

ADMINISTRATIVE PANEL DECISION

Rakuten Group, Inc. v. mark jones
Case No. D2023-2332

1. The Parties

Complainant is Rakuten Group, Inc., United States of America, represented by Greenberg Traurig, LLP, United States of America.

Respondent is mark jones, United States of America.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 30, 2023. On May 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 31, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on June 7, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on June 12, 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 Respondent of the Complaint, and the proceedings commenced on June 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 3, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 5, 2023.

The Center appointed Timothy D. Casey as the sole panelist in this matter on July 14, 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

Complainant was established in Japan 1997, entering the United States of America market in 2000 with a cash back shopping service, and currently offers over 70 different services, ranging from an online marketplace, online banking services, credit cards, and is associated with a number of professional sports teams. Complainant is the owner of numerous trademark registrations related to different goods and services that include “RAKUTEN” as the trademark or part of the trademark (the “RAKUTEN Marks”), including the following:

Mark	Jurisdiction	Class(es)	Registration No.	Registration Date
RAKUTEN and Design	United States of America	9, 41	6,604,750	January 4, 2022
RAKUTEN	United States of America	9, 41	6,610,523	January 11, 2022
RAKUTEN and Design	United States of America	5, 9, 10, 35, 36, 38, 39, 41, 42, 43, 44, 45	6,886,764	November 1, 2022

The disputed domain name was registered January 9, 2023, using a privacy service.

Complainant provided evidence showing that the disputed domain name is being used in connection with a website that uses Complainant’s RAKUTEN Marks in connection with an online marketplace where consumers can engage in shopping for all manner of goods and services.

5. Parties’ Contentions

A. Complainant

Complainant contends that the disputed domain name is confusingly similar to the RAKUTEN Marks because it contains all or part of the RAKUTEN Marks in their entirety, only adding the term “shoping,” which is a clear misspelling of “shopping.” Complainant’s online marketplace services enable consumers to shop for all manner of goods and services. Complainant cited prior UDRP cases that found the addition of such descriptive terms did not eliminate confusing similarity, as well as prior UDRP cases that found that confusion was heightened by the addition of such descriptive terms.

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name, is not affiliated with Complainant, and that Respondent has never operated any *bona fide* or legitimate business using the disputed domain name.

Complainant notes that Respondent uses the disputed domain name to divert Internet traffic to a website (which Complainant defines as the “Imposter Website”) that impersonates Complainant’s website by using the same look and feel and branding of Complainant’s website, along with similar toolbars, product categories, and image tiles, and merely changes the color from purple to red. In addition, the Imposter Website includes an option for collecting individual personal identifying information, including a picture of a consumer’s photo identification, and engages in fraudulent transactions with consumers, seals personal information and login information, and confuses consumers. Complainant cited prior UDRP cases that concluded such activities do not establish legitimate rights or interests and are not *bona fide* offerings.

Complainant contends that Respondent is not commonly known by the disputed domain name and that pertinent information from the Registrar can be used to establish the same. Complainant further contends that Respondent’s registration and use of the disputed domain name has not been authorized, licensed, or consented to by Complainant.

Complainant contends that Respondent registered the disputed domain name to host the Imposter Website, which is sufficient to establish bad faith registration and use. Complainant further contends that Respondent

had constructive notice of the RAKUTEN Marks by virtue of their registrations and was clearly aware of the RAKUTEN Marks at the time of registration of the disputed domain name. Complainant further contends that Respondent's attempt to conceal its true identity by registering the disputed domain name with a privacy service and providing false information (Respondent's address corresponds to a restaurant) to the Registrar supports the inference that Respondent registered the disputed domain name in bad faith and to trade off Complainant's goodwill in the RAKUTEN Marks. Further, Complainant contends that Respondent's use of an active MX record, that can be used for email, evidences additional bad faith because the disputed domain name can be used in suspicious activities.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant's use of the RAKUTEN Marks for more than 25 years and registrations for the same are more than sufficient to establish that Complainant has trademark rights in the RAKUTEN Marks prior to registration of the disputed domain name.

Complainant contends that the disputed domain name is confusingly similar to the RAKUTEN Marks.

Given that Complainant's RAKUTEN Marks are recognizable in the disputed domain name the Panel agrees and finds that the disputed domain name is confusingly similar to the RAKUTEN Marks.

B. Rights or Legitimate Interests

The Panel finds that Respondent has no rights or legitimate interests in the disputed domain name. Respondent does not appear to be commonly known by the disputed domain name. Complainant has not licensed or otherwise permitted Respondent to use the RAKUTEN Marks.

Respondent's use of the disputed domain name in association with a website impersonating Complainant's website and appearing to sell similar goods and services is not a *bona fide* offering of goods or service that would give rise to rights or a legitimate interest in the disputed domain name.

Furthermore, the nature of the disputed domain name, comprising the RAKUTEN Marks and adding a descriptive term, regardless of the misspelling, carries a risk of Internet user confusion (that seemingly being Respondent's aim), and accordingly cannot constitute a fair use in these circumstances.

Respondent has not rebutted Complainant's *prima facie* case and has provided no arguments or evidence showing potential rights or legitimate interests in the disputed domain name. For these reasons, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Given i) the timing of Complainant's first use of the RAKUTEN Marks in 1997, and in the United States of America in 2000, and the prior registrations of the RAKUTEN Marks in the United States of America, predating registration of the disputed domain name, where Respondent reportedly resides, and Complainant's use of the RAKUTEN Marks in association with the Imposter Website, ii) the inherently misleading nature of the disputed domain name as a combination of the RAKUTEN Marks with a descriptive term, regardless of the misspelling, in combination with a deceptive website engaged in potentially illegal activity, and iii) Respondent's use of the disputed domain name, indicates that Respondent had clear knowledge of the RAKUTEN Marks and Complainant's business prior to registration.

The Panel finds that Respondent's registration of the disputed domain name was in bad faith.

In addition, the Panel finds Respondent's usage of the disputed domain name to attract consumers to a website associated with the disputed domain name by falsely associating the website with Complainant constitutes use in bad faith consistent with paragraph 4(b)(iv) of the Policy.

The Panel concludes that the disputed domain name was registered and has been used in bad faith.

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, <rakutenshoping.com>, be transferred to Complainant.

/Timothy D. Casey/

Timothy D. Casey

Sole Panelist

Date: July 28, 2023