

ADMINISTRATIVE PANEL DECISION

Sandals Resorts International 2000 Inc v. Privacy service provided by
Withheld for Privacy ehf. / Ivs Prasad
Case No. D2022-2677

1. The Parties

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

The Respondent is Privacy service provided by Withheld for Privacy ehf., Iceland /Ivs Prasad, India.¹

2. The Domain Name and Registrar

The disputed domain name <beachs.beauty> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 22, 2022. On July 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 25, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 1, 2022, 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 August 4, 2022.

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 August 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2022. On August 5, 2022, the Center received two

¹ As the first-named Respondent is a privacy service, the Panel will refer to the second-named Respondent as the Respondent unless the context requires the contrary.

emails from the Respondent. The Respondent did not submit any further response. On August 30, 2022, the Center notified the parties that no further Response had been received and, accordingly, it would proceed to the appointment of the Panel.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on September 9, 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

The Complainant has been operating a business of international holiday resorts under the trademark “Beaches” or “Beaches Resorts” since 1997. It has resorts in the Turks & Caicos, Jamaica, and Ocho Rios with another resort opening in Jamaica in the near future.

Amongst other things, the Complainant’s resorts under the name “Beaches Resorts” have been named the world’s leading family all-inclusive resort brand by the World Travel awards for the last 24 years in succession. The Complainant’s “Beaches Resorts” have also received awards on numerous other occasions in a wide range of other industry and consumer awards including Condé Nast Traveler’s Annual Readers’ Choice Awards, the American Academy of Hospitality Sciences International Star Diamond Award, and the TripAdvisor Certificate of Excellence to name just three.

According to the Complaint, the Complainant’s trademarks have been promoted extensively in numerous jurisdictions including the United States of America (“United States”), the European Union (“EU”) and the United Kingdom (“UK”) in TV, print, online, billboards, and other forms of advertising and promotion.

The Complainant also promotes its services via a website to which the domain name <beaches.com> resolves.

The Complaint also includes evidence that the Complainant’s resorts have received extensive coverage by reference to the “Beaches” trademark in the press.

The Complaint includes evidence of numerous trademarks registered by the Complainant. These include registrations for “Beaches” in cursive lettering over a wavy line in:

- (a) UK, Registered Trade Mark No. UK00900169995, which is registered with effect from April 1, 1996, for a range of goods and services in International Classes 16, 25, 28, and 42;
- (b) EU, EUTM No. 000169995, which was entered on the Register on June 5, 1998, also for a range of goods and services in International Classes 16, 25, 28, and 42;

The Complainant also has registered trademarks for BEACHES in plain text in:

- (c) EU, EUTM No. 009401357, which was entered on the Register on March 22, 2013, in respect of a range of services in International Classes 35, 39, 41, 43, and 44;
- (d) US, United States Registered Trademark No. 2951577, which was registered as a Service Mark on May 17, 2005, in respect of a range of services in International Classes 39 and 43; and
- (e) US, United States Registered Trademark No. 3070140, which was registered in the Principal Register on March 21, 2006, in respect of a range of goods in International Classes 16, 18, and 25.

The Complainant also has registered trademarks for a third form which features the word “Beaches” in a cursive script and the words “Resorts by Sandals” in much small script underneath, including:

(f) EUTM No. 014605513, which was entered on the Register on February 8, 2016, in respect of a range of goods and services in International Classes 16, 25, 35, 36, 39, 41, 43, and 44; and

(g) US Registered Trademark No. 5304502, which was registered on October 10, 2017, in respect of a range of goods and services in International Classes 16, 25, 35, 39, 41, 43, 44, and 45.

US Registered Trademark No. 5304502 includes the words “Resorts for Everyone by Sandals” rather than just “Resorts by Sandals”. It also includes a disclaimer of “Resorts” and a distinctiveness limitation statement as to “Beaches”.

In addition to numerous other registrations, the Complaint also includes evidence that the Complainant filed a trademark application to register the “Beaches Resorts for Everyone by Sandals” trademark in India on May 2, 2022, Application No. 5431938. This application has been advertised accepted on August 1, 2022, but has not yet proceeded to registration.

According to the Complaint, the Respondent registered the disputed domain name on May 26, 2022. The Respondent has not disputed the Complainant’s claim.

In June and July 2022, the disputed domain name resolved to a web page stating “This domain was recently registered at Namecheap. Please check back later!” Beneath that statement appeared numerous “related links” or “sponsored links”. The links were for a range of things including “Family Photos”, “2022 All Inclusive Holidays”, “Family Vacations”, “Family Resorts”, “Cozumel”, “Holiday Vacations”, “Girls Nearby” and so on.

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 trademark 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.

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 it 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 trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of numerous registrations for “Beaches” including in both the European Union and the United States plain word registrations of BEACHES.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of

confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.beauty” gTLD, the disputed domain name consists of the Complainant’s registered trademark without the penultimate letter “e”. As the test is a simple visual and aural comparison, it has long been recognised under the Policy that it is insufficient to avoid a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.9.

Insofar as the Complainant’s other forms of registration can be seen as “fancy marks”, it is also usual to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. Where the textual elements have been disclaimed in the registration or cannot fairly be described as an essential or important element of the trademark, however, different considerations may arise. See for example, [WIPO Overview 3.0](#), section 1.10. In the present case, the word “Beaches” is by far the most prominent element with the other words being positioned underneath and in very much smaller font. Two of the United States’ registrations do have a distinctiveness limitation ‘as to “Beaches”’ but the other registrations do not.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

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 can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making 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 trademark 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. 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., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name long after the Complainant began using its trademark and also well after the Complainant had registered its trademark.

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 is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name. On the other hand, "beachs" can be seen as essentially a typographical error of a dictionary word. That said, the way the disputed domain name was being used before the Complaint was filed was not directly related to that dictionary meaning.

As the disputed domain name resolves to a web-page with Pay-Per-Click (PPC) advertising links, it does not qualify as a legitimate noncommercial or fair use for the purposes of paragraph 4(c)(iii) of the Policy.

These matters taken together are sufficient to raise the required *prima facie* case.

In his (albeit brief) Response, the Respondent stated that the Registrar did not give him any trademark warnings when he registered the disputed domain name. He states further that he is the owner of "OurVizag.com" on behalf of the city of that name (or more formally, Visakhapatnam) in Andhra Pradesh State, India. According to the Respondent, this city has lots of beautiful beaches along the Bay of Bengal. His intention was, or is, to promote those wonderful beaches to the people of the world. At this stage, however, the Respondent says he is only at the conceptual stage being very "busy with other technical works towards our Digital Services for the City of Visakhapatnam". Thirdly, the Respondent says he has had no involvement in the placing of PPC links on the website which may have been automatically generated by the Registrar's system. The second of the Respondent's two emails includes two photographs of what the Panel understands to be beaches at or near Visakhapatnam.

The domain name "OurVizag.com" does resolve to a website which appears to be offering online digital services or promoting Vizag as a center for digital services. For example, the banner headline promotes a special event which was to take place on July 7, 2022 – a "Massive Digital Explosion is going to happen on this July 7th, 2022 in Our City. Vizag are You Ready?"

Other paragraphs appear to offer services for talented professions "Do you have any talent? Leave the Digital set up to us. We take you global." Or, if you are unemployed, the website claims "We are going to empower you Digitally in 100 Days."

Yet another section, under the heading "Making an Impact Across the Globe" states "By 2025 our dream is to make Vizag, World's Digital Hub. With great natural and human resources, Vizag is going to be the next Silicon Valley of East." Similar claims about Vizag are made under headings such as "Global Leader in Digital Technology" and "Culture & Technology".

The landing page also links to an Our Vizag YouTube channel and Facebook page. The Facebook page describes OurVizag.com as a social media agency. The Facebook page has links or advertisements promoting services such as Yoga classes, massage and something called CMoklub.com. The Facebook page appears to have been created on December 14, 2020.

Turning to the Respondent's first point, the failure of the Registrar to issue any trademark warning does not give rise to any rights or legitimate interests. The registration agreement itself makes it plain that the responsibility for ensuring that the registration and use of a domain name does not conflict with a third person's rights falls on the registrant. As all domain names in the ".beauty" gTLD are registered subject to

the Policy, moreover, the Policy itself makes it clear that domain names are registered subject to prior trademark rights.

[WIPO Overview 3.0](#), section 2.10.1 notes that merely registering a domain name comprised of a dictionary word does not automatically confer rights or legitimate interests. Generally speaking, it is expected that there would be a demonstration of genuine use, or a demonstrated intention so to use, in connection with the asserted dictionary meaning. The [WIPO Overview 3.0](#) gives as an example of the different outcomes use of "orange" *simpliciter* in respect of the fruit (which could be legitimate) or a use, which targeted telecommunications services (which would not be legitimate if not authorised by or otherwise associated with the telecommunications provider).

As noted above, the Respondent does claim that he registered the disputed domain name in connection with a plan to promote the region's beaches to the world. As explained in [WIPO Overview 3.0](#), section 2.2, such claims will not be accepted where they are merely unsupported assertions. Clear contemporaneous evidence of good faith preparations before the Complaint was filed will typically be required. What will suffice will depend on the circumstances of the case. Examples given in [WIPO Overview 3.0](#) include things such as (i) evidence of business formation-related due diligence/legal advice/correspondence, (ii) evidence of credible investment in website development or promotional materials such as advertising, letterhead, or business cards (iii) proof of a genuine (*i.e.*, not pretextual) business plan utilizing the domain name, and credible signs of pursuit of the business plan, (iv) *bona fide* registration and use of related domain names, or (v) other evidence generally pointing to a lack of indicia of cybersquatting intent.

[WIPO Overview 3.0](#), section 2.2 concludes with the warning that the "claimed examples of use or demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services cannot be merely self-serving but should be inherently credible and supported by relevant pre-complaint evidence."

The Panel does not consider that appending two (apparently) generic pictures of local beaches to an email discharges this onus. The photographs could have been taken at any time for any purpose. There is no suggestion that the relevant local or regional authorities had engaged the Respondent to undertake or begin such a project. There is nothing about the Respondent's other activities which suggests an interest or involvement in promoting the area's beaches as a travel destination. It is unclear why the Respondent registered a typographical error for "beaches" as a domain name. However, that would most likely be because <beaches.com> is already taken – by the Complainant. On that basis, the Respondent would very likely have been aware of the Complainant and its resorts when registering the disputed domain name and so on notice of the risk of deception and confusion. It would be difficult to characterise that conduct as being in good faith in those circumstances.

The Respondent's third argument that the PPC links have been generated by the website host without his involvement also does not assist him. It is well-established under the Policy that the registrant is responsible for the use made of the disputed domain name in the absence of proof that the registrant actively took steps to suppress activity trading on a trademark owner's rights. See *e.g.*, [WIPO Overview 3.0](#), section 2.9. In the present case, there is no such evidence.

Taking all these matters into account, the Panel finds that the Respondent has not rebutted the *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see *e.g.*, *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The evidence in this proceeding demonstrates that the Complainant has been using its “Beaches Resorts” trademarks (in various forms) since 1997. While its resorts appear to be located in the Caribbean region, the Complainant has achieved very substantial international recognition and prominence.

Moreover, the Respondent appears to have become the registrant of the disputed domain name only very shortly after the Complainant applied to register its trademark in India.

Further, while the Respondent has stated that he received no warnings of trademark infringement when registering the disputed domain name, the Respondent has not expressly and unambiguously denied knowledge of the Complainant and its trademark – and here, it is hard to escape the inference of targeting the same on account of the disputed domain name being a typographical error for “beaches”.

Instead, the Respondent has advanced a justification for his registration of the disputed domain name, which, on the limited evidence in this proceeding, the Panel has been unable to accept and so rejected.

The rejection of that defence in the circumstances outlined above leads to a clear inference that the Respondent registered the disputed domain name with knowledge of the Complainant and its trademark and, the claimed intended use having been rejected, the further inference that the Respondent did so with the intention of taking advantage of the Complainant’s trademark.

Accordingly, the Panel finds that the Respondent registered the disputed domain name in bad faith. Consistent with the reasoning explained in section 2.9 of [WIPO Overview 3.0](#), therefore, the way the Respondent has been using the disputed domain name to resolve to a parking page with PPC links constitutes use in bad faith under the Policy.

Accordingly, the Complainant has established all three requirements under the Policy.

6. 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, <beachs.beauty>, be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: September 23, 2022