Decision for dispute CAC-UDRP-105063

Case number	**CAC-UDRP-105063**
Time of filing	**2022-12-16 09:16:49**
Domain names	**xn--bck9e5a2832f.com**

Case administrator

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

Complainant

Organization	**KADOKAWA CORPORATION**

Complainant representative

Organization	**RODENBAUGH LAW**

Respondent

Name	**Jan Everno**

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 following trademark registrations:

Trademark	Jurisdiction	Reg. No.	Filing Date	Reg. Date
	Japan	3042467	Apr. 16,1992	May 31, 1995
(stylized)	United States	3064830	Sept. 2, 2004	Mar. 07, 2006

The Complainant proved its ownership of listed trademark registrations by the submitted extract from the Registers.

FACTUAL BACKGROUND

The Complainant is a Japanese multinational company that provides publishing and entertainment services globally. One of the Complainant's famous online publications is a video game review magazine found at <famitsu.com>. The title of this publication is ,

which is a Japanese transliteration of “famitsu” (provided as annex).

The disputed domain name <xn--bck9e5a2832f.com> (hereinafter “disputed domain name”) was registered on May 28, 2019 (provided as annex) and resolves to an Apple iTunes download page (provided as annex).

According to the Registrar verification, the Respondent is Jan Everno. The Respondent’s provided address as being at Grandville, MI, the United States.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the Complainant’s trademarks.
First, the Complainant contends It has prior valid trademark rights in the mark and that it may satisfy the threshold requirement for standing under Paragraph 4(a)(i) of the UDRP by demonstrating ownership of a valid trademark [WIPO Case D2007-1629, F. Hoffmann-La Roche AG v. Relish Enterprises) (quoting “WIPO Decision Overview” at §1.1)]. The Complainant adds that its trademark registrations for the mark establish its prior rights pursuant to paragraph 4(a)(i) of the UDRP.

The Complainant’s trademark rights in the mark date back to at least 1992, when the mark was first applied for in Japan (evidenced by Annex). Moreover, the Complainant’s rights in the United States date to at least 2004, when the mark was applied for at the USPTO (evidenced by Annex). On the other hand, the disputed domain was not even registered by the Respondent until May 2019 (evidenced by Annex). Therefore, the Complainant assumes that the Respondent (who is purportedly residing in the US) was on constructive notice of the Complainant’s US registration for some fifteen years prior to registering the disputed domain name. Furthermore, a cursory internet search of would prominently have led Respondent to Complainant’s website, indicating Complainant’s common law trademark rights in the US (evidenced by Annex).

The Complainant adds that the mark is essentially identical to the disputed domain name. The Complainant points out that “[a] showing of confusing similarity only requires a “simple comparison of the mark relied upon with the domain name in issue.” (WIPO Case No. D2009-0227, Research in Motion Limited v. One Star Global LLC).

Consequently, the Complainant contends that a simple comparison of the mark and the disputed domain name demonstrates that they are essentially identical, as the addition of the .com top-level domain is negligible. Therefore, the Complainant asserts that has established the first element of the UDRP under Paragraph 4(a).

The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.
The Complainant contends that the Respondent has no rights or legitimate interest in the disputed domain name. The Respondent not only registered the disputed domain name decades after the Complainant’s rights in the famous and distinctive mark were registered, but also is using the disputed domain name to redirect internet users to the Apple website, for the Respondent’s commercial gain (evidenced by Annex). Additionally, the Complainant has demonstrated longstanding registration and exclusive global use of the trademark (evidenced by Annexes), and the Complainant’s rights predate any registration or use of the disputed domain name by the Respondent by 27 years at least.

The Complainant suggests that in considering whether a respondent has a right or legitimate interest in a disputed domain name under Paragraph 4(c) of the UDRP, the Panel may consider: (i) whether the respondent is using the disputed domain in connection with a bona fide offering of goods or services; (ii) whether the respondent is commonly known by the disputed domain; and (iii) whether the respondent is making a legitimate noncommercial use or fair use of the disputed domain name.

In that context, the Complainant brings the following statements:

“Respondent Does Not Use, And Has Not Used, The Disputed Domain name In Connection With A Bona Fide Offering Of Goods Or Services
The website resolving from the Disputed Domain Name is an Apple iTunes download page. See Annex. Use of a domain name that is confusingly similar to a complainant’s mark to promote the sales of third-party commercial products online, is not a bona fide use of the Disputed Domains. See, e.g., WIPO Overview 2.5.3 “Commercial Activity” (“a respondent’s use of a complainant’s mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests”); Sanofi-aventis v. Brian Nagele, D2011-0669 (WIPO Arbitration and Mediation Center June 6, 2011) (finding bad faith when the disputed domain was used by the Complainant to promote a competitive medicinal product).

Respondent is Not Commonly Known by the Disputed Domain Name
There is no evidence from the WHOIS that Respondent is commonly known by the Disputed Domain name. See Annex; Braun Corp. v. Loney, Claim No. 699652 (Forum July 7, 2006) (finding respondent was not commonly known by the disputed domain names where the Whois record did not indicate such). Rather, the fact that the Disputed Domain is identical to Complainant’s mark indicates that Respondent is attempting to use the Disputed Domain name to profit from Complainant’s goodwill in that famous mark.

Respondent Does Not Use The Disputed Domain Name For Any Legitimate Or Noncommercial Fair Use
The website available at the Disputed Domain Name is not used for any sort of non-commercial fair use such as parody or comment. Instead, the website only redirects to a third-party software download site. See Annex. Use of a domain name that is confusingly similar to a complainant’s mark to promote the sales of third-party commercial products online, is not a bona fide use of the Disputed

Domain name. See, e.g., WIPO Overview 2.5.3 “Commercial Activity” (“a respondent’s use of a complainant’s mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests”); Sanofi-aventis v. Brian Nagele, D2011-0669 (WIPO Arbitration and Mediation Center June 6, 2011) (finding bad faith when the disputed domain was used by the Complainant to promote a competitive medicinal product).”

In consequence, the Complainant asserts that 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. According to the Complainant, the evidence strongly demonstrates that the Respondent lacks any rights or legitimate interest in the disputed domain name and will be unable to meet this burden.

The Complainant contends that the disputed domain name has been registered and is being used in bad faith.
While demonstrating that the disputed domain name has been registered and is being used in bad faith, the Complainant raises the following statements:

“Respondent Intentionally Attempts To Divert Internet Users By Creating Likelihood Of Confusion
A 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. Under Paragraph 4(b)(iv) of the UDRP, the Panel may make a finding that the registrant has registered and used a domain name in bad faith where “by using the domain name, [the registrant has] 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 [registrant’s] web site or location or of a product or service on [registrant’s] web site or location.”

According to the Complainant the Respondent has made active use of the disputed domain name to redirect to the Apple website, and to offer the disputed domain name for sale. Use of a domain name that is confusingly similar to a complainant’s mark to promote the sales of third-party commercial products online, is not a bona fide use of the domain names. Instead, 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 under the UDRP.

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 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 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 thereon.

Such use results in a disruption to Complainant’s business and demonstrates Respondent’s bad faith use and registration 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 a bad faith registration for the sole purpose of disrupting Complainant’s business for Respondent’s own commercial gain.

Respondent Was Or Should Have Been Aware Of Complainant’s Rights In The 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 domain name. It is also impossible that a name as specific and peculiar as 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.

Respondent is a Serial Cybersquatter; Further Proving Bad Faith in This Case
UDRP panels typically find that a pattern and practice of past cybersquatting is a very strong indication of bad faith registration and use under the Policy. See, e.g., WIPO Overview 3.1.2 (“UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration”) (citing cases). In this case, Respondent’s pattern of bad faith cybersquatting is abundantly clear. According to the UDRP.tools website, Respondent has lost at least 20 UDRP decisions” (see e. g. WIPO No. D2022-1801; Forum No. 1983493; Forum No. 1902824; WIPO No. D2020-1393).

RESPONDENT:

No administratively Complaint 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 UDRP).

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 UDRP).

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 UDRP).

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

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them (Paragraph 5(f) of The Rules).

CONFUSING SIMILARITY
The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark "".

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter "The WIPO Overview 3.0") in Paragraph 1.7 states: "[…] in cases where a domain name incorporates the entirety of a trademark […] the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

In the WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin, the Panel stated that: "In numerous cases, it has been held that a domain name that wholly incorporates a Complainant's registered mark may be sufficient to establish confusing similarity for purposes of the UDRP."

In the WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., the Panel stated that: "It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar".

In the Forum Case No. FA2212002022524, E*Trade Financial Holdings, LLC v. Jerry Hughes, the Panel stated that: "The domain name in dispute is <xn--etrde-zqa.org> which is an internationalized domain name ("IDN") that, with a PUNYCODE translation, is identified as <etráde.org>. An IDN is a domain name that contains non-traditional characters, such as letters with diacritics or other non-ASCII characters. In order to display characters or symbols in a domain name, the terms of the domain name are encoded into a scheme such as PUNYCODE. For Complainant to display the <xn--etrde-zqa.org> properly in the <etráde.org> domain name, it first had to encode it into the <xn--etrde-zqa.org> domain name.
IDNs and their PUNYCODE translations are equivalent. See Damien Persohn v. Lim, FA 874447 (Forum Feb. 19, 2007) (finding an internationalized domain name, <têtu.com>, and its PUNYCODE translation, <xn--ttu-fma.com>, to be one and the same under the Policy); see also Württembergische Versicherung AG v. Emir Ulu, D2006-0278 (WIPO May 4, 2006) (finding that the <xn--wrttembergische-versicherung-16c.com> should be considered as equivalent to the <württembergische-versicherung.com> domain name, based on previous panel decisions recognizing the relevance of I-nav software for translating German letters such as "ä" or "ü" into codes such as <xn--[name]-16c> and similar)."

In the current proceedings, the Complainant has established that owns Japanese and US trademark registrations for the "" mark designated for the classes in connection with books and magazines containing news and information concerning computer, video and global computer network games (evidenced by Annex).

The disputed domain name <xn--bck9e5a2832f.com> is an international domain name that, with a PUNYCODE translation, is identified as <.com> (evidenced by Annex). The Panel finds that the <.com> domain name is the same as its PUNYCODE translation, <xn--bck9e5a2832f.com>, for purposes of these proceedings. Therefore, the Complainant's trademark is incorporated in its entirety in the disputed domain name. The addition of the gTLD <.com> does not change the overall impression of the disputed domain name either.

As stated in the WIPO Overview 3.0 in Paragraphs 1.7, where a domain name incorporates the entirety of a trademark, the domain will normally be considered confusingly similar.

Therefore, the disputed domain name <xn--bck9e5a2832f.com> as it reproduces the "" trademark in its entirety is considered to be confusingly similar to the relevant trademark.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfils this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the Policy (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman).

Moreover, past Panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past Panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the Policy, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing particular evidence.

In the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., the Panel stated: “Complainant must make at least a prima facie showing that Respondent has no rights or legitimate interests in the mark. After Complainant has met its initial burden of proof, if Respondent fails to submit a response Complainant will be deemed to have satisfied Paragraph 4 (a) ii of the Policy.”

In the CAC Case No. 102279, FileHippo s.r.o. v. whois agent, the Panel stated that “[i]n the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under Paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of Paragraph 4(a)(ii) of the Policy.”

The WIPO Overview 3.0 in Paragraph 2.5.3 states: “[…] a respondent’s use of a complainant’s mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests.”

In the Forum Case No. FA 1781783, Skechers U.S.A. Inc. v. Chad Moston / Elite Media Group, the Panel stated that: “where a response is lacking, WHOIS information can support a finding that the respondent is not commonly known by the disputed domain name”.

In the Forum Case No. FA0605000699652, The Braun Corp. v. Wayne Loney, the Panel stated that: “Complainant contends that because the WHOIS information lists the registrant of the domain names as “Wayne Loney,” and there is no other evidence in the record indicating that Respondent is commonly known by any of the disputed domain names, Respondent is not commonly known by any of the disputed domain names.”

In the present case, the Complainant states that the Respondent has no rights or legitimate interest in the disputed domain name. Moreover, the Complainant contends that the Respondent registered the disputed domain decades after the Complainant’s marks were registered (evidenced by Annexes) and that the Respondent is, by redirecting the users to Apple iTunes website, using the disputed domain name for commercial gain (evidenced by Annex).

As was stated above, the disputed domain is confusingly similar to the Complainant’s mark, registered in Japan in 1995 and in the US in 2006 (evidenced by Annex). On the other hand, the disputed domain name was registered in 2019 (evidenced by Annex). The Respondent’s provided address is in Grandville, US. A simple Google search of mark shows multiple results featuring the Complainant apps and <famitsu.com> website (evidenced by Annex). In the Whois database, there is no other evidence in the record indicating that the Respondent is commonly known by the disputed domain (evidenced by Annex). Therefore, this Panel states that the Respondent is not commonly known by the disputed domain name.

Moreover, the disputed domain name redirects internet users to a competing Apple iTunes download page (demonstrated by Annex). By that, it promotes the sales of third-party products online and so constitutes a commercial activity. This Panel states that the disputed domain is not used bona fide.

To the satisfaction of the Panel, the Complainant has shown a prima facie case that the Respondent has no rights to the Complainant’s trademarks nor the disputed domain name.

The Respondent did not reply to the Complaint and so failed to demonstrate its rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the UDRP.

THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH
The Panel finds that the Respondent registered and used the disputed domain in bad faith.

According to Paragraph 4(b)(iv) of the UDRP “[…] following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: […] (iv) by using the domain name, you [the registrant] have intentionally attempted to attract, for commercial gain, Internet users to your [the registrant’s] 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 your web site or location or of a product or service on your web site or location.“

The WIPO Overview 3.0 in Paragraph 3.1.4 states: “Panels have consistently found that the mere registration of a domain name that is

identical or confusingly similar […] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Panels have moreover found the following types of evidence to support a finding that a 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: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, (iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer, (v) redirecting the domain name to the complainant's (or a competitor's) website, and (vi) absence of any conceivable good faith use."

The WIPO Overview 3.0 in Paragraph 3.2.2 states: "[n]oting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

The WIPO Overview 3.0 in Paragraph 3.1.2 states: "UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration."

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the Panel stated: "when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted."

In the present case, the Complainant owns trademark registrations consisting of the "" mark, registered in Japan (1995) and in the US (2006) (evidenced by Annex). Moreover, the Complainant has a certain reputation in online entertainment publications globally (proven by Annexes).

Therefore, this Panel assumes that the Respondent must have been aware of the Complainant's trademark and Its reputation before the registration of the disputed domain name on May 2019.

To the satisfaction of this Panel, it is established that the Respondent registered the disputed domain name which incorporates the entirety of the Complainant's widely known trademark. Additionally, the Respondent is not recognized as the disputed domain name in the Whois database (evidenced by Annex). Therefore, the domain was registered by an unknown and unaffiliated entity.

Furthermore, the disputed domain name resolves to the Apple iTunes download page (evidenced by Annex). By that, the Respondent is using the disputed domain name for commercial purposes and his own commercial gain. Therefore, the Respondent is taking unfair advantage of the Complainant's mark reputation in order to attract internet users. Additionally, the Respondent is confusing internet users into believing that the disputed domain is part of the Complainant's business activities. In the view of the Panel, this form of use represents bad faith.

In addition to that, the Respondent must have been aware of the Complainant's mark at the time of the disputed domain's registration. Such a specific mark as the could have been found by a simple Google search (demonstrated by Annex) before the domain's registration.

Moreover, the Respondent previously registered numerous domain names abusing other parties trademark rights. Past Panels held in favor of the trademark owners (see e. g. WIPO No. D2022-1801; Forum No. 1983493; Forum No. 1902824; WIPO No. D2020-1393).

Following the above mentioned, the Panel finds that the Complainant has satisfied Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **xn--bck9e5a2832f.com** : Transferred

PANELLISTS

Name	**Radim Charvát**

DATE OF PANEL DECISION 2023-01-24

Publish the Decision