

## **ADMINISTRATIVE PANEL DECISION**

Rakuten Group, Inc. v. Hasting H  
Case No. D2023-3877

### **1. The Parties**

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

The Respondent is Hasting H, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <rakutenstroke.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 16, 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 19, 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 September 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 11, 2023.

The Center appointed Alfred Meijboom as the sole panelist in this matter on October 20, 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 publicly traded company which was established in 1997 in Japan. It offers, *inter alia*, an online marketplace, portal and media services, a travel agency, online banking services, securities services, and credit cards. The Complainant's "Rakuten Ichiba" is one of the largest e-commerce sites in Japan, with about 83 million active members and a domestic gross transaction volume, including financial services, of around 7.1 trillion yen. The Complainant has been active in the United States since 2000, where it operates an online marketplace at "rakuten.com/shop", which offers over 18 million products and has over 20 million customers.

The Complainant is owner of approximately 300 trademark registrations for its RAKUTEN trademarks covering at least 55 countries, including United States trademark RAKUTEN with registration No. 6,610,523 of January 11, 2022 for goods and services in classes 9 and 41.

The disputed domain name was registered on July 5, 2023 and resolves to a website which operates an online shop that adopts the same look and feel of the Complainant's website, prominently displays the Complainant's RAKUTEN trademark, and purports to provide information about the Complainant (the "Respondent's Website").

#### 5. Parties' Contentions

##### A. Complainant

The Complainant claims that the disputed domain name is confusingly similar to its RAKUTEN trademark. According to the Complainant, the addition of the term "stroke" fails to produce a domain name distinct from the Complainant's RAKUTEN trademark.

Further, the Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name because 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 impersonating the Complainant and defrauding consumers.

According to the Complainant it is obvious that, at the time of registration of the disputed domain name, the Respondent had actual knowledge of the Complainant's RAKUTEN trademark as such actual knowledge is the entire reason behind the Respondent's registration of the disputed domain name. The Complainant also alleges that the disputed domain name has been used to host a website which passes itself off as the Complainant's website or a website sponsored by or affiliated with the Complainant, which at worst is used to steal consumers' personal or company information, and at best, simply confuses consumers, which activities fall squarely into the explicit example of bad faith registration and use of paragraph 4(b)(iv) of the Policy. According to the Complainant the whole *modus operandi* of the Respondent is fraudulent, which establishes that the use of the disputed domain name is in bad faith.

##### B. Respondent

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

#### 6. Discussion and Findings

The Respondent did not file a Response. However, as set out in section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the consensus view of UDRP panels is that the respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still establish each of the three elements required by paragraph 4(a) of

the Policy. Although the Panel may draw appropriate inferences from the Respondent's default, paragraph 4 of the Policy requires the Complainant to support its assertions with actual evidence in order to succeed in this proceeding. Paragraph 14(b) of the Rules provides that, in the absence of exceptional circumstances, the panel shall draw such inferences as it considers appropriate from a failure of a party to comply with a provision or requirement of the Rules. The Panel finds that in this case there are no such exceptional circumstances.

Under the Policy, the Complainant must prove that:

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

#### **A. Identical or Confusingly Similar**

It is well established that the generic Top-Level Domain ("gTLD") ".com" should typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's RAKUTEN trademark. The disputed domain name incorporates the Complainant's RAKUTEN trademark in its entirety, and merely adds the term "stroke", which does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's RAKUTEN trademark (see section 1.7 of the [WIPO Overview 3.0](#): "While each case is judged on its own merits, 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").

Consequently, the first element of paragraph 4(a) of the Policy is met.

#### **B. Rights or Legitimate Interests**

The Complainant must show a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which the Respondent may rebut (e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel takes note of the Complainant's various allegations and more specifically that no authorization has been given by the Complainant to the Respondent to use the Complainant's RAKUTEN trademark or to register the disputed domain name, and the disputed domain name resolves to the Respondent's Website which intentionally creates confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. The Panel finds that the Complainant has sufficiently demonstrated that the Respondent's Website is probably intended to deceive Internet users into believing that they have visited the Complainant's online marketplace, and that the Respondent's Website may be used to defraud such Internet users.

The allegations of the Complainant remain unchallenged. There is no evidence before the Panel to show that the Respondent has rights or legitimate interests in the disputed domain name. The Panel therefore finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel is satisfied that the Respondent must have had RAKUTEN trademark in mind when it registered the disputed domain name, as the Complainant secured registration for the RAKUTEN trademark before the registration of the disputed domain name, and the disputed domain name has been resolving to the Respondent's Website which prominently displays the Complainant's RAKUTEN trademark and mimics the Complainant's website, immediately upon registration of the disputed domain name.

Further, the Panel considers the use of the disputed domain name to resolve to the Respondent's Website which adopted the same look and feel of the Complainant's website and branding, purports to provide information about the Complainant and encourages visitors to "sign up" and create accounts for both purchasing and selling products, as an intentional attempt to attract, for commercial gain, Internet users to the Respondent's Website, by creating a likelihood of confusion with the Complainant's RAKUTEN trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website as meant in paragraph 4(b)(iv) of the Policy. The Panel considers the Complainant's allegation that the disputed domain name at worst is used to steal consumers' personal or company information, and at best, simply confuses consumers, credible. As the Respondent failed to offer any explanation for its conduct, the Panel is satisfied that the Complainant demonstrated that the disputed domain name has been registered and is being used in bad faith.

Consequently, the third and last element of paragraph 4(a) of the Policy is also met.

### **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 <rakutenstroke.com> be transferred to the Complainant.

*/Alfred Meijboom/*

**Alfred Meijboom**

Sole Panelist

Date: November 2, 2023