ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Lendlease Corporation Limited v. CIVIL & CIVIC PROJECTS PTY LTD
Case No. DAU2025-0038

1. The Parties

The Complainant is Lendlease Corporation Limited, Australia, represented by Herbert Smith Freehills Kramer Australia, Australia.

The Respondent is CIVIL & CIVIC PROJECTS PTY LTD, Australia.

2. The Domain Name(s) and Registrar(s)

The disputed domain name <civilandcivic.com.au> is registered with GoDaddy.com, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 12, 2025. On September 12, 2025, the Center transmitted by email to GoDaddy.com, LLC a request for registrar verification in connection with the disputed domain name. On September 15, 2025, GoDaddy.com, LLC 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 .au Dispute Resolution Policy (the "Policy"), the Rules for .au Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 23, 2025. In accordance with the Rules, paragraph 5(a), the due date for Response was October 13, 2025. The Response was filed with the Center on October 13, 2025.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on October 23, 2025. 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 the successor in title to the "Civil and Civic" business. Both the Complainant and the "Civil and Civic" business were founded by the same person, Dick Dusseldorp AO.

The Civil and Civic business was founded in 1951. From 1951 until 1999, that business was responsible for or involved in the construction of some of the most iconic building projects in Australia during that period. These include:

1. The Sydney Opera House;

2. Australia Square on George Street in Sydney;

3. The National Tennis Centre in Melbourne;

4. Riverside Centre in Brisbane;

5. The MLC Centre in Sydney;

6. The Canberra Centre in Canberra; and

7. Brisbane Airport International Terminal in Brisbane, Queensland.

In the recent Trade Marks Office decision of *Civil & Civic Group Pty Ltd v Lend Lease Corporation Ltd* [2025] ATMO 153, the Registrar's Delegate noted at paragraph 20 that:

"Of the nine projects identified as being internationally significant public architecture, three are identified as being constructed under the [Complainant's] Trade Mark. Additionally, of the 100 tallest buildings identified in the publications, 17 were build using construction services that were offered under the [Complainant's] Trade Mark. The [Complainant] has established that there were many construction projects completed by the [Complainant] under the Trade Mark from 1951 until 1999."

According to the Complaint, in 1999, the Civil & Civic business was rebranded to "Lendlease". Since then, there are historical references to the Civil & Civic brand on the Complainant's "About us" web page at <lendlease.com.au>. There is also an article about the historical operation of the Civil & Civic business on the Complainant's LinkedIn page, which generated some 440 likes and 19 nostalgic comments.

The Complainant is the owner of Australian Registered Trade Mark No. 650511, CIVIL & CIVIC, which has been registered since January 16, 1995 for services in Classes 36 and 37 including property management administration, construction, and construction engineering services, amongst other things.

The information before the Panel does not indicate when the disputed domain name was first created. However, the Respondent claims it was acquired as part of a legitimate business acquisition in 2012.

According to a current and historical company extract from Australian Securities and Investment Commission's (ASIC's) records, the Respondent itself was actually incorporated on February 2, 2019. The Respondent itself could not have held the disputed domain name before that. It is not clear if the party to the Trade Marks Office decision, supra, is related to the Respondent. The sole director and shareholder of the Respondent claims, however, to have been associated with using the name "Civil and Civic" in connection with building projects for almost 20 years and has provided some evidence of his use of the disputed domain name in his email address in at least 2013 and 2014.

At the time this decision is being prepared, the disputed domain name does not resolve to an active website. On September 23, 2025, however, the disputed domain name resolved to a home page featuring the logo CIVIL & CIVIC, with links to pages headed Home, About Us, What We Do, and Contact Us, against a

background featuring an image of the striking roofline of the Sydney Opera House. According to the Response, the Respondent uses the disputed domain name in company email accounts, client and supplier correspondence, multifactor authentication for secure access, cloud storage, and on "years" of corporate stationery.

Although ASIC's records show that the Respondent was incorporated only in 2019, it claims to be the successor in title to a business which has been using the name "Civil & Civic" for "more than 20 years" including involvement in a AUD 6 billion infrastructure project for the NSW Department of Education, various other government projects and projects for various hospitals and clinics.

There is a third unrelated business trading under the name "Civil & Civic" in, it appears, the Australian Capital Territory. This business has a website at "www.civilandcivic.co" which bears a copyright notice dated 2020. It appears to be unrelated both to the Complainant and the Respondent.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

(i) the disputed 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 has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered or subsequently used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the 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 the Panel deems applicable.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's name, trade mark or service mark.

In this case, the Complainant has proven ownership of the Australian registered trade mark for CIVIL & CIVIC.

In comparing the disputed domain name to this trade mark, all that is required is simply a visual and aural comparison and assessment of the disputed domain name itself to the Complainant's trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd.*, WIPO Case No. DAU2002-0001. This test is narrower than and thus different to the question of "likelihood of confusion" under trade mark law which can require an assessment of the nature of the goods or services protected and those for which any impugned use is involved, geographical location or timing. Such matters, if relevant however, may fall for consideration under the other elements of the Policy.

Typically and as is appropriate in this case, it is permissible to disregard the country code Top-Level Domain ("ccTLD"), ".au", and the second-level domain, ".com", as functional components of the domain naming system. See for example auDA Overview of Panel Views on Selected auDRP Questions Second Edition ("auDRP Overview 2.0"), section 1.11.

Disregarding the ".com.au" ccTLD, the disputed domain name consists of the Complainant's registered trade mark. Accordingly, the Panel finds that the disputed domain name is identical to the Complainant's trade mark and the Complainant has established the first requirement under the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances may be situations in which a respondent has rights or legitimate interests in a disputed domain name:

(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 (not being the offering or domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark 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 trade mark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the complainant. Previous panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent under this head and an evidential burden will shift to the respondent to rebut that prima facie case. The ultimate burden of proof, however, remains with the complainant. See e.g., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. DAU2002-0001; auDA Overview 2.0, section 2.1.1.

In the present case, the Respondent became the registrant of the disputed domain name many years after the Complainant's predecessor began using its trade mark and also at least 20 years after the trade mark was registered.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name and the Respondent's corporate name both feature the common phrase "Civil and [or &] Civic". It appears from the Response, however, that the disputed domain name was registered before the Respondent was incorporated; the Respondent claiming to succeed an earlier business.

The Response includes three testimonials from 2007 commending the work undertaken by "Civil & Civic" [the Panel infers, the Respondent's predecessor] on significant infrastructure projects including the Albury Hume Freeway Project, the Westlink M7 project, the Bonville By-Pass and the Lane Cove Tunnel Project. [The nature of the work is not identified in detail.] The Response also includes five emails in 2013 / 2014 between personnel at the Complainant and the Respondent's sole director and shareholder (using an email address "[…]@civilandcivic.com.au").

Assuming the Respondent is in fact carrying on business as claimed in the Response (but denied in the Complaint), the services which the Respondent claims to be providing fall within the scope of the Complainant's registered trade mark.

In *Civil & Civic Group Pty Ltd v Lend Lease Corporation Ltd*, supra, the Registrar's Delegate found that the Complainant has not used the registered trade mark as a trade mark in at least the three years preceding August 15, 2023. In view of the Complainant's "spillover" reputation from the former business' operations, however, the Delegate exercised the Registrar's discretion not to remove the trade mark.

That is not an end to the matter, however. As already noted, the Respondent claims to be the successor in title to a business which claims to have been using "Civil & Civic" independently of the Complainant for in the order of 20 years. It also claims that it has been doing so with the Complainant's knowledge since in or about 2013.

These claims may afford the Respondent potential defences of acquiescence or estoppel or rights of registration as an "honest concurrent user" through Trade Marks Act 1995 (Cth) sections 122(1)(f) and (fa) read with section 44(3).

Establishing these defences and rights is not straightforward. Assuming in the Respondent's favour that there has been continuous use by the predecessor(s) and the Respondent, there are also questions whether the communications in 2013 and 2014 were with personnel who would be regarded as relevant decision makers within the Complainant that their knowledge constitutes knowledge of the Complainant. The concept of "honest concurrent user" raises potentially complicated factual inquiries about what the Respondent – or its principal – knew and all the detailed circumstances. Even if these matters can be established, there are also issues about whether the Respondent would be able to establish the defence under sections 122(1)(f) and (fa) through section 44(3) in the face of the potential opposition to such registration pursuant to section 58 and 60.

The Panel considers the Response provides a sufficient basis to conclude that the Respondent's claim that it is the successor in title to a business which has been operating under the name "Civil & Civic" for about 20 years is not mere assertion in a proceeding of this nature. In proceedings on the papers such as proceedings under the Policy, the Panel further considers that finding is sufficient to find that the Respondent has rebutted the Complainant's prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. As the analysis in the preceding paragraph shows, the issues raised by the Complainant's claim of trade mark infringement and the Respondent's defence require far more detailed forensic investigation and analysis than is available in proceedings under the Policy. Going solely on the record in this proceeding, the Respondent (and its predecessor(s)) appear to have been using the disputed domain name for 20 years undisturbed by the Complainant. In those circumstances, the Panel finds that the Complainant has not established the second requirement under the Policy. Accordingly, the Complaint must fail.

C. Registered or Subsequently Used in Bad Faith

As the Complaint must fail, no good purpose would be served by addressing the third requirement under the Policy.

7. Decision

For all the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/
Warwick A. Rothnie
Sole Panelist
Date: November 6, 2025

Addendum (December 4, 2025)

The Respondent has requested a finding of reverse domain name hijacking. While the Complaint has failed, the reasons for that failure do not support a finding of reverse domain name hijacking.

Paragraph 15(e) of the Rules provides, in part:

"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 was brought primarily 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."

Paragraph 1 of the Rules defines "Reverse Domain Name Hijacking" to be "using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name".

The fact that a Complaint has failed is not in itself sufficient to warrant a finding of reverse domain name hijacking.

WIPO Overview 3.0, section 4.16 provides a number of examples of situations where findings or reverse domain name hijacking have been made:

"(i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant's lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (see generally section 3.8) such as registration of the disputed domain name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the WhoIs database, (iii) unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which prima facie justify advancing an alternative legal argument, (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, (vi) the complainant's failure to disclose that a case is a UDRP refiling, (vii) filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis, (viii) basing a complaint on only the barest of allegations without any supporting evidence."

These are only examples and do not constrain the overarching consideration whether the particular circumstances lead the Panel to conclude the Complaint was brought in bad faith.

In the present case, a company which may be related to the Respondent failed in its attempt to have the Complainant's registered trade mark removed for non-use. So far as the Panel is aware, there has not been an appeal from that decision. At the least, neither Party has informed the Panel that an appeal has been filed. That means that the Respondent's use of the disputed domain name in connection with its building and construction business is prima facie inconsistent with the Complainant's registered trade mark.

Further, the Panel has not found that the Respondent has rights or legitimate interests in the disputed domain name. Rather, it has found that the Complainant has not proved the Respondent does not have rights or a legitimate interest in circumstances where the Respondent provided sufficient evidence to support a claim that it (and its predecessor in title) have been using the disputed domain name undisturbed for 20 years and there are other arguable defences which, on the limited record in this proceeding, have not been excluded.