registration of the Domain Name other than take advantage of the reputation associated with the Kings Cross Properties acquired by the Complainant. Accordingly, this amounts to bad faith by the respondent for the purposes of the Policy and the Rules.

FACTS ALLEGED BY THE RESPONDENT

- 5.1 The Domain Name was not registered 4 July 2013 as submitted by the Complainant (Paragraph 4.1) but was registered 17 March 2011 as evidenced in Document 3.4(iii).

- 5.2 There is no requirement for the Respondent to launch a website or similar prior to any particular date.
- 5.3 The Respondent has a legitimate interest in the Domain Name as it is held by Nicoff Investments Pty Ltd as trustee for NJS Trust No.1 ABN 46 192 633 292 which is an investment vehicle, not an operating company and, accordingly no website has been developed by the Respondent. It is intended that the Respondent will transfer ownership to a related operating company which will develop the website, obtain a separate ABN and any other associated formalities.
- 5.4 The Business Name "Soho House" was first registered by the Complainant on 12 November 2016, five years after the Domain Name was registered by the Respondent on 17 March 2011.
- 5.4 The reference by the Complainant to the history of "Soho Night Club" in Kings Cross has little or no relevance. The business was called the "Soho Night Club". Not "Soho House Night Club". Such business ceased trading in 2015 and was not any relevant time owned or operated by the Complainant. The Complainant provides no evidence that the business was "known" as "Soho House". It is more plausible that the business was simply known as "Soho" as the business did not have, as far as the Respondent was aware, the reference to "House" in their title at any time, nor did anyone register the business name "Soho House" at any time whilst trading, nor has the Respondent ever received any complaint by the previous owner of the business or property or anyone else about the Domain Name.
- 5.5 As the Respondent registered the Domain Name first, it could not have been "confusingly similar" to the Complainant's business name. The Respondent is not, and has never been, in the business of "nightclubs". The Complainant has not provide evidence that the Respondent was aware of other proprietary rights of any other person to use the name "Soho House" in New South Wales or Australia.
- 5.6 The names "Soho" and "Soho House" and similar is a commonly used name in many industries both in Australia and overseas and is widely associated with "trend/fashion/entertainment" areas in both London and New York, so in no way relate specifically to the Kings Cross area or the proposed business operations of the Complainant of which the Respondent had not been aware. The Respondent is not aware of any trademarks or other intellectual property rights held by the Complainant or any other party restricting the Respondent's rights to be the registered owner of the Domain Name (see Document 3.4.iv)
- 5.7 In the light of Paragraphs 5.1 to 5.6 inclusive, the Complainant has not satisfied the onus of proof for the purpose of Paragraph 4(a)(i) of Schedule A to the Policy
- 5.8 As is evidenced in Document 3.4.(v),the ABN for the trust, the owner of the Domain Name has been active since 14 April 2010 and is an investment vehicle of privately owned companies, including investments in property and hospitality industries.

- 5.9 The Domain Name was acquired in 2011 originally for a proposed project in Sydney aimed primarily at the film industry to be known as “Soho House” or “Soho House, Sydney”, which is still under consideration. The Respondent also registered the domain name “sohohousesydney.com.au” at the same time for this purpose. The Respondent has engaged a Lawyer, a real estate agent and an accountant for the project, but the plans are confidential and the Respondent is not prepared to divulge details to the Complainant who operates in a similar industry sector and the same geographical location as the Respondent.
- 5.10 At no time since 2011 has the Respondent purported to sell, rent or otherwise transfer the Domain Name to any third party (including the Complainant) for any commercial or financial gain or otherwise. The Respondent is not “parking” the Domain Name for any financial or commercial gain or for any “untoward purpose”. In fact, the Respondent has incurred costs to maintain the Domain Name for its own legitimate business purposes and has at all times acted in good faith.
- 5.11 Pursuant to Paragraphs 5.8 to 5.10 inclusive, in accordance with Paragraph 4(a)(ii) and Section 4(c) of Schedule A to the Policy, the Respondent has shown a legitimate interest in respect to the Domain Name by way of a bona fide use of, or demonstrable preparations to use, the Domain Name in connection with an offering of goods or services (not being the offering of domain names that the Respondent has acquired for the purpose of selling, renting or otherwise transferring) and the Complainant has not satisfied the onus of proof to the contrary.
- 5.12 The Respondent did not register the Domain Name “in bad faith”, nor could it have, as it was registered first and was not aware of the Complainant’s business. The Complainant has not presented any evidence of “bad faith”. Accordingly, the Complainant has not satisfied the onus of proof for the purposes of Paragraph 4(a)(iii) of Schedule A to the Policy or otherwise.

6 Jurisdiction

- 6.1 Paragraph 2.1 of the auDRP states:

“All Domain Name licences issued or renewed in the open 2LDs from 1 August 2002 are subject to a mandatory administrative proceeding under the auDRP.”

- 6.2 The Domain Name, being “com.au”, is an open 2LD within the scope of the aforementioned paragraph. It is therefore subject to the mandatory administrative proceeding prescribed by the auDRP

7 Basis of Decision

- 7.1 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.”

7.2 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.

I note that **all three** components of Paragraph 4(a) are required to be proven for any Complaint to be upheld.

- **Domain Name is identical and confusingly similar to names or Trade Marks in which the Complainant has rights.**

The Complainant contends that the Domain Name is identical to the business name of the Complainant. In accordance with, inter alia, of Paragraph 5.4 the Respondent obtained registration of the Domain Name over 5 years prior to the registration of the Business Name.

The Domain Name is identical to the Business Name of the Complainant. Accordingly, I find that Paragraph 4(a) (i) is satisfied.

- **Respondent has no rights or legitimate interests in respect of the Domain Name**

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name upon the basis that the Domain Name has been “parked” and not pointed to a website or online content, the Kings Cross properties were known as “Soho House” for over 20 years and the Complainant is in the process of redeveloping the properties and intends to trade as “Soho House”, the Respondent has no active business or use the Domain Name or is known by such name, the Respondent has no ABN and is not making any bona fide offering of goods or service in connection with the Domain Name.

Pursuant to Schedule A of auDRP the Respondent is required to demonstrate its rights or legitimate interests in respect to the Domain Name by inter alia, any of the following:

- *before any notice to the respondent of the subject matter of the dispute, the respondent’s bona fide use of, or demonstrable preparations to use, the*

domain name or a domain name corresponding to the domain name in connection with an offering of goods or services(not being the offering of domain names that it has acquired for the purpose of selling, renting or otherwise transferring); or

- *the respondent (as an individual, business, or other organisation) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or*
- *the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue.*

The Respondent contends the Domain Name was registered prior to any notice by the complainant in respect of a proposed business project (and still intends to so proceed). In support of this contention, the Respondent has engaged various professional persons and has expended money on such project. There has been no evidence to the contrary advanced by the Complainant, who has the burden of proof.

Upon evaluating all the evidence provided to me I find that the Respondent is making a legitimate non-commercial or fair use of the Domain Name without intent for commercial gain to mislead or divert consumers or tarnish the name and, has accordingly demonstrated its rights or legitimate interests to the Domain Name for the purposes of Paragraph 4(a)(ii).

- **The Domain Name was registered or was subsequently used in bad faith**

The Complainant contends that the Domain Name was registered or was being used in bad faith as it was registered after the Complainant's Business Name and has been parked (unused) since it was registered and this could indicate that it was registered primarily for the purpose of selling, renting or transferring it to another person for valuable consideration.

The Respondent denies bad faith upon the basis that it was acquired with the intention of using it and had taken steps to do so.

Pursuant to Schedule A of auDPR the following circumstances, inter alia, shall be evidence of the registration and use of a domain name in bad faith:

- (i) *circumstances indicating that the domain name has been registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for a profit; or*
- (ii) *the registration of the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or*

- (iii) *registering the domain name primarily for the purpose of disrupting the business activities of another person; or*
- (iv) *using the domain name to intentionally attempt 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 of that website or location or of a product or service on that website or location.*

Apart from the delay in pointing the Domain Name to a website, there is no evidence offered by the Complainant that the Respondent used the Domain Name in breach of (i), (ii),(iii) or (iv) of Schedule A referred to above.

Accordingly, I find that the Domain Name was not registered or subsequently used in bad faith.

In accordance with the above findings, I find that Paragraph 4(a)(i) is satisfied, and Paragraphs 4(a)(ii) and (iii) not satisfied.

7. *Decision.*

7.1 As I have found that as each element of Paragraph 4(a) has not been proven, the Complainant is dismissed.

7.2 Accordingly, for the above reasons, I direct that the Domain Name continue to remain with the Respondent.

Dated 3 March 2018



Dennis Liner

Panellist