

Decision for dispute CAC-UDRP-104419

Case number	CAC-UDRP-104419
Time of filing	2022-03-18 09:13:06
Domain names	softbankfinance.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	SoftBank Group Corp.
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Complainant representative

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

Name	Jeff Hwang
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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

The Complainant is the owner, inter alia, of the following trademark registrations for SOFTBANK:

- China trademark registration No. 2024468 for SOFTBANK (word mark), registered on October 21, 2002, in international class 36;
- Japan trademark registration No.1858515 for SOFTBANK (word mark), registered on April 23, 1986, in international classes 6, 9, 16, 19 and 20;
- Japan trademark registration No. 4476883 for SOFTBANK (word mark), registered on May 25, 2001, in international class 36;
- United States trademark registration No. 2542547 for SOFTBANK (word mark), registered on February 26, 2002, in international class 36;
- European Union trademark registration No. 002070225 for SOFTBANK (word mark), registered on December 19, 2002, in international classes 35 and 36; and
- International trademark registration No. 861654 for SOFTBANK (figurative mark), registered on June 7, 2005, in international classes 9, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant is a Japanese multinational conglomerate holding company established in 1981 and a 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.

The Complainant has 1.408 subsidiaries, had 58.786 employees on a consolidated basis as of March 31, 2021, and was ranked 27th in Forbes Global 2000 in 2021. Fortune.com ranked the Complainant as 184th amongst its Global 500 list of companies and also one of the World's Most Admired Companies in 2021. The Complainant is also the second largest publicly traded company in Japan after Toyota, as shown in Forbes World's Largest Public Companies of 2021 Ranking.

The Complainant is the owner of the domain name <softbank.jp>, which was registered on March 26, 2001 and is used by the Complainant to promote its products services under the trademark SOFTBANK.

The disputed domain name <softbankfinance.com> was registered on December 24, 2021 and is currently not redirected to an active website. According to the screenshots submitted by the Complainant, which have not been contested by the Respondent, the disputed domain name previously resolved to a website displaying the Complainant's figurative trademark and promoting cryptocurrency investments.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant states that the disputed domain name <softbankfinance.com> is confusingly similar to its trademark SOFTBANK as it reproduces the trademark in its entirety with the sole addition of the term "finance" and the gTLD ".com", which is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark.

The Complainant also highlights that even the use of the disputed domain name contributes to the confusion, since the Respondent has pointed the disputed domain name to a website that passes off as the Complainant, a circumstance which suggests that the Respondent intended the disputed domain name to be confusingly similar to Complainant's trademark as a means of furthering consumer confusion.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name because the Respondent is in no way sponsored by or affiliated with the Complainant in any way, nor was it ever given license, authorization, or permission to use the Complainant's trademarks in any manner, including in domain names.

The Complainant further states that, in view of the registrant's name disclosed in the Whois records and of the prior use of a Whois privacy service to conceal such information in the public records, the Respondent cannot claim to be commonly known by the disputed domain name.

The Complainant also asserts that the Respondent registered the disputed domain name only on December 24, 2021, which is significantly after the Complainant applied for registration of its trademarks and also significantly after the Complainant first used the trademark SOFTBANK in commerce in 1981 and registered its domain name <softbank.jp> and <softbank.com>.

Moreover, the Complainant contends that the Respondent is not making a bona fide offering of goods or services or legitimate, non-commercial fair use of the disputed domain name without the intent of taking advantage of the fame and goodwill of the Complainant, considering it is not only using the confusingly similar disputed domain name, but is also imitating the Complainant by displaying the Complainant's logo and services in the attempt to pass off as the Complainant.

In addition, the Complainant points out that the Respondent also operated a website at <http://www.unicornpark.vip/>, whose contents are identical to those featured on the website to which the disputed domain name resolves. The Complainant underlines that, in the "About Us" page of such website, "SoftBank Financial Holdings Group" is described as "crypto oriented

quantitative investing management, created by SoftBank Ventures Asia and UnicornPark, launching active crypto-investing strategies in hongkong.” The Complainant highlights that, while Complainant does not provide crypto oriented quantitative investing management services, the 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 further underlines that the Respondent’s mention of “SoftBank Ventures Asia” as one of its creators further enhances such likelihood of confusion because SoftBank Ventures Asia Corp. is the Complainant’s corporate venture capital arm.”

With reference to the circumstances evidencing bad faith, the Complainant states that, since the website to which the disputed domain name resolves makes reference to SOFTBANK and its services, the Respondent probably registered the domain name with full knowledge of the Complainant’s well-known trademark.

The Complainant also highlights that the disputed domain name resolves to a website publishing the Complainant’s figurative mark edited with the word “financial”, using “SoftBank Financial Holdings Group” as business name and including the copyright notice “Copyright by SoftBank Financial Group” at the website’s bottom page. The Complainant thus contends that the Respondent has attempted to attract Internet users to his own website for commercial gain, by causing a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation, or endorsement of its website.

Moreover, the Complainant asserts that the contact information provided on the website at the disputed domain name is incorrect and concludes that such false details further demonstrate the Respondent’s bad faith.

Lastly the Complainant points out that, at the time of registering the disputed domain name, the Respondent had employed a privacy service to hide its identity, which is further evidence of bad faith registration and use.

RESPONSE

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.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name is confusingly similar the Complainant’s trademark SOFTBANK as it reproduces the trademark in its entirety, with the mere addition of the descriptive term “finance” and the generic Top-Level Domain “.com”. As stated in a number of prior decisions rendered under the UDRP, these minor changes are not sufficient to prevent a finding of confusing similarity.

2. With reference to the Respondent’s rights or legitimate interests in the disputed domain name, the Complainant states

that the Respondent is in no way sponsored by or affiliated with the Complainant, nor was it ever given license, authorization, or permission to use the Complainant's trademarks in any manner, including in domain names.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name and is not making a bona fide offering of goods or services or legitimate, non-commercial fair use of the disputed domain name without the intent of taking advantage of the Complainant's fame and goodwill. The Complainant also highlights that the use of the disputed domain name, of the Complainant's logo and of related content, only serves to confirm that the Respondent was attempting to pass off as the Complainant for commercial gain.

The Panel finds that the Complainant has made a prima facie case and that the Respondent, by failing to submit a Response, has not demonstrated that it has rights or legitimate interests in the disputed domain name.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the prior registration and use of the trademark SOFTBANK by the Complainant and of the well-known character of the trademark also in China, where the Respondent is based, the Respondent was or ought to be aware of the Complainant's trademark at the time of registration.

The Panel also finds that the Respondent, by redirecting the disputed domain name to a website publishing the Complainant's figurative mark edited with the word "financial", with contents partially related to the Complainant's market niche, as well references to a "SoftBank Financial Group" (as shown in the screenshots in annex to the Complaint), has intentionally attempted to attract internet users to its website for commercial gain, by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy.

Moreover, the Panel notes that the incomplete and inaccurate contact details provided by the Respondent in the Registrar-disclosed Whois records and on the website to which the disputed domain name resolved and the Respondent's use of a privacy service to hide its identity in the public Whois records are further evidence of bad faith registration and use.

The disputed domain name is currently not resolving to an active web site, i.e. is passively held. As established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding, especially in cases of domain name registrations corresponding to distinctive and well-known trademarks; see i.a. the landmark case *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Therefore, the Panel finds that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. SOFTBANKFINANCE.COM: Transferred

PANELLISTS

Name	Luca Barbero
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DATE OF PANEL DECISION 2022-04-27

Publish the Decision
