Decision for dispute CAC-UDRP-103274

Case number	CAC-UDRP-103274
Time of filing	2020-09-09 08:59:17
Domain names	SAIYORICOH.NET

Case administrator

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

Complainant

Organization	Ricoh Company, Ltd

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Name	Bowen Liu

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

The reputation of "Ricoh" trademarks and domain names is self-evident and proved by the following evidences:

- Complainant´s trademarks;

Trademark: RICOH
Jurisdiction: United States
Reg. No.: 0657420
Reg. Date: 1958-01-21

Trademark: RICOH
Jurisdiction: European Union
Reg. No.: 000227199
Reg. Date: 1999-07-12

Trademark: RICOH

Jurisdiction: China
Reg. No.: 175270
Reg. Date: 1983-04-15

- Complainant´s domain names.

FACTUAL BACKGROUND

Ricoh Company, Ltd (“Ricoh” or “Complainant”) is a Japanese multinational imaging and electronics company, offering a full range of technology products, solutions, and services for commercial and personal use. Ricoh currently employs over 100,000 people worldwide and provides products and services around the globe. Product offerings include: general office equipment and services, including but not limited to, 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. Ricoh’s primary company website can be found at the domain <ricoh.com>.

Ricoh has continuously used the RICOH mark in global commerce since at least 1946 (“Complainant’s Mark”). Since that time, Ricoh has registered the RICOH mark in numerous jurisdictions throughout the world, including but not limited to the United States, the European Union, and China. Ricoh’s trademark registrations include, but are not limited to.

Respondent’s bad faith registration and use of the disputed domain name

The Whois information for the <saiyoricoh.net> domain name (the “Disputed Domain”) is masked by a privacy service and Respondent’s contact information is therefore unknown. The Disputed Domain was registered on or about April 28, 2020. Id.

The Disputed Domain redirects internet users to the domain name <se6902.com> and associated website, which appears to advertise, display and/or sell “adult content”.

No business relationship exists between the parties

Respondent does not have, and never has had, permission to use the RICOH trademark.

If a simple comparison is not enough, it is well established that the incorporation of a well-known trademark within a domain name (as is the case here) is alone enough to sustain a finding of confusing similarity. See e.g., SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L., Case No. D2008-0792 (WIPO Jul. 8, 2008) (finding the domain name myhostingfree.com to be confusingly similar to complainant’s MYHOSTING mark, stating, “This similarity is established whenever a mark is incorporated in its entirety, regardless of other terms added to the domain name.”); Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., Case No. D2000-1525 (WIPO Jan. 29, 2001) (finding confusing similarity between numerous “magnum”-formative domains and complainant’s MAGNUM trademark). Here, the Disputed Domain incorporates Complainant’s Mark in its entirety, merely adding the descriptive term ‘saiyo’ (the Japanese term for ‘recruiting’) and therefore cannot avoid a finding of confusing similarity.

Further, there is no question that merely adding the generic ‘.net’ top-level domain does nothing to distinguish the Disputed Domain from Complainant’s RICOH mark. See G. Bellentani 1821 S.p.A. v. Stanley Filoramo, Case No. D2003-0783 (WIPO Nov. 21, 2003) (“The gTLD ".net" is of no significance when determining whether or not a domain name is confusingly similar to a trademark or service mark. Accordingly, the Panel finds that the domain name at issue is confusingly similar to the Complainant’s registered trademarks.”); see also, e.g. FC Bayern München AG v. Peoples Net Services Ltd., Case No. D2003-0464 (WIPO July 15, 2003) (finding <bayernmuenchen.net> and <bayernmunchen.net> confusingly similar to FC BAYERN MÜNCHEN E.V without any discussion of the generic top-level domain); Robert Half International Inc. v. Henry Glickel / Sales Recruiters, Inc., FA1104001383463 (Forum May 24, 2011) (same).

Accordingly, a simple comparison of Complainant's Mark's and the Disputed Domain demonstrates that the two are confusingly similar. Therefore, Complainant has established the first element of the Policy under paragraph 4(a).

Respondent does not use, and has not used, the Disputed Domain in connection with a bona fide offering of goods or services.

Respondent is not commonly known by the Disputed Domain.

There is no evidence that Respondent is commonly known by the Disputed Domain.

Respondent does not use the Disputed Domain for any legitimate or noncommercial fair use.

Ricoh has met its burden to make a prima facie showing that the Respondent has no rights or legitimate interest in the Disputed Domain. As such, the burden shifts to the Respondent to rebut Complainant's showing. However, the evidence strongly demonstrates that Respondent lacks any rights or legitimate interest in the Disputed Domain and will be unable to establish its burden.

Here, Respondent registered the Disputed Domain in an effort to confuse consumers, and divert Internet traffic away from Complainant's <ricoh.com> and website for Respondent's own commercial gain. Respondent only stands to profit from the confusion of Internet users looking for Complainant's website. Such confusion is likely because consumers have commonly come to know and associate Complainant with Complainant's Mark and brand through Complainant's widespread exclusive use of the RICOH mark for more than half a century. Further there is no reason why an internet user would not expect to find Complainant in connection with a domain name that includes Complainant's Mark and the generic term 'recruiting'). Whether consumers are actually confused as to the source once they arrive at the Infringing Website is of no consequence. E.g., Paris Hilton v. Deepak Kumar, Case No. D2010-1364 (WIPO Sept. 23, 2010). Therefore, Respondent's actions in connection with the Disputed Domain amounts to bad faith use.

Respondent registered the Disputed Domain primarily for the purpose of disrupting Complainant's business

Respondent is using the Disputed Domain to disrupt Complainant's business, for Respondent's financial gain. Such use of the Disputed Domain has the potential to result in media and consumer inquiries, which requires Complainant to devote valuable resources thereto and results in a disruption to Complainant's business and demonstrates Respondents bad faith use and registration of the Disputed Domain. Moreover, the fact that Respondent has undertaken such actions well after Complainant's trademark rights arose is further evidence of bad faith registration for the sole purpose of disrupting Complainant's business for Respondent's own commercial gain.

Respondent was or should have been aware of Ricoh's rights in Complainant's marks and registered the Disputed Domain in bad faith

Complainant's trademark rights date back to 1946 and at least as early as 1958 when the mark registered in the United States. 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. Such efforts include numerous trademark registrations worldwide for the RICOH trademark, and major expenditures in advertising throughout the world. As a result of such efforts, the RICOH mark has achieved international fame.

The Disputed Domain was not created until over sixty years after Complainant's trademark rights were first registered, and is confusingly similar to the Complainant's Mark, discussed supra. Moreover, Complainant's Marks is famous throughout the world; it would be inconceivable to imagine that Respondent was unaware of Complainant's rights upon registering the

Disputed Domain. See e.g. Ricoh Company, Ltd. v. Hu He, Case No. 102607 (“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 trademark[] RICOH . . . 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.”).

Thus, it is clear that Respondent knowingly registered and has used the Disputed Domain to not only confuse customers as to the source of the Infringing Website, but also to disrupt Complainant’s business, evidencing Respondent’s bad faith use and registration of the Disputed Domain.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

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 addition of the prefix "SAIYO" is not sufficient element to escape the finding that the disputed domain name is confusingly similar to the Complainant´s trademarks and domain names.

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).

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use the trademarks and/or domains "ricoh" as a domain or on a website. The Respondent does not carry out any activity for, nor has any business with the Respondent.

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).

Given the distinctiveness of the trademark and the content of its website, it is clear that the Respondent registered the disputed domain name in knowledge of the Complainant and its trademark.

All these elements lead to the conclusion that the Respondent has intentionally attempted to attract Internet users to the Respondent´s website for commercial gain by creating a likelihood of confusion with the Complainant´s trademarks as to the source, sponsorship, affiliation, or endorsement of such websites.

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 three essential issues under the paragraph 4(a) of the Policy are whether:

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 with respect to the disputed domain name; and

iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain names, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant has clearly proven that it is a long standing and successful imaging and electronics company. It is clear that its trademarks and domain names “RICOH” are well-known.

The Complainant states that the disputed domain name is confusingly similar to its trademark. Indeed, the trademark is incorporated in its entirety in the disputed domain name.

The disputed domain name is therefore deemed identical or confusingly similar.

b) It has to be stressed that it was proven that there are no fair rights of the Respondent to the disputed domain name. The Respondent is not generally known by the disputed domain name and has not acquired any trademark or service mark rights in the name or mark.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) The disputed domain name was registered with an intention to attract customers of another well-known domain name/registered trademark holder. Therefore there cannot be seen any legitimate interest of the Respondent.

It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered and used. It is therefore concluded that the disputed domain name was registered with an intention to attract customers of another well-known domain name/registered trademark holder.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SAIYORICOH.NET**: Transferred

PANELLISTS

Name	**Dr. Vít Horáček**

DATE OF PANEL DECISION 2020-10-14

Publish the Decision