Decision for dispute CAC-UDRP-106049

Case number	CAC-UDRP-106049
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Domain names	sonic-thehedgehog.org

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	SEGA CORPORATION

Complainant representative

Organization	Zacco Sweden AB

Respondent

Name	Kamryn Dudley

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 numerous SONIC and SONIC THE HEDGEHOG trademarks, including:

- EU word trademark registration no. 003904471 “SONIC THE HEDGEHOG”, registered on November 3, 2005;
- EU word trademark registration no. 003904448 “SONIC”, registered on September 21, 2011;
- EU figurative trademark registration no. 000076653 “SONIC”, registered on April 15, 1998.

The Complainant also owns domain name <sonicthehedgehog.com> registered on May 31, 1997, and owned through the Complainant’s subsidiary, Sega Europe Ltd.
The disputed domain name <sonic-thehedgehog.org> was registered on September 19, 2023.

PARTIES CONTENTIONS

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

- The Complainant is a multinational video game and entertainment company headquartered in Tokyo, Japan, with several subsidiaries. The company was founded in 1960 and released its internationally known video game Sonic the Hedgehog in 1991.

- Over time, Sonic the Hedgehog series included 25 mainline games and countless spin-offs and collaborations with other game manufacturers, involving various characters from the game. Today, the series consists of nine games. The game has sold over 140 mn units by 2016 and grossed over US$5 bn as of 2014. Series sales and free-to-play mobile game downloads totalled 1.5 bn as of 2022.
- Sonic the Hedgehog has been listed as one of the greatest games of all time by many magazines. For many, Sonic the Hedgehog is a symbol of culture of the 1990s and has become a cultural phenomenon itself. The game's admirers invest in collections of numerous memorabilia items connected to the game. The largest collection of 3,050 items has been entered in the Guinness World Records in 2022.
- The main trademarks for the Sonic the Hedgehog game series are the word marks SONIC and SONIC THE HEDGEHOG as well as the figurative mark. The marks have been intensively used since their inception not only for the video games but for a wide variety of products and services, including films, books, journals, merchandise, collectibles and foods.
- As of 2023, the Sonic brand as such is valued at over US$5 bn.

A. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

- The Complainant owns multiple trademark registrations and applications for the word marks SONIC, SONIC THE HEDGEHOG and the figurative mark worldwide. The trademarks cover a broad variety of goods and services, including video game software and computer game programs in class 9. They are protected, inter alia, in the EU, where the Respondent is residing. Furthermore, the Complainant owns many domain names incorporating the Sonic Trademarks, including <sonicthehedgehog.com>.
- The disputed domain name is confusingly similar to the Sonic Trademarks, in which the Complainant has rights. The trademarks SONIC and SONIC THE HEDGEHOG are included in their entirety in the disputed domain name. The only symbol that differs the disputed domain name from the main domain of the Complainant is a dash in the middle of the mark. It is obvious that the use of such similar designation is intended to give potential visitors the impression that the disputed domain name represents the original website for the Complainant's game Sonic the Hedgehog.
- The addition of the generic Top-Level Domain ("gTLD") ".org" does not have any impact on the overall impression of the dominant part of the disputed domain name and is therefore irrelevant when determining the confusing similarity between the Sonic Trademarks and the disputed domain name.
- There is a considerable risk that the target public will perceive the disputed domain name either as a domain name owned by the Complainant, or that there exists a business relationship between the Complainant and the Respondent. By using the Sonic Trademarks as the main part of the disputed domain name, the Respondent exploits the goodwill and the image of the Complainant's trademark, which may result in dilution and other damage to the trademark.

B. The Respondent has no rights or legitimate interest in respect of the disputed domain name

- To the best of Complainant's knowledge, there is no information indicating that the Respondent is known for, trades under or prepares for use of a name corresponding to the disputed domain name. In fact, the website connected to the disputed domain name refers to the Complainant and its subsidiaries as if it was them who owned and operated the website. The website used the same layout, colours and content compared to the Complainant's own website. Under such circumstances, the Respondent cannot claim to be commonly known by the disputed domain name or by names corresponding to the disputed domain name.
- The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services. Instead, the Respondent has intentionally chosen the disputed domain name based on another trademark in order to generate traffic and presumably income through a website displaying a clear copy of the Complainant's own website, including use of the Complainant's logotype, name, design and corporate colours. Although the actual purpose of reproducing the Complainant's original website by the Respondent is unclear, the Complainant submits that the Respondent's actions resulted in confusing Internet users, who search for the Sonic the Hedgehog game, about the website's origin and affiliation with the Complainant.
- No license or authorization of any other kind has been given by the Complainant to the Respondent to use the Sonic Trademarks. Furthermore, the Respondent is not an authorized dealer of the Complainant's products or services and has never had a business relationship with the Complainant. As no evidence has been found indicating that the Respondent is using the name "SONIC THE HEDGEHOG", or similar, as a company name or that it has any other legal rights in the name, it is quite clear that the Respondent is simply trying to sponge off the Complainant's trademarks, presumably for its own commercial benefit.
- Further, the website does not fulfil the test put forward in Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903 in connection with any allegation that the Respondent is a reseller or distributor and is making a bona fide offering of goods or services. The Complainant argues that the Respondent's non-existing relationship with the Complainant is not being made clear on the website connected to the disputed domain name. To the contrary, the Respondent has prominently included the Complainant's logotype and design on the main page in order to create the impression that the disputed domain name is somehow connected to the Complainant. Such use does not give rise to a legitimate interest in the disputed domain name.
- Accordingly, for the foregoing reasons, the Complainant argues that the Respondent has no legitimate interest in the disputed domain name.

C. The disputed domain name was registered and is being used in bad faith

- The Complainant holds registrations of the trademarks SONIC and SONIC THE HEDGEHOG worldwide, including in the EU. The Sonic Trademarks are well known within, but not limited to, the EU.
- The disputed domain name was registered by the Respondent in September 2023. This date is subsequent to when the Complainant obtained registered trademark rights for Sonic Trademarks in the EU and in many other countries. It is evident that it is the fame and value of the Sonic Trademarks that has motivated the Respondent to register the disputed domain name. The fact that the disputed domain name refers to a website copying the Complainant's own website makes it obvious that the Respondent was fully aware of the Complainant and the Sonic Trademarks at the time of the disputed domain name's registration. Furthermore, the Complainant recently recovered the domain name <sonic-thehedgehog.com> in another UDRP

procedure (dispute CAC-UDRP-105758). This domain name was connected to an identical website and had the same registrar and registrant details. Shortly after the Complainant recovered that domain name, this new disputed domain name was registered by the same individual, namely the Respondent. The Complainant argues that this is a further indication of bad faith in this case.

- As mentioned, the disputed domain name hosts a website that copies the Complainant's own websites and displayed similar content in an attempt to target and deceive consumers into believing that the disputed domain name is operated by the Complainant. The Complainant can only presume that the Respondent is intentionally creating the false impression of affiliation to or endorsement by the Complainant, thereby disrupting the Complainant's business. The exact purpose with doing so is unclear, however, the Respondent do include several links on the website and do collect privacy details from visitors searching for the Complainant, presumably in an attempt to obtain money or with any other illicit intent. In any event, it is clear that potential visitors would be highly likely to assume that the disputed domain name is operated by or connected to the Complainant.
- Consequently, it is the Complainant's view that the Respondent, by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its own web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical to a trademark 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

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

1. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
2. The respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the numerous SONIC and SONIC THE HEDGEHOG trademark registrations while the first EU trademark registrations are from 1998, 2005 and 2011. The disputed domain name <sonic-thehedgehog.org> was registered on September 19, 2023, i.e. almost 25 years after the first of the SONIC EU trademark registrations. The disputed domain name fully incorporates the Complainant's trademark SONIC THE

HEDGEHOG.

The three words of the trademark (SONIC THE HEDGEHOG) are divided by the spaces, while the space between words THE and HEDGEHOG is deleted within the disputed domain name and the space between words SONIC and THE is replaced by hyphen (dash). The replacement of the space is usually made by the deletion or by the hyphen as the space is not supported character to be used in the domain names. Therefore, the use of the hyphen instead of the space between two parts of the trademark as well as the deletion of the space between other parts of the trademark does not distinguish the disputed domain name from the Complainant's trademark.

The addition of the generic top-level domain ".org" does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers the disputed domain name <sonic-thehedgehog.org> to be identical to the Complainant's trademark SONIC THE HEDGEHOG which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

As stated in the WIPO Jurisprudential Overview 3.0 at Section 2.1, while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name.

There is no available evidence that the Respondent is engaged in, or have engaged in any activity or work, i.e. legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name. Moreover, the disputed domain name resolves to a website with the same or at least similar layout, colours and content compared to the Complainant's own website on <sonicthehedgehog.com> including use of the Complainant's logotype, name, design and corporate colours.

There is further no evidence, that the Respondent is known by the disputed domain name or that it has a legitimate interest over the disputed domain name. It has not been proved by the Respondent that he has rights or legitimate interests in the disputed domain name or the Respondent is related with the Complainant. Neither license nor authorization has been proven to be granted to the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain name.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name <sonic-thehedgehog.org> within the meaning of paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

The Respondent has registered the disputed domain name which consists of the full content of the Complainant's trademark "SONIC THE HEDGEHOG". There are no doubts that the Respondent had the Complainant and its trademark in mind when registering the disputed domain name as he redirected the disputed domain name to the webpage with the almost identical content as the content of the Complainant's own website.

It is inconceivable that the Respondent would have come up with a domain name consisting of the terms “SONIC THE HEDGEHOG” without having prior knowledge of the Complainant and its trademarks and activities. On the balance of probabilities, it is evident that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence and scope of the Complainant's trademarks at the time of registration and use of the disputed domain name. Moreover, the same Respondent registered almost the same disputed domain name <sonic-thehedgehog.com> in the past as evidenced by the CAC decision no 105758.

Therefore, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site by creating a likelihood of confusion with the Complainant’s (Paragraph 4(b)(iv) of the Policy).

The Complainant has established the fact, that the disputed domain name creates direct association to the Complainant and is therefore capable of creating a likelihood of confusion of the internet users. The registration and usage of the disputed domain name could therefore potentially harm Complainant’s business.
Considering the confusing similarity between the Complainant’s trademark and the disputed domain name, long time between the registration of the Complainant’s trademark and the disputed domain name, resolving of the disputed domain name to a webpage copying the Complainant’s own website, distinctiveness of the Complainant’s trademark and its worldwide reputation and failure to submit a response in the UDRP proceedings and to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

The Panel therefore considers that the disputed domain name <sonic-thehedgehog.org> has been registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

The Panel finally considers that the Complainant has shown that:

1. the disputed domain name <sonic-thehedgehog.org> is identical to a trademark in which the Complainant has rights;
2. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. the disputed domain name has been registered and is being used in bad faith.

The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **sonic-thehedgehog.org**: Transferred

PANELLISTS

Name	**Petr Hostaš**

DATE OF PANEL DECISION 2024-01-04

Publish the Decision