Decision for dispute CAC-UDRP-102700

Case number	CAC-UDRP-102700
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Domain names	RICOH.NET

Case administrator

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

Complainant

Organization	Ricoh Company, Ltd.

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Name	qi hao qiu

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of the following trade marks:
1. US word trade mark for RICOH registered under number 0657420 which covers photographic cameras and accessories in class 26 (international class 9). This trade mark was registered on the 21 January 1958;

2. European figurative trade mark for RICOH registered under number 000227199 which covers printing in classes 1, 2, 7, 9, 16. This trade mark was registered on the 12 July 1999; and

3. Chinese figurative trade mark for RICOH and a Chinese translation of RICOH registered under number 175270 which covers Copying machine, Computing device, Printer, Movie instrument, Computer and peripheral, Equipment, Word processor, Billing machine, Counting machine and Cash register in classes 0900, 0901 and 0902. This trade mark was registered on the 15 April 2015.

The Complainant has used the RICOH mark in global business since in or around 1946 and operates its main company website at <ricoh.com>.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

I. Introduction

This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy), approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), approved by ICANN on September 28, 2013, and in effect as of July 31, 2015, and the UDRP Supplemental Rules for the Czech Arbitration Court (the Supplemental Rules) in effect as of the date of this filing.

II. The Parties

A. The Complainant

The Complainant in this administrative proceeding is Ricoh Company, Ltd.

B. The Respondent

According to the concerned registrar's Whois database, the respondent in this administrative proceeding is "qi hao qiu". A copy of the current Whois database records for the Disputed Domain was provided as an annex to the Complaint.

III. The Domain Name and Registrar

This dispute concerns the domain name identified below ("Disputed Domain"): RICOH.NET

The registration service provider with which the domain names are registered is: DropCatch.com 694 LLC

IV. Language of Proceedings

The language of both the Namebright Terms of Service and Namebright Dispute Policy are in English, a copy of which is provided as an annex to this Complaint, and can be found at https://www.namebright.com/ and https://www.namebright.com/

V. Jurisdictional Basis for the Administrative Proceeding

This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The Dispute Policy, pursuant to which the Disputed Domain is registered, incorporates the Policy.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant asserts it has registered rights in the US word trade mark; the EU figurative trade mark and the Chinese figurative trade mark for RICOH described above. It explains that it first used RICOH in commerce in the United States in 1946. It further explains that its brand has gained substantial renown worldwide through global use of the RICOH brand. It submits that the disputed domain name is identical or confusingly similar to its trade marks.

The Complainant submits that providing evidence of ownership of a valid trade mark satisfies the threshold for the purposes of filing a UDRP case. It notes that its numerous trade mark registrations for RICOH establish its prior rights pursuant to paragraph 4(a)(i) of the Policy in accordance with the findings in F. Hoffmann-La Roche AG v. Relish Enterprises, WIPO Case No. D2007-1629.

The Complainant refers to Research in Motion Limited v. One Star Global LLC, WIPO Case No. D2009-0227 wherein it was held that the threshold for establishing confusing similarity is low. In Research in Motion Limited the Complainant notes that only a "simple comparison of the mark relied upon with the domain name in issue" is required to show confusing similarity. It also refers to Ricoh Company, Ltd. v. Hu He, CAC Case No. 102607 which further supports this contention, wherein it was found 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"".

The Complainant notes that the incorporation of a well-known trademark within a domain name alone is sufficient to meet the confusing similarity requirement. In support of this point, it refers to SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L., WIPO Case No. D2008-0792 where the Panel stated that "This similarity is established whenever a mark is incorporated in its entirety, regardless of other terms added to the domain name."

The Complainant refers to G. Bellentani 1821 S.p.A. v. Stanley Filoramo, WIPO Case No. D2003-0783 wherein it was found that "The gTLD ".net" has no significance when establishing whether or not a domain name is confusingly similar to a trade mark. Therefore, the Complainant explains that by adding the generic '.net' top-level domain name, the Respondent does not distinguish the disputed domain name from Complainant's RICOH mark. In respect of this point, it also relies on FC Bayern München AG v. Peoples Net Services Ltd., WIPO Case No. D2003-0464.

It follows the Complainant contends, that a simple comparison of the Complainant's marks and the disputed domain name shows they are confusingly similar and therefore, it has proved that it has established rights in RICOH within the meaning of 4(a)(i) of the Policy.

The Complainant refers to the decision in Accor v. Eren Atesmen, WIPO Case No. D2009-0701 and claims that once it has proved a prima facie case, the burden of proof shifts, and it is up to the Respondent to demonstrate its right or legitimate interest in the disputed domain name by providing relevant information. In support of this assertion, the Complainant also refers to Mile, Inc. v. Michael Burg, WIPO Case No. D2010-2011.

The Complainant claims that it is clear that the Respondent has no rights or legitimate interest in the disputed domain name, the Respondent registered the disputed domain name decades after the Complainant registered its trade marks. The Complainant refers to the screenshot of <ricoh.net> as evidence that the Respondent is using the disputed domain name to direct Internet users to a pay-per-click page which advertises and provides links to online casinos and other gambling websites and adult content.

The Complainant submits that the Panel may consider paragraph 4(c) of the policy when assessing whether a respondent has a right or legitimate interest in a disputed domain name. In respect of 4(c)(i), the Complainant asserts that the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services. Referring to Paris Hilton v. Deepak Kumar, WIPO Case No. ibid, it explains that Panels have routinely found that use of a domain name that is confusingly similar to a complainant's mark to direct Internet users to a pay-per-click and/or parking page does not constitute a bona fide offering of goods and services. In support of this argument, the Complainant relies on the findings in cases Ricoh Company, Ltd. v. Hu He,ibid; Sanofi v. Farris Nawas, WIPO Case No. D2014-0705 and Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright, WIPO Case No. D2007-0267. Further it refers to the Panel's findings in Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright, WIPO Case No. D2007-0267 wherein the Panel held that it does not matter if the respondent is not responsible for the content on the parking page.

Moreover, relying on the panel's findings in Manitoba Inc. v. W P, The Cloud Corp, WIPO Case No. D2018-1254; Speedo

Holdings B.V. v. Dave Evans, WIPO Case No. D2007-0911 and ABB Asea Brown Boveri Ltd. v. Quicknet, WIPO Case No. D2003-0215 the Complainant explains that use of a domain name that is confusingly similar to a complainant's mark for displaying adult content is not bona fide use.

In relation to 4 (c)(ii) the Complainant confirms that there is no evidence that the Respondent is commonly known by the disputed domain name. Referring to the Whois record, the Complainant explains that the Respondent is known as "qi hao qiu" and it finds no other evidence to show that the Respondent is commonly known by the disputed domain name. The Complainant relies on Braun Corp. v. Loney, FORUM Claim No. 699652 where it was found that the respondent was not commonly known by the disputed domain names where neither the Whois record or other recorded evidence indicated such use. It also relies on Ricoh Company, Ltd. v. Hu He, ibid to support this plea.

The Complainant notes that use of a domain name to redirect customers to a parking and/or pay-per-click website does not constitute a legitimate or non-commercial fair use in accordance with 4 (c)(iii). It refers to the findings in Lardi Ltd v. Belize Domain WHOIS Service Lt, WIPO Case No. D2010-1437 (WIPO Oct. 7, 2010); Ricoh Company, Ltd. v. Hu He, ibid; Paris Hilton v. Deepak Kumar, ibid; Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273 and Talk City, Inc. v. Michael Robertson, WIPO Case Number D2000-0000.

Moreover, the Complainant explains that use of the disputed domain name to display adult content does not amount to legitimate or non-commercial fair use. It refers to Downhole Technology, LLC v. Dharshinee Naidu, WIPO Case No. D2017-0817 where the Panel stated "that the Policy requires that any "legitimate noncommercial or fair use of the Domain Name, [to be] without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.". It also relies on the finding in Fibox Oy Ab v. Ville Muilu, WIPO Case No. D2007-1429.
The Complainant asserts that it has proved that the Respondent has neither rights nor legitimate interest in the disputed domain name. As a result, it explains the burden shifts to the Respondent to rebut the assertion. The Complainant states that the evidence strongly demonstrates that the Respondent lacks any rights or legitimate interest in the disputed domain name.

The Complainant explains that, by virtue of Paragraph 4(b)(iv) of the Policy, the Panel may make a finding that the Respondent has registered and used a domain name in bad faith "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."
Relying on the Panel's findings in Paris Hilton v. Deepak Kumar, ibid the Complainant explains that the use of a confusingly similar domain name to direct Internet users to a pay-per-click page is considered acting in bad faith. In support of this point, the Complainant refers to cases Lardi Ltd v. Belize Domain WHOIS Service Lt, WIPO Case No. D2010-1437; Ricoh Company, Ltd. v. Hu He, ibid; Sanofi v. Farris Nawas, WIPO Case No. D2014-0705 and Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273.

The Complainant further submits that the use of the disputed domain name to direct Internet users to a website that promotes gambling is proof of bad faith. In Ticketmaster Corporation v. Amjad Kausar, WIPO Case No. D2002-1018, the Complainant explains that the Panel held that "The series of links documented in the evidence and confirmed by the panelist on December 18, 2002, indicates that the Respondent not only is diverting those who inadvertently make typographical errors in their URLs to a competitor's web site but is also attempting to "mouse trap" them into gambling and other referral web sites.". It also relies on the Panel's decision in Geoffrey, Inc., v. Russian Baby, WIPO Case No. D2000-1010.
The Complainant submits that the Respondent registered the disputed domain name for commercial gain, in an effort to confuse consumers, and divert Internet traffic away from Complainant's websites. It explains that the Respondent seeks to profit from Internet users' confusion. The Complainant relies on the findings in Paris Hilton v. Deepak Kumar, ibid that it is irrelevant that when the Internet user arrives at the pay-per-click site it is no longer confused and that it then becomes clear to said user that the website is unconnected with the trade mark holder.

The Complainant states that a finding of bad faith can still be found even if the Respondent is not financially benefitting from the pay-per-click revenues. The Complainant referred to the finding in Express Scripts, Inc. v. Windgather Investments Ltd. /

Mr. Cartwright, WIPO Case No. D2007-0267 wherein the Panel states that paragraph 4(b)(iv) does not require that the owner of the disputed domain name earns revenue from the diversion.

The Complainant submits that the Respondent's use of the disputed domain name disrupts it business. As a result of the Respondent's activities, the Complainant may have to devote valuable resources to deal with inquiries which disrupts the Complainant's business and is further evidence of bad faith registration.

The Complainant asserts that the Respondent was or should have been aware of the Complainant's registered trade mark rights, in circumstances that the Complainant has expended resources on registering the RICOH trade mark and promoting its brand through advertising. The Complainant claims that the RICOH brand enjoys international renown. The Complainant relies on Ricoh Company, Ltd. v. Hu He, ibid wherein the Panel found that it would be inconceivable to imagine that Respondent was unaware of Complainant's rights upon registering the disputed domain name.

The Complainant argues that even if the Respondent was not aware of the Complainant's registered rights, it has a duty to ensure that its use of the disputed domain name would not infringe third-party rights. The Complainant relies on Collegetown Relocation, L.L.C. v. John Mamminga, FA 95003 to support this argument. The Complainant submits that had the Respondent carried out a basic Google search it would have discovered evidence of the Complainant's mark.

RIGHTS

The Complainant has established that it owns the RICOH word mark under number 0657420 registered in the United States on the 21 January 1958.

The Complainant's registered RICOH mark is wholly contained in the disputed domain name. In fact, the disputed domain name is identical to the disputed domain name apart from the addition of ".net". The ".net" top level domain name element is not material in these circumstances and does not function as a distinguisher.

Accordingly, the Panel finds that the disputed domain name is identical or confusingly similar to the trade mark for the purposes of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

There is no evidence to suggest that the Complainant has licensed or authorised the Respondent to use its RICOH mark or that the Respondent is commonly known by the disputed domain name or is using the website to which the disputed domain name resolves for a legitimate non commercial purpose.

Rather, the disputed domain name appears to being used without authorisation to re- direct Internet users to a pay-per-click page that advertises, and provides links to online casinos and other gambling websites. The Panel infers that this is for the Respondent's own commercial gain or for some other illegitimate purpose and in any event does not represent a bona fide use of the RICOH mark.

For these reasons the Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond or to rebut this case and for this reason and as set out below under "Bad Faith" the Panel finds that the Complainant succeeds under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has demonstrated that it owns registered trade mark rights in the RICOH mark as described above. The disputed domain name was registered on 24 June 2019 nearly seventy years after the Complainant's word mark RICOH was first used in the US in 1946. The Complainant correctly asserts that the Respondent was or should have been aware of the Complainant's registered rights, or at the very least should have conducted a basic Internet search. Considering the degree of distinctiveness of the RICOH mark and the degree of renown that attaches to it internationally as a result of long standing use, it seems to the Panel more likely than not that the Respondent was aware of the Complainant's mark when it registered

the disputed domain name.

In this case the Respondent has used the disputed domain name to divert Internet users to an unrelated pay-per-click site that appears to divert Internet users to a site that features links to casino and gaming sites provided by a range of companies. Under Paragraph 4(b)(iv) of the Policy it is evidence of registration and use in bad faith to attract internet users intentionally for commercial gain to your 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 your web site or location or of a product or service on your web site or location. It appears to the Panel that this is precisely the circumstance here and that absent any explanation from the Respondent it is more likely than not that the Respondent gains commercially from this arrangement. This is exactly the sort of cybersquatting activity that the Policy was intended to proscribe and accordingly, the Panel finds that the Complainant has demonstrated that the disputed domain name was registered and used in bad faith and the Complainant succeeds under 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

The Complainant owns registered trade mark rights for its RICOH mark. The disputed domain name wholly incorporates this mark and as a result the disputed domain name is identical or confusingly similar to the Complainant’s trade marks.

There is no evidence that the Respondent was permitted to use the Complainant’s RICOH trade mark and no evidence that it was making a bona fide or non-commercial use of the disputed domain name. It is no legitimate activity for the Respondent to use without authority the disputed domain name that wholly incorporates the Complainant’s very well-known mark to resolve to a pay-per-click parking page that diverts to a site featuring links to third party gaming sites.

The disputed domain name was registered after the first use of the RICOH mark in commerce in the US and after its trade marks were registered. The RICOH mark has an established worldwide reputation and is distinctive. As a result, it is likely that the disputed domain name was registered with prior knowledge of the Complainant’s mark. The use of the disputed domain name to resolve to a pay-per-click parking page supports a finding that the disputed domain name was registered and used in bad faith under paragraph 4(b) iv of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **RICOH.NET**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2019-11-11

Publish the Decision