

## **ADMINISTRATIVE PANEL DECISION**

Toyota Motor Credit Corporation v. Domain Administrator,  
See PrivacyGuardian.org / Vu Manh Cuong  
Case No. D2022-2684

### **1. The Parties**

The Complainant is Toyota Motor Credit Corporation, United States of America (“United States” and “US”), represented by CSC Digital Brand Services Group AB , Sweden.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States / Vu Manh Cuong, Viet Nam.

### **2. The Domain Name and Registrar**

The disputed domain name <toyotapay.com> is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 22, 2022. On July 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 22, 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 July 28, 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 amended Complaint on August 1, 2022.

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 of the Complaint, and the proceedings commenced on August 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 24, 2022.

The Center appointed Andrew Brown Q.C. as the sole panelist in this matter on August 26, 2022. 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 an indirect wholly-owned subsidiary of Toyota Jidosha Kabushiki Kaisha (also trading as Toyota Motor Corporation (TMC)).

The Complainant is in fact wholly owned by Toyota Financial Services International Corp (TFSIC) which is in turn a wholly-owned subsidiary of Toyota Financial Services Corp (TFSC). TFSC is a wholly-owned subsidiary of Toyota Motor Corporation (TMC). The Complainant provides a variety of finance and vehicle payment protection products and services to authorized Toyota and Lexus dealers in the United States (excluding Hawaii).

TMC, the ultimate parent, is a Japanese multi-national manufacturer of motor vehicles including Toyota, Lexus, and Scion cars, trucks, and sport utility vehicles (SUV). TMC is the owner of multiple trademarks for TOYOTA (the TOYOTA Mark) in the United States of America, Japan, Viet Nam, Canada, the European Union, and has an International Registration with WIPO (see, for instance, United States Reg. No. 1338339, registered on May 28, 1985). TMC has used the TOYOTA trademark in the US since at least 1958. The Complainant as used the TOYOTA trademark in respect of its financial services since 1983.

The Complainant, along with its parent and sister companies maintains and operates the websites <www.toyota.com> and <www.toyotafinancial.com>. Between April and June 2022, the domain name <www.toyota.com> had 15.4 million visits.

The disputed domain name was registered on June 10, 2021, and resolves to a parking page.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that "by virtue of its trademark registrations as shown in Annex 1 it is the owner of TOYOTA trademark". It further claims that the granting of registrations to the Complainant for the TOYOTA trademark is "*prima facie* evidence of ... the Complainant's ownership of this trademark and of the Complainant's exclusive right to use the TOYOTA trademark in commerce on or in connection with the goods and/or services" specified in those registered trademarks.

The Complainant contends that the disputed domain name is confusingly similar to the TOYOTA Mark. It states that the addition of the descriptive term "pay" makes the disputed domain name confusingly similar to that mark. The fact that the term "pay" is closely linked and associated with the Complainant's brand and trademark is claimed to underscore and increase the confusing similarity.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. In this respect, the Complainant states that it has not given the Respondent license or authorization or permission to use its trademark in any manner, including in domain names. Further, the Respondent is not sponsored by or affiliated with the Complainant in any way. Nor is the Respondent commonly known by the disputed domain name.

The Complainant points to the Respondent being identified as "Vu Manh Cuong". The Complainant relies on the fact that this name does not resemble the disputed domain name in any way. The Complainant relies too on the fact that the Respondent was using a privacy Whois service as equating to a lack of legitimate

interests. Finally, the Complainant notes that the registration of the disputed domain name on June 10, 2021, was significantly after the Complainant's registration of its TOYOTA Mark with the major trademark registries, its first use in commerce in the United States of America in 1958, and registration of its own domain names.

The Complainant notes that the Respondent is using the disputed domain name to direct Internet users to a website that resolves to a parking page and lacks content. The Complainant relies on past Panel decisions (see *Washington Mutual, Inc. v. Ashley Khong*, WIPO Case No. [D2005-0740](#). ("Parking a domain name which then points to its registrar's Website services does not constitute a *bona fide* offer of goods or services as required by the Policy paragraph 4(c)(i)").

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. It asserts that the Respondent was fully aware or at least should have known of the existence of the Complainant's trademark and registration of domain names when registering the disputed domain name, given the fame of the Complainant's TOYOTA Mark. The Complainant says that performing searches across a number of internet search engines for "toyota pay" returns multiple links referencing the Complainant and its business.

In so far as the disputed domain name currently resolves to a registrar parking page, the Complainant relies on the well-known principle that passively holding a domain name can constitute a factor in finding bad faith registration and use (*Telstra Corp. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

As to use in bad faith, the Complainant claims that the disputed domain name can only be taken as intending to cause confusion amongst internet users as to the source of the disputed domain name. It claims that there is no plausible good faith reason or logic for the Respondent to register the disputed domain name and that the Respondent's actions are indicative of an intention to hold the disputed domain name "for some future active use in a way which would be competitive with or otherwise detrimental to the Complainant" (see *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#)).

The Complainant says finally that any use of the disputed domain name, whether actual or theoretical, would have to be in bad faith as it is not possible to conceive of any plausible, actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate such as by being a passing off, an infringement of consumer protection legislation or an infringement of the Complainant's rights under trademark law.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to paragraph 4(a) of the Policy, a Complainant must prove each of the following elements with respect to the disputed domain name in order to succeed in this proceeding:

- (i) That the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights; and
- (ii) That the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) That the disputed domain name has been registered and is being used in bad faith.

## A. Identical or Confusingly Similar

As noted earlier in the Factual Background, the Complainant is indirectly a wholly-owned subsidiary of TMC – that ownership being several intermediary companies, TFSIC and TFSC.

The Complainant has provided evidence that the ultimate parent company TMC is the owner of registered trademarks for TOYOTA in multiple jurisdictions including in the United States of America, Japan, Viet Nam, Canada, the European Union, and an International Registration in multiple classes including 12, 36, and 39. Most pertinently, the registration in classes 36 and 39 include “financing the purchases of vehicles by others and vehicle renting and lending services”.

In parts of the Complaint, the Complainant asserts that it “is the owner of the TOYOTA Mark” and refers to the various registrations as *prima facie* evidence of “the Complainant’s ownership of this trademark ...”. However, the facts clearly show that TMC is the owner of the relevant trademarks, not the Complainant.

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition “[WIPO Overview 3.0](#)” addresses the question as to whether a trademark owner’s affiliate (such as the Complainant in this case) has standing to file a UDRP complaint.

“1.4.1 A trademark owners’ affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint.

While panels have been prepared to infer the existence of authorization to file a UDRP case based on the facts and circumstances described in the complaint, they may expect parties to provide relevant evidence of authorization to file a UDRP complaint.

In this respect, absent clear authorization from the trademark owner, a non-exclusive trademark licensee would typically not have standing to file a UDRP complaint.”

In the present case the Complainant has shown that it is a wholly-owned indirect subsidiary of its ultimate parent, TMC, which owns all the related TOYOTA trademarks. The Complainant has also provided evidence that for almost 40 years prior to the Complaint, the Complainant has been providing a variety of finance and voluntarily vehicle and payment protection products and services under the TOYOTA Mark to authorized Toyota and Lexus dealers or dealer groups and private label dealers in the United States (excluding Hawaii).

Given this evidence of extensive use by the Complainant of the TOYOTA trademark in relation to vehicle financing and payment protection products and services over such a long period, the Panel is prepared to infer the existence of authorization by its parent, TMC, to file this UDRP Complaint. The Panel therefore finds that the Complainant has standing.

The Panel therefore accepts that the Complainant and its parent, TMC, have clearly and sufficiently demonstrated TMC’s rights in the TOYOTA Mark as well as long-standing permitted use by the Complainant of that Mark. The Panel is satisfied the TMC and the Complainant are well-known by the TOYOTA Mark in relation to a core group of goods and services including motor vehicles, trucks, SUVs and vehicle financing and payment protection products.

The Panel accepts that the disputed domain name is confusingly similar to the TOYOTA Mark. The TOYOTA Mark is clearly and unmistakably recognizable in the disputed domain name. It is the Panel’s view that the addition of the term “pay” to the TOYOTA Mark does not prevent a finding of confusing similarity between the disputed domain name and the TOYOTA Mark, which remains clearly recognizable.

The Panel finds that the disputed domain name is therefore confusingly similar to the Complainant’s TOYOTA Mark and finds in favor of the Complainant.

## B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish that it has rights or legitimate interests in the disputed domain name, among other circumstances, by showing any one of the following elements:

- (i) That before notice of the dispute, the Respondent used or made demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) That the Respondent has been commonly known by the disputed domain name, even if it had acquired no trademark or service mark rights; or
- (iii) That the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The overall burden of proof for establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name lies with the Complainant.

There is no evidence of the existence of any rights or legitimate interests on the part of the Respondent in the TOYOTA Mark pursuant to paragraph 4(c) of the Policy. TMC unquestionably has prior rights in the TOYOTA Mark, which precede the Respondent's registration of the disputed domain name by some 63 years (in relation to motor vehicles) and almost 40 years in relation to vehicle finance and payment protection services. The Panel is satisfied that TMC has never licensed or permitted the Respondent to use its TOYOTA Mark. It is also satisfied that the Respondent has never been commonly known by the disputed domain name.

The Panel is satisfied too that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The Respondent finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant, particularly when considering the Complainant's registered services in relation to vehicle financing and payment protection services. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Respondent has failed to show that it has acquired any rights in respect of the disputed domain name or that the disputed domain name is used in connection with a *bona fide* offering of goods and services. The Respondent had the opportunity to demonstrate its rights or legitimate interests, but it did not reply to the Complainant's complaint.

The Panel therefore finds that the Complainant has satisfied the burden of establishing a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and accordingly finds that paragraph 4(a)(ii) of the Policy is satisfied in favor of the Complainant.

## C. Registered and Used in Bad Faith

The Panel is also satisfied that the disputed domain name has been registered in bad faith for the following reasons:

- (i) The Panel is satisfied that the TOYOTA Mark is well known internationally for a range of goods including motor vehicles, trucks, SUV's, together with vehicle financing and payment protection products. The Panel is also satisfied that the Respondent was aware of TMC and TOYOTA Mark at the time of registration. This is evidenced by the fact that the disputed domain name reproduces TOYOTA Mark entirely and adds to it the descriptive word "pay" being descriptive activities in relation to vehicle finance and payment protection products and services for which TMC and the Complainant are well known under the TOYOTA Mark;

- (ii) Paragraph 2 of the UDRP puts a burden on registrants where it states “by applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and bond to us that [...] to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of a third party [...]. It is your responsibility to determine whether your domain name infringes or violates someone else’s rights”. Even the most cursory trademark or other online search or any online search of existing domain names prior to the Respondent registering the disputed domain name would instantly have revealed TMC and its TOYOTA Mark as well as the Complainant’s activities. See in this regard section 3.2.3 of the [WIPO Overview 3.0](#).

The Panel is satisfied that the doctrine of passive holding applies in this case and therefore the inactive status of the disputed domain name does not prevent a finding of bad faith ([WIPO Overview 3.0](#) section 3.3). Relevant factors under the doctrine, which apply in this case are:

- (i) The TOYOTA Mark is well known internationally and has become exclusively associated with TMC and its subsidiaries. When confronted with the disputed domain name, many internet users would wrongly assume that the disputed domain name is owned by, connected with, licensed by or otherwise endorsed by TMC and its subsidiaries including the Complainant;
- (ii) There is no evidence of any contemplated or actual *bona fide* use of the disputed domain name.
- (iii) The Respondent had the opportunity to respond to the Complaint but has not done so. The Panel is therefore entitled to draw adverse inferences from that omission.
- (iv) The Respondent concealed its identity in the publicly available Whois via the use of a privacy service.

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied in favor of the Complainant.

## 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, <toyotapay.com>, be transferred to the Complainant

/Andrew Brown Q.C./

**Andrew Brown Q.C.**

Sole Panelist

Date: September 12, 2022