

Decision for dispute CAC-UDRP-104614

Case number	CAC-UDRP-104614
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Time of filing	2022-05-30 09:56:09
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Domain names	uniqlojapan.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Fast Retailing Co. Ltd.
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Complainant representative

Organization	RODENBAUGH LAW
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Respondent

Name	Leu Thi Hong Van
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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 Fast Retailing Co., Ltd. was founded in 1949 and has used the UNIQLO trade mark in global commerce globally and continuously for many decades. It has also registered the UNIQLO mark in many jurisdictions throughout the world, including but not limited to Japan and Vietnam.

General information about the Complainant, including details on its respective products can be found at the website <uniqlo.com> and the Vietnamese-language website <uniqlo.com/vn/vi/>, among other sites.

The Complainant is owner of many trademarks by WIPO. Just a fraction of Complainant's International Registrations, each designating protection in Vietnam (and various other countries) and dating back many years, are:

UNIQLO 1009787 8 May 2009;

UNIQLO 984577 31 October 2008;

UNIQLO 878952 17 November 2004; and

UNIQLO 877905 14 October 2005.

Those International Registrations show a broad array of products sold globally under Complainant's famous trademark, and

also include protection as to online retail services in Class 35.

The Respondent registered the disputed domain name <UNIQLOJAPAN.COM> on 3 June 2015. The disputed domain name was not even registered by Respondent until June 2015.

FACTUAL BACKGROUND

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

FACTUAL BACKGROUND

Fast Retailing Co., Ltd. (“Complainant”) is a Japanese multinational company that offers innovative clothing, footwear, headwear and fashion accessories to consumers worldwide, under the internationally famous brand UNIQLO. The Complainant was originally founded in Yamaguchi, Japan, in 1949, but now operates more than 2000 retail fashion stores worldwide. Complainant is headquartered in Tokyo, Japan. Complainant earned global revenues in excess of 600 billion yen in its fiscal year ending 2021. As of November, 2021, there were nine UNIQLO branded stores throughout Vietnam alone, including a global flagship store in Ho Chi Minh City. A recent news article from the Hanoi Times discusses Complainant’s successful expansion and opening of its online store in Vietnam.

The Complainant has invested copious amounts of time and money to promote the ubiquitous UNIQLO brand, in Vietnam and worldwide. As such, consumers around the world have come to associate Complainant with the UNIQLO marks and brand. Through such longstanding and exclusive use by Complainant, the UNIQLO mark is famous in Vietnam, Japan, and throughout the world.

The use of the disputed domain name for Respondent’s website is only for the purpose of taking unfair advantage of Complainant’s famous name and trademarks, and constitutes passing off and/or free riding.

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

The Complainant Has Prior, Valid Trademark Rights in The UNIQLO Mark

The disputed domain name is comprised of Complainant’s globally famous mark UNIQLO and the country JAPAN, referring to Complainant’s origins as a famous Japanese retailer. The disputed domain name resolves to a website in Vietnamese language, apparently selling products such as nutritional supplements and skin whiteners, priced in Vietnamese dollars. The “Contact Us” page of the website indicate this business is located in Hanoi. The website also contains Complainant’s famous red logo at the bottom, along with other logos, attempting to give the Respondent’s website some air of legitimacy.

The disputed domain name is Confusingly Similar To Complainant's Trademarks

A simple comparison of the UNIQLO trade marks and the disputed domain name demonstrates that they are confusingly similar, and the addition of the .com top-level domain is negligible.

The Complainant recalled:

- WIPO Case No. D2007-1629S in F. Hoffmann-La Roche AG v. Relish Enterprises, (17 December 2007);
- WIPO Case No. D2009-0227 in Motion Limited v. One Star Global LLC, (9 April 2009);
- CAC Case No. 101592 in Fujitsu Ltd. v. Thomas Ruben, (18 July 2017);
- WIPO Case No. D2018-2450 in Alibaba Group Holding Limited v. Huang Guofeng, (26 December 2018);
- WIPO Case No. D2018-0816 in Open Society Institute v. Admin Contact, PrivateName Services Inc. / Axel Feldt (13 June 2018).

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

In this case, it is clear that Respondent has no rights or legitimate interest in the disputed domain name. Respondent not only registered the disputed domain name more than a decade after Complainant’s rights in the famous and distinctive UNIQLO mark were registered in Vietnam, but is also using the disputed domain name to offer for sale items from Japan that could be linked with the Complainant’s business. On the other hand, Complainant has demonstrated longstanding, exclusive use of the

UNIQLO trademark. Complainant's rights predate any registration or use of the disputed domain name by ten years at least.

Respondent Does Not Use The Disputed Domain Name With A Bona Fide Offering Of Goods Or Services

The website available at the disputed domain name provides only a rudimentary retail store, which purports to offer products from Japan and thus is in direct competition with Complainant. The use of the disputed domain name that is confusingly similar to a complainant's mark to promote the sales of competitive products online, is not a bona fide use of the disputed domain names.

Respondent is Not Commonly Known By The Disputed Domain Name

Complainant has met its burden to make a prima facie showing that the Respondent has no rights or legitimate interest in the disputed domain name. 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 name and will be unable to meet this burden.

Respondent Registered the Disputed Domain Name Primarily For The Purpose Of Disrupting Complainant's Business

By its prominent use of Complainant's globally famous, coined UNIQLO trademark, Respondent is using the disputed domain name for no other reason than to disrupt Complainant's business by trying to confuse internet users into believing they might be led to, or have arrived at, a website run by the Complainant or its subsidiary.

Complainant recalled:

- WIPO Case No. D2009-071 in Accor v. Eren Atesmen, (10 July 2009);
- WIPO Case No. D2010-2011 in Mile, Inc. v. Michael Burg, (7 February 2011);
- Forum Claim No. 699652 in Braun Corp. v. Loney, (7 July 2006);
- WIPO Case No. D2011-0669 in Sanofi-aventis v. Brian Nagele, (6 June 2011);
- CAC Case No. 104475 in Fast Retailing Co., Ltd. v. De Gao, (10 May 2022).

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

Respondent Intentionally Attempted To Divert Internet Users By Creating Likelihood Of Confusion

Respondent has registered and/or used a disputed domain name in bad faith where the purpose of the registration is to cause confusion as to the source of the website or other service offered via the domain name. Respondent has made active use of the disputed domain name to provide a competitive online retail store. Use of a domain name that is confusingly similar to a complainant's mark to promote the sales of competitive products online, is not a bona fide use of the disputed domain name and merely taking advantage of the Complainant's fame and goodwill to attract users to Respondent's website constitutes use in bad faith of the disputed domain name.

Respondent Was Or Should Have Been Aware Of Complainant's Rights In The UNIQLO Mark and Registered The Disputed Domain Name In Bad Faith

It can reasonably be inferred that Respondent was aware of Complainant's rights given the way the Respondent has been using the disputed domain name. It also impossible that a name as specific and peculiar as UNIQLO could have been found or chosen by chance. Alternatively, even if Respondent did not have actual knowledge of Complainant's Marks (which it likely did), Respondent had a duty to ensure that the registration of the disputed domain name would not infringe a third party's rights.

The Complainant recalled:

- CAC Case No. 104475 in Fast Retailing Co., Ltd. V. De Gao, (10 May 2022);
- WIPO Case No. D2018-1397 in Sanofi v. VistaPrint Technologies Ltd., (12 August 2018);
- WIPO Case No. D2017-0280 in Sodexo v. Takashi Yamaguchi, (28 March 2017);
- Forum Claim No. FA 95003 in Collegetown Relocation, L.L.C. v. John Mamminga, (20 July 2000).

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.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs the 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.

Paragraph 4(b)(iv) requires that complainant must prove that the registrant has registered and used a domain name in bad faith where by using the domain name, has intentionally attempted to attract, for commercial gain, Internet users to a web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of a web site or location or of a product or service on a web site or location.

Paragraph 4(c) 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) whether respondent is using the disputed domain in connection with a bona fide offering of goods or services;
- (ii) whether respondent is commonly known by the disputed domain; and
- (iii) whether respondent is making a legitimate non-commercial use or fair use of the disputed domain.

The Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations because of the Respondent's failure to submit a response. Therefore, it accepted as true all allegations of the Complainant.

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

The Panel finds that the disputed domain name is comprised of Complainant's globally famous mark UNIQLO and the country JAPAN, referring to Complainant's origins as a famous Japanese retailer and the disputed domain name resolves to a website in Vietnamese language, apparently selling products such as nutritional supplements and skin whiteners, priced in Vietnamese dollars. The "Contact Us" page of the website indicate this business is located in Hanoi. The website also contains

Complainant's famous red logo at the bottom, along with other logos, attempting to give the Respondent's website some air of legitimacy. The Complainant is owner of many valid trademarks establishing its prior rights over the disputed domain name. The burden to establish confusing similarity only requires a simple comparison of the UNIQLO mark and the disputed domain name. The incorporation of a well-known trademark within a disputed domain name, along with a geographic indicator, as is the case here, is alone enough to sustain a finding of confusing similarity. Moreover, the addition of the generic top-level domain ".com" does nothing to distinguish the disputed domain name from Complainant's mark. The addition of the ".com" top-level domain is negligible.

Thus, the Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the trademarks in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAME

The second element of the claim only requires that the Complainant make a prima facie showing that respondent lacks a right or legitimate interest in the disputed domain name. Once a complainant has made such a showing, the burden shifts to the respondent to demonstrate that it has rights or legitimate interest in the disputed domain name.

The Panel finds that Respondent has no rights or legitimate interest in the disputed domain name. Respondent registered the disputed domain not only a decade after Complainant's rights in the famous and distinctive UNIQLO trademark were registered in Vietnam, but is also using the disputed domain name to offer for sale items from Japan that could be linked with the Complainant's business. Complainant's rights in UNIQLO trademark predate any registration or use of the disputed domain name by ten years at least. It was established that the website available at the disputed domain name provides only a rudimentary retail store, which purports to offer products from Japan and thus is in direct competition with Complainant. There is no evidence from the WHOIS that Respondent is commonly known by the disputed domain name. Rather, the fact that the disputed domain name is confusingly similar to Complainant's UNIQLO mark indicates that Respondent is attempting to use the disputed domain name to profit from Complainant's goodwill in that famous mark. The Panel finds that the website available at the disputed domain name is not used for any sort of non-commercial fair use such as parody or comment. In conclusion Complainant has met its burden to make a prima facie showing that the Respondent has no rights or legitimate interest in the disputed domain name. 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 name and will be unable to meet this burden.

Thus, 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).

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

The Panel concludes that the Respondent has registered and/or used a domain name in bad faith where the purpose of the registration is to cause confusion as to the source of the website or other service offered via the domain name. Respondent is merely taking advantage of the Complainant's fame and goodwill to attract users to Respondent's website. That is clearly a bad faith use of the disputed domain name. It is obvious that by its prominent use of Complainant's globally famous, coined UNIQLO trademark, Respondent is using the disputed domain name for no other reason than to disrupt Complainant's business by trying to confuse internet users into believing they might be led to, or have arrived at, a website run by the Complainant or its subsidiary. This practice alone is enough to cause a disruption to Complainant's business, as any reasonable person is likely to be confused about the source or affiliation of this disputed domain name and the website run thereon. Panel moreover finds that the Respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark for the Respondent's commercial benefit, even if unsuccessful. Moreover, the fact that Respondent has undertaken such actions decades after Complainant's trademark rights arose is further evidence of a bad faith registration of the disputed domain name. It also impossible that a name as specific and peculiar as UNIQLO could have been found or chosen by chance. Given that "UNIQLO" is not a dictionary and/or commonly used term but a trademark with a famous worldwide reputation, the Panel infers that the Respondent must have had the Complainant's trademark in mind when registering the disputed domain name. The disputed domain name was therefore registered in bad

faith. Even if Respondent did not have actual knowledge of Complainant’s trademarks, Respondent had a duty to ensure that the registration of the disputed domain name would not infringe a third party’s rights.

Thus, 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **UNIQLOJAPAN.COM**: Transferred

PANELLISTS

Name	JUDr. Vojtěch Trapl
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DATE OF PANEL DECISION 2022-06-24

Publish the Decision