

ADMINISTRATIVE PANEL DECISION

Rakuten Group, Inc. v. vlad cech, NetTra
Case No. D2022-3649

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 vlad cech, NetTra, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 30, 2022. On October 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 3, 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 (Privacy service provided by Withheld for Privacy ehf, Iceland) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 4, 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 October 7, 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 October 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 1, 2022.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on November 8, 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 was founded in 1997, offering cash back deals and shopping rewards for online shopping worldwide. It is headquartered in Tokyo and is listed on the Tokyo Stock Exchange, employing more than 10,000 people worldwide. The Complainant's business covers a variety of sectors, including fintech, e-commerce, digital content and communications in more than 70 businesses and counts more than 1.5 billion members across the world.

Furthermore, the Complainant is the owner of at least 640 RAKUTEN or 楽天 trademark registrations in multiple jurisdictions worldwide (in at least 39 countries). Below are details of a few exemplary trademarks (Annexes 11-13 to the Complaint):

- European Union Trade Mark Registration No. 4755741 for RAKUTEN, registered June 29, 2007, for services in Class 35;
- Japanese Trademark Registration No. 4453054 for 楽天 (pronunciation (reference information): Rakuten), registered February 16, 2001, for goods and services in Classes 9, 16, 35, 41, and 42;
- United States Trademark Registration No. 4088493 for RAKUTEN, registered January 17, 2012, for services in Classes 35, 39, and 43.

The Complainant owns numerous domain names that consist of or include the word "rakuten", including the domain name <rakuten.com> registered on September 12, 1997.

The disputed domain name <rakuten-inc.com> was registered on July 7, 2022, and resolves to an active website that contains pay-per-click links for the online sale of diverse goods and services. Besides that, the disputed domain name is used for phishing activities by linking it to an email account impersonating the Complainant's chairman and CEO.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three requirements stated in paragraph 4(a) of the Policy is established in the present case:

The Complainant submits that the disputed domain name is confusingly similar to the registered trademarks, namely RAKUTEN, in which the Complainant has rights. The relevant comparison to be made is with the second-level portion of the disputed domain name only (*i.e.*, "rakuten-inc"), as it is well established that the Top-Level Domain (*i.e.*, "com") may be disregarded for this purpose. The disputed domain name contains the Complainant's RAKUTEN trademark in its entirety. The addition of the term "inc" connected with a hyphen in the disputed domain name does not prevent a finding of confusing similarity.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It 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 way. By using the disputed domain name in connection with a phishing scam impersonating the Complainant's chairman and CEO, the Respondent clearly has not used the disputed domain name in connection with a *bona fide* offering of goods or services. This, according to the Complainant, is underlined by the use of the disputed domain name for a pay-per-click page that includes links for goods and services as they may be offered by the

RAKUTEN trademark. 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.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith by the Respondent. It claims that the RAKUTEN trademark is famous and/or widely known, given that it is protected by at least 640 trademark registrations in at least 39 jurisdictions worldwide, the oldest of which was registered more than 21 years ago, and considering the global reach and popularity of the Complainant's services. Therefore, it is implausible that the Respondent was unaware of the Complainant when it registered the disputed domain name. Furthermore, the Complainant contends that using the disputed domain name as part of a phishing scam impersonating the Complainant's chairman and CEO and in connection with a monetized parking page constitutes the use of the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (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;
- (iii) the Respondent has registered and is using the disputed domain name in bad faith.

In the following, the Panel discusses in consecutive order whether each of these are met.

A. Identical or Confusingly Similar

On the first element, the Complainant has demonstrated registered trademark rights that consist of or contain RAKUTEN and which predate the registration of the disputed domain name.

The test of identity or confusing similarity under the Policy, paragraph 4(a)(i), is limited in scope to a direct comparison between the Complainant's trademark and the textual string which comprises the disputed domain name.

The disputed domain name contains the Complainant's trademark RAKUTEN in its entirety. It consists of the term "rakuten" plus a hyphen followed by the term "inc" and the generic Top-Level Domain ("gTLD") ".com". Neither the inclusion of the hyphen followed by the addition of the term "inc" (commonly known to be an abbreviation for "incorporated") nor the gTLD ".com" prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name, see Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Thus, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

On the second element, under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see *Credit Agricole S.A. v. Dick Weisz*, WIPO Case No. [D2010-1683](#); see *Champion Innovations, Ltd. v. Udo Dussling*, WIPO Case No. [D2005-1094](#); see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#); see *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. D2004 0110).

The Panel notes that with respect to paragraph 4(c)(i) of the Policy, there is no evidence in the record that the Respondent, before any notice of the dispute, used or has prepared 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.

Further, the Panel notes that with respect to paragraph 4(c)(ii) of the Policy, there is no evidence that indicates that the Respondent has ever been commonly known by the disputed domain name or has acquired trademark rights in a name corresponding to it.

In addition, with respect to paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent has made, and is making, a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

On the contrary, the Complainant has not authorized, licensed or permitted in any way the Respondent to register or use the disputed domain name. This finding is supported by the fact that the Respondent failed to file a response within the proceedings before the Panel. As far as failure to file a response is concerned, it is for a complainant to prove its case, as there may be good reasons why an honest respondent may decide not to prepare and file such document. But where allegations are made which are as serious as those levied by the present Complainant in its Complaint that the Respondent has used the disputed domain name to impersonate the Complainant's chairman and CEO for sending phishing emails, one would expect any honest respondent to positively deny those allegations (see *The Commissioners for HM Revenue and Customs v. Tyrone Jackson*, WIPO Case No. [D2018-0298](#)).

Consequently, the Panel finds that the Respondent's default in refuting the *prima facie* case made by the Complainant is sufficient to establish a lack of rights or legitimate interests of the Respondent in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

On the third element, under paragraph 4(a)(iii) of the Policy, the Complainant has to establish that the disputed domain name has been registered and is being used in bad faith by the Respondent.

Whether a domain name is used in bad faith for the purposes of the Policy may be determined by evaluating the factors set out under paragraph 4(b) of the Policy.

However, the aforementioned provisions are without limitation, and bad faith registration and use may be found otherwise, taking into account all circumstances relevant to the case (see *Cleveland Browns Football Company LLC v. Andrea Denise Dinoia*, WIPO Case No. [D2011-0421](#)).

The Complainant has submitted sufficient evidence to prove that the RAKUTEN trademark is widely known in connection with its services. Considering the Complainant's business by itself and through its numerous subsidiaries using the RAKUTEN trademark, in addition to the Complainant's more than 1.5 billion members worldwide, it is highly unlikely that the Respondent would not have known of the Complainant's rights in the trademark at the time of the disputed domain name's registration. Prior knowledge of the Complainant's trademark rights is another indication for a bad faith registration of the disputed domain name (see *TRS, Quality, Inc v. Privacy Protect*, WIPO Case No. [D2010-0400](#)). The Panel notes that the disputed domain name was registered after the Complainant's trademarks were registered and accepts that the disputed

domain name was chosen by reference to the RAKUTEN trademark. The Complainant obtained the first registration of the RAKUTEN trademark 21 years ago.

The mere 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 3.0](#). Considering the circumstances of this case, the fact that the disputed domain name resolves to a website with a monetized parking page clearly constitutes use in bad faith (see *Columbia Pictures Industries, Inc. v. North West Enterprise, Inc.*, WIPO Case No. [D2006-0951](#)). According to the Complainant's statement and the evidence submitted, the Respondent in addition uses the disputed domain name as part of a phishing scam impersonating the Complainant's chairman and CEO.

Given that the use of a domain name for *per se* illegitimate activities such as phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith, see section 3.1.4 of the [WIPO Overview 3.0](#).

In light of the above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith pursuant to 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 <rakuten-inc.com> be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: November 28, 2022