

ADMINISTRATIVE PANEL DECISION

Rakuten Group, Inc. v. Bui Quang Hieu
Case No. D2023-3870

1. The Parties

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

The Respondent is Bui Quang Hieu, Viet Nam.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on September 15, 2023. On September 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 18, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant, providing the contact details and that the language of the Disputed Domain Name’s registration agreement was Vietnamese.

On September 19, 2023, the Center transmitted an email communication to the Parties in both English and Vietnamese regarding the language of the proceeding. On September 19, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 September 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 18, 2023.

The Center appointed Pham Nghiem Xuan Bac as the sole panelist in this matter on October 24, 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, Rakuten Group, Inc. is a global innovation leader 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.

According to the Complaint, the Complainant owns Rakuten Ichiba, which is one of the largest e-commerce sites in Japan, with active memberships of about 83 million people and a domestic gross transaction volume of around 7.1 trillion yen (USD 68 billion). Additionally, the Complainant's website under the domain name <rakuten.com> offers over 18 million products and has over 20 million customers.

The Complainant is the owner of many trademark registrations that consist of or contain RAKUTEN (the "RAKUTEN trademarks") in many jurisdictions throughout the world, including, but not limited to, Viet Nam Trademark Registrations No. 4-0167947-000 registered on July 19, 2011 and No. 4-0169502-000 registered on August 10, 2011.

The Disputed Domain Name was registered on May 11, 2023. As of the date of this Decision, the Disputed Domain Name does not resolve to an active website. However, as submitted by the Complainant, the Disputed Domain Name used to resolve to a website providing an e-commerce platform bearing the Rakuten brand.

As indicated in the Complaint, the Complainant sent to the Registrar a claim with regard to the Disputed Domain Name on August 23, 2023, in which the Complainant asked for the suspension of such Disputed Domain Name. On September 4, 2023, the Registrar responded to the Complainant that it had suspended the Disputed Domain Name.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case, as follows:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark, in which the Complainant has rights.

First, the Complainant contends that the Complainant is the registered owner of trademark registrations for RAKUTEN in numerous jurisdictions around the world, including in Viet Nam, where the Respondent is purportedly located. Further, the Complainant asserts that the RAKUTEN name and trademark including the stylized Rakuten Rewards Logo and stylized "R" logo are widely used in commerce.

Second, the Complainant contends that the Disputed Domain Name is confusingly similar to the trademark owned by the Complainant since the Disputed Domain Name incorporates the Complainant's trademark RAKUTEN in full, and the only difference is the addition of generic term "express", which directly describes not only the speed with which consumers can create accounts, but also the speed with which consumers can access deals and Cash Back rewards through the Complainant's online marketplace. The said addition could not dispel any likelihood of confusion.

Third, the Complainant submits that the addition of the generic Top-Level Domain (“gTLD”) suffix “.net” in the Disputed Domain Name does not add any distinctiveness to the Disputed Domain Name.

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Complainant submits that the elements set forth in the Policy, paragraph 4(c) are not fulfilled.

First, the Respondent is neither a licensee of the Complainant, nor otherwise authorized to use the Complainant’s RAKUTEN trademark.

Second, the Complainant contends that the Respondent has not made use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a *bona fide* offering of goods or services. Also, the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. The Complainant asserts that the Respondent is using the Disputed Domain Name to divert Internet traffic to a website that impersonates the Complainant’s website. The associated website is used to engage in fraudulent transactions with consumers and steal personal information and login information to the Complainant’s website from them. By displaying the Complainant’s RAKUTEN logo and the ® designation on the same location on the associated website, the Respondent falsely implies that it is the proper owner of the federally registered RAKUTEN mark.

In addition, the Complainant asserts that the Respondent is not commonly known by the Disputed Domain Name or the name “Rakuten”, since the pertinent Whois information identifies the Registrant as “Bui Quang Hieu” and there is no prior trademark application or registration in the name of the Respondent for any mark incorporating the RAKUTEN mark anywhere in the world.

(iii) The Disputed Domain Name was registered and is being used in bad faith.

First, the Complainant asserts that the Disputed Domain Name has been used to host a website passing itself off as the Complainant’s website or a website sponsored by or affiliated with the Complainant, which confuses consumers. Moreover, there is a risk that the Respondent’s website could be used to steal consumers’ personal or company information. Such activities fall squarely into the explicit example of bad faith registration and use.

Second, the Complainant submits that it is evident from the Respondent’s use of the Disputed Domain Name that the Respondent has actual knowledge of the Complainant’s RAKUTEN trademark at the time of registering the Disputed Domain Name.

Third, the Complainant’s RAKUTEN trademark is well-known, with trademark registrations across numerous countries. Thus, the Complainant contends that the Respondent has constructive knowledge of the RAKUTEN trademark.

Finally, the Complainant contends that the Disputed Domain Name is obviously connected with the Complainant and its online discount services and that its use by someone with no connection to the Complainant suggests opportunistic bad faith.

With the said arguments, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Procedural Issue

(i) Language of the Proceeding

The Complaint was filed in English. However, the Registrar confirmed that the language of the Registration Agreement was Vietnamese.

As the Complaint was filed in English, the Center, in its communication dated September 19, 2023, invited the Complainant to submit either (i) satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceeding should be in English, or (ii) the Complaint translated into Vietnamese, or (iii) a substantiated request for English to be the language of the proceeding.

On September 19, 2023, the Complainant sent an email to the Center requesting that English be the language of the proceeding.

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Similar to previous UDRP decisions, the Panel finds that the spirit of paragraph 11(a) is to ensure fairness in the selection of language by giving full consideration to the Parties' level of comfortability with each language, the expenses to be incurred and possibility of delay in the proceeding in the event translations are required and other relevant factors (see, e.g., *Deutsche Messe AG v. Kim Hyungho*, WIPO Case No. [D2003-0679](#)).

In the present case, the Panel takes into account the circumstances of the proceeding, including, but not limited to:

- (i) the fact that the Complainant, a Japanese business entity, does not appear to be able to communicate in Vietnamese, and therefore, if the Complainant was required to have the documents translated into Vietnamese, the proceeding would be unduly delayed, and the Complainant would have to incur substantial expenses for translation;
- (ii) it is evidenced to the Panel that the website under the Disputed Domain Name used to contain English contents; these suggest that the Respondent has ample knowledge of the English language and would be able to communicate in English;
- (iii) the Respondent did not object for English to be the language of the proceeding and did not submit a response in either English or Vietnamese.

Therefore, for easy comprehension of the Complainant (ultimately, the Party solely taking part in the proceeding) of the Panel's decision without any necessity of translations, and in the interest of fairness to both Parties as well as the Panel's obligation under paragraph 10(c) of the Rules, which provides that "the Panel shall ensure that the administrative proceeding takes place with due expedition", the Panel hereby decides, under paragraph 11(a) of the Rules, that the language of the proceeding shall be English and shall render its decision in English.

(ii) The Respondent's Failure to Respond

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., *Tradewind Media, LLC d/b/a Intopic Media v. Jayson Hahn*, WIPO Case No. [D2010-1413](#), and *M. Corentin Benoit Thiercelin v. CyberDeal, Inc.*, WIPO Case No. [D2010-0941](#)). However, the Panel may draw appropriate inferences from the Respondent's default.

B. Identical or Confusingly Similar

The Complainant is required to establish the following: (i) that it has trademark rights, and, if so, (ii) that the Disputed Domain Name is identical or confusingly similar to its trademark.

First of all, the Panel finds that the Complainant has clearly evidenced that it has registered trademark rights to RAKUTEN in numerous countries all over the world, including Viet Nam, where the Respondent resides. These registrations are well before the registration date of the Disputed Domain Name.

Second, the Disputed Domain Name comprises the Complainant's RAKUTEN mark, in which the Complainant has exclusive rights. The difference between the Disputed Domain Name and the trademark is the addition of the term "express".

It is well established that the addition of the term "express" to a trademark does not prevent confusing similarity. Thus, in the Panel's view, the addition of the said suffix does nothing to prevent the trademark from being recognizable in the Disputed Domain Name, as it was found in previous UDRP decisions (see, e.g., *American Airlines, Inc. v. Yanick Elangwe*, WIPO Case No. [D2023-3034](#); *Comair Limited v. sui wang ma*, WIPO Case No. [D2022-1955](#); *MICROMANIA GROUP contre Serge Blanco, Micromania Litige*, WIPO Case No. [D2021-1702](#)).

Third, the Panel finds, similarly to other UDRP panels, that the addition of the gTLD ".net" is viewed as a standard registration requirement (see, e.g., *Volkswagen AG v. Privacy Protection Services*, WIPO Case No. [D2012-2066](#); *The Coca-Cola Company v. David Jurkiewicz*, WIPO Case No. [DME2010-0008](#); *Telecom Personal, S.A., v. NAMEZERO.COM, Inc.*, WIPO Case No. [D2001-0015](#); *F. Hoffmann La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's RAKUTEN trademark, and the first element of the Policy is established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists circumstances, in particular but without limitation, which, if found by the Panel to be proved, demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

"(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Panel finds that the Complainant has made a *prima facie* evidence on that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The consensus of previous UDRP decisions is that while the overall burden of proof in UDRP proceedings is on the Complainant, once a *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating his rights or legitimate interests in the Disputed Domain Name (see e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Julian Barnes v. Old Barn Studios Limited*, WIPO Case No. [D2001-0121](#)). In this instant case, the Panel finds that the Respondent has failed to meet that burden since no response was submitted for evidence to the contrary.

Regarding paragraph 4(c)(i) of the Policy, the Panel finds, in light of the Complainant's asserted facts, that no license, permission, or authorization of any kind to use the Complainant's trademark has been granted to the Respondent. There is no evidence available that the Respondent holds any registered or unregistered trademark rights in any jurisdiction. Thus, the Panel finds that the Respondent has no rights in the trademark RAKUTEN.

Furthermore, the Panel finds that the Disputed Domain Name was used to resolve to a website where the Complainant's RAKUTEN Trademarks were displayed, while no statement or disclaimer disclosing accurately the (lack of) relationship between the Complainant and the Respondent was placed. This unauthorized use of the RAKUTEN Trademarks may mislead Internet visitors into believing in a connection or association between the Respondent and the Complainant, where such connection or association does not exist in reality. Therefore, the Panel finds that by using the Disputed Domain Name in such a manner, the Respondent is attempting to ride on the reputation of the RAKUTEN Trademarks, and thus, such use does not constitute a *bona fide* use within paragraph 4(c)(i) of the Policy.

Regarding paragraphs 4(c)(ii) and 4(c)(iii) of the Policy, the Panel finds that there is no evidence that would suggest that the Respondent, as an individual, business, or other organization, has been commonly known by the Disputed Domain Name, or that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, as it appears following the Complainant's assertions and evidence with regard to the Respondent's registration of the Disputed Domain Name, the Respondent had full knowledge of the RAKUTEN trademark and had an intention to gain profit by riding on the goodwill and reputation of the Complainant.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, and the second element, paragraph 4(a)(ii) of the Policy is established.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, including:

"(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 the 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 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 your website or location or of a product or service on your website or location.”

The above four circumstances are not exhaustive and bad faith may be found by the Panel alternatively.

The Panel finds that the Complainant has put forth evidence that the Respondent has registered and used the Disputed Domain Name in bad faith. The Respondent did not reply to the Complainant's contentions and, therefore, did not refute the Complainant's contentions.

The Panel has considered the Complainant's assertions and evidence with regard to the Respondent's registration and use of the Disputed Domain Name. In this regard, the Panel finds that the Complainant's RAKUTEN trademark has been registered in a variety of jurisdictions around the world. In addition, the Complainant's RAKUTEN trademark has been registered and put in use in, among other countries, Viet Nam where the Respondent resides. These trademark registrations well predate the registration of the Disputed Domain Name.

The Disputed Domain Name comprises the RAKUTEN trademark in its entirety, adding the non-distinctive term “express” at the end. Given the extensive use of the RAKUTEN trademark for online shopping services by the Complainant, which occurs in numerous countries, it is very unlikely that the Respondent registered the Disputed Domain Name in a fortuity. Also, in consideration of the use of the Disputed Domain Name and the contents of the website thereunder, the Panel is of the view that the Respondent obviously knew of the Complainant and its trademark when it registered the Disputed Domain Name, and the Panel considers the registration is an attempt by the Respondent as to take advantage of the Complainant's goodwill.

On the date of this Decision, the Panel accesses the Disputed Domain Name and finds that it resolves to an inactive website. However, it is well proved and evidenced by the Complainant that the website under the Disputed Domain Name used to offer an online marketplace branded with the Complainant's trademark RAKUTEN. In addition to the adoption of the Complainant's RAKUTEN trademark as a uniquely distinctive part of the Disputed Domain Name, the Respondent used the Complainant's trademark on the website, which falsely represented itself as the Complainant or the Complainant's associated entity.

The Panel takes the view that any Internet users seeking the Complainant's RAKUTEN services would very likely mistakenly believe that the Respondent is either the Complainant or associated with the Complainant, while no such connection exists in fact. Such misleading behavior is indicative of bad faith within the meaning of paragraph 4(b)(iv) of the Policy, on the part of the Respondent.

Taking into account all of the above and the available record, the Panel finds that the Disputed Domain Name was registered and used by the Respondent in bad faith and the third element under paragraph 4(a)(iii) of the Policy is 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 <rakutenexpress.net> be transferred to the Complainant.

/Pham Nghiem Xuan Bac/

Pham Nghiem Xuan Bac

Sole Panelist

Date: November 7, 2023