

ADMINISTRATIVE PANEL DECISION

Rakuten Group, Inc. v. plum Bruce, Nasdaq
Case No. D2023-2697

1. The Parties

The Complainant is Rakuten Group, Inc., Japan, represented by Greenberg Traurig, LLP, United States of America (“United States” or “US”).

The Respondent is plum Bruce, Nasdaq, China.

2. The Domain Name and Registrar

The disputed domain name <rakutensss.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 22, 2023. On June 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 26, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on June 27, 2023, providing the further 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 July 2, 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 July 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 10, 2023.

The Center appointed Theda König Horowicz as the sole panelist in this matter on August 22, 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 was established in Japan 1997 where it is a publicly traded company. The Complainant 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.

The Complainant is active in Japan, notably through a large e-commerce platform Rakuten Ichiba, but also in several other countries, including the United States since 2000 where it primarily operates under the website “www.rakuten.com”.

The 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, including US Registration No. 6,604,750 of January 4, 2022, covering international classes 9 and 41.

The disputed domain name was registered on January 9, 2023, and has been used for a website displaying the Complainant’s logo and trademark.

5. Parties’ Contentions

A. Complainant

The Complainant alleges to have common law rights over RAKUTEN which has been used back over 20 years. The Complainant also claims to have registrations for the trademark RAKUTEN in several countries including the United States and China. The disputed domain name incorporates the trademark RAKUTEN in full. The addition of the letters “sss” are insufficient to distinguish the Respondent’s domain name from the Complainant’s mark. The disputed domain name is therefore confusingly similar to the Complainant’s mark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, is not affiliated with the Complainant, and that the Respondent has never operated any *bona fide* or legitimate business using the disputed domain name. The Complainant notes that the Respondent uses the disputed domain name to divert Internet traffic to a website (which the Complainant defines as the “Imposter Website”) that impersonates the Complainant’s website by using the same look and feel and branding of the Complainant’s website. The litigious website also displays the RAKUTEN trademark and purports to be Rakuten, thus attracting unsuspecting customers to enter their Rakuten login credentials and to engage in fraudulent transactions. The Complainant concludes that such activities do not establish legitimate rights or interests and are not *bona fide* offerings. Additionally, the Complainant contends that the Respondent is not commonly known by the disputed domain name and that pertinent information from the Registrar can be used to establish the same. The Complainant further contends that the Respondent’s registration and use of the disputed domain name has not been authorized, licensed, or consented to by the Complainant.

The Complainant also alleges that the disputed domain name was registered and is being used in bad faith. The disputed domain name has been used to host a website passing itself off as the Complainant’s website and is used to engage in fraudulent transactions and steal consumers’ personal or financial information. The Respondent also used false contact information in the registration of the disputed domain name.

Furthermore, at the time of the registration of the disputed domain name, it is obvious that the Respondent had actual knowledge of the Complainants well-known RAKUTEN marks.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following:

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

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainant. At the same time, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules, or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

A. Identical or Confusingly Similar

The Complainant has shown to have obtained trademark rights in RAKUTEN in several countries including in the United States and China.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing 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. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark RAKUTEN since it contains this mark in entirety. The addition of the letters "sss" in the disputed domain name does not prevent a finding of confusing similarity as the relevant trademark remains clearly recognizable within the disputed domain name. See section 1.8 of the [WIPO Overview 3.0](#).

The generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement, and as such is typically disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

The Panel therefore finds that the conditions in paragraph 4(a)(i) of the Policy are fulfilled in relation to the disputed domain name.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances that may demonstrate when a respondent has rights or legitimate interests in a domain name. The list includes:

- (i) the use of the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) being commonly known by the domain name; or

- (iii) the making of a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers.

Once the Complainant establishes a *prima facie* case against the Respondent under this ground, the burden of production shifts to the Respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has made sufficient statements in order to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant has not licensed or otherwise permitted the Respondent to use its trademarks. There is no evidence showing that the Respondent would be commonly known by the disputed domain name or that a legitimate business would be run by the Respondent under the disputed domain name.

The Panel therefore finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and the burden of production shifts to the Respondent who has chosen not to reply.

The Respondent has not rebutted the Complainant's *prima facie* case, and there is no evidence of the types of circumstances set out in paragraph 4(c) of the Policy that might give rise to rights or legitimate interests in the disputed domain name on the part of the Respondent in these proceedings.

The Panel notes that the disputed domain name resolves to a commercial website that impersonates the Complainant's website and uses the RAKUTEN marks without authorization and without any statement clarifying the website's relationship to the Complainant. This behavior does obviously not qualify as a legitimate noncommercial or fair use under the Policy.

As already stated before, nothing is contained in the case file which would show that the disputed domain name has been legitimately noncommercial or fairly used by the Respondent or that the Respondent would have any rights or legitimate interests in the disputed domain name.

Furthermore, the nature of the disputed domain name, incorporating the Complainant's distinctive RAKUTEN trademark in its entirety with the mere addition of the letters "sss", and the content at the website found at the disputed domain name, displaying both the Complainant's trademark and logo, reflects the Respondent's intention to create a direct inference of association to the Complainant.

The Panel therefore finds that the conditions in paragraph 4(a)(ii) of the Policy are fulfilled in relation to the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the complainant to prove both registration and use of the domain name in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances which shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business

of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the holder's respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's respondent's website or location or of a product or service on the holder's respondent's website or location.

Accordingly, for the Complainant to succeed, the Panel must be satisfied that the disputed domain name was registered and is being used in bad faith.

Given the circumstances of the case, including the fact that the disputed domain name identically reproduces the Complainant's notorious RAKUTEN trademark and resolves to a website that impersonates the Complainant's website and uses the RAKUTEN marks without authorization, it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainant's trademark and business which has acquired a high level of notoriety since its creation and which is widely promoted worldwide through the Complainant's official website "www.rakuten.com".

The bad faith use condition is also fulfilled as the disputed domain name resolves to a website pretending to be a Rakuten website and using without authorization the trademark of the Complainant. The Respondent thus creates on purpose the confusing impression for the consumers that its business is connected to the business of the Complainant, for commercial gain.

By doing so, the Respondent obviously makes a bad faith use of the disputed domain name.

The Respondent has not contested the allegations made by the Complainant and his silence in these proceedings is an additional inference of bad faith in these circumstances. The Panel therefore finds that the disputed domain name was registered and is being used in bad faith.

The Panel therefore finds that the conditions in paragraph 4(a)(iii) of the Policy is fulfilled in relation to the disputed domain name.

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, <rakutensss.com>, be transferred to the Complainant.

/Theda König Horowicz/

Theda König Horowicz

Sole Panelist

Date: September 16, 2023