

## **ADMINISTRATIVE PANEL DECISION**

Rakuten Group, Inc. v. Xserver Inc. / Ikuo Shoji  
Case No. D2022-2918

### **1. The Parties**

The Complainant is Rakuten Group, Inc., Japan, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States of America (“United States”).

The Respondent is Xserver Inc., Japan / Ikuo Shoji, Japan.

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

The disputed domain name <rakuten-mobile.com> is registered with Netowl, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on August 8, 2022. On August 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 10 and 12, 2022, the Registrar transmitted by email to the Center its verification responses 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 August 12, 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 in English on August 15, 2022.

On August 12, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On August 15, 2022, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on August 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 9, 2022.

The Center appointed Masato Dogauchi as the sole panelist in this matter on September 14, 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**

Whereas the Respondent has not submitted any response, the following information from the Complaint is found to be the factual background of this case.

The Complainant, founded in 1997, has been doing mainly business in e-commerce, fintech, digital content and communications, and at present has more than 70 businesses and more than 1.5 billion members across the world. The Complainant's revenue of the fiscal year 2021 was JPY 1,681,757 million. The Complainant has many subsidiaries including Rakuten Mobile, Inc., founded in 2018, providing mobile communications services, and employs 4,621 people as of January 1, 2022.

The Complainant is the owner of at least 640 trademark registrations in at least 39 jurisdictions worldwide for marks that consist of or contain "Rakuten" or "楽天" such as follows:

- Japanese Registration No. 4,453,054, registered February 16, 2001, for the mark 楽天 (pronunciation (reference information): Rakuten);
- United States Registration No. 4,088,493, registered January 17, 2012, for the mark RAKUTEN.

The Complainant owns the domain name <rakuten.com> registered on September 12, 1997.

The disputed domain name <rakuten-mobile.com> was registered on September 5, 2021. At the time of filing of the Complaint, the disputed domain name resolved to a website providing information related to Rakuten Mobile, and displaying third party commercial links. The disputed domain name currently does not resolve to an active webpage.

The Complainant requests that the disputed domain name be transferred to the Complainant.

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

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

The Complainant's contentions are divided into three parts as follows:

First, the Complainant asserts that the disputed domain name is confusingly similar to its trademark and its domain name. As it is well established that the generic Top-Level Domain ("gTLD") (*i.e.*, ".com") may be disregarded for the purpose of determining confusing similarity. Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain name, *i.e.*, "rakuten-mobile." The disputed domain name contains the entirety of the Complainant's RAKUTEN trademark. The addition of the word "mobile" followed by a hyphen in the disputed domain name does not prevent a finding of confusing similarity.

Second, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Further, the Complainant contends that the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the RAKUTEN trademark in any manner, and that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services. In addition, to the Complainant's knowledge, the Respondent has never been commonly known by the disputed domain name and has never acquired any trademark or service mark rights in the disputed domain name.

Third, the Complainant asserts that the disputed domain name should be considered as having been registered and used in bad faith by the Respondent. The Complainant contends that, given the global reach and popularity of the Complainant's services under the RAKUTEN trademark, it is inconceivable that the Respondent chose the disputed domain name without knowledge of the Complainant's activities and the name and trademark under which the Complainant is doing business. In addition, the Complainant contends the foregoing is especially true given that the disputed domain name contains the word "mobile," which is associated with the Complainant's subsidiary, Rakuten Mobile, Inc.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Preliminary Issue: Language of the Proceeding**

In respect of the language to be used in the administrative proceeding, in accordance with the Rules, paragraph 11(a), the language of the administrative proceeding shall be, in principle, the language of the registration agreement. However, the same provision allows the panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In the present case, the Registrar has confirmed that the language of the Registration Agreement is Japanese.

However, the Panel determines, in order to ensure both that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, that the language of this proceeding shall be English rather than Japanese on the following grounds that:

- the Complainant's request to that effect;
- the Respondent did not reply to the Center's Language of the Proceeding email or Notification of the Complaint email, which were both sent in English and Japanese; and
- the use of Japanese language would produce undue burden on the Complainant and unnecessarily delay the proceeding in consideration of the absence of a Response from the Respondent.

### **6.2. Substantive Matters**

In accordance with the Rules, paragraph 15(a), a panel shall decide a case on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. Since the Respondent has not made any arguments in this case, the following decision is rendered on the basis of the Complainant's contentions and other evidence submitted by the Complainant.

In accordance with the Policy, paragraph 4(a), in order to qualify for a remedy, the Complainant must prove each of the following:

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

#### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant is the owner of at least 640 trademark registrations in at least 39 jurisdictions worldwide, including in Japan and the United States, for marks that consist of or contain “Rakuten” or “楽天”.

The addition of the word “mobile” represents one of the businesses done directly or through a subsidiary of the Complainant. In any event, in the case where the disputed domain name contains the entirety of the Complainant’s trademark, the addition of the other word in the disputed domain name does not prevent a finding of confusing similarity. The hyphen between the words “rakuten” and “mobile” does not alter the above determination.

The last part of the disputed domain name, *i.e.*, “.com” represents one of the gTLDs, which is irrelevant in the determination of the identity or confusing similarity.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has right. The above requirement provided for in paragraph 4(a)(i) of the Policy is accordingly satisfied.

#### **B. Rights or Legitimate Interests**

There is no evidence that shows the Respondent is commonly known by the name “rakuten”, “mobile” or “rakuten mobile” or that the Respondent is affiliated with the Complainant or authorized or licensed to use the Complainant’s RAKUTEN trademark.

The disputed domain name previously resolved to a website providing information related to Rakuten Mobile, and displaying third party commercial links and currently resolves to an inactive website. This suggests that the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or for any legitimate noncommercial or fair use.

Since the Respondent did not reply to the Complaint in this proceeding, the Panel finds on the available record that the Complainant has established an un rebutted *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The above requirement provided for in paragraph 4(a)(ii) of the Policy is accordingly satisfied.

#### **C. Registered and Used in Bad Faith**

The Panel finds that the RAKUTEN trademark is widely known in connection with its services. In consideration of the Complainant’s business by itself and through its subsidiaries using the RAKUTEN trademark, including the business of one of the subsidiaries, Rakuten Mobile, Inc., it is highly unlikely that the Respondent would not have known of the Complainant’s right in the trademark at the time of the disputed domain name’s registration. In addition, in light of the fact that nothing in the disputed domain name bears a reasonable relevance to the name of the Respondent, there can be found no reasonable possibility of fortuity in the Respondent’s registration of the disputed domain name.

The registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The disputed domain name previously resolved to a website providing information related to Rakuten Mobile, and displaying third party commercial links. Therefore, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website or other on-line locations, by creating a likelihood of confusion with the Complainant's mark. The fact that the disputed domain name currently resolves to an inactive page does not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of the [WIPO Overview 3.0](#).

Since the Respondent did not reply to the Complaint in this proceeding, based on the available record the Panel finds that the disputed domain name has been registered in bad faith and is being used in bad faith. The above requirement provided for in paragraph 4(a)(iii) of the Policy is accordingly satisfied.

In conclusion, all three cumulative requirements as provided for in paragraph 4(a) of the Policy are determined to be satisfied.

## **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 <rakuten-mobile.com> be transferred to the Complainant.

*/Masato Dogauchi/*

**Masato Dogauchi**

Sole Panelist

Date: September 28, 2022