

ADMINISTRATIVE PANEL DECISION

FC2, Inc. v. 申昌兰 (Shen Chang Lan)

Case No. D2023-4590

1. The Parties

The Complainant is FC2, Inc., United States of America (“United States”), represented by Corsearch B.V., Netherlands (Kingdom of the).

The Respondent is 申昌兰 (Shen Chang Lan), China.

2. The Domain Name and Registrar

The disputed domain name <fc2.top> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on November 6, 2023. On November 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 7, 2023, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 10, 2023, 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 amended Complaint in English on November 13, 2023.

On November 10, 2023, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On November 13, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

The Center verified that the Complaint together with the amended 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 in English and Chinese of the Complaint, and the proceedings commenced on November 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 8, 2023.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on December 18, 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 headquartered in the United States and is one of the most popular video hosting services in Japan. The Complainant was established in 1999 and offers various free and paid web services in various languages such as Japanese, English, and Chinese, including domain names, blogs, chats, rental servers, video hosting, and more. The Complainant's main website has been among the most popular websites in the world, receiving hundreds of millions of visitors on average per month, and is consistently ranked as one of the most popular websites in Japan in terms of website visitors.

The Complainant has an international portfolio of trademarks, protecting the mark FC2 in several jurisdictions, including but not limited to, Japanese Trademark Registration No. 5823261 for FC2, registered on January 29, 2016; International Trademark Registration No. 1275290 for FC2, registered on March 16, 2015; and United States Trademark Registration No. 5046126 for FC2, registered on September 20, 2016. The Complainant also proves that it has a strong online presence including a domain name portfolio including many domain names incorporating the FC2 trademark, including <fc2.com> and <fc2.net>.

The disputed domain name was registered on May 17, 2017, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name directs to an active webpage in Japanese featuring different blog posts discussing and promoting what are presumed to be counterfeit watches. Each blog posts typically contains at least one link to an online web shop where the presumed counterfeit goods can be purchased.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical to its registered trademark for FC2, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith to divert Internet users to the Respondent's webpage which offers for sale counterfeit products.

The Complainant essentially contends that the disputed domain name is identical to the Complainant's well known trademarks as it fully incorporates the Complainant's FC2 trademark, with the only differing element being the addition of the Top-Level Domain ("TLD") ".top" to the disputed domain name. The Complainant also argues that the Respondent had, or can be expected to have had, prior notice of the Complainant's trademarks at the time the disputed domain name was registered, since the Complainant registered its trademarks for FC2 years prior to the registration of the disputed domain name and since these marks are well known, especially to a Japanese-speaking public which seems to be the public targeted by the Respondent. The Complainant argues that the Respondent has linked the disputed domain name to a

website promoting counterfeit goods. The Complainant essentially contends that the registration and use of the disputed domain name in such circumstances constitutes registration and use in bad faith.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the Respondent may be proficient in the English language as the Respondent opted for a domain name with a TLD in Latin script; the fact that other domain names registered by the Respondent contain English words, (e.g., <thewatchessale.com>) and the fact that conducting the proceeding in Chinese would, according to the Complainant, unfairly burden the Complainant.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time, and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name, [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. It is the settled view of panels applying the Policy that the TLD (here ".top") should be disregarded under the first element test. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, the Panel notes that, based on the evidence submitted by the Complainant, the Respondent used the disputed domain name to connect it to an active webpage in Japanese featuring different blog posts discussing and promoting what are presumed to be counterfeit watches, with the blog posts typically containing at least one link to an online web shop where the presumed counterfeit goods can be purchased. The Panel also notes that the website at the disputed domain name itself seems to suggest that it provides information about counterfeit goods as it displays statements such as “super copy watch” and “replica watches”, and also mentions the names of internationally famous brands such as BULGARI and ROLEX etc. Based on the above, the Panel accepts the Complainant’s argument that the blog posts are discussing and promoting what are presumed to be counterfeit watches.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered the disputed domain name which is identical to the Complainant’s intensely used, distinctive, and well known trademark. The Panel refers in this regard to prior UDRP decisions where the Complainant’s rights in its FC2 trademarks were recognized, such as *FC2, Inc. v. Suzuki Kenzo, Kenzo Suzuki*, WIPO Case No. [D2022-5005](#). The Panel considers that by registering the disputed domain name, the Respondent deliberately and consciously targeted the Complainant’s prior trademarks for FC2. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states “[p]anels have consistently found that 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.” Furthermore, the Panel also notes that the Complainant’s trademarks for FC2 were registered several years before the registration date of the disputed domain name. The Panel deduces from these elements that the Respondent knew, or at least should have known, of the existence of the Complainant’s trademarks at the time of registering the disputed domain name. In the Panel’s view, these elements indicate bad faith on the part of the

Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Panel notes that, based on the evidence submitted by the Complainant, the Respondent used the disputed domain name to connect it to a website discussing and promoting what are presumed to be counterfeit watches and providing links to listings for the purchase of such products.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitute bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <fc2.top> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: December 26, 2023