

ADMINISTRATIVE PANEL DECISION

South32 Limited v. South32, South32 is a trademarked film company
Case No. D2023-1808

1. The Parties

The Complainant is South32 Limited, Australia, represented by Griffith Hack Lawyers, Australia.

The Respondent is South32, South32 is a trademarked film company, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <south32.com> is registered with Sea Wasp, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 24, 2023. On April 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 28, 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 (Jewella Privacy – 29338, Jewella Privacy LLC Privacy ID# 1228614) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 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 May 11, 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 May 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 4, 2023. The Response was filed with the Center on May 20, 2023.

The Center appointed Andrew D. S. Lothian, Nicholas Smith, and Mohamed-Hossam Loutfi as panelists in this matter on June 15, 2023. The Panel finds that it was properly constituted. Each member of 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 a mining and metals company headquartered in Perth, Australia. It is listed on the Australian Securities Exchange with secondary listings on the Johannesburg and London Stock Exchanges. It carries out business operations in a large number of countries, including Australia, South Africa, United States, Mozambique, and Colombia, and has 9,000 employees. Its website is at “www.south32.net”.

The Complainant was demerged from a larger mining company named BHP Billiton in May 2015. An article in the “Sydney Morning Herald” newspaper dated December 8, 2014, reported that BHP Billiton had said the proposed company would be branded “South32” in a nod to the line of latitude upon which its major operations in South Africa and Australia were located, noting that the name had been chosen by a combination of employee suggestions and advice from a creative agency.

The Complainant is the owner of a variety of registered trademarks for the word mark SOUTH32, the earliest of which appears to have been filed on the day after the said newspaper article was published. Said trademark is Australian Registered Trademark No. 1663256 for the word mark SOUTH32, filed on December 9, 2014, and registered on July 8, 2015, in Classes 4, 6, 37, 40, and 42.

The disputed domain name was registered on April 3, 2012. The current registrant name is “South32” and the registrant organization is “South32 is a trademarked film company”. The registrant address is an address in Malibu, California, United States. The website associated with the disputed domain name contains material that is critical of the Complainant and at least one unrelated mining company.

The Respondent produced various materials relating to the disputed domain name to demonstrate its continuous control thereof from the date of registration. The first item is a registration invoice (“the first invoice”) numbered 978335 branded “Fabulous” using an email address at the domain name <fabulous.com>. Said invoice is addressed to “South32”. It quotes the disputed domain name and a registration date of April 3, 2012, noting the registration period as three years.

The second item is a renewal invoice (unnumbered) (“the second invoice”) from the disputed domain name registrar “GoDaddy” dated January 28, 2015. This invoice specifies a registration period of four years and is addressed to “Kari Bian” at an address in Malibu, California, United States which differs slightly from the Respondent’s current address as provided by the Registrar but shares the same zip code. The address section of this invoice also mentions an entity named “Losangelesnews.com incorporated”.

The third item is a renewal invoice numbered 1564874 (“the third invoice”) dated November 9, 2020, from the present Registrar, branded “Fabulous.com”. This invoice specifies the renewal of the disputed domain name for three years and is addressed to “Luigi Bian | Losangelesnews.com inc.” at the same address provided by the Registrar as the Respondent’s current address.

The Complainant produces a historic “Whois” report for the disputed domain name which does not cover its full history and commences on September 14, 2015. Screenshots provided with each of the Whois records do not necessarily have the same date as the historic Whois entry and for this reason the Panel has separated these out and listed all records provided in chronological order in the table below. It should be noted that in every available record the registration date of the disputed domain name is given as April 3, 2012.

Whois or screenshot record date	Registrant	Registrar	Domain expiration date	Screenshot content (as far as discernable from thumbnail(s))
September 14, 2015				South32 An independent thriller focusing on bullying in America [...] Executive producer: Luigi Bian

October 6, 2015	Registration Private, Domains By Proxy, LL	GoDaddy.com, LLC	April 3, 2019	
June 2, 2018				South32 Established March 2012 [image of a clapperboard] Rent Buy Watch trailer
December 7, 2018	Registration Private, Domains By Proxy, LL	GoDaddy.com, LLC	April 3, 2021	
May 25, 2019				South32 cash reward for locating an Australian/his company. Noting CEO South32.com as Luigi Bian.
October 16, 2019	Registration Private, Domains By Proxy, LL	GoDaddy.com, LLC	April 3, 2021	
May 17, 2020				Content apparently referencing and critical of the Complainant.
May 30, 2020	Registration Private, Domains By Proxy, LL	GoDaddy.com, LLC	April 3, 2021	
November 11, 2020	Privacy.co.com – 29338, Jewella Privacy LLC Privacy ID# 1228614	Sea Wasp, LLC	April 3, 2025	
November 18, 2020				South32.com is almost here [...] DreamHost
July 7, 2021	Jewella Privacy – 29338, Jewella Privacy LLC Privacy ID# 1228614	Sea Wasp, LLC	April 3, 2025	
August 4, 2021				South32 suing BHP.com Lawsuit
September 17, 2021	Jewella Privacy – 29338, Jewella Privacy LLC Privacy ID# 1228614	Sea Wasp, LLC	April 3, 2025	

September 29, 2021	Jewella Privacy – 29338, Jewella Privacy LLC Privacy ID# 1228614	Sea Wasp, LLC	April 3, 2025	
May 18, 2022	Jewella Privacy – 29338, Jewella Privacy LLC Privacy ID# 1228614	Sea Wasp, LLC	April 3, 2025	
February 9, 2023				Current content critical of the Complainant and others.
February 15, 2023	Jewella Privacy – 29338, Jewella Privacy LLC Privacy ID# 1228614	Sea Wasp, LLC	April 3, 2030	

It should be noted that the registrar details and expiration date of the disputed domain name are broadly consistent with the second and third invoices provided by the Respondent.

5. Parties' Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The disputed domain name is confusingly similar to the Complainant's SOUTH32 trademark, which has become one of Australia's and the world's leading mining industry brands. Consumers viewing the disputed domain name are likely to expect an association with the Complainant and its mark in light of the similarity. The Top-Level Domain ("TLD") does not affect the confusing similarity assessment.

Rights or legitimate interests

The Respondent has not been commonly known by the disputed domain name at any time and the Complainant is not aware of any similar or identical trademarks in which the Respondent may have rights. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. Use of a domain name for free speech purposes may in principle support a claim to a legitimate interest, the Respondent's use of the disputed domain name to criticize the Complainant, the mining industry in general and other companies trading in the mining industry, does not amount to criticism which is fair use for the purposes of the Policy. It is not genuine, informed or reasonable criticism but is misleading, offensive and inflammatory in nature. It is not limited to the Complainant but targets the industry in general and other companies trading therein.

Use of a domain name consisting of one company's trademark cannot be fair use if the website criticizes unrelated companies or the industry as a whole. Use of the Respondent's website to publish comments falsely attributed to senior management of the Complainant amounts to an unfair and unreasonable

impersonation of the Complainant, and will mislead consumers. Use of the Respondent's website to publish offensive content precludes fair use as it is not legitimate or fair criticism of the Complainant. A number of panels have found that a right to legitimate criticism does not necessarily extend to registering or using a domain name which is identical to a particular trademark, including because this will create an impermissible risk of user confusion through impersonation. Internet users will naturally expect the Respondent's website to be operated by the Complainant and the disputed domain name does not include words which identify it as resolving to a criticism website or one not operated by the Complainant. The misrepresentation inherent in the disputed domain name is unavoidable. The Respondent can only be intending to convey a false association with the Complainant in order to divert internet users to the Respondent's website.

Registered and used in bad faith

Use of a domain name featuring one company's trademark for the purpose of criticizing any particular industry, or third parties, amounts to bad faith, especially as the Respondent is impersonating the Complainant. This is intended to disrupt and harm the Complainant's business. Any delay in bringing the Complaint does not preclude a finding of registration and use in bad faith as concepts such as laches do not apply in UDRP disputes. If the Respondent were to continue use of the disputed domain name, there is a high risk of future consumer confusion, and it is highly unlikely that any delay has had a material effect on the issue of the Respondent's rights or legitimate interests in the disputed domain name.

If the disputed domain name was registered before the Complainant acquired rights in its trademark this should not prevent it from succeeding in the Complaint as the remedies under the Policy are injunctive rather than compensatory in nature, with the aim of preventing ongoing or future confusion. The Whois history reveals that the registrant and registrar details have changed since the disputed domain name was registered, which indicates that the Respondent acquired the disputed domain name after the Complainant acquired rights in its SOUTH32 trademark. The Panel should consider the circumstances at the date the Respondent acquired and began using the disputed domain name. The changes of registrant and registrar establish a clear inference that the Respondent acquired the disputed domain name after the Complainant acquired rights in its mark and did so to cause confusion and disrupt the Complainant's business. It is likely that the Respondent knew of the Complainant's business and trademark when taking a transfer of the disputed domain name and took such transfer to target the Complainant's mark, given that the associated website clearly targets the Complainant.

B. Respondent

In summary, the Respondent contends as follows:

General

Neither Jewella Privacy nor Fabulous.com are owners of the disputed domain name. Jewella Privacy is a registrant privacy company and Fabulous.com is a hosting company. The true owner of the disputed domain name since 2012 has been Luigi Bian (formerly known as Kari Bian prior to a name change). It is not true that the Respondent acquired the disputed domain name after 2015 when the Complainant registered its trademark. The Complaint being based upon that claim, it must fail.

The Respondent owns a film company which is itself trademarked. It operates under the name "South32" and has continuously used the disputed domain name since 2012 to advance its endeavors. The Respondent has not allowed the Complainant to take over the disputed domain name and has been subject to a campaign of harassment in consequence. The Complainant failed to do due diligence before applying for its trademark. The Respondent had considerable success in the film industry and a significant Internet presence including page one ranking on a Google search before the Complainant attempted to obtain the disputed domain name and created its own "South32" content. The Respondent has lost millions in revenue and began using the disputed domain name to inform the world of the Complainant's actions. The Complainant was not the first to have an established trademark in the term.

Identical or confusingly similar

There is similarity but the Respondent has shown that its rights were first in time.

Rights or legitimate interests

The Respondent registered and operated the disputed domain name for three years before the Complainant's company was named. There is no indication prior to 2014 that the name was being considered by the Complainant's corporate group. Prior to this, the Respondent had done business in the film industry and produced significant works with award winning actors. The Complainant is infringing the Respondent's rights. There is evidence of the Respondent's use of the disputed domain name in connection with a *bona fide* offering of goods and services, to produce films in the movie industry, as evidenced by the registration date. The Respondent is commonly known by the disputed domain name. The Respondent is making a legitimate noncommercial or fair use of the disputed domain name. The Parties are not in the same industry and there could be no misleading attraction of their respective customers.

Registered and used in bad faith

The Complainant cannot establish any of the provisions of paragraph 4(b) of the Policy as the disputed domain name was registered three years before the Complainant existed.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (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.

A. Identical or Confusingly Similar

The first element of the Policy is usually addressed in two parts. First, the Complainant must show that it has UDRP-relevant rights in a trademark, whether registered or unregistered. Secondly, the Panel compares any such trademark to the disputed domain name (usually excluding the TLD as this is required for technical reasons only). The comparison typically proceeds on a straightforward side-by-side basis. If the trademark is recognizable in the disputed domain name, confusing similarity is generally found. If the trademark is alphanumerically identical to the disputed domain name, identity is usually found.

The first element operates as a threshold issue to determine whether the complainant has standing and a *bona fide* basis for the complaint. Issues such as the respondent's own rights in the domain name concerned, if any, are considered under the second and third elements.

In the present case, the Panel is satisfied that the Complainant has rights in its SOUTH32 trademark as described in the Factual Background Section above. Turning to the comparison exercise, on the basis described above, it may be seen that this is alphanumerically identical to the disputed domain name. This point is conceded by the Respondent, correctly, in the Panel's view. The fact that the Respondent may have registered the disputed domain name before the Complainant's rights came into being is not a matter for this particular element of the Policy.

In all of these circumstances, the Panel finds that the disputed domain name is identical to a trademark in

which the Complainant has rights and thus that the Complainant has carried its burden with regard to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The requirements of paragraph 4(a) of the Policy are conjunctive. A consequence of this is that failure on the part of a complainant to demonstrate one element of the Policy will result in failure of the complaint in its entirety. Accordingly, in light of the Panel's finding in connection with registration and use in bad faith, discussed below, it is unnecessary for the Panel to address the issue of the Respondent's rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the Complainant to demonstrate that the disputed domain name has been registered in bad faith, and that it is being used in bad faith. These two requirements are conjunctive and each must be proved, on the balance of probabilities, if the Complainant is to carry its burden in connection with the third element of the Policy. Generally speaking, in order to prove registration in bad faith, the Complainant must show that the Respondent registered the disputed domain name with the Complainant's rights in mind and with intent to target these unfairly. The Complainant may show any of the non-exclusive circumstances outlined in paragraph 4(b) of the Policy, which may be evidence of registration and use in bad faith, or it may show that other *indicia* of bad faith are present.

Where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent (see section 3.8.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")), although, in the event that the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith (see section 3.8.2 of the [WIPO Overview 3.0](#)). While a renewal of a domain name in the hands of the respondent will not reset the time at which registration in bad faith should be assessed, the position is different if the domain name has been transferred from a third party to the respondent (see section 3.9 of the [WIPO Overview 3.0](#)) when registration in bad faith would be tested as at the date of the respondent's acquisition.

Here, both Parties are clear that the original registration date of the disputed domain name predates the coming into existence of the Complainant's rights. Given this fact, the Complainant speculates that the Respondent must have acquired the disputed domain name from a third party at some point thereafter, albeit that it does not identify any point at which its trademark rights were "nascent" within the meaning of section 3.8.2 of the [WIPO Overview 3.0](#).

The only evidence produced by the Complainant in support of an alleged subsequent acquisition is its selected historic Whois records dating back to 2015. The Panel has reproduced the salient details in the factual background section above. There is a change of registrar from GoDaddy.com LLC to Sea Wasp, LLC, between May 20, 2020 and November 11, 2020 accompanied by a change of privacy service, and it is this upon which the Complainant focuses as a potential acquisition date. The period before and after this registrar change is reflected in the second and third invoices relating to the disputed domain name produced by the Respondent. The second invoice dates from January 28, 2015. The third invoice dates from November 9, 2020. In terms of any potential transfer of registrant, it may be seen that both documents are addressed to a person by the surname of "Bian", albeit "Kari Bian" in the first place and "Luigi Bian" in the second. They each reference an address in Malibu, California within the same zip code. They each list an entity named "Losangelesnews.com incorporated" in the address field. The dates are consistent with the renewal dates of the disputed domain name. The second invoice (registrar: GoDaddy.com LLC) of January 28, 2015, is consistent with a transfer between registrars and a renewal effected ahead of the anticipated expiration of the original period of registration on April 3, 2015. The third invoice (registrar: Fabulous.com/Sea Wasp, LLC) of November 9, 2020, is consistent with the Complainant's historic Whois entry of two days later.

In determining whether there is an unbroken chain of possession here or a transfer of the disputed domain name between unconnected registrants, there are three evident anomalies in the invoices. First, there is the fact that there are two different first names for the person named "Bian". The Respondent says that it changed its name from "Kari Bian" to "Luigi Bian" in the intervening period but provides nothing to evidence this. Secondly, the entity named "Losangelesnews.com incorporated", while common to both invoices, is never discussed by the Respondent. It is possible that this might refer to the Respondent's film company, which allegedly has operated the disputed domain name since 2012, although this seems at least from the current registrant name to be "South32". In any case, the Respondent itself does not offer any explanation for the presence of this entity despite it being listed on both invoices. Thirdly, there is the fact that the current registrant of the disputed domain name is neither of the Bians nor "Losangelesnews.com incorporated" but rather "South32", or "South32 is a trademarked film company", which has the same address and telephone number as that shown on the third invoice. That said, an earlier link to a film company is demonstrated by the screenshots of September 14, 2015, and June 2, 2018, in the Complainant's historic Whois report.

Despite the lack of explanation from the Respondent, the Panel has reached the view that these anomalies are minor in nature and not fatal to the Respondent's position. The common features between the two invoices, together with the fact that they are self-evidently in the Respondent's possession, suggest to the Panel on the balance of probabilities that they were received by the Respondent in its capacity as the registrant of the disputed domain name at the relevant dates. Even if "Kari Bian" and "Luigi Bian" were different people, they are tied to a similar address and to the consistently named entity "Losangelesnews.com incorporated". Equally, "South32", or "South32 is a trademarked film company" is tied to the same address and telephone number as Luigi Bian in the third invoice. Finally, it should be noted that the names on invoices may not necessarily be an accurate reflection of the registrant name at any time and may possibly reflect the name of a billing contact instead. All of this is sufficient in the Panel's view to constitute satisfactory evidence of an unbroken chain of possession with, at most, merely "formal" changes or updates to registrant contact information (see section 3.9 of the [WIPO Overview 3.0](#)). There is nothing in this history to suggest, as the Complainant speculates, that there has been any transfer of the disputed domain name from an independent third party to the Respondent sufficient to reset the clock for the purposes of assessing registration in bad faith.

The Respondent's history of possession of the disputed domain name thus far takes the Panel back to early 2015. On one view, this would be enough for the Respondent to succeed as the Complainant itself asserts that it was not launched until May of that year. However, the Respondent has pointed out that the Complainant's intended name was public knowledge from December 2014. As such, it might be thought that the Complainant or its predecessor may have had nascent trademark rights from that date, albeit that the only evidence of this is an Australian newspaper report which the Respondent, based in Malibu, California, United States, may not necessarily have been expected to see.

For completeness, the Panel will take the history back before 2015 by reviewing the Respondent's first invoice, bearing to be a communication from the registrar on the first registration of the disputed domain name in April 2012. This document is not exactly conclusive of the identity of the original registrant, given that it is only addressed to "South32", though it is possible for the Respondent to argue that this is a direct match for the registrant name field of the Respondent as matters stand today. There is no evidence that the first invoice was sent to an email address associated with the Respondent, as those details have not been included on the print provided to the Panel. That said, the document is in the Respondent's possession and the Panel must remind itself that the fact that the Respondent holds it is consistent with the Respondent being the original registrant of the disputed domain name.

Added to this must be the fact that the second invoice produced by the Respondent is broadly consistent with the Respondent having registered the disputed domain name for three years in 2012 and then effected a registrar transfer and a renewal in the run up to the initial expiration of the disputed domain name, estimated by the Panel to be April 3, 2015. Likewise, while circumstantial at best, it must be noted taking the three invoices as a whole that the disputed domain name began life sponsored by Fabulous.com as the registrar, moved to GoDaddy.com LLC for a period, and then finally returned to Fabulous.com (being the

Registrar, Sea Wasp, LLC). This provides a further, albeit modest, link between the original period of registration and the position today. It is possible that there might be something that would contradict these apparent links contained in the earlier parts of the Complainant's historic Whois report. However, if that were the case, it would be reasonable to expect the Complainant to have produced it. It is also possible that there might be something that would contradict the position by way of historic content on the Internet Archive "Wayback Machine" but neither of the Parties have produced any corresponding screenshots from the relevant period.

In all of these circumstances, the Panel considers that it is reasonable on the basis of the present record for it to find on the balance of probabilities that the Respondent is indeed the original registrant of the disputed domain name. Given that finding, there can be no suggestion that the Respondent registered the disputed domain name in the knowledge of the Complainant's rights and with intent to target these, since they were not in existence at the material date, nor could they be said to be "nascent" or capable of anticipation by the Respondent in any way. Having reached that conclusion, the Panel notes for completeness that it rejects the Complainant's argument that such a finding should not prevent it from succeeding in the Complaint due to the nature of the remedies under the Policy. In the Panel's view, the wording of the Policy is plain, calling for registration in bad faith, and the onus of proving this falls upon the Complainant. Registration in bad faith means bad faith at the point of registration, and not at any later date.

Given the conjunctive requirement of proving both registration and use in bad faith, the Complaint must fail and the question of use in bad faith is moot. Accordingly, the Complainant has failed to carry its burden in respect of paragraph 4(a)(iii) of the Policy and the Complaint fails.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/
Andrew D. S. Lothian
Presiding Panelist

/Nicholas Smith/
Nicholas Smith
Panelist

/Mohamed-Hossam Loutfi/
Mohamed-Hossam Loutfi
Panelist

Date: June 29, 2023