

ADMINISTRATIVE PANEL DECISION

Kingston Brass Inc. v. Chengshuang Xu

Case No. D2023-1636

1. The Parties

The Complainant is Kingston Brass Inc., United States of America ("United States"), represented by Nguyen Tabet LLC, United States.

The Respondent is Chengshuang Xu, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <salekingstonbrass.com> (the "Domain Name") is registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 13, 2023. On April 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 14, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint [together with the amendment to the Complaint/amended Complaint] satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 19, 2023.

The Center appointed Nicholas Smith as the sole panelist in this matter on May 24, 2023. 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.

4. Factual Background

The Complainant is an American company that offers various kitchen and bathroom furnishings, including faucets, sinks, toilets and other related goods and accessories, under the trademark KINGSTON BRASS (the “KINGSTON BRASS Mark”). The Complainant offers its products under the KINGSTON BRASS Mark through, amongst other places, its website at the domain name <kingstonbrass.com>.

The Complainant is the owner of a United States trademark registration for the KINGSTON BRASS Mark, registered on November 14, 2017, for goods in classes 11 and 20 (Registration Number 5,333,085).

The Domain Name was registered on September 29, 2022. The Domain Name resolves to a website (the “Respondent’s Website”) that reproduces the KINGSTON BRASS Mark and images of the Complainant’s products taken from the Complainant’s official website. The Respondent’s Website purports to offer a range of the Complainant’s products at a significant discount. The Respondent’s Website does not contain any disclaimer that the Respondent is not associated with the Complainant, indeed it uses the same photos and stylised logos that are used on the Complainant’s official website. The Complainant asserts, but provides no documentary evidence to support its assertion, that the Respondent does not ship any goods ordered through the Respondent’s Website (*i.e.* that the Respondent is committing a fraud on customers who visit the Respondent’s Website under the misapprehension that they are visiting a website connected to the Complainant).

5. Parties’ Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainant’s KINGSTON BRASS Mark;
- (ii) that the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the KINGSTON BRASS Mark, having registered the KINGSTON BRASS Mark in the United States of America. The Domain Name reproduces the KINGSTON BRASS Mark along with the word “sale” that does not distinguish the Domain Name from the KINGSTON BRASS Mark.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Respondent is not commonly known as the Domain Name nor does the Respondent have any authorization from the Complainant to register the Domain Name. The Respondent is not making a legitimate noncommercial or fair use of the Domain Name. Rather the Respondent is using the Domain Name to create a website that diverts customers from the Complainant’s official website and enables the Respondent to defraud said customers, such use not being *bona fide*.

The Domain Name was registered and is being used in bad faith. By using the Domain Name for a website that trades off the goodwill of the Complainant and its KINGSTON BRASS Mark, the Respondent is clearly aware of the KINGSTON BRASS Mark and is using it to deceive consumers as to its affiliation with the Complainant. Such conduct amounts to registration and use of the Domain Name in bad faith.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

To prove this element the Complainant must have trademark or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trademark or service mark.

The Complainant is the owner of the KINGSTON BRASS Mark, having registrations for KINGSTON BRASS as a trademark in the United States. The Domain Name incorporates the KINGSTON BRASS Mark with the addition of the word "sale" and the generic Top-Level Domain ("gTLD") ".com", which is generally disregarded under the first element confusing similarity test.

Other UDRP panels have repeatedly held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element; see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Domain Name is confusingly similar to the Complainant's KINGSTON BRASS Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

In general, to succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

"Any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the KINGSTON BRASS Mark or a mark similar to the KINGSTON BRASS Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name. There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial use.

The Respondent is using the Domain Name to operate a website that purports to offer the Complainant's products for sale at discount prices. If the products sold on the Respondent's Website are not genuine products produced by the Complainant or the Respondent simply does not ship any products, the Respondent's use of the Domain Name does not grant it rights or legitimate interests since it is using the

Complainant's KINGSTON BRASS Mark for a site selling counterfeit products or to commit a fraud (see [WIPO Overview 3.0](#), section 2.13.1).

Even if the Respondent is offering genuine KINGSTON BRASS products from the Respondent's Website, such use does not automatically grant it rights or legitimate interests. The principles that govern whether a reseller of genuine goods has rights or legitimate interests have been set out in a variety of UDRP decisions, starting with the case of *Ok! Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The [WIPO Overview 3.0](#), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

"[...] Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Ok! Data test', the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to 'corner the market' in domain names that reflect the trademark.

The 'Ok! Data test' does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

In this case, the Respondent's Website does not accurately or prominently disclose the Respondent's relationship with the Complainant, in particular that it is not an authorized dealer or has any particular connection with the Complainant. Rather, through its use of photographs and logos copied from the Complainant's official website, the Respondent actively and incorrectly asserts that it is connected to the Complainant. Even in the event that the Respondent is reselling genuine KINGSTON BRASS products from the Respondent's Website, its use of the Domain Name (also noting the nature of the Domain Name) for the Respondent's Website does not grant it rights or legitimate interests in the Domain Name.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has had the opportunity to put forward evidence of its rights or legitimate interests, including submissions as to why its conduct amounts to a right or legitimate interest in the Domain Name under the Policy. In the absence of such a response, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location (Policy, paragraph 4(b)).

The Panel finds that the Respondent was aware of the Complainant and its reputation in the KINGSTON BRASS Mark at the time the Domain Name was registered. The Respondent's Website contains numerous references to the Complainant, including purporting to offer the Complainant's products for sale and reproducing images of the Complainant's products taken from the Complainant's official website. The registration of the Domain Name in awareness of the KINGSTON BRASS Mark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

The Respondent registered the Domain Name for the purposes of operating a website specifically to sell either the Complainant's products and/or products that are not genuine. The Respondent is using the Domain Name that is confusingly similar to the KINGSTON BRASS Mark to sell products, be they genuine or otherwise, without the Complainant's approval and without meeting the Oki Data test. Moreover, an individual viewing the Domain Name may be confused into thinking that the Domain Name refers to a website in some way connected to the Complainant.

Consequently, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant and the Complainant's KINGSTON BRASS Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website.

Accordingly, the Panel finds that the Respondent has registered and used the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <salekingstonbrass.com>, be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: June 7, 2023