

ADMINISTRATIVE PANEL DECISION

Seafolly Pty Limited and Seafolly IP Co. Pty Ltd v. Xueqing Yi
Case No. D2022-3388

1. The Parties

The Complainants are Seafolly Pty Limited (hereinafter also referred to as First Complainant) and Seafolly IP Co. Pty Ltd (hereinafter also Second Complainant), Australia, represented by K&L Gates, Australia.

The Respondent is Xueqing Yi, China.

2. The Domain Name and Registrar

The disputed domain name <seafollypromo.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 September 12, 2022. On September 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 13, 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 September 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 10, 2022.

The Center appointed Anna Carabelli as the sole panelist in this matter on October 25, 2022. 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

Since 2006, the Second Complainant, formerly known as P&Y Halas Pty Limited, is the owner of several trademark registrations for SEAFOLLY (SEAFOLLY Trademark), which have been registered in numerous jurisdictions all over the world, including China, such as the international registration No. 896290 for SEAFOLLY registered on May 17, 2006.

The Second Complainant has granted an exclusive license to the First Complainant to use the SEAFOLLY Trademark. Any use of the SEAFOLLY Trademark by the First Complainant has been under this license.

The First Complainant owns the domain names <seafolly.com> and <seafolly.com.au>, both redirecting to the First Complainant's website, which functions as a platform for advertising and brand information, and as online store.

The First Complainant is a successful designer, manufacturer, wholesaler, and retailer of swimwear and related accessories by reference to the Seafolly brand and SEAFOLLY Trademark. Seafolly products are sold in over 500 multi-brand stores in Australia and in over 1,700 retail outlets around the world.

The disputed domain name was registered on March 3, 2022. As per the evidence submitted with the Complaint, the disputed domain name resolves to a website which sells swimwear and related accessories and mimics the layout of the First Complainant's website.

The First and Second Complainants will be referred as the "Complainant" hereinafter.

5. Parties' Contentions

A. Complainant

The Complainant submits and contends that:

- The disputed domain name is identical or confusingly similar to the SEAFOLLY Trademark in which the Complainant has rights. The disputed domain name entirely incorporates the SEAFOLLY Trademark with the addition of the term "promo" which does not remove the confusion or neutralize the similarity.
- The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not been licensed or otherwise permitted by the Complainant to use the SEAFOLLY Trademark. The website at the disputed domain name sells swimwear and related accessories and mimics the layout and user experience of the Complainant's website (by using a banner image of a model in beachwear beneath the words "SEAFOLLY COLLECTIVE" which is stylized in the same manner as on the Complainant's website, and some subcategories of "Collections" which are identical to the Complainant's). This use supports the false impression, that the website at the disputed domain name is endorsed by the Complainant, which it is not.
- The Respondent is not a customer of the Complainant, has no lawful access to commercial quantities and does not meet the requirements of the so called Oki Data test (as set out in the *Oki Data Americas, Inc. v. ASD Inc.*, WIPO Case No. [D2001-0903](#)) as the website at the disputed domain name does not disclose the Respondent's (lack of) relationship with the Complainant.
- The disputed domain name was registered and is being used in bad faith by the Respondent to derive illegitimate commercial gains in an attempt to attract users who are familiar with the Complainant's products and reputation. The disputed domain name was registered years after the SEAFOLLY Trademark was filed and the Respondent likely chose it with full knowledge of the Complainant and the SEAFOLLY Trademark.

Based on the above the Complainant requests the disputed domain name be transferred to the First Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the Respondent, shall be evidence of the Respondent's rights to or legitimate interests in the disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark SEAFOLLY based on the evidence submitted in the Complaint.

As highlighted in section 1.11 of the WIPO Overview of WIPO Panels View on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the addition of the generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain name, *i.e.*; "seafollypromo".

The disputed domain name entirely incorporates the Complainant's mark SEAFOLLY and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), 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 also *Amazon Europe Core S.à.r.l. v. Wuki Yilian LLC*, WIPO Case No. [D2017-2254](#), where it was found that the term "promo" (common shorthand for "promotion") is strongly related to online retailing activities.

In the light of all the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks and the Complainant has established element 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;
- (iii) it is 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 Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) The Complainant holds prior rights in the globally registered SEAFOLLY Trademark, (b) The Respondent has no affiliation with the Complainant and has not been authorized to use its SEAFOLLY Trademark in any way, (c) the disputed domain name resolves to a website which sells swimwear and related accessories and mimics the layout of the First Complainant's website.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy. There is no indication before the Panel of any activity in relation to the disputed domain name that would give rise to rights or legitimate interests in the Respondent.

Therefore, the Panel finds that the Complainant has established paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith.

The SEAFOLLY Trademark is distinctive and has been used globally by the Complainant for many years. This leads the Panel to conclude that the Respondent knew, or should have known that the disputed domain name it registered would be confusingly similar to the Complainant's trademark. The fact that the website at the disputed domain name has a similar layout and user experience to that of the First Complainant's website indicates that the Respondent targeted the Complainant when it registered the disputed domain name.

The above suggests that the disputed domain name was registered in bad faith (see section 3.2.2 of the [WIPO Overview 3.0](#)) with a deliberate intent to create an impression of an association with the Complainant.

The website at the disputed domain name sells swimwear and related accessories by reference to the SEAFOLLY Trademark, without the consent of the Complainant. This indicates an attempt to benefit from the reputation of the Complainant's trademark and to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites or of the services offered on the Respondent's websites

Accordingly, pursuant to paragraph 4(b)(iv) of the Policy, the Panel finds that the disputed domain name was registered and is being used in bad faith by the Respondent.

On this basis the Panel finds that the Complainant has satisfied the third and last point of the Policy, paragraph 4(a)(iii).

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 <seafollypromo.com> be transferred to the First Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date November 3, 2022