

ADMINISTRATIVE PANEL DECISION

FEWSTONE PTY. LTD., t/a City Beach, CBSA Investments Pty Ltd v.

Xueqing Yi

Case No. D2022-4558

1. The Parties

The Complainants are FEWSTONE PTY. LTD., t/a City Beach, Australia, and CBSA Investments Pty Ltd, Australia, represented by Macpherson Kelley Pty Ltd, Australia.

The Respondent is Xueqing Yi, China.

2. The Domain Name and Registrar

The disputed domain name <citybeachsale.com> is registered with Name.com, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 30, 2022. On November 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 1, 2022, 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 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 December 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 26, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 27, 2022.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on January 4, 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 Complainants in this administrative proceeding are FEWSTONE PTY. LTD., t/a City Beach, and CBSA Investments Pty Ltd (hereinafter referred to as the “Complainants”). The Complainants are part of the same corporate group, and both Complainants have an interest in the rights relied upon, and therefore a common grievance against the Respondent. Both Complainants own some intellectual property and registered trademarks which comprise and/or include the CITY BEACH sign.

The City Beach business, founded in 1985 (Queensland, Australia), is one of the largest businesses in Australia within the clothing retail industry. The City Beach business also exports to many countries internationally, including the United States of America (“US”), its third biggest market after Australia and New Zealand.

The Complainants are, *inter alia*, the owner of:

US trademark CITY BEACH AUSTRALIA (device) registration no. 4920311 registered on March 22, 2016;
US trademark CITY BEACH USA registration no. 6283265 registered on March 2, 2021;
Australian trademark CITY BEACH registration no. 2061493 registered from January 8, 2020; and
Australian trademark CITY BEACH AUSTRALIA (device) registration no. 1337158 registered from December 16, 2009.

In addition, the Complainants hold and operate the domain names (and related websites) <citybeach.com> and <citybeach.com.au>.

The disputed domain name was registered on March 3, 2022.

The disputed domain name resolves to a website where the Complainants’ trademark and logo are displayed.

The Complainants’ trademark registrations predate the registration of the disputed domain name.

5. Parties’ Contentions

A. Complainants

The Complainants claim that the disputed domain name is confusingly similar to their trademark registrations. The Complainants further state that the Respondent has no rights or legitimate interests whatsoever with respect to the disputed domain name. No license, or authorization of any other kind, has been given by the Complainants to the Respondent to use the CITY BEACH trademarks. The Complainants thus conclude that the disputed domain name has been intentionally used to attract Internet users, for commercial gain, to the website hosted at the disputed domain name by creating a likelihood of confusion with the Complainants’ trademark, such confusion encompassing the source, sponsorship, affiliation or endorsement of the website of the Respondent.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainants have established rights in the CITY BEACH trademark.

The disputed domain name contains the Complainants' CITY BEACH trademark with the addition of the term "sale" and the generic Top-Level Domain ("gTLD") ".com". The addition in the disputed domain name of the term "sale" does obviously not prevent a finding of confusing similarity with the CITY BEACH trademark.

Pursuant to section 1.8 of the Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") which states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements." In addition, the gTLD is disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds the disputed domain name to be confusingly similar to the CITY BEACH trademark in which the Complainants have rights.

Accordingly, the Panel finds that the Complainants have satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

This Panel finds that the Complainants have made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent has no connection or affiliation with the Complainants, and the Complainants have not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainants' trademarks. The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services, but is rather misrepresenting itself as the Complainants. In addition, the Respondent does not appear to be commonly known by the disputed domain name or by a similar name. The Complainants' representative attempted to purchase goods from the website at the disputed domain name, however, no products have yet been received, despite money having been taken. Use of the disputed domain name for illegal activity can never confer rights or legitimate interests on the Respondent. Moreover, the Respondent has not replied to the Complainants' contentions, claiming any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainants have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Based on the evidence put forward by the Complainants, the Panel is of the opinion that the Respondent was aware of the Complainants' trademark registrations and rights to the CITY BEACH mark when it registered the disputed domain name.

The Respondent's knowledge of the CITY BEACH trademark is particularly obvious, given that the Respondent, on its website, prominently displays the Complainants' trademark as well as photographic images of models wearing clothing marketed by the Complainants and taken from the Complainants' website. Hence, the registration of the disputed domain name does not seem to be a coincidence, and thus indicates that the Respondent knew of the Complainants' marks and intentionally intended to create an association with the Complainants and their business at the time of the registration of the disputed domain name.

In addition, the Respondent's use of the disputed domain name to resolve to a website where the Complainants' trademark is displayed constitutes an inference of bad faith use as well as a disruption of the Complainants' business under the Policy.

Inference of bad faith can also be made in the failure to respond to the Complainants' contentions, and the Respondent's lack of any rights or legitimate interests in the disputed domain name.

Another factor supporting the conclusion of bad faith registration and use of the disputed domain name, based on the documents filed by the Complainants, and not refuted by the Respondent, is given by the fact that the Respondent apparently provided incorrect, if not false, details regarding its contact references.

Further inference of bad faith can be seen in the fact that the Respondent has registered other domain names corresponding to and/or containing other third parties' trademarks.

Accordingly, the Panel finds, on the basis of the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith.

Therefore, the Complainants have satisfied 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 disputed domain name <citybeachsale.com> be transferred to the Complainants.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: January 16, 2023