

ADMINISTRATIVE PANEL DECISION

Sato Holdings Corporation v. Ebuka John, waaz solution Inc
Case No. DCO2022-0107

1. The Parties

The Complainant is Sato Holdings Corporation, Japan, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States of America.

The Respondent is Ebuka John, waaz solution Inc, United States of America.

2. The Domain Name and Registrar

The disputed domain name <sato-global.co> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 28, 2022. On November 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 29, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 30, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on December 1, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 4, 2023.

The Center appointed Oleksiy Stolyarenko as the sole panelist in this matter on January 13, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a Japanese corporation that specializes on auto-identification solutions that tags IDs including barcodes, RFID, and image recognition technologies. The Complainant helps companies from the retail, manufacturing, food, transport and logistics, and health care industries run smoothly.

The Complainant was founded by Yo Sato in 1940 and incorporated in 1951, after that the Complainant has changed its business model in roughly 20-year intervals to respond to shifting market needs and technological innovations.

With its headquarters in Tokyo, the Complainant has offices in 27 countries around the world and conducts business in more than 90 countries or regions. In 2021, the Complainant had revenue of JPY 124,783 million and employed about 5,400 people.

The Complainant has registered a number of SATO trademarks worldwide covering various goods and services related to the activities of the Complainant. Some of the SATO trademark registrations are indicated below:

- Japanese trademark registration for SATO and design No. 0907655 registered on July 8, 1971, in class 7, 9, and 16;
- United States of America ("U.S.") trademark registration for SATO and design No. 1098105 registered on August 1, 1978, in class 16;
- International registration for SATO and design No. 857693 registered on April 23, 2004, in class 7, 9, 16, 20, 37, and 42.

The Complainant is the owner of the domain names <sato.co.jp> registered on May 29, 1995, <satoamerica.com> registered on April 17, 1996, <satoeurope.com> registered on March 24, 2005, and <sato-global.com> registered on December 23, 2013. The Complainant actively uses these domain names in connection with the websites to promote its products, services, and engage with clients.

The Respondent registered the disputed domain name on May 24, 2022. The disputed domain name does not resolve to an active webpage. However, according to the Complainant, the disputed domain name was used for configuring the mail server and dispatching fraudulent emails to third parties.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has established rights in the SATO trademark by virtue of its longstanding use and registration of at least 229 trademark registrations in at least 34 countries or jurisdictions worldwide that consist of or contain the trademark SATO.

The trademark SATO is inherently distinctive and non-descriptive, and it is famous throughout the world within the sphere of business of the Complainant.

The Complainant argues that the disputed domain name is confusingly similar to the Complainant's SATO trademark as it incorporates the Complainant's registered SATO trademark entirely.

The Respondent has no rights or legitimate interests in the disputed domain name and the Respondent has registered the disputed domain name many years after the establishment of the Complainant's rights on SATO mark.

The disputed domain name does not resolve to an active website, however, the Complainant alleges that the Respondent was using the disputed domain name and the name of the Complainant opportunistically to make targeted, fraudulent requests and elicit the transfer of funds from a third party.

The Complainant has not authorized the Respondent to use the SATO trademark in the disputed domain name or in any way to use the Complainant's name or names of the Complainant's employees or represent as the Complainant's employees.

The Respondent is not commonly known by the disputed domain name.

The Respondent was fully aware of the Complainant's reputation and the Complainant's rights on the SATO trademarks when the Respondent registered the disputed domain name.

The disputed domain name was registered in bad faith for the purpose of fraudulently obtaining funds and personal information from the third parties.

The use of the disputed domain name by the Respondent is disruptive to the Complainant's business and will harm the significant reputation that exists in the SATO trademark, and members of the public would suffer as a result of the Respondent's activity.

Therefore, the disputed domain name has been registered and used by the Respondent in an unfair manner and in bad faith. It is also inconceivable that the Respondent had any good faith intentions at the point of registering the disputed domain name.

The Complainant seeks a decision that the disputed domain name be transferred to the Complainant

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the SATO trademark, based on its Japanese, U.S., and international trademark registrations covering numerous countries in the world and continuous use in connection with provision of the goods and services in the sphere of auto-identification.

Therefore, the Panel considers that the Complainant has satisfied the threshold requirement of having relevant trademark rights.

The disputed domain name is comprised of the Complainant's SATO trademark with the added dictionary word "global" with the hyphen between them, and combined with the country code Top-Level Domain ("ccTLD") ".co".

The Panel notes that the addition of the hyphen and the dictionary word "global" in the disputed domain name does not prevent the Complainant's trademark from being recognizable in the disputed domain name.

It is a usual practice for the panels to disregard the Top-Level Domain ("TLD") under the first element confusing similarity test as it is viewed as a standard registration requirement. See section 1.11.1 of the

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“the [WIPO Overview 3.0](#)”). Here the disputed domain name is registered in a ccTLD, “.co”, and as such, the Panel disregards such ccTLD for the purposes of this comparison on the same grounds.

Thus, the Panel finds that the disputed domain name incorporates the Complainant’s SATO trademark entirely.

Furthermore, the Panel considers that the disputed domain name is confusingly similar to the Complainant’s SATO trademark.

For all the foregoing reasons, the Panel finds that the first element of paragraph 4(a) of the Policy has therefore been satisfied by the Complainant.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to establish that the respondent has no rights or legitimate interests in the domain name. Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#). In this case, the Respondent did not rebut the Complainant’s *prima facie* case regarding the lack of rights or legitimate interests.

However, the overall burden of proof remains with the Complainant. Paragraph 4(c) of the Policy provides circumstances that demonstrate the respondent’s rights or legitimate interests to the disputed domain name, and that complainants frequently address to show that the activities of the respondent does not fall under the *bona fide* offering of goods or services (paragraph 4(c)(i) of the Policy), that the respondent is not commonly known by the disputed domain name (paragraph 4(c)(ii) of the Policy) and that the respondent is not involved into a legitimate noncommercial or fair use of the disputed domain name (paragraph 4(c)(iii) of the Policy).

According to the Complainant, the Respondent is not an authorized or licensed to use the SATO trademark in the disputed domain name.

Furthermore, the Complainant provided evidence confirming that the Respondent used the disputed domain for fraudulent purposes, namely, dispatching emails associated with the disputed domain name pretending to originate from the employees of the Complainant and soliciting for payment by a third party of a fake invoice.

The Panel notes, that as it was found by previous UDRP panels that any type of impersonation or passing off supports finding that the respondent has no rights or legitimate interests in the disputed domain name. See section 2.13.1 of the [WIPO Overview 3.0](#).

Moreover, given that the disputed domain name is identical, with exception of the ccTLD, to one of the Complainant’s domain names <sato-global.com> registered on December 23, 2013, and which is being used by the Complainant in connection with its official website, the Panel struggles to conceive any legitimate interests of the Respondent in the disputed domain name.

Under such circumstances, any use of the disputed domain name by the Respondent only increases the possibility of the Internet users’ to falsely attribute the disputed domain name to the activities of the Complainant, seeing as such Internet users will likely be unaware of the one letter difference between the gTLD “.com” as in the Complainant’s official domain name and website and ccTLD “.co”, provided also that the disputed domain name reproduces the Complainant’s trademark entirely. Evidently, such is the intent of the Respondent, considering use of the disputed domain name for a fraudulent email scheme impersonating the Complainant, as discussed above.

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

Therefore, the Panel finds that the Respondent is not involved in a *bona fide* offering of goods or services (under paragraph 4(c)(i) of the Policy) and the Respondent's activities does not fall under a legitimate noncommercial use (under paragraph 4(c)(iii) of the Policy).

The Panel did not find any evidence that the Respondent is commonly known by the disputed domain name and concludes that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

Thus, the Panel finds that the Complainant has satisfied the second element of the Policy, namely paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

As the Panel established above, the Complainant's SATO trademark was registered and was widely used in commerce well before the registration of the disputed domain name.

The Panel finds that the Respondent was well aware of the Complainant's SATO trademark when registering the disputed domain name. This conclusion is supported by the facts that the disputed domain name is confusingly similar to the Complainant's SATO trademark, the disputed domain name was registered 51 years after the registration of the Complainant's trademark, and that the disputed domain name was used to configure the mail server to dispatch fraudulent emails impersonating the employee of the Complainant and soliciting payment of fake invoices issued in the name of the Complainant.

Previous panels found that bad faith is demonstrated when the Respondent registered the disputed domain name with the purpose of using it for unlawful purposes, profiting from the attempts to solicit business transactions with third parties while impersonating the Complainant, creating a likelihood of confusion and aiming to take undue advantage of the Complainant's reputation and goodwill. See *Minerva S.A. v. TT Host*, WIPO Case No. [D2016-0384](#).

Furthermore, the Panel finds it implausible that the disputed domain name could be used by the Respondent in good faith considering that it is confusingly similar to the Complainant's trademark.

On the contrary, the Respondent has impersonated an employee of the Complainant to send at least one email regarding an unpaid invoice to a third party, which indicates the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement with the Complainant.

The Respondent failed to submit a Response or provide any evidence of a good-faith use or to show rights or legitimate interests in the disputed domain name.

Therefore, under the totality of the circumstances, the Panel finds the Respondent registered and used the disputed domain name in bad faith and that the Complainant consequently has satisfied the third element of the Policy, namely, paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <sato-global.co>, be transferred to the Complainant.

/Oleksiy Stolyarenko/

Oleksiy Stolyarenko

Sole Panelist

Date: February 2, 2023