

ADMINISTRATIVE PANEL DECISION

Living Edge (Aust) Pty Ltd v. Kawing Chiu
Case No. D2023-4133

1. The Parties

The Complainant is Living Edge (Aust) Pty Ltd, Australia, represented by Actuate IP, Australia.

The Respondent is Kawing Chiu, United States of America (“United States”), represented by John Berryhill, United States.

2. The Domain Name and Registrar

The disputed domain name <livingedge.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2023. On October 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 4, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 5, 2023, providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 12, 2023.

The Center verified that the Complaint together with the 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 October 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 8, 2023. On November 7, 2023, the Respondent requested an extension to the Response due date. On November 8, 2023, the Center informed the Parties that the Response due date had been extended to November 12, 2023, in accordance with paragraph 5(b) of the Rules. The Response was filed with the Center on November 12, 2023.

The Center appointed Antony Gold as the sole panelist in this matter on November 20, 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.

On November 16, 2023, the Complainant made a request to file supplemental submissions in reply to the Response. On November 22, 2023, the Complainant made an unsolicited filing (“Supplementary Submission”). Having regard to the fact that there are assertions in the Respondent’s Response which the Complainant could not reasonably have anticipated at the time of filing the Complaint, the Panel has admitted the filing to the record; see paragraphs 10 and 12 of the Rules and section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”). The Panel issued Administrative Panel Procedural Order No. 1 on November 22, 2023, giving the Respondent until November 29, 2023 in which to file a response to the Complainant’s Supplementary Submission, should it wish to do so. On November 27, 2023 the Respondent filed its response, which has been duly admitted to the record.

4. Factual Background

The Complainant is an Australian-based retailer of designer furniture and lighting goods and a provider of interior design services for residential and commercial clients. The Complainant’s goods and services are provided under the mark LIVING EDGE. The Complainant’s predecessor in title commenced the sale of goods under this mark in or about 2000 and established an active website for the purpose of its business in or around 2001. In 2010, this entity assigned the trade marks referred to below to a third party who, in turn assigned them to the Complainant in March 2015. The Complainant operates Instagram, Facebook, and LinkedIn accounts which have been active since 2013, 2011, and 2011 respectively.

The Complainant provides its goods and services throughout Australia and has stores and showrooms located in Sydney, Melbourne, Brisbane, and Perth. The Complainant is the owner, through assignment, of various trade marks for LIVING EDGE, including, by way of example only, Australian trade mark, registration number 1199844, for LIVING EDGE, in classes 20 and 35, registered on September 20, 2007.

The Respondent is an individual based in New York, United States. On February 21, 2005, the Respondent registered the disputed domain name which, he says, was part of the preparations for the establishment by him, in conjunction with a partner, of an information technology business. The corporate entity they formed was Living Edge International Inc., incorporated in August 2005. This business traded until in or about 2009, after which time it wound up its operations.

The Respondent has produced archived screenshots showing that, whilst Living Edge International Inc. was actively trading, the disputed domain name resolved to a website providing information about its services. More recently, it has resolved to a parking page which contains links to furniture-related websites such as “Living Room Furniture Modern”, “Contemporary Furniture”, and “Chair Furniture”. The disputed domain name does not presently resolve to an active website.

The Complainant has provided evidence that the Respondent has registered other domain names which incorporate well-known brands and trade marks, such as <canoncams.com> and <ebayshoppe.com>.

5. Parties’ Contentions

A. Complainant – Amended Complaint

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, the Complainant contends that;

- the disputed domain name is identical or confusingly similar to the Complainant's trade marks for LIVING EDGE, full details of one of these marks having been provided above. In addition to its registered rights, it says that the Complainant's ultimate predecessor in title began supplying its goods and services under the LIVING EDGE marks in around 2000. The Complainant has produced screenshots, cached at the Internet archive known as the Wayback Machine, showing use by its predecessor on its website of the term LIVING EDGE in relation to furniture stores in Australia, including for the period 2002-2004. It claims that it and its predecessors have invested heavily in promoting this brand, both offline and online since at least 2001;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name. In particular, the Respondent is not commonly known by the disputed domain name, nor is there any evidence that it has any trade mark rights in it. In this respect, Internet searches reveal that, since February 2009, the Respondent has been working as a licensed real estate agent at a differently named business in New York. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods and services in that it is being used to direct to a parking page which contains links to mainly Australian-based retailers of furniture who are competitors of the Complainant. Such links capitalize on the reputation and goodwill of the Complainant's trade marks. Lastly, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name;
- the Respondent has registered and is using the disputed domain name in bad faith. The disputed domain name has been used by the Respondent in an attempt to attract, for commercial gain, Internet users to the third party pay-per-click ("PPC") links displayed on his website, by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of those links. As at the date of registration of the disputed domain name, the Complainant had a strong reputation in relation to furniture retail and it is reasonable to infer that the Respondent would have been aware of the Complainant's trade marks as at that time. There is no other apparent reason for the Respondent's registration of the disputed domain name, not least when the words "living edge" have no common or generic meaning in relation to furniture retail.

B. Respondent – Response

The Respondent acknowledges that the first element of the Policy has been satisfied but points out that the trade marks relied on by the Complainant post-date his registration of the disputed domain name.¹ He also puts the Complainant to proof that it is the successor in title to the business in Australia which was the original user of LIVING EDGE in relation to furniture and says that no assignment of any alleged unregistered rights in this mark to the Complainant has been produced.

The Respondent asserts that it has rights or legitimate interests in the disputed domain name in that it registered it for the purpose of conducting a business, formed in August 2005, namely Living Edge International Inc. The Respondent can therefore claim to be commonly known by the disputed domain name. Moreover, the Respondent registered the disputed domain name as part of his *bona fide* demonstrable preparations for the launch of his business and indeed proceeded to use the disputed domain name for those purposes, well before the Complainant had registered any of its trade marks.

The Respondent denies that he has registered or used the disputed domain name in bad faith. His activities in registering the disputed domain name and using it in connection with an information technology business in New York City occurred before any claim of relevant rights of the Complainant for use of its mark in connection with interior design and furniture rentals of which the Respondent could plausibly have known. There are no Complainant's rights or reputation in LIVING EDGE of which the Respondent could or should have been aware as at the date of its registration of the disputed domain name in 2005. Specifically, the Complainant has adduced no evidence to support a claim that the Respondent should have been aware, as at the date of registration of the disputed domain name by him, of an interior design and furniture business

¹ The Respondent makes a number of arguments relating to three abandoned trade mark applications for LIVING EDGE filed by the Complainant's predecessor in the United States Patent and Trademark Office. These were not relied on by the Complainant in its Amended Complaint and this issue is not considered further by the Panel.

operating out of a single showroom in Australia. Indeed, the Complainant has still not expanded its business beyond the use of four showrooms in Australia.

The Respondent acknowledges that the disputed domain name was parked after Living Edge International Inc. ceased to trade, but there is nothing improper in this course. Furthermore, whilst it is correct that there are domain names which include third party trade marks and which are associated with the Respondent's email address which were acquired during the Respondent's business in information technology, the material question is whether the Respondent has cybersquatted the disputed domain name specifically, rather than any other domain names with which he may have been associated. It is clear that he has not done so. The Respondent suggests that this may be an appropriate case for the Panel to make a determination of Reverse Domain Name Hijacking.

C. Complainant – Supplementary Submission

In its Supplementary Submission, the Complainant notes that Living Edge International Inc., was active between about August 2005 and February 2009. However, it states that the only party listed in the company record is an individual other than the Respondent. There is therefore no evidence connecting this party with the Respondent and the Panel is accordingly invited to ignore any use by this company, not least when the Respondent has not submitted any evidence, such as financial records or other documents, to demonstrate actual trading by this entity. Lastly, the Complainant asserts that it has not engaged in Reverse Domain Name Hijacking.

D. Respondent – Supplemental Reply

As evidence that the Respondent was actively involved in the business of Living Edge International Inc., the Respondent draws attention to the Whois record which shows that the Respondent is named as the Administrative Contact for the disputed domain name. The Respondent also submits some business records to support his assertion that Living Edge International Inc. was an actively trading entity for the period between 2005-2009. Conversely, the Complainant has not produced any evidence to establish the repute of its LIVING EDGE brand, whether in the United States or elsewhere, and whether by it or its predecessor, as at the date of registration of the disputed domain name in February 2005. The only evidence produced by the Complainant relating to its promotion of its LIVING EDGE mark post-dates the registration of the disputed domain name by some years.

6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements in respect of each disputed domain name in order to succeed in its Complaint in relation to that disputed domain name: (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trade mark and the disputed domain name; see the [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of its LIVING EDGE trade mark for the purposes of the Policy; see the [WIPO Overview 3.0](#), section 1.2.1. For the purpose of the first element, it is not necessary for the mark relied on by the Complainant to pre-date the date of registration of the disputed domain name; see section 1.1.2. of the [WIPO Overview 3.0](#).

As a technical requirement of registration, the generic Top-Level Domain (“gTLD”) that is “.com” in the case of the disputed domain name, is usually disregarded when assessing identity or confusing similarity. The Complainant’s mark is reproduced in its entirety within the disputed domain name and it contains no additional characters. The disputed domain name is accordingly identical to the Complainant’s mark.

For the above reasons, based on the available record, the Panel finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

In the light of the finding made by the Panel below in relation to the third element, it is unnecessary for the Panel to consider the second element of the Policy.

C. Registered and Used in Bad Faith

For the purpose of considering the question of bad faith use, the Panel accepts the Complainant’s contention that it is the successor in title of the original user of the LIVING EDGE brand in connection with furniture retail in Australia and that at least some use of this brand had commenced in Australia prior to registration by the Respondent of the disputed domain name. There are four issues which require consideration.

First, has the Respondent established that the disputed domain name was registered in connection with the establishment of and operation of a *bona fide* business, namely Living Edge International Inc. The Whois record referred to above, establishes that, in some capacity, the Respondent was actively involved in the operation of this company. As evidence that this business was actively traded, the Respondent has produced insurance documents and an invoice for telephony services, each dating from 2008, which relate to the company. Whilst not considerable, the Panel takes account of the fact that the company has not been in operation for approximately 14 years and that extensive records of trading are unlikely to be readily available. The evidence is sufficient to establish that, for a period at least, Living Edge International Inc. was an actively traded entity and made *bona fide* use of the disputed domain name for business purposes.

Second, does the evidence support the Respondent’s contention that he did not have knowledge of (and thereby targeted) the LIVING EDGE mark, as at the date of registration of the disputed domain name in February 2005? The Respondent having expressly denied that he had any awareness of the Complainant and its LIVING EDGE mark as at the date of registration of the disputed domain name, the issue which arises for consideration is whether there are any established facts which render his denial sufficiently implausible as not to be accepted.

As at the date of registration of the disputed domain name, the Complainant was a furniture retailer operating from a limited number of locations in Australia. While it also claims unregistered rights through its predecessor in title since 2001, it has not produced evidence of its trading activities and/or its repute in LIVING EDGE from that point or as at February 2005, nor at any proximate date, whether in the United States nor even in Australia. Its chief evidence is sales figures for the last five years which is not helpful to answer the question. This is notwithstanding the express challenge to the extent of the Complainant’s repute in LIVING EDGE, as at the date of the Respondent’s registration of the disputed domain name, which was put forward in the Respondent’s Response.

In the absence of any such evidence, the Panel does not accept that the Complainant’s LIVING EDGE trading style (which was not registered as a trade mark at that date) had come to the attention of the Respondent. In these circumstances, the Panel accepts his contention that he had no knowledge of the Complainant as at the date of registration of the disputed domain name.

In fact, the issue goes further. It should be noted that rights in domain names would generally be considered as acquired on a first-come, first-served basis; see, for example, *GWG Holdings, Inc. v. Jeff Burgar, Alberta Hot Rods*, WIPO Case No. [D2016-1420](#). Accordingly, even if the Respondent had somehow been made aware of the Complainant’s LIVING EDGE brand, it would not necessarily have prohibited the registration by the Respondent of the disputed domain name if he intended to use it for (by way of example) a business in a

different sector and country and in a manner which did not in any way seek to take unfair advantage of the Complainant's mark or cause confusion to Internet users.

Finally, the Complainant has adduced evidence showing the registration by the Respondent of domain names which incorporate the well-known trade marks of unconnected third parties. In certain circumstances, there can be a duty on those trading in domain names to search registers. The Respondent has not given a full or satisfactory account as to why these domain names were registered. Had he not given a credible account for his registration of the disputed domain name, this may have been relevant to show a general intent to target third-party brands, but he has established that the disputed domain name was used in connection with the operation of the business in which he was then involved. But, in any event, even if a search had been conducted and had revealed that the disputed domain name was identical to the trading style of the Complainant's predecessor, as discussed above, this would not have meant that its registration could not be undertaken or would be considered to be in bad faith, having regard to the intended non-abusive use for the disputed domain name; see, for example, *Rolyn Companies Inc. v. Mediablue Inc.*, WIPO Case No. [D2018-0072](#) and *Delta Dental Plans Association v. Domains by Proxy LLC / Kwangpyo Kim*, WIPO Case No. [D2022-0566](#).

It follows from the above that the Complainant has failed to establish on a balance of probabilities that the disputed domain name was registered in bad faith. As the requirements of showing bad faith registration and bad faith use under the third element are cumulative, the Complainant has failed to make out its case in respect of the third element. It is therefore unnecessary for the Panel to consider the question of bad faith use.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking; see the [WIPO Overview 3.0](#), section 4.16.

Although the Complainant has not succeeded in its Complaint and the Respondent's criticisms of the shortcomings in the Complainant's case are largely valid, the Panel, by a narrow margin, declines to make a finding of Reverse Domain Name Hijacking in these proceedings. The Complainant had a weak case but has not conducted its case in a manner which suggests that it is appropriate for the Panel to make a finding of Reverse Domain Name Hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Antony Gold/

Antony Gold

Sole Panelist

Date: December 11, 2023