Decision for dispute CAC-UDRP-102607

Case number	CAC-UDRP-102607
Time of filing	2019-08-05 10:16:31
Domain names	ricohelemex.com

Case administrator

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

Complainant

Organization	Ricoh Company, Ltd.

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Name	Hu He

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.The Complainant is the owner, inter alia, of the following trademark registrations consisting of or comprising RICOH and RICOH ELEMEX:

IDENTIFICATION OF RIGHTS

The Complainant is the owner, inter alia, of the following trademark registrations consisting of or comprising RICOH and RICOH ELEMEX:

- United States trademark registration No. 0657420 for RICOH (word mark), filed on November 16, 1956 and registered on January 21, 1958, in International class 9;

- Chinese trademark registration No. 175270 for RICOH (figurative mark), filed on March 15, 1982 and registered on April 15, 1983, in class 9;

- Japanese trademark registration No. 0003234274 for RICOH ELEMEX (figurative mark), filed on September 29, 1992 and registered on December 25, 1996, in class 37;

- European Union trademark registration No. 000227199 for RICOH (figurative mark), filed on April 1, 1996 and registered on

July 12, 1999, in classes 1, 2, 7, 9 and 16;

- Korean trademark registration No. 4004820220000 for RICOH ELEMEX (figurative mark), filed on April 28, 2010 and registered on August 26, 2010, in classes 9 and 11.

FACTUAL BACKGROUND

The Complainant is a Japanese multinational imaging and electronics company offering a full range of technology products, solutions, and services for commercial and personal use including general office equipment and services, such as printers, scanners, computers, network equipment, software support, and other related services; commercial printing products and services; industrial printing equipment and systems; digital cameras for personal and industrial use; thermal media; and, other optical equipment and electronic components.

The Complainant currently employs over 100,000 people worldwide and provides products and services around the globe, including in China, where the Complainant owns the company Ricoh China Co. Ltd.

The Complainant owns a further number of companies which are collectively referred to as the “Ricoh Group” of companies. The Ricoh Group of companies includes Ricoh China Co. Ltd. and Ricoh Elemex Corporation (“REC”), which was established in 1938.

The Complainant has continuously used the RICOH trademark in global commerce since at least 1946. Since that time, the Complainant has registered the RICOH trademark in numerous jurisdictions throughout the world, including but not limited to the United States, the European Union, and Japan. The Complainant also owns trademark registrations for RICOH ELEMEX in Japan and Korea.

The Complainant’s primary company website can be found at the Complainant’s domain name <ricoh.com>, registered on September 23, 1997, while the Complainant’s Chinese website is published at the domain name <ricoh.com.cn>, registered on October 31, 2000.

REC engages in developing a wide range of products based on its high-precision manufacturing technology. REC’s website can be found at <ricohelemex.co.jp>.

The disputed domain name <ricohelemex.com> was registered on April 13, 2019 and redirects to a Chinese parking page that consists of a list of banner-type ads linking to different websites, such as online games, casino and pornography.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name <ricohelemex.com> is confusingly similar to the trademarks RICHO and RICHO ELEMEX in which the Complainant has rights.

The Complainant also states that the Respondent has no rights or legitimate interests in the disputed domain name since the Respondent i) is not commonly known by the disputed domain name, ii) is not affiliated with nor authorized by the Complainant in any way, iii) has not been granted by the Complainant any license or authorization to use the Complainant’s trademarks or apply for registration of the disputed domain name.

The Complainant asserts that the Respondent is not making a bona fide use or legitimate non-commercial or fair use of the disputed domain name since its registration, as the disputed domain name redirects to a parking page containing a list of banner-type ads linking to different websites, such as online games, casino and pornography.

The Complainant further states that the Respondent deliberately registered the disputed domain name using the Complainant's trademarks, to purposely cause confusion to Internet users who land on the parking page, with the sole aim of profiting from the renown of the RICOH AND RICOH ELEMEX marks and brands, thus clearly acting in bad faith whilst also giving the impression of being in some way affiliated to the Complainant.

Moreover, the Complainant asserts that it has exclusive use of the RICOH and RICOH ELEMEX trademarks, and that its rights predate any registration or use of the disputed domain name by the Respondent by some 61 years. Therefore, the Complainant argues that the Respondent was well aware of the Complainant's rights upon registering the disputed domain name, further evidencing the Respondent's bad faith in registering the disputed domain name.

RESPONDENT:

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

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).

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).

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).

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

1. The Panel finds that the disputed domain name is confusingly similar to the Complainant's figurative trademark RICOH ELEMEX, as it includes the dominant part of the Complainant's trademark, constituted by the denominative elements "Ricoh Elemex", with the mere addition of the Top-Level domain ".com". As stated in a number of prior decisions rendered under the UDRP, these minor changes are not sufficient to exclude the likelihood of confusion. Moreover, the disputed domain name is also confusingly similar to the Complainant's word trademark RICOH, since such trademark is entirely reproduced as prefix in the disputed domain name.

2. The Complainant stated that the Respondent is not affiliated with or authorized by the Complainant in any way. There is no evidence of the fact that the Respondent might have been commonly known by the disputed domain name or by a name corresponding to the disputed domain name. According to the evidence on records, the Respondent has redirected the disputed domain name to a parking page containing a list of banner-type ads linking to different websites, such as online games, casino, pornography, showing that the Respondent did not make use, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, or that it has made a legitimate non-commercial or fair use of the disputed domain name. Therefore, and in the absence of a Response, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name.

3. As to the bad faith at the time of the registration, the Panel finds that, in light of the distinctiveness of the Complainant's trademarks, with which the disputed domain name is confusingly similar, and of the prior registration and use of the

trademarks RICOH and RICOH ELEMEX by the Complainant, the Respondent was very likely aware of the Complainant's trademarks at the time of the registration of the disputed domain name.

Furthermore, the Panel finds that, in light of the use of the disputed domain name in connection with a parking page with sponsored banners, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its website, by causing a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **RICOHELEMEX.COM**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2019-08-29

Publish the Decision