

Decision for dispute CAC-UDRP-104701

Case number	CAC-UDRP-104701
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Time of filing	2022-07-13 08:53:51
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Domain names	uniqlobd.com
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Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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	Director Mohd Moniruggaman
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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

Complainant has established extensive trademarks registrations around the world in the UNIQLO mark.

The Complainant has been using the UNIQLO mark in global commerce globally and continuously for many decades. Complainant has also registered the UNIQLO mark in many jurisdictions throughout the world, including but not limited to China, the United States and Bangladesh.

As one of those international registrations, the Complainant relies on the trademark registration for

UNIQLO, Trademark number 129969 which was registered on February 3, 2010 with the Department of Patents, Designs and Trademarks of the People's Republic of Bangladesh. Evidence has been tendered to establish that fact and the Panel accepts that evidence. Therefore, although the Panel will take notice of all of the international registrations, the present discussion need only have regard to one such registration, as the Complainant is required only to adduce evidence of "a trademark" and the Complainant's registration in Bangladesh is clearly the most significant of the registrations for that purpose.

Thus, the Panel finds that the Complainant has rights in the UNIQLO mark as registered in Bangladesh and internationally.

Notably, the Complainant registered its mark in Bangladesh more than ten years before the disputed domain name was registered.

Complainant submits that it has invested copious amounts of time and money to promote the ubiquitous UNIQLO brand, both in Bangladesh 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 Bangladesh as well as China, the United States, and throughout the world.

The WHOIS records in evidence prove that the Disputed Domain was registered in December, 2021. The domain name invokes Complainant's aforementioned business operations and website in Bangladesh. Indeed, the Respondent apparently resides in Dhaka, Bangladesh. The disputed domain name resolves to a website published on Wordpress, which seems to have listings for clothing items available for sale. The bottom of the website indicates the intent of the website: "We are online shopping market place where consumer can shopping their products with trust and satisfaction."

The use of the name Uniqlo BD for this 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.

No Business Relationship Exists Between the Parties

Obviously, Respondent does not have, and never has had, Complainant's permission to use the UNIQLO trademark in such manner, or at all.

FACTUAL BACKGROUND

The Complainant is a Japanese multinational company that offers innovative clothing, footwear, headwear and fashion accessories to consumers worldwide, under the internationally famous brand UNIQLO.

Complainant operates in many places internationally including Bangladesh and its online store for Bangladesh is at <grameenuniqlo.com> which incorporates its famous trademark UNIQLO and which is used for the Complainant's business in that country.

Complainant has a partnership in Bangladesh with the company Grameen to produce and supply its products in Bangladesh.

Respondent has registered the domain name <uniqlobd.com> which is an obvious copy of the UNIQLO trademark with the addition of the letters "bd" which constitute the internet country code designation for Bangladesh.

The Complainant is concerned at the damage that is and can be done to its trademark and brand if the Respondent is permitted to continue using the disputed domain name and to pretend falsely that it is associated with the Complainant and it has therefore brought this proceeding to have the domain name transferred to the Complainant.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

A summary of the Parties' contentions is as follows.

COMPLAINANT

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

The Complainant submits that it has trademark rights in the UNIQLO mark that are derived from its registration of the mark with many trademark authorities around the world. Evidence has been tendered to that effect. Among those international registrations, the Complainant relies in particular on its registration of the mark in Bangladesh as it appears from the record that the Respondent lives in Bangladesh.

The Complainant also submits that the domain name is confusingly similar to the UNIQLO mark as it is an exact copy of the mark with the addition of the letters "bd" and the ".com" gTLD.

The Complainant submits that the domain name and the trademark are confusingly similar. They are similar because the entire trademark is included and they are confusingly so because the addition of the letters "bd" invokes Bangladesh and implies that the domain name and any website to which it leads will be official and will deal with the legitimate promotion of the Complainant's goods and services in Bangladesh.

Moreover, the addition of the generic top-level domain ".com" does nothing to distinguish the disputed domain name from the UNIQLO mark.

In summary, a simple comparison of the UNIQLO mark and the disputed domain name demonstrates that they are confusingly similar, and the addition of the "bd" country code and the .com top-level domain is negligible. Therefore, the Complainant has established the first element of the Policy under paragraph 4(a).

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

The second element of a UDRP claim only requires that the complainant make prima facie showing that respondent lacks a right or legitimate interest in the disputed domain name.

The Respondent has no rights or legitimate interests in the disputed domain name as the Respondent registered it more than a decade after Complainant's rights in the famous and distinctive UNIQLO mark were established and registered in Bangladesh.

Also, the Respondent is using the disputed domain name to offer access to an apparent web store that could be linked with the Complainant's business in the retail fashion industry in Bangladesh. Thus, Complainant has demonstrated longstanding, exclusive use of the UNIQLO trademark, and Complainant's rights predate any registration or use of the disputed domain name by Respondent by 20 years at least.

The Complainant submits that the respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, is not commonly known by the disputed domain and is not making a legitimate noncommercial use or fair use of the disputed domain name.

The website available at the disputed domain name provides only a rudimentary retail fashion store, which is in direct competition with Complainant.

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 the Complainant submits that this is very apparent on the evidence in the present case.

The evidence is that the Respondent is not commonly known by the disputed domain name. That is so because the WHOIS record lists 'uniqlobd' as the registrant organization, and the Infringing Website contains Uniqlobd in the top line, with an address, phone, e-mail and logo that is primarily in the same color red as Complainant's famous logo. The Complainant is not aware of any such organization in Bangladesh or elsewhere. It is highly doubtful that any such organization exists.

Moreover, the disputed domain name is confusingly similar to Complainant's UNIQLO mark, indicating that Respondent is attempting to use it to profit from Complainant's goodwill in that famous mark. Such blatantly infringing use cannot be legitimate under the Policy.

There is simply no evidence that the Respondent is or ever was commonly known by the domain name.

Also, the evidence is that the website at the disputed domain name is not used for a non-commercial fair use such as parody or comment but to go into competition with the Complainant. 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.

Complainant has therefore made out prima facie showing that the Respondent has no rights or legitimate interests in the domain name.

RESPONDENT REGISTERED AND USED THE DISPUTED DOMAIN NAME IN BAD FAITH

Respondent Intentionally attempted to divert internet users by creating a likelihood of confusion.

This case comes clearly within the meaning of paragraph 4(b)(iv) of the Policy as the Respondent has attempted to create confusion between the Complainant's mark and the nature of the website to which the domain name resolves.

The Respondent has merely put on the internet a rudimentary online retail fashion store, which is in direct competition with Complainant. This shows that the intention of the Respondent was to give the false impression that the domain name would lead to an official website of the Complainant promoting its goods and services, which is false and the Respondent must be taken to have known that it was false. Thus, the Respondent, in doing so, registered and then used the domain name in bad faith.

Moreover, Respondent has been taking advantage of the Complainant's fame and goodwill, not only its global fame but in particular the fame of Complainant's business operations in Bangladesh and Respondent has been doing so to attract users to Respondent's website.

The evidence will also show that the Respondent registered the disputed domain name primarily for the purpose of disrupting complainant's business.

By its prominent use of Complainant's globally famous and 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 that 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 domain name and the website run on it.

Respondent is also 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.

Moreover, 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 registration. Such a use results in a disruption to Complainant's business and demonstrates Respondent's bad faith registration and use of the disputed domain name.

Moreover, the fact that Respondent has undertaken such actions decades after Complainant's trademark rights arose is further evidence of bad faith registration for the sole purpose of disrupting Complainant's business for Respondent's own commercial

gain.

It can also reasonably be inferred that Respondent was aware of Complainant's rights given the way the Respondent has been using the domain name. It also impossible that a name as specific and unique 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 should infer 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.

Indeed, how could the Respondent not have known of the UNIQLO trademark when it registered and then used the disputed domain name? Thus, Respondent failed to discharge its duty to ensure that its registration of the domain name would not infringe Complainant's famous trademark, and the registration and use of the domain name was thus in bad faith.

For all of these reasons the Respondent registered and used the domain name in bad faith.

With respect to each of the foregoing elements, the Complainant has cited several prior UDRP decisions in support of its contentions.

RESPONDENT

Respondent did not file a Response in this proceeding.

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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

A. Administrative compliance

By notification dated July 13, 2022 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that:

1) In its Complaint, it had not sufficiently identified the Respondent and it was invited to see the Registrar's verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder.

2) Its Complaint did not specify to which Mutual Jurisdiction the Complainant would submit with respect to any challenges to a decision in a UDRP proceeding, i.e. either:

- a. The principal office of the Registrar (provided the domain name holder had submitted to that jurisdiction for court adjudication of disputes concerning or arising from the use of the domain name in its Registration Agreement); or
- b. The domain name holder's address as provided in the registration of the domain name under Registrar's WHOIS database at the time the complaint is submitted to the CAC.

In accordance with Paragraph 4 (d) of the Rules, the Complainant was requested to correct the above-mentioned deficiencies and submit an amended Complaint within five (5) days of receiving the notification. The amended Complaint was required to be submitted using the Form "Amend Complaint" available on the CAC's on-line platform in the left-hand menu of the Case File.

On July 18, 2022, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) The 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.

The Panel will therefore deal with each of these requirements in turn.

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

A. Identical or Confusingly Similar

The Complainant has adduced evidence described above and which the Panel accepts to the effect that it is the registered owner of the UNIQLO trademark and that as such it has rights in that trademark and had them at the time the disputed domain name was registered.

The Panel next finds that the disputed domain name <uniglobd.com> is confusingly similar to the UNIQLO trademark for the following reasons.

The domain name includes the entirety of the UNIQLO trademark and the addition of the letters "bd" which constitute the internet country code for Bangladesh. Accordingly, the domain name would inculcate in the mind of any internet user who saw it, particularly in Bangladesh, that it was in fact the well-known UNIQLO mark and hence an official domain name of the Complainant that would lead to an official website of the Complainant.

Secondly, as the domain name includes the two letters "bd", the internet user would naturally think that this may well be an official domain name of the Complainant for use in Bangladesh which would also lead to an official website of the Complainant promoting its goods and services in Bangladesh, which it is not. The internet user would therefore find the domain name and the trademark similar and confusingly so.

Thirdly, taken as a whole, the domain name would convey to the objective bystander that it related to the activities of the Complainant particularly in Bangladesh, giving rise to inevitable confusion.

It is also now well established that the addition of a generic top-level domain, such as ".com" in the present case, cannot negate confusing similarity that is otherwise present, as it is in this case.

Accordingly, the Panel finds that the domain name is confusingly similar to the Complainant's UNIQLO trademark. The Complainant has thus shown the first of the three elements that it must establish.

That conclusion is supported by prior UDRP decisions cited by the Complainant.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in

the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The evidence of the Complainant is that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the trademark UNIQLO and does not carry out any activity for, nor has any business with, the Complainant.

It is also clear from the evidence that the Respondent is not commonly known by the domain name under Policy 4(c)(ii).

Moreover, the essence of this proceeding is that the Respondent has deliberately altered the spelling of the trademark by the addition to the trademark of the letters "bd" which stand for Bangladesh, to deceive and trick internet users into thinking that the domain name is an official domain name of the Complainant and that it will lead to an official website of the Complainant dealing with the promotion of the Complainant's legitimate business in Bangladesh, which it is not, as it is completely unauthorized. Clearly, such conduct cannot give rise to a right or legitimate interest in the domain name and the Panel finds that it does not.

The disputed domain name points to a parking page with commercial links in relation to the Complainant and its competitors. It is now well established that such conduct cannot give rise to a right or legitimate interest in the domain name and the Panel so holds in the present proceeding. The reason why that is so is a valid one, namely that the Respondent is in fact using the Complainant's trademark to earn money under colour of the Complainant's name and trademark. That is illustrated by Annex 6 to the Complaint which shows that using a confusingly similar domain name as the Respondent has done is an attempt to promote online the sales of products that are competitive with those of the Complainant, which does not give rise to a right or legitimate interest in the disputed domain name.

These facts give rise to the prima facie case made out by the Complainant.

None of the evidence could conceivably give rise to a right or legitimate interest on the part of the Respondent in the domain name.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default.

Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registration and Use in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website 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 the respondent's website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraphs 4(b) (iii) and (iv) of the Policy and probably within other provisions of paragraph 4 (b) and bad faith in general.

That is so for the following reasons.

The Complainant first submits that it is reasonable to infer that Respondent was aware of Complainant and its well-known trademark at the time of registration of the disputed domain name. The Panel agrees. Because of the fame and strong reputation of the UNIQLO trademark, the Respondent must have been aware of the existence of the Complainant and its reputation when it registered the disputed domain name. The Panel finds that it is highly likely that the Respondent chose the trademark to invoke the concept of the Complainant, its fame and its activities and particularly in Bangladesh, as the domain name was clearly aimed at the Complainant's activities in Bangladesh. By that means the Respondent, in registering the domain name deceptively and without any authority to do so, must be taken to have created a likelihood of confusion, with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. Accordingly, the domain name was registered in bad faith within the meaning of paragraph 4 (b)(iv).

Secondly, the Respondent is also in breach of paragraph 4 (b)(iv) because the disputed domain name points to a website with commercial links. The Panel accepts the Complainant's evidence to that effect and the use the Complainant makes of those links having been made by the Respondent and by the Respondent having traded on them. Thus, the Complainant contends, and the Panel agrees, that the Respondent registered the disputed domain name primarily for the purpose of deceptively attracting internet users to its own website for commercial gain by confusing its site with that of the Complainant. The Panel agrees. That conduct is clearly in bad faith and the Panel so holds. The Panel also notes that there are many UDRP decisions to that effect.

Thirdly, the evidence leads to the conclusion that the Respondent registered the domain name to attract, for commercial gain, internet users to its web site. By clicking on these links, internet users are redirected to a webpage in which links to competing goods and services are displayed. These facts also bring the case squarely within paragraph 4(b)(iv) of the UDRP, i.e. "by using the domain name, (the Respondent) ... intentionally attempted to attract, for commercial gain, Internet users to (its) 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 (its) web site or location or of a product or service on (its) web site or location".

Fourthly, the conduct of the Respondent also amounts to a probable intention to try to sell the domain name, intending to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name within the meaning of paragraph 4(b) (ii) and intending to disrupt the business of the Complainant within the meaning of paragraph 4(b)(iii).

Fifthly, apart from and in addition to the specific criteria for bad faith and having regard to the totality of the evidence, the Panel finds that, in view of Respondent’s registration of the disputed domain name using the UNIQLO mark and in view of the conduct that Respondent has engaged in when using the domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

As the Complainant submits, such conduct has been held by previous UDRP panels to constitute bad faith registration and use.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

The Complainant must therefore prevail in this proceeding.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **UNIQLOBD.COM**: Transferred

PANELLISTS

Name	The Hon. Neil Brown, QC
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DATE OF PANEL DECISION	2022-08-11
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Publish the Decision
