

Decision for dispute CAC-UDRP-103655

Case number CAC-UDRP-103655

Time of filing 2021-03-17 11:03:21

Domain names soft-ebank.com

Case administrator

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

Complainant

Organization SoftBank Group Corp.

Complainant representative

Organization CSC Digital Brand Services Group AB (c/o Paddy Tam)

Respondent

Organization Mariel ATTONDE / Toile Informatique

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

SoftBank Group Corp. is the owner of various registrations for the trademark "SOFTBANK" on a worldwide basis, including Japan and China ("Complainant's trademark"). The most relevant registrations to this matter are:

- SOFTBANK (JP Reg. No. 1858515) registered on April 23, 1986; Japan Patent Office (JPO)
- SOFTBANK (JP Reg. No. 4476883) registered on May 25, 2001; Japan Patent Office (JPO)
- SOFTABANK (US Reg. No. 2542547) registered on February 26, 2002; United States Patent and Trademark Office (USPTO)
- SOFTBANK (EU Reg. No. 002070225) registered on December 19, 2002; European Union Intellectual Property Office (EUIPO)
- SOFTBANK & Design (WIPO Reg. No. 861654) registered on June 7, 2005; World Intellectual Property Office (WIPO)

The Disputed Domain Name <soft-ebank.com> was registered on September 14, 2020.

The Disputed Domain Name's registration date occurred after the Complainant's registrations of its <softbank.jp> domain name on March 26, 2001 and <softbank.com> domain name on April 1, 1991.

FACTUAL BACKGROUND

SoftBank is a Japanese multinational conglomerate holding company established in 1981. SoftBank is the parent company of a global portfolio of subsidiaries and affiliates, involved in investment activities, advanced telecommunications, internet services, Internet of Things, robotics and clean energy technology providers, it is also an internationally renowned company for its active investments in internet related field on a global scale (the "Businesses"). It has 1,475 subsidiaries, 80,909 employees (consolidated basis) as of March 31, 2020.

SoftBank was ranked #13 in Forbes Top 100 Digital Companies 2019, #83 in Forbes Top Regarded Companies 2019 and #36 in Forbes Global 2000 2019. It is the second largest publicly traded company in Japan after Toyota.

SoftBank maintains a strong internet presence through its primary website found at <http://softbank.jp/>. According to Similarweb.com, <softbank.jp> ranks 1,041 globally and 83 in Japan. Additionally, Complainant's <softbank.jp> had an average of 39.62 million visits during the period November 2019 – April 2020. It also operates an additional website at <https://www.softbank.com/>.

Through its high-profile, large-scale, extensive and diversified global practices, SoftBank has acquired and enjoy tremendous goodwill and reputation of "SoftBank" worldwide. SoftBank and its brands, namely, "SoftBank", are well recognized on a global scale. SoftBank has made significant investment over the years to advertise, promote, and protect the "SOFTBANK" trademark through various forms of media, including the internet. Based on its extensive use and trademark registrations, SoftBank owns the exclusive right to use the "SOFTBANK" trademarks worldwide.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

The Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed allegations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules because of the Respondent's failure to submit a response.

Therefore, in the absence of a response, it is appropriate to accept as true all allegations of the Complainant.

COMPLAINANTS' CONTENTIONS:

1. The Disputed Domain Name is confusingly similar to the protected mark

The Complainant is the owner of SOFTBANK trademark.

The Complainant recalled the WIPO Jurisprudential Overview 3.0 at 1.2.1.

When comparing a Disputed Domain Name to Complainant's trademark, there is a standard practice to not take the extension into account. The Disputed Domain Name can be considered as capturing, in its entirety, when the Complainant's SOFTBANK trademark was simply adding the letter "e" in between "soft" and bank". The letter "e" preceding the term "bank" has come to be understood as indicating an electronic, Internet-based form of the same (e.g., e-commerce, e-mail, e-retailing). Thus, the mere addition of the letter "e" in the middle of Complainant's trademark does not negate the confusing similarity between the Disputed Domain Name and the Complainant's trademark.

The Complainant recalled the WIPO Jurisprudential Overview 3.0 at 1.11.1 and Finter Bank Zurich v. Charles Osabor, D2005-1142 (WIPO December 30, 2005).

Respondent's addition of a hyphen between "soft and "ebank" does nothing to distinguish the Disputed Domain Name from Complainant's trademark and the use of such hyphen does not diminish the confusing similarity between the Disputed Domain Name and Complainant's trademark and should be disregarded for purposes of making this determination.

The Complainant recalled Chernow Commc'ns, Inc. v. Kimball, D2000-0119 (WIPO May 18, 2000).

Respondent's use of the Disputed Domain Name contributes to the confusion. Respondent is using the Disputed Domain Name to resolve to a website that passes off as Complainant, which suggests that Respondent intended the Disputed Domain Name to be confusingly similar to Complainant's trademark as a means of furthering consumer confusion.

The Complainant recalled the WIPO Jurisprudential Overview 3.0 at 1.15.

2. The Respondent does not have any rights or legitimate interest in the Disputed Domain Name

The granting of registrations by the JPO, USPTO, EUIPO and WIPO to Complainant for the SOFTBANK trademark is prima facie evidence of the validity of the term "softbank" as a trademark, of Complainant's ownership of this trademark, and of Complainant's exclusive right to use the SOFTBANK trademark in commerce on or in connection with the goods and/or services provided by the Complainant. Respondent is not sponsored by or affiliated with Complainant in any way. Furthermore, Complainant has not licensed, authorized, or permitted Respondent to use Complainant's trademark in any manner, including in domain names.

The Complainant recalled Sportswear Company S.P.A. v. Tang Hong, D2014-1875 (WIPO December 10, 2014).

The Respondent is not commonly known by the Disputed Domain Name, which evinces a lack of rights or legitimate interests which is confirmed by Whois data for the Disputed Domain Name.

The Complainant recalled World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe, D2008-0642 (WIPO June 6, 2008).

The Whois identifies the Registrant as "Mariel ATTONDE / Toile Informatique", which does not resemble the Disputed Domain Name in any way. Where no evidence, including the Whois record for the Disputed Domain Name, suggests that Respondent is commonly known by the Disputed Domain Name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the Disputed Domain Name.

The Complainant recalled Moncler S.p.A. v. Bestinfo, D2004-1049 (WIPO, February 8, 2005).

The Respondent is not making a bona fide offering of goods or services or legitimate, noncommercial fair use of the Disputed Domain Name. Respondent's inclusion of the Complainant's SOFTBANK logo on the Disputed Domain Name's website is a direct effort to take advantage of the fame and goodwill that Complainant has built in its brand, and Respondent is not only using the confusingly similar Disputed Domain Name, but is also imitating Complainant by displaying the Complainant's logo. This imitation is referred to as "passing off," and Respondent, in also using a confusingly similar Disputed Domain Name to mislead Complainant's customers, is not making a bona fide offering of goods and services and noncommercial or fair use of the domain name.

The Complainant recalled Houghton Mifflin Co. v. Weatherman, Inc., D2001-0211 (WIPO April 25, 2001).

Furthermore, it is apparent that Respondent has intentionally registered the Disputed Domain Name for the purpose of

making illegitimate or unfair use of Complainant's trademark by misleading Internet users who are seeking information about Complainant's products or services. Respondent did not only use Complainant's SOFTBANK trademark/logo in the domain name and its website, but also uses "Softbank" as its business name. In the website's "About Us" page, Respondent claims to operate as "Softbank", "the subsidiary of one of the strongest banking groups in Europe and around the world." Respondent also included the copyright notice "Copyright © 2021 SOFT BANK" on its website. While Complainant does not provide banking services, Respondent's overall use of the Disputed Domain Name creates a likelihood of confusion and mistaken belief among Internet users that the Disputed Domain Name and its website are connected or affiliated with the Complainant.

The Complainant recalled *Bytedance Ltd. v. Registration Private, Domains By Proxy, LLC / Lê Van Luong, Cong ty TNHH Thuong Mai NNA Viet Nam, D2020-3219* (WIPO February 9, 2021).

Respondent's use to-date of the Disputed Domain Name confirms that Respondent is not making a legitimate noncommercial or fair use without intent for commercial gain.

Respondent registered the Disputed Domain Name on September 14, 2020, which is obviously after Complainant filed for registration of its trademark with JPO, USPTO, EUIPO and WIPO, and after Complainant's first use in commerce of its SOFTBANK trademark in 1981. The Disputed Domain Name's registration date is also after the Complainant's registrations of its <softbank.jp> domain name on 26 March 2001 and <softbank.com> domain name on April 1, 1991.

3. The Disputed Domain Name has been registered and is being used in bad faith

The Complainant and SOFTBANK trademark are known internationally, with trademark registrations across numerous countries. The Complainant has marketed and sold its goods and services using the SOFTBANK trademark since 1981, which is well before Respondent's registration of the Disputed Domain Name. By registering a domain name that includes Complainant's SOFTBANK trademark and created a domain name that is confusingly similar to Complainant's trademark, as well as its <softbank.jp> and <softbank.com> domains the Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business. Further, by copying Complainant's official SOFTBANK logo, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's brands at the time the Disputed Domain Name was registered.

The Complainant recalled *Telstra Corp. Ltd. v. Nuclear Marshmallows, D2000-0003* (WIPO February 18, 2000).

The SOFTBANK trademark is so closely linked and associated with Complainant that Respondent's use of this mark or any minor variation thereof strongly implies bad faith. Where a domain name is "so obviously connected with such a well-known name and products,...its very use by someone with no connection with the products suggests opportunistic bad faith."

The Complainant recalled *Parfums Christian Dior v. Javier Garcia Quintas, D2000-0226* (WIPO May 17, 2000).

ICANN policy dictates that bad faith can be established by evidence that demonstrates that "by using the domain name, [Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [Respondent's] web site..., 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 [Respondent's] web site or location." The Respondent creates a likelihood of confusion with Complainant and its trademark by copying Complainant's SOFTBANK logo, with Respondent then attempting to profit from such confusion by offering banking services. Respondent is attempting to cause consumer confusion in a nefarious attempt to profit from such confusion. The impression given by the Disputed Domain Name and its website would cause consumers to believe the Respondent is somehow associated with Complainant when, in fact, it is not. Respondent's actions create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name, and the Respondent is thus using the fame of the Complainant's trademark to improperly increase traffic to the website listed at the Disputed Domain Name for Respondent's own commercial gain. It is well established that such conduct constitutes bad faith.

The Complainant recalled *World Wrestling Fed'n Entm't, Inc. v. Ringside Collectibles*, D2000-1306 (WIPO January 24, 2001).

Additionally, the Disputed Domain Name's website has a Contact Us page, where Internet users can input their names, email addresses and messages. Having been deceived into believing that Complainant was the source of the Disputed Domain Name and its website, Internet users could unsuspectingly supply Respondent with their personal information at the website's Contact Us page, which allows the possibility of phishing. This further demonstrates Respondent's bad faith.

The Complainant recalled *Peteski Productions, Inc. v. Host Master, 1337 Services LLC*, D2020-2033 (WIPO September 28, 2020).

Finally, on balance of the facts set forth above, it is more likely than not that the Respondent knew of and targeted Complainant's trademark, and Respondent should be found to have registered and used the Disputed Domain Name in bad faith.

The Complainant recalled *Tudor Games, Inc. v. Domain Hostmaster, Customer ID No. 09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, D2014-1754 (WIPO January 12, 2014).

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

LANGUAGE OF THE PROCEEDINGS

The Complainant contended that it is unable to communicate in French and translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter and that such additional delay, considering the obviously abusive nature of the Disputed Domain Name and its website. Respondent has registered confusingly similar domain name to Complainant's SOFTBANK trademark and is using the Disputed Domain Name to pass off as Complainant poses continuing risk to Complainant and unsuspecting consumers seeking Complainant or its products or services and that the term SOFTBANK, which is the dominant composition of the Disputed Domain Name, does not carry any specific meaning in the French language and that the Disputed Domain Name's website provides users an option to view the website content in different languages – Arabic, Chinese (Simplified), Dutch, English, French and German, which suggests that Respondent comprehends different languages, including English.

Pursuant to Paragraph 11(a) of the Rules, the Panel may determine the language of the proceedings having regard to all circumstances, and to help ensure fairness, and maintain an inexpensive and expeditious avenue for resolving domain disputes.

The Panel determined that the language of the proceedings shall be English.

Panel finds in accordance with Paragraph 11(a) of the Rules that it is unduly burden Complainant to have to arrange and pay for translation where Respondent has prima facie demonstrated behavior that disrupts Complainant's business and has already required Complainant to devote significant time and resources to addressing this instance of abuse. The Disputed Domain Name does not carry any specific meaning in the French language and the Disputed Domain Name's website provides users an option to view the website content in different languages – Arabic, Chinese (Simplified), Dutch, English, French and German, which suggests that Respondent comprehends different languages, including English.

MERITS OF THE PROCEEDINGS

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (ii) respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

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

The Panel finds that the Complainant is the owner of SOFTBANK trademark. When comparing a Disputed Domain Name to Complainant's trademark It is well established that an addition in the Disputed Domain Name is not sufficient to overcome a finding of confusing similarity, to not take the extension into account. The Disputed Domain Name is in its entirety capturing. The addition of the letter "e" in between "soft" and bank" while the letter "e" is preceding the term "bank" has to be understood as indicating an electronic, Internet-based form of the same (e.g., e-commerce, e-mail, e-retailing). Thus, the mere addition of the letter "e" in the middle of Complainant's trademark does not negate the confusing similarity between the Disputed Domain Name and the Complainant's trademark. Moreover the Respondent's addition of a hyphen between "soft and "ebank" does nothing to distinguish the Disputed Domain Name from Complainant's trademark and does not alter the fact that a name is identical to a mark. The Panel comes to the conclusion that Respondent has created, by merely adding the letter "e" and a hyphen into the Disputed Doman Name which includes Complainant's SOFTBANK trademark, a domain name that is confusingly similar to Complainant's trademark, as well as its <softbank.jp> and <softbank.com> domains.

The Panel therefore finds that the Disputed Domain Name is confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

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

The Panel finds that the Complainant's registered its <softbank.jp> domain name on 26 March 2001 and <softbank.com> domain name on 1 April 1991 when Respondent registered the Disputed Domain Name on 14 September 2020, which is

obviously after Complainant filed for registration of its trademark with JPO, USPTO, EUIPO and WIPO, and significantly after Complainant's first use in commerce of its SOFTBANK trademark in 1981.

The Panel concludes, and Respondent did not prove the opposite, that the registrations by the JPO, USPTO, EUIPO and WIPO to Complainant for the SOFTBANK trademark is prima facie evidence of the validity of the term "softbank" as a trademark and of Complainant's exclusive right to use the SOFTBANK trademark in commerce on or in connection with the proven goods and/or services and that Respondent is not sponsored by or affiliated with Complainant. Respondent is not commonly known by the Disputed Domain Name while the Whois identifies the Registrant as "Mariel ATTONDE / Toile Informatique", which does not resemble the Disputed Domain Name. Respondent is not making a bona fide offering of goods or services or legitimate, noncommercial fair use of the Disputed Domain Name. Panel comes to the conclusion that Respondent has intentionally registered the Disputed Domain Name for the purpose of making illegitimate or unfair use of Complainant's trademark by misleading Internet users who are seeking information about Complainant's products or services while Respondent included the copyright notice "Copyright © 2021 SOFT BANK" at the bottom page of its website.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name (within the meaning of paragraph 4(a)(ii) of the Policy).

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

The Panel finds that Complainant and SOFTBANK trademark are known internationally, with trademark registrations across numerous countries and has marketed and sold its goods and services using the SOFTBANK trademark for many decades, which is well before Respondent's registration of the Disputed Domain Name. By registering a domain name that includes Complainant's SOFTBANK trademark while merely adding the letter "e" and a hyphen, Respondent has created a domain name that is confusingly similar to Complainant's trademark, as well as its well known domains. As such, Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business. Further, by copying Complainant's official SOFTBANK logo, it is impossible to conceive of any situation in which the Respondent would have been unaware of the Complainant's brands at the time the Disputed Domain Name was registered. The SOFTBANK trademark is quite closely linked and associated with Complainant so that Respondent's use of this mark and any minor variation thereof fully implies bad faith.

UDRP policy dictates that bad faith can be established by evidence that demonstrates that "by using the domain name, [Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [Respondent's] web site..., 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 [Respondent's] web site or location." The Panel finds that Respondent creates a likelihood of confusion with Complainant and its trademark by copying Complainant's SOFTBANK logo, with Respondent then attempting to profit from such confusion by offering banking services as the Complainant proved. It is obvious that Respondent is attempting to cause consumer confusion in an unfair attempt to profit from such confusion. The impression given by the Disputed Domain Name and its website would have caused consumers to believe that the Respondent is somehow associated with Complainant when, in fact, it is not. Respondent's actions create a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name, and the Respondent is using the fame of the Complainant's trademark to improperly increase traffic to the website listed at the Disputed Domain Name for Respondent's own commercial gain. It is well established that such conduct constitutes bad faith.

The Panel established that the Disputed Domain Name's website has a Contact Us page, where Internet users can input their names, e-mail addresses and messages. Thus, Internet users could unsuspectingly supply Respondent with their personal information at the website's Contact Us page by having been deceived into believing that Complainant was the source of the Disputed Domain Name and its website, which is an open door to the possibility of phishing. This further confirms Respondent's bad faith.

The Panel finds that the Respondent knew of and targeted Complainant's trademark so that it registered and used the Disputed Domain Name in bad faith while having the trademark in mind when registering the Disputed Domain Name.

The Panel concluded that the overall circumstances of this case show that the Disputed Domain Name was registered and is being used in bad faith and the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SOFT-EBANK.COM**: Transferred
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PANELLISTS

Name	JUDr. Vojtěch Trapl
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DATE OF PANEL DECISION 2021-04-11

Publish the Decision
