

ADMINISTRATIVE PANEL DECISION

Sandals Resorts International 2000 Inc. v. Domain Administrator, Sugarcane Internet Nigeria Limited

Case No. D2023-0308

1. The Parties

The Complainant is Sandals Resorts International 2000 Inc., Panama, represented by Dechert, United Kingdom.

The Respondent is Domain Administrator, Sugarcane Internet Nigeria Limited, Nigeria.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 20, 2023. On January 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 1, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 1, 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 February 6, 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 February 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 1, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on March 14, 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 has been operating a holiday business under the trademark SANDALS since the mid-1980s. The Complainant has now 24 properties in eight countries across the Caribbean, including 17 luxury hotels operating under the SANDALS brand.

The Complainant is the owner of several trademark registrations for SANDALS, including the following:

- United States of America trademark registration No. 1614295 for SANDALS (word mark), filed on December 18, 1989 and registered on September 18, 1990, in international classes 39 and 42;
- United States of America trademark registration No. 2054532 for SANDALS (word mark), filed on February 6, 1996 and registered on April 22, 1997, in international classes 16, 18 and 25;
- European Union trademark registration No. 000169946 for SANDALS (figurative mark), filed on April 01, 1996 and registered on June 11, 1998, in international classes 16, 25, 28 and 42;
- United Kingdom trademark registration No. UK00001310680 for SANDALS (figurative mark), filed on May 21, 1987 and registered on March 19, 1993, in class 43.

The Complainant is also the owner of the domain name <sandals.com>, which was registered on July 5, 1995 and is used by the Complainant to promote its services under the trademark SANDALS.

The disputed domain name <sandalsonlinepayment.com> was registered on November 29, 2022 and, according to the screenshots submitted by the Complainant – which have not been contested by the Respondent - was previously pointed to a pay-per-click landing page including links related to the Complainant's services, such as "Sandals Resorts Online Payment", "Sandals Reservations" and "Sandals Manage My Booking". At the time of the drafting of the Decision, the disputed domain name does not point to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name <sandalsonlinepayment.com> is confusingly similar to the trademark SANDALS in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the descriptive terms "online" and "payment" and the generic Top Level Domain ".com".

The Complainant further contends that the addition of the generic words "online" and "payment" serves only to enhance the confusion between the disputed domain name and the trademark as such words are apt to mislead Internet users into believing that they are being directed to make their payments online for services provided by or related to the Complainant. In particular, the risk of confusion would be heightened as the Complainant offers an "online payment form" through the Complainant's sub-domain <onlinepayment.sandals.com>, which is highly similar to the disputed domain name and which Internet users can use for bookings made online on the SANDALS website.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant submits that, considering the disputed domain name was registered over two decades after the Complainant

first conducted business under the brand SANDALS, the Complainant has achieved significant success under such trademark and has developed its business and brand extensively around the world. The Complainant concludes that, due to its reputation and international presence, it is highly unlikely that the Respondent independently conceived the name "Sandals online payment" or was unaware of the Complainant at the time of registering the disputed domain name.

The Complainant further underlines that the Respondent cannot argue, under paragraph 4(c)(iii) of the Policy, that it is making legitimate non-commercial or fair use of the disputed domain name without the intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue, since the disputed domain name originally hosted a website consisting of a directory of pay-per-click links and, since January 09, 2023, it included links to services that are identical or at the very least highly similar to the services covered by the Complainant's trademark registrations and the services for which the Complainant has developed goodwill and reputation under the trademarks SANDALS and SANDALS RESORTS, such as "Sandals Resorts Online Payment", "Sandals Reservations" and "Sandals Manage My Booking".

The Complainant is concerned that the disputed domain name may be used in the future to promote the kinds of goods and services that appeared on the previous pay-per-click links which may mislead, confuse, deceive and/or divert Internet users to make payments to illegitimate websites. Such content would be detrimental to the Complainant's reputation and presents a security risk for its customers given that the Respondent could be engaged in a phishing scheme. The Complainant further contends that it has not licensed or otherwise permitted or authorized the Respondent to use its trademark or to apply for a domain name incorporating the trademark.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the disputed domain name has not yet been used for any legitimate purpose and that the lack of any legitimate, good faith use suggests bad faith. Furthermore, the potential for use of the disputed domain name for phishing and other online scams would also suggest bad faith use.

The Complainant emphasizes that the fact that the Respondent was willing to pay money to register or acquire the disputed domain name, to continue to maintain it, and to host a website, are all evidence that the Respondent expected to profit from the domain name in this way and submits that there is a continuing risk that the Respondent may re-upload the pay-per-click links at the disputed domain name in future.

The Complainant underlines that the Respondent could not have chosen or subsequently used the Complainant's entire trademark in the disputed domain name for any reason other than to trade on the Complainant's rights in that name and to confuse Internet users into thinking that the Respondent is somehow connected to the Complainant, by creating a likelihood of confusion with the trademark as to the source, sponsorship, affiliation or endorsement of its website or a product or service on its website.

Moreover, the Complainant states that, considering the disputed domain name was used to host a website consisting of a directory of pay-per-click links also related to the Complainant's services and to payment methods and/or booking methods relating to the Complainant's resorts, which may have or may mislead Internet users in future to make payments using the links listed on the website at the disputed domain name, the Respondent's prior use of the disputed domain name clearly amounts to bad faith.

The Complainant further underlines that the Respondent's passive holding of the disputed domain name is an indication of bad faith use as is also the fact that the Respondent has engaged in a pattern of trademark-abusive domain name registrations since, in 2021 alone, 12 cases were decided adversely to the Respondent.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: “A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark SANDALS based on the trademark registrations cited under section 4 above.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant’s trademark and the disputed domain names to assess whether the trademark is recognizable within the disputed domain name (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). Moreover, where the relevant trademark is recognizable within the disputed domain names, the addition of generic or descriptive terms does not prevent a finding of confusing similarity under the first element (sections 1.8 of the [WIPO Overview 3.0](#)).

In the case at hand, the Complainant’s trademark SANDALS is entirely reproduced in the disputed domain name, with the mere addition of the terms “online” and “payment” and the Top-Level Domain “.com”, which is commonly disregarded under the first element confusing similarity test (section 1.11 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(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 non-commercial 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.”

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not submitting a Response, has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks.

Furthermore, there is no indication before the Panel that the Respondent is commonly known by the disputed domain name, has made preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, or that it intends to make a legitimate, non-commercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

According to the records, the disputed domain name, confusingly similar to the Complainant's trademark, was previously pointed to a website displaying pay-per-click links also related to the Complainant's trademark and services, as well as to online payments, and redirecting users to third-party websites. Such use of the disputed domain name does not amount to a *bona fide* offering of goods or services or a legitimate non-commercial or fair use.

See Section 2.9 of the [WIPO Overview 3.0](#), "Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users".

In addition, the Panel notes that the disputed domain name is currently passively held. In view of the Respondent's default, the Panel shares the view held in *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#), where the Panel found that, absent some contrary evidence from a respondent, passive holding of a domain name does not constitute legitimate non-commercial or fair use.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The Panel finds that, in light of the prior registration and use of the Complainant's trademark SANDALS in connection with the Complainant's products and services, including online on the Complainant's website "www.sandals.com", which has an internal section dedicated to online payments, the Respondent was or could have been aware of the Complainant and its trademark when it registered the disputed domain name.

Moreover, the references made to the Complainant's products and services on the website to which the disputed domain name resolved demonstrates that the Respondent was indeed aware of the Complainant and its trademark.

The Panel also finds that the Respondent's prior use of the disputed domain name in connection with a website displaying pay-per-click links, also related to the Complainant's trademark and services, amounts to bad faith under paragraph 4(b)(iv) of the Policy, since the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the website and the services advertised therein.

The Panel finds that paragraph 4(b)(ii) of the Policy is also applicable in the present case since the Respondent has engaged in a pattern of trademark-abusive domain name registrations, having been subject of 12 prior WIPO cases which were concluded with the transfer of the domain names to the complainants. According to Section 3.1.2 of the [WIPO Overview 3.0](#), "UDRP panels have held that establishing a pattern of

bad faith conduct requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner. A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners”.

At the time of the drafting of this Decision, the disputed domain name does not resolve to an active website. However, it is well established that passive holding of a domain name does not prevent a finding of bad faith under certain circumstances as decided, i.a., in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

In the present case, in view of i) the Respondent’s registration of a domain name confusingly similar to the Complainant’s trademark and to the Complainant’s third-level domain used to receive online payments from customers (<onlinepayment.sandals.com>); ii) the absence of any documented rights or legitimate interests of the Respondent in the disputed domain name; and iii) the prior use of the disputed domain name as demonstrated by the evidence submitted by the Complainant - which has not been challenged by the Respondent -, the Panel finds that the current passive holding of the disputed domain name does not prevent a finding of bad faith registration and use. See section 3.3 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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 <sandalsonlinepayment.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: March 29, 2023