

ADMINISTRATIVE PANEL DECISION

Rakuten Group, Inc. v. Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2023-3613

1. The Parties

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

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <rakutendealmaker.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 August 28, 2023. On August 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 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 the Complainant on September 1, 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 September 5, 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 September 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 3, 2023.

The Center appointed Taras Kyslyy as the sole panelist in this matter on October 5, 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 a global innovation company offering more than 70 different services, including an online marketplace, portal and media services, a travel agency, online banking services, securities services, and credit cards. The Complainant also owns a professional baseball team. The Complainant's online marketplace, Rakuten Ichiba, is one of the largest e-commerce sites in Japan, with active membership of about 83 million people and domestic gross transaction volume, including financial services, of around JPY 7.1 trillion (USD 68 billion). The Complainant has also spent two decades building a close community of publishers, advertisers, and innovative marketing leaders and conducts an annual event to bring them all together entitled "Deal Maker". Representatives from hundreds of companies attend Rakuten Deal Maker and every year over 4,000 meetings take place at Rakuten Deal Maker.

The Complainant owns numerous trademark registrations for its RAKUTEN mark in various jurisdictions, including for instance Japan trademark registration No. 5536382, registered on November 16, 2012.

The Complainant runs its business via official website at "www.rakuten.com".

The disputed domain name was registered on May 10, 2023, and resolves to a webpage comprising of pay-per-click ("PPC") links. The disputed domain name is offered for sale for USD 1,299 on Afternic, a domain name sales and auction platform.

There are over 200 prior UDRP Panel decisions under the Policy against the Respondent the vast majority of which concern the Respondent registering and using the domain names incorporating famous and well-known marks in bad faith.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

In particular, the Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark. The disputed domain name incorporates the Complainant's trademark in full, changing it only by adding the generic terms "deal" and "maker" at the end, which directly describes the Complainant's online marketplace services that it provides to its members, including "making deals" in terms of offering its members cash back at numerous third party stores and is also identical to the Complainant's annual Deal Maker event, and the generic Top-Level Domain ("gTLD") ".com".

The Respondent does not have rights or legitimate interests in respect of the disputed domain name. Long after the Complainant established rights in its trademark, without the Complainant's authorization or consent, the Respondent registered the disputed domain name, which misappropriates and is confusingly similar to the Complainant's trademark. The Respondent has not used or prepared to use the disputed domain name in connection with a *bona fide* offering of goods or services, and has not been authorized, licensed, or otherwise permitted by the Complainant to register and/or use the disputed domain name, and registered the disputed domain name for the purpose of perpetuating a fraud on the public. The Respondent is using the disputed domain name to divert Internet traffic to websites that contain PPC or affiliate advertising links that redirect to third party websites. The Respondent is not commonly known by the disputed domain name.

The Complainant also contends that the disputed domain name was registered and is being used in bad faith. Long after the Complainant established rights in its trademark, and with knowledge of the Complainant's well-known trademark, the Respondent acquired the confusingly similar disputed domain name to divert Internet traffic to websites garnering PPC or affiliate advertising revenue for the Respondent's commercial gain. The Respondent's pattern of prior bad faith registration of domain names utilizing well-known trademarks in which the Respondent has no rights or legitimate interests provides further evidence of the Respondent's bad faith registration and use of the disputed domain name. The disputed domain name is so obviously connected with the Complainant and its services that its very use by someone with no connection to the Complainant suggests opportunistic bad faith. The Respondent has also used a proxy service to register the disputed domain name to shield its identity and elude enforcement efforts by the legitimate trademark owner, which demonstrates the Respondent's bad faith use and registration of the disputed domain name. The disputed domain name has an active mail exchange (MX) record, which indicates use for email, which evidences a likelihood of additional bad faith use of the disputed domain name, *e.g.*, through phishing or fraudulent email communications. The Respondent has also listed the disputed domain name for sale for USD 1,299.00 on Afternic, a domain name sales and auction platform.

B. Respondent

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

6. Discussion and Findings

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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The applicable gTLD in a domain name (*e.g.*, ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards gTLD ".com" for the purposes of the confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms here, "deal" and "maker", may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The available evidence does not confirm that the Respondent is commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent. The use of the disputed domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the Complainant's mark and otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9. Thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

A number of factors including the nature of the domain name, the chosen Top-Level Domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark. In the present case, the Respondent registered the disputed domain name incorporating the Complainant's trademark adding event name pursued by the Complainant for decades. The Respondent is also known for its pattern of registering third parties' known marks as domain names as obviated by hundreds of respective prior decisions under the Policy. The Panel finds the above confirms that the Respondent was aware of and targeted the Complainant and its trademark when registering the disputed domain name which indicates bad faith. [WIPO Overview 3.0](#), section 3.2.2.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. To facilitate assessment of whether this has occurred, and bearing in mind that the burden of proof rests with the complainant, paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 respondent'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 respondent 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 its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

In this regard, the Panel finds that at least the first, the second, and the fourth of the above scenarios apply to the present case confirming the Respondent's bad faith. [WIPO Overview 3.0](#), section 3.1.

Moreover, the Respondent used a privacy service to register the disputed domain name. The use of a privacy or proxy service merely to avoid being notified of a UDRP proceeding, may support an inference of bad faith; a respondent filing a response may refute such inference. However, no such response was provided by the Respondent. The Panel finds that such use of the privacy service here supports the Panel's finding of bad faith. [WIPO Overview 3.0](#), section 3.6.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <rakutendealmaker.com> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: October 19, 2023