Decision for dispute CAC-UDRP-101956

Case number	CAC-UDRP-101956
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Domain names	RICOH360.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Ricoh Company, Ltd.

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Organization	GlobalVision Communication

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant relies on the following trademark registrations:

- American trademark RICOH, no. 0657420, registered on January 21, 1958;
- Swiss trademark RICOH, no. 2P-302723, registered on February 29, 1980;
- European trademark RICOH, no. 000227199, registered on July 12, 1999;
- Japanese trademark RICOH COMPANY LTD., no. 0000637081, registered on February 19, 1964.

Only the Swiss and European trademarks could be verified. They are sufficient to establish the Complainant's prior rights.

The Complainant contends that it owns and maintains the following domain names which resolve to its official websites, which are dedicated to its products and services:

- <ricoh.com>;
- <theta360.com>

Respondent alleges to be the registrant of the domain name <globalvision360.com>, without providing any evidence.

FACTUAL BACKGROUND

The disputed domain name was registered on November 6, 2015. It is currently “parked”.

The Respondent is GlobalVision Communication. It is domiciled in Switzerland.

The Complainant, Ricoh Company, Ltd, is a Japanese multinational imaging and electronics company, offering technology products. Ricoh currently employs over 100,000 people worldwide and provides products and services around the globe, including in Switzerland.

The Complainant is the manufacturer of a “360 degree” compact digital camera called “RICOH THETA”, which takes 360-degree pictures. The first version of its product was revealed to the public in 2013, 2 years before the disputed domain name was registered. This innovative 360-degree technology has earned many awards.

The Complainant has invested to promote RICOH trademark around the world and asserts that it’s well-known. The RICOH trademark dates back to 1946 and was first used in commerce in the United States as early as 1958.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name entirely reproduces the RICOH trademark, merely adding the “360” number.

The Complainant relies on the prior UDRP decisions SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L., WIPO Case No. D2008-0792 and Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525, that considered that the incorporation of a well-known trademark within a domain name is a sufficient proof of confusing similarity.

The Complainant contends that the addition of a number does not avoid the confusing similarity. it relies on several decisions, including Instagram, LLC v. Perfect Priva"cy, LLC and Lo Tim Fu, WIPO Case No. D2017-1951 about the domain name <instagram-360.com> or Facebook, Inc. v. Domain Admin, Privacy Protection Service Inc. d/b/a PrivacyProtect.org / Ông Trần Huỳnh Lâm, WIPO Case No. D2016-0771 about the domain name <facebook360.com>.

The number 360 does not provide any distinctiveness. It refers to Complainant’s product which shoots photos and videos in a 360 degree panorama from the point of shooting.

RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

The disputed domain name is using to direct Internet users to a parking page that links to multiple third-party websites which advertise competing products. According to many prior UDRP decisions, like Donald J. Trump v. Mediaking LLC d/b/a Mediaking Corporation and Aaftek Domain Corp., WIPO Case No. D2010-1404, this redirection does not constitute a bona fide offering of goods and services.

According to prior UDRP decision Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright, WIPO Case No.

D2007-0267, “it is of no consequence whether Respondent is responsible for the content of the website when it is parked”.

The Respondent is not commonly known by the disputed domain name. Indeed, the Whois record indicates the name “GlobalVision Communication”.

The Complainant relies on the prior UDRP decision Lardi Ltd v. Belize Domain WHOIS Service Lt, WIPO Case No. D2010-1437 to prove that the redirection of Internet users to a parking website does not constitute a legitimate or non-commercial fair use. It is not established that demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods and services have been made.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

Bad faith registration

Complainant’s trademark rights date back to 1946. Since that time Complainant has expended substantial amounts of time and effort to ensure that consumers associate the RICOH trademark with Ricoh and its products and services. As a result of such efforts, the RICOH mark has achieved international fame.

It would be inconceivable to imagine that Respondent was unaware of Complainant’s rights upon registering the disputed domain name.

In any case, Respondent had a duty to ensure that the registration of the disputed domain name would not infringe a third party’s rights. Complainant relies on the prior decision Collegetown Relocation, L.L.C. v. John Mamminga, NAF Case FA 95003 which provides that “[w]hen registering domain names, the respondent has a duty to investigate and refrain from using a domain name that infringes on a third-party’s rights”. Had Respondent performed a simple Google search, it would have been presented with numerous search results relating and/or referring to Complainant and the existence of Complainant’s rights in the RICOH mark.

Bad faith use

The use of a confusingly similar domain name to direct internet users to a parking page constitutes bad faith where the “registrant is using the domain name in this manner because of its similarity to a mark . . . in the hope and expectation that the similarity would lead to confusion on the part of Internet users and result in an increased number of Internet users being drawn to that domain name parking page . . .”. Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364.

The Complainant contends that it does not matter if consumers are really confused about the source once they access to the litigious website, according to the prior UDRP decision Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364.

The Complainant relies on the prior UDRP decision Twiflex Limited v. Industrial Clutch Parts Ltd, WIPO Case D2000-1006 deciding that the use of an identical or confusingly similar domain to promote third party competing products, services and websites that compete with those of Complainant can only be construed as an effort to disrupt Complainant’s business.

The Complainant relies on Paragraph 4(b)(iv) of the Policy “by using the domain name, [the registrant has] intentionally attempted to attract, for commercial gain, Internet users to [its] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [registrant’s] web site or location or of a product or service on [registrant’s] web site or location.”

RESPONDENT:

IDENTICAL OR CONFUSINGLY SIMILAR

Respondent's intention is to emphasize on the content that is intended to be put online, which shows 360° images. This type of image can possibly made by RICOH cameras.

The Respondent contends that adding "360°" suffix is enough to differentiate the disputed domain name from the RICOH trademark and to dissipate doubt in the mind of the users.

The term "RICOH" is understood as a generic term.

The absence of confusion is reinforced by the non-commercial nature of Respondent's content.

RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

The Respondent explains that it intended to provide a content that would be similar to a "fanpage". it wants to display use-cases and images captured with 360° cameras, made by the Complainant. The disputed domain name is parked because the Respondent is unable to complete this project.

In consequence, "ricoh360" is a descriptive way to name its website. It does not divert or put prejudice on the Compalainant.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

The disputed domain name is not active. It never hosted any public content and such was simply kept parked be the registrar.

The Respondent contends that the disputed domain name was never offered for sale on public platforms. As the holder of the disputed domain name, it never contact the Complainant to try to get financial gain.

The Respondent claims to have kept the original registrar parking page, without any modification or gain.

The Respondent alleges to have registered the disputed domain name in good faith and with the intention to emphasize on the 360° aspect. It explains that it never used the disputed domain name for commercially-minded initiative and that it did not gain any dime from any possible advertisement shown by the registrar on the parking page. It just wanted to share its passion, using what it considers to be a generic term to describe 360°cameras.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

The Complainant is the owner of the RICOH trademark, having registrations in Switzerland and the European Union.
It did not produce an updated official copy of the American trademark and the copy of the Japanese trademark registration is not translated in the language of the procedure.

The disputed domain name directly and entirely incorporates the Complainant's RICOH trademark. The most distinctive part of the disputed domain name is "Ricoh", which is identical to the RICOH registered trademark.

The addition of the number "360" is in direct relation with the cameras designated under the RICOH trademark, which are "360 degree" compact digital camera, taking 360-degree pictures. The addition of the suffix "-360" does not operate to distinguish the disputed domain name from the RICOH trademark in any significant way.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in

respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

"Any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii) of the Policy:

(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 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." (Policy, paragraph 4(c))

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the disputed domain name or to seek the registration of any domain name incorporating the RICOH trademark. There is no evidence that the Respondent is commonly known by the disputed domain name or any similar name. There is no evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services or for a legitimate non-commercial use.

The combination of “ricoh” and “360” emphazises the connection between the disputed domain name and the RICOH trademark.

The disputed domain name is using to direct Internet users to a parking page that links to multiple third-party websites which advertise competing products. Such redirection does not constitute a legitimate fair use. The Respondent is liable for the use of the disputed domain name.

The Respondent merely alleges that it wanted to create a website for fans of 360° cameras, but does not prove it. It also alleges that it did not make any commercial gain, what cannot be true, since the disputed domain name is parked and generates pay per click revenues.

The disputed domain name is parked and necessarily generates profits for the Respondent. Thus, there is no non-commercial fair use.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name's registration to the Complainant who is the owner of the trade mark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the disputed domain name; or

(ii) The Respondent has registered the disputed domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of

such conduct; or

(iii) The Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

Bad faith registration

The Respondent contends to make a generic use of the Complainant's trademark to promote its products. Thus, its reveals its knowledge of the Complainant's trademark RICOH.

Moreover, the disputed domain name is offered for sale on the available parking landing page.
The Respondent was aware of the Complainant and its reputation in the RICOH Mark at the time of the disputed domain name was registered.

Therefore, the Panel finds that the disputed domain name was registered in bad faith, for the purpose to sell it and to take advantage of the reputation of the RICOH trademark.

Bad faith use

The Respondent parked the disputed domain name to resolve to a website that provides links to multiple third-party websites which advertise competing products. Thus, contrary to the Respondent's allegations, a commercial content is available, that disturbs the Complainant's business operations. The Respondent is responsible for that content, even if the parking website is operated by the registrar.

Therefore the Panel finds that "by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location".

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain name is composed with the Complainant's RICOH trademark. It resolves to a parking page that links to multiple third-party websites which advertise competing products. It's offered for sale on this parking page. The Respondent has no rights or legitimate interests to use the term "ricoh". It was well aware of the RICOH trademark when it registered the disputed domain name. Its use of the disputed domain name generates profits for the Respondent and disturbs the Complainant's business operations.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **RICOH360.COM**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2018-05-29

Publish the Decision