

Decision for dispute CAC-UDRP-103557

Case number	CAC-UDRP-103557
Time of filing	2021-03-01 09:23:07
Domain names	SonyCreativeSoftware.info

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Sony Corporation
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Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.
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Respondent

Name	Alice Mitchell
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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

In this proceeding, the Complainant relies on the following trademarks:

- “SONY” (word) EU trademark No.000000472, registered on May 05, 1998 and renewed;
- “SONY” (word) international trademark No. 978971, registered on June 23, 2008 and renewed and
- “SONY” (word) international trademark No.1194843, registered on March 29, 2012.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant (‘SONY’) is one of the world’s largest and most successful Japanese companies.

The Complainant is engaged in several fields related to electronics, games and entertainment as well as operating in the

financial sector, etc.

The Complainant's principal business operations include Sony Corporation (a consumer and professional electronics product manufacturer and its main brands are "SONY", "BRAVIA", "α", "Cyber-shot", "WALKMAN", "Handycam", etc.), Sony Interactive Entertainment (one of the three biggest companies in video game industry globally and its main brand is "PlayStation"), Sony Mobile Communications ("Sony Mobile", a mobile phone manufacturer and its main brand is "XPERIA"), Sony Music Entertainment (one of the three major music labels globally), and Sony Pictures Entertainment (one of the six largest film studios globally).

The Complainant claims its name is well-known throughout the world.

The Complainant has several subsidiary companies around the world and amongst them is Sony Creative Software Inc. which is a wholly-owned subsidiary of Sony Corporation, and it manages the domain name <sonycreativesoftware.com> for its official website. Sony Creative Software offers video editing, powerful organization tools, and products and services that support the flow from camera shooting to posting.

The Complainant has registered the SONY mark over a wide range of goods and services, in countries around the world and refers to the trademarks registrations listed above that also cover Russia and the European Union.

The Complainant also refers to previous Panels that recognized the SONY mark as a well-known mark throughout the world. The Complainant alleges that the disputed domain name is confusingly similar to the Complainant's SONY trademarks since the dominant component of the disputed domain name is the word "sony".

The disputed domain name differs from the Complainant's trademark by adding the words "creative" and "software" and the addition of generic words after a trademark does not remove the confusing similarity between the mark and the disputed domain name.

The Complainant states that It is settled case law that forming a domain name by adding to a complainant's mark a word which is descriptive or suggestive of the very services offered by the Complainant under that mark, effectively ensures that the disputed domain name will convey the same idea, or impression, as the mark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The registration date of the disputed domain name is July 20, 2020.

The Complainant refers to some earlier UDRP cases and claims that taking into account Complainant's earlier "Sony" marks, their fame and goodwill worldwide, it is reasonable to conclude that the Respondent could not legitimately use the disputed domain name without creating a false impression of association with the Complainant.

The Respondent is not associated with the Complainant or any related entity, has not received an authorization or a license to use the SONY mark and cannot demonstrate any legitimate offering of goods or services under the SONY mark.

Moreover, the Complaint also asserts that the disputed domain name was used for phishing and refers to email correspondence from an email address related to the disputed domain name and cites WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), par.2.13.1: "Panels have categorically held that the use of a domain name for illegal activity (e.g., phishing, distributing malware, or other types of fraud) can never confer rights or legitimate interests on a respondent."

The Complainant adds that there is also no indication that the Respondent is commonly known by the disputed domain name. The Respondent cannot establish that it has been commonly known as "SonyCreativeSoftware" and has not sought registration of trademarks (or otherwise) for this term. Furthermore, the Respondent has failed to demonstrate any of the other circumstances evidencing rights or legitimate interests under the Policy.

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

The Complainant claims that Respondent's bad faith is proven by the circumstances suggesting that the disputed domain name has been used for fraudulent purposes.

Before the disputed domain name was registered, the Complainant had registered the SONY trademark in many countries and regions around the world, including Russia and due to its worldwide recognition (including in Russia), it is a well-known trademark.

The Respondent must have known this well-known trademark when registering the disputed domain name on July 20, 2020.

The Complaint lists a number of factors indicating bad faith and states that they all speak in Complainant's favor.

The Complainant alleges that the Respondent's actions are designed to disrupt and harm the Complainant's business.

Given the fame and reputation in the SONY trade marks, and the fact that its goods and services are distributed throughout the world, it can be inferred the Respondent knew of the Complainant's business.

The Respondent might argue that he is not a competitor of the Complainant. However, as noted in *GB Investments, Inc. v. Donald Baker*, WIPO Case No. D2007-1320: "In engaging in this commercial activity, Respondent did (if only indirectly) become a competitor of Complainant and attracted Internet users for commercial gain, and in so doing it must have been apparent to the Respondent that this would have a disruptive effect on the business of the Complainant."

The Complainant adds that evidence of attempted malware infection is relevant in a Panel's determination of bad faith.

The Complainant notes, as in its prior WIPO Case D2017-2341 (*Sony Corporation v. Domain Admin, Privatewhois.biz*) that the Respondent (whose true identity, also in this case, is unclear at the time of filing the Complaint) used a privacy service when creating the disputed domain name. Although privacy services might be legitimate in many cases, it is difficult to see in the present case, why the Respondent should need to protect its identity except to make it difficult for the Complainant to protect its trademark rights.

It appears that the Respondent has registered the disputed domain name for the purpose of being able to send fraudulent e-mails from a domain name that is capable of creating an association with the Complainant.

The Respondent likely recognized the popularity of the trademark and knew that the Complainant promoted its business via a website. The Respondent then registered the disputed domain name which was likely to be confused with the Complainant's trademark and own domain name. In this way, it is possible for the Respondent to mislead Internet users to believe that the domain name is owned by the Complainant (or its agent/distributor) when sending them e-mails.

The Respondent attempted to obtain benefits (either free advertising services, or having internet users install malicious / unauthorized software for the purpose of getting access to their YouTube account) from the resulting confusion with the Complainant's trademark. This behavior constitutes malicious registration and use of domain names under Article 4(b)(iv) of the Policy.

The use of the trade mark(s) in this manner is strongly indicative of targeting and thus registration and use in bad faith in respect of the disputed domain name in accordance with the circumstances described in paragraph 4(b)(iv) of the Policy.

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).

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.

The registrar of the disputed domain name is Reg.ru from Russia.

The registrar in its communication to the Czech Arbitration Court (CAC) stated that the language of the registration agreement is Russian.

The Complainant requests that English shall be the language of this proceeding.

The Panel agrees with the Complainant, taking into account that the disputed domain name is in the .info zone that is the international TLD, the registrar has a registration agreement in both Russian and English languages and the English language version of the website (see <https://www.reg.com>), the Respondent uses the English words in the contact email address, the alleged emails sent in English by the Respondent and the fact that the Respondent has been given a fair chance to object but has not done so and considering previous UDRP decisions (e.g. CAC Case No.103140 and Orlane S.A. v. Yu Zhou He / He Yu Zhou, WIPO Case No. D2016-1763).

It is the Panel's obligation to ensure that the administrative proceeding takes place with due expedition under paragraph 10 (a) of the UDRP Rules and in the Panel's opinion it would be fair to have English as the language of this proceeding.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar with Complainant's trademark

The Complainant is the owner of the "SONY" trademark registrations effective in many jurisdictions.

As confirmed by WIPO Overview 3.0, paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain name fully incorporates the "SONY" mark of the Complainant coupled with the addition of the words "creative" and "software", both descriptive and referring to Complainant's subsidiary and its website.

It is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity under the first element (see par. 1.8 of WIPO Overview 3.0).

The Panel notes that the addition of the words "creative" and "software" does not change overall impression and does not eliminate the confusing similarity between the disputed domain name and the Complainant's "SONY" trademarks. The trademark is clearly recognizable in the disputed domain name and the addition of two descriptive words actually creates an association with Complainant's business, one of its subsidiaries and its official website and the domain name.

The gTLD suffix ".info" is to be disregarded under the confusing similarity test.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see *Julian Barnes v. Old Barn Studios*, WIPO Case No. D2001-0121; *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. D2004-0110 and CAC Case No. 101284.

The Complainant states that the Respondent is not associated with the Complainant or any related entity, has not received an authorization or a license to use the SONY mark and cannot demonstrate any legitimate offering of goods or services under the SONY mark.

The Complainant also alleges that the disputed domain name was used for phishing and provides some evidence (copies of 2 emails offering to download a software product on behalf of “Sony Creative”).

The disputed domain name was registered on July 20, 2020.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and *Vertical Solutions Management, Inc. v. webnet-marketing, inc.*, FA 95095, National Arbitration Forum).

The Panel notes that the use of a domain name for illegal activity (e.g. phishing) can never confer rights or legitimate interests on a respondent (see par. 2.13.1 of the WIPO Overview 3.0 and see also CAC Case No. 103393).

There is no evidence of any rights or legitimate interests of the Respondent in this dispute.

The Complainant has made out a prima facie case.

The Panel, therefore, finds that the Complainant satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith. These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

A range of considerations shall apply in assessing Respondent’s bad faith, i.e. the nature of the domain name, the timing and circumstances of the registration of the disputed domain, a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent’s choice of the domain name, or other indicia generally suggesting that the respondent had somehow targeted the Complainant (see par. 3.2.1 of the WIPO Overview 3.0).

The Panel finds that the following factors demonstrate bad faith of the Respondent in this dispute.

First of all, previous UDRP Panels confirmed well-known status of the Complainant’s “SONY” mark (see e.g. one of the earlier UDRP cases *Sony Kabushiki Kaisha v. sony.net*, WIPO Case No. D2000-1074 recognizing back in 2000 that “the Complainant’s name and principal trademark, SONY, is a household name, exclusively associated with the Complainant and its products”; *Sony Kabushiki Kaisha, also trading as Sony Corporation v. Richard Mandanice*, WIPO Case No. D2004-1046 and *Sony Corporation v. WhoisGuard Protected, WhoisGuard, Inc. / David Grant*, WIPO Case No. D2020-3162).

The Complainant’s marks had been registered and had been famous long before the registration of the disputed domain name.

Second, as confirmed by WIPO Overview 3.0 “Panels have consistently found that the mere registration of a domain name that

is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith” (see par. 3.1.4).

Third, the Complainant provided some evidence confirming suspicious use of the disputed domain name for possible phishing and malware. Under par. 3.4 of WIPO Overview 3.0 “Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution.” The Respondent has concealed his/her identity and that, in addition to the other factors, is also an indication of bad faith.

Fourth, given all the circumstances above and in the absence of Respondent’s response and any explanations, there is no credible explanation for the Respondent’s choice of the disputed domain name.

As noted by the Panel in Sony Corporation v. WhoisGuard Protected, WhoisGuard, Inc. / David Grant, WIPO Case No. D2020-3162: “The circumstances leave no doubt that Respondent was fully aware of Complainant’s rights in the SONY trademark (notwithstanding its claimed worldwide recognition) when registering the disputed domain name and that the latter clearly is directed thereto.

Moreover, using the disputed domain name for phishing activities by sending fraudulent emails is a clear indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own email communication by creating a likelihood of confusing with Complainant’s SONY trademark as to the source, sponsorship, affiliation or endorsement of Respondent’s email.”

The Panel finds that the Respondent’s conduct in this case falls within paragraph 4(b) of the Policy, namely 4(b) (iv) and by using the disputed domain name the Respondent is attempting to attract for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s mark as to the affiliation or endorsement of the Respondent’s website.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **SONYCREATIVESOFTWARE.INFO**: Transferred

PANELLISTS

Name	Igor Motsnyi / Mocni Konsalting doo
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DATE OF PANEL DECISION	2021-03-31
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Publish the Decision