

ADMINISTRATIVE PANEL DECISION

Kabushiki Kaisha Yakult Honsha v. CÔNG TY TNHH TẬP ĐOÀN GLOBAL NHÀ MÁY LIÊN DOANH SẢN XUẤT DP USA PHÁP - DO THÁI USARAEL(R)

Case No. D2023-3811

1. The Parties

The Complainant is Kabushiki Kaisha Yakult Honsha, Japan, represented by BMVN International LLC, Viet Nam.

The Respondent is CÔNG TY TNHH TẬP ĐOÀN GLOBAL NHÀ MÁY LIÊN DOANH SẢN XUẤT DP USA PHÁP - DO THÁI USARAEL(R), Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <yakult.online> (the “Disputed Domain Name”) is registered with P.A. Viet Nam Company Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 13, 2023. On September 13 and October 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 18 and October 6, 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 verified that 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 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2023. The Respondent sent an email communication to the Center on October 25, 2023. The Complainant made a supplemental filing on October 31, 2023.

The Center appointed Nick J. Gardner as the sole panelist in this matter on November 9, 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 Japanese corporation. It has been in business for over 90 years. It manufactures and sells a range of probiotic yoghurts and related dairy products. It does so internationally in at least 40 countries around the world, including Vietnam. It sells around 40 million bottles of dairy products per day.

The Complainant owns numerous trademark registrations for the word YAKULT including for example Vietnamese registration 4-0012489-000 registered on July 6, 1994. These registrations are referred to as the “YAKULT trademark” in this decision.

The Disputed Domain Name was registered on May 10, 2022. It resolves to a website (the “Respondent’s Website”) the text of which is in Vietnamese but which contains numerous images of what appear to be the Complainant’s bottles (which have a distinctive shape) and uses on these bottles and elsewhere on the website the Complainant’s distinctive red and white logo which prominently features the word “yakult”. Yakult is a coined word with no other meaning except in relation to the Complainant and its products.

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.

Notably, the Complainant contends that the Respondent’s Website shows that the Respondent must have been well aware of the YAKULT trademark when it registered and started using the Disputed Domain Name, given the number of unauthorized uses and false references made by the Respondent on the website. The Complainant also says the Respondent falsely claims to have registered trademark rights in Vietnam to the word YAKULT.

B. Respondent

No formal Response has been filed. The Respondent’s email communication to the Center of October 25, 2023 stated as follows:

“We are very happy to receive[sic] your E- mail

We have two things to say:

1. We have legal brand named Yakult(R) at medical Field as a local license’s government in our country where we put the company.

2. We don’t have any branches outside our country. We bought, registered and only using the Domain “Yakult .online” in our country limited, where we have the right and legality.

So, we are not illegal in this situation at Local government in our country.

We’d like to recommend you shouldn’t tell us something like that.

We think human has the right to compete each other and the company equally so. We bought “domain” and registered license and only using in our country.

We’d like to Show you our legal license in our country. Thank you so much and good luck.

Sincerely,”

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 Panel finds the entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 Panel notes that the Respondent's informal email (see above) claims it has a "legal brand named Yakult(R) at medical Field as a local license's government in our country". This statement has not been substantiated by any evidence and appears to the Panel to be inconsistent with the contents of the Respondent's Website – which appears to show the Respondent offering for sale products the same as those produced by the Complainant, with packaging and labelling that reproduce the packaging and labelling used by the Complainant. Accordingly, the Panel attaches no weight to the Respondent's statement in this regard.

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.

In the present circumstances the fact that the Disputed Domain Name was linked to the Respondent's Website which appears to offer for sale products which impersonate those of the Complainant lead the Panel to conclude the registration and use were in bad faith.

The Panel concludes that the Respondent chose to register a name comprising the Complainant's YAKULT trademark in order to facilitate a scheme where the Respondent's website offered for sale products which purported to be those of the Complainant.

Under paragraph 4(b) of the Policy, a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

In the present circumstances the Panel agrees with the Complainant that factor (iv) applies as the Respondent was seeking to achieve commercial gain by selling products which impersonated those of the Complainant. The Panel discounts the explanation offered by the Respondent in its informal email for the reasons discussed above.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith and 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 <yakult.online> be transferred to the Complainant

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: November 23, 2023