

Decision for dispute CAC-UDRP-103603

Case number	CAC-UDRP-103603
-------------	------------------------

Time of filing	2021-03-17 09:03:06
----------------	----------------------------

Domain names	us-sony.com
--------------	--------------------

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
--------------	--

Complainant

Organization	Sony Corporation
--------------	-------------------------

Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.
--------------	---

Respondent

Name	FRANKLIN BAILEY
------	------------------------

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

The Complainant is the owner of the SONY trademark in numerous countries worldwide. Among these trademark registrations and for the purpose of this Complaint, the Complainant cites in particular the following:

- SONY, US registration No. 0770275, registered on 26 May, 1964, in class 9;
- SONY, US registration No. 0777400, registered on 22 September 1964, in class 11;
- SONY, US registration No. 5801309, registered on 9 July, 2019, in class 42;
- SONY, US registration No. 4313348, registered on 2 April 2013, in class 38;
- SONY, US registration No. 3591609, registered on 17 March 2009, in class 36;
- SONY, European registration No. 000000472, filed on 1 April 1996, and registered on 5 May 1998;
- SONY, International registration No. 978971, designating, among other countries, also the European Union, where it was registered on 23 June 2008, in classes 9, 35 and 41;
- SONY, International registration No. 1194843, registered on 29 March 2012, in classes 9, 35, and 38, designating several countries, including the European Union, where it was registered on 26 October 2015.

The Complainant is also the owner of the domain name <sony.com>, which resolves to the Complainant's official website and promotes the Complainant's goods and services worldwide.

FACTUAL BACKGROUND

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

The Complainant is one of the world's largest and most successful Japanese companies. The Complainant operates in several fields, related to electronics, games, entertainment, financial, etc. The Complainant is a leading manufacturer of consumer goods, such as audio and video equipment, computer games, mobile phones. The Complainant also sells professional goods, such as electronic components, professional solutions and medical related equipment, and provides broadcasting services as well. The Complainant's principal business operations include Sony Corporation (a consumer and professional electronics product manufacturer), Sony Interactive Entertainment (one of the three biggest companies in videogames), Sony Mobile Communications (a mobile phone manufacturer), Sony Music Communications (one of the three major music labels globally), and Sony Interactive Entertainment (one of the six largest film studios globally). The Complainant and its trademark SONY are well known throughout the world.

The disputed domain name was registered on 9 April 2020 and apparently is passively held. However, the disputed domain name has been actively used for phishing purposes, as better explained below.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

According to the Complainant, the disputed domain name is confusingly similar to its SONY trademark. The disputed domain name differs from the Complainant's trademark by prefixing it with the letters "us", a common identifier for the United States, and the dash sign "-". Both these additions are of no significance and do not remove the confusing similarity between the Complainant's trademark and the disputed domain name.

The Complainant further maintains that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent is not associated with the Complainant or any related entity, has not received authorisation or license to use the SONY mark and cannot demonstrate any legitimate offering of goods or services under this mark. The Respondent cannot establish that it has been commonly known by the disputed domain name and has not sought registration of trademarks for the term SONY. Furthermore, the Respondent has failed to demonstrate any of the other circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy.

The Complainant's trademark SONY enjoys high reputation and the Respondent cannot legitimately use it without creating a false impression of association with the Complainant. While the disputed domain name apparently leads to a parking page, it is actively used for phishing purposes. On the very day of acquiring the disputed domain name, the Respondent sent out an apparent spear-phishing email containing the impersonation of a Sony Corporation employee, with the title "Accounts Receivable Specialist". This email mentioned that the Sony bank account had changed and that payments had to be sent to a new bank account number. The e-mail address was sent from an IP address managed by NameCheap, Inc., which is the Registrar of the disputed domain name. The use of the disputed domain name for a payment instruction fraud cannot confer rights or legitimate interests to the Respondent.

Lastly, the Complainant contends that the disputed domain name has been registered and is being used in bad faith. Considering the extensive reputation of the Complainant's trademark, the Respondent must have known the SONY mark at the time it registered the disputed domain name. It appears that the Respondent 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 registered a domain name, which was likely to be confused with the Complainant's trademark and own domain name. The purpose of this registration was to disrupt and harm the Complainant's business. The Respondent use of the

disputed domain name is therefore in bad faith.

RESPONDENT:

The Respondent did not submit any Response to the Complaint and therefore the Panel shall proceed with her decision based on the documents and arguments on file.

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

I. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (paragraph 4(a)(i) of the Policy).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark SONY. The disputed domain name fully reproduces the SONY trademark followed by the hash sign "-" and the two letters "us", that are commonly used as the abbreviation of "United States". Therefore, the disputed domain name consists of the Complainant's trademark followed by a geographical indication. The latter bears no distinctive character and is certainly not able to reduce the confusing similarity of the disputed domain name with the Complainant's trademark. According to section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0"), "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element".

In light of the foregoing, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of rights or legitimate interests in respect of the disputed domain name (paragraph 4(a)(ii) of the Policy).

It is a generally accepted principle that when a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of proof of the rights or legitimate interests on the domain name shifts to the respondent. In the case at issue, the Complainant affirms that it has no relationship with the Respondent and that there is no indication that the Respondent is known by the disputed domain name. Moreover, the Complainant has shown that on the same day the disputed domain name was registered, the Respondent sent a fraudulent email informing that Sony bank account had changed and that payments had to be made to the new bank account. This e-mail was signed "Accounts Receivable Specialist - Sony Electronics Inc.". The e-mail also included a pdf file directing customers to the alleged new bank account, providing the relevant details. This pdf document depicted the trademark SONY prominently and was signed "Mike Schneibel - Financial Controller".

The use of the disputed domain name to falsely impersonate the Complainant to fraudulently direct customers' payments to a bank account clearly not belonging to the Complaint, does not amount to a bona fide offering of goods and services, nor to a

legitimate non-commercial or fair use of the disputed domain name.

Therefore, the Panel is satisfied that also the second condition under the Policy is met.

III. Bad faith (paragraph 4(a)(iii) of the Policy)

The Policy requires that in order to meet the third and last requirement under the Policy, the Complainant must successfully prove that both the registration and use of the disputed domain name have been made in bad faith.

In the instant case, there are no doubts that the Complainant's trademark SONY enjoys extensive reputation. This has also been recognized in various other prior UDRP decisions. Therefore, it is clear that at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant and of its well-known trademark SONY. Furthermore, the Respondent has been using the disputed domain name in connection with an e-mail phishing/scam campaign against the Complainant's customers in order to divert their payments to a bank account clearly not belonging to the Complainant, impersonating the Complainant through the unauthorised use of the SONY trademark and of a confusingly similar domain name. The Complainant tried to solve this matter by sending a phishing report to the Registrar of the disputed domain name, but failed to receive a reply, even after several reminders.

In view of the foregoing, the Panel concludes that the disputed domain name has been registered and is being used in bad faith.

Therefore, the Panel is satisfied that the third and last condition under the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **US-SONY.COM**: Transferred

PANELLISTS

Name	Angelica Lodigiani
------	---------------------------

DATE OF PANEL DECISION	2021-04-21
------------------------	------------

Publish the Decision
