

ADMINISTRATIVE PANEL DECISION

Kanematsu USA, Inc. v. SIMON SIMON

Case No. D2023-0402

1. The Parties

The Complainant is Kanematsu USA, Inc., United States of America, represented by Ingram Yuzek Gainen Carroll & Bertolotti, LLP, United States of America.

The Respondent is SIMON SIMON, Uganda.

2. The Domain Name and Registrar

The disputed domain name <kanematsusa.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 January 27, 2023. On January 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 30, 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 (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 31, 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 on January 31, 2023.

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 February 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 1, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on March 8, 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 the US subsidiary of the Kanematsu Corporation, founded in 1889 in Japan. The Kanematsu network comprises offices in over 50 cities worldwide; the Complainant provides a website under <kanematsuusa.com> (Annex 5 to the Complaint).

Furthermore, the Complainant is the owner of the registered trademark KANEMATSU USA, registered May 4, 2004, Reg. No 2,838,015 in the International Class 35 and 36 (Annex 4 to the Complaint); its business name is KANEMATSU USA.

The disputed domain name was registered on September 19, 2022 (Annex 1 to the Complaint).

The disputed domain name redirected to the Complainant's website at <kanematsuusa.com>; currently, the disputed domain name resolves to a website which states "this website is not available" (Annex 9 to the Complaint).

The Respondent used the disputed domain name to create an email address; it impersonated names of the Complainant's employees for sending emails with fake documents to deceive and mislead third parties into doing business (Annex 14 – 17 to the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant is a general trading company that develops and supplies various products and services in a wide range of business such as food, electronic equipment/components, steel, chemicals, and motorcycle/automotive/aerospace parts. The Complainant is a subsidiary of Kanematsu Corporation, one of the oldest global trading companies founded in 1889 in Japan. The Complainant itself was established in 1910.

The Kanematsu Group has 36 offices and over 130 group companies worldwide in Asia, the Middle East, North America, South and Central America, Europe, and the Oceania regions, with approximately 7,446 employees worldwide and USD 6 billion in revenue. For 112 years, the Complainant has been continuously providing value added services to its business partners in North America and continues to expand its business throughout North America and worldwide. Since in or about April 1990, the Complainant has consistently traded under the name "Kanematsu USA".

The Complainant holds a trademark registration for the mark KANEMATSU USA in the United States, Registration No. 2838015, filed on March 18, 2003 and registered on May 4, 2004 in classes 35 and 36.

Moreover, the Complainant operates a website at <kanematsuusa.com>, which was first registered in 1996. The website contains information about the Complainant's services, locations, and business activities. Besides the website, the Complainant maintains an active profile on LinkedIn.

The disputed domain name is confusingly similar to a trademark in which the Complainant has rights, since it wholly incorporates the distinctive portion of the Complainant's registered trademark KANEMATSU USA and consists of a common, obvious, or intentional misspelling of the Complainant's trademark – the only difference is the absence of an "u" between the words "kanematsu" and "usa".

Moreover, the Respondent has no rights or legitimate interests in the disputed domain name: The Respondent neither has been commonly known by the disputed domain name nor is it 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 or service mark at issue. Further, the Respondent is not an authorized licensee of the Complainant; has no affiliation or connection with the KANEMATSU USA trademark, the Complainant, or the Kanematsu Group companies, and is not otherwise authorized to use the Complainant's logo or the registered rights either as a domain name or in any other way.

The Respondent is using the disputed domain name to send fraudulent emails attaching fake documents to a third party. It has done this by impersonating the Complainant's employees and seeking to mislead third parties into sending products that the Respondent has no intention of paying for. The nature of these emails is such that the Respondent was well aware of the Complainant's business at the time it registered the disputed domain name, and the Respondent has also carefully researched and selected the third parties to whom emails are sent.

The Respondent uses the disputed domain name in bad faith: It redirects the disputed domain name to the Complainant's website and attracts, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark insofar as the Respondent retains control over the redirection thus creating a real or implied ongoing threat to the Complainant.

Moreover, the Respondent is engaging in an elaborate scam by holding itself out as the Complainant to unwitting third parties, and sending deceptive emails with fake documents to deceive such third parties into sending products that the Respondent has no intention of paying for. The Respondent impersonates employees of the Complainant by using their names at the bottom of the email.

Hence, the Respondent is not using the disputed domain name to provide good faith goods or services via a website, but instead registered and used it for scamming purposes to illegally impersonate the Complainant to gain a commercial gain by deceiving unwitting third parties into believing that the Respondent is the Complainant.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (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 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

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. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the mark KANEMATSU USA.

In the present case the disputed domain name <kanematsusa.com> is confusingly similar to the KANEMATSU USA mark in which the Complainant has rights since it only omits an “u” between the words KANEMATSU and USA. Furthermore, the disputed domain name consists of a common, obvious, or intentional misspelling of the Complainant's mark.

It has long been established under UDRP decisions that such misspellings of a trademark or where the relevant trademark is recognizable within the disputed domain name the mere omission of a letter will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition “[WIPO Overview 3.0](#)”). This is the case at present.

Finally, it has also long been held that generic Top-Level-Domains are generally disregarded when evaluating the confusing similarity of a disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

Furthermore, the nature of the disputed domain name, it consists of a common, obvious, or intentional misspelling of the Complainant's trademark, together with the Complainant's contentions that the Respondent has no rights or legitimate interests in the disputed domain name, that the Respondent has no connection or affiliation with the Complainant, and the Respondent has not received any license or consent, express or implied, to use the Complainant's mark KANEMATSU USA in a domain name or in any other manner, lead the Panel to the conclusion that the Complainant has made out an undisputed *prima facie* case so that the conditions set out in paragraph 4(a)(ii) of the Policy have been met by the Complainant.

This conclusion is confirmed by the fact that the Complainant put forward evidence, which remains unrebutted, that the disputed domain name was used for illegal activity, *e.g.* swindle, fraud, impersonation and identity theft, which can never confer rights or legitimate interests on a respondent (see section 2.13 of the [WIPO Overview 3.0](#)).

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (*e.g.* *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
 - the disputed domain name is being used by the Respondent in bad faith.
- (a) It is well-settled case law that the practice of typosquatting may in itself be evidence of a bad faith registration of a domain name (see, *e.g.*, *Longs Drug Stores California, Inc. v. Shep Dog*, WIPO Case No. [D2004-1069](#); *Wal-Mart Stores, Inc. v. Longo*, WIPO Case No. [D2014-0816](#)).

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos) to a trademark by an unaffiliated entity (as it is in the present case) can by itself create a presumption of bad faith (see section 3.1.4 [WIPO Overview 3.0](#)).

It is inconceivable that the Respondent has registered the disputed domain name without knowledge of the Complainant's rights; this is especially supported by the fact that the Complainant has a strong Internet presence and the Respondent redirected Internet users to the Complainant's website.

The Panel is therefore convinced that the disputed domain name was registered with full knowledge of the Complainant's rights and as such in bad faith by the Respondent.

- (b) Although the disputed domain name currently is not actively used, the Complainant put forward evidence that the disputed domain name was used for redirecting Internet users to the Complainant's website; moreover the Respondent used the disputed domain name for sending deceptive emails with fake documents to deceive third parties *e.g.* into sending products that the Respondent has no intention of paying, or impersonates employees of the Complainant by using their names at the bottom of the email and by doing so mislead unwitting third parties into believing that the Respondent is the Complainant.

This fraudulent and deceptive scheme represents bad faith use of the disputed domain name.

The evidence and documents produced and put forward by the Complainant together with the fact that the Respondent has failed to present any evidence of any good faith registration and use with regard to the disputed domain name leads this Panel to the conclusion, that the disputed domain name was registered and is being used by the Respondent in bad faith under 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 <kanematsusa.com> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: March 22, 2023