

ADMINISTRATIVE PANEL DECISION

JCB Co., Ltd v. alcides Bellido Tohalino, publicides
Case No. D2023-4695

1. The Parties

The Complainant is JCB Co., Ltd, Japan, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States of America ("United States").

The Respondent is alcides Bellido Tohalino, publicides, Peru.

2. The Domain Name and Registrar

The disputed domain name <jcbsii.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 November 11, 2023. On November 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 13, 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 November 14, 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 amendment to the Complaint on November 15, 2023.

The Center verified that the Complaint together with the amendment to 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 November 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 11, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on December 21, 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 founded in 1961 as Japan Credit Bureau and, that year, issued Japan's first credit card and also became the first private company in Japan to offer customers convenient automatic bank draft payment for credit card bills. The Complainant is the only international payment brand based in Japan, offering high quality payment solutions and technologies trusted worldwide.

The Complainant employs 4,373 people and has more than 154 million cardmembers, 43 million merchants, and annual transaction volume of 43.3 trillion yen (approximately USD 296.6 billion). The Complainant's card-issuing network operates in 24 countries and territories, and its credit, debit and pre-paid cards are accepted in more than 190 countries and territories.

The Complainant is the registrant of many domain names that consist of or include "jcb," including <jcb.co.jp > (created on July 18, 1995), <jcbcard.com> (created on January 22, 2002), <jcbusa.com> (created on September 11, 1996), and <global.jcb> (created on January 8, 2016). The Complainant is the registry operator for the ".jcb" top-level domain ("TLD"), which was delegated to the Complainant on January 16, 2015.

The Complainant is the owner of the mark JCB registered in the following jurisdictions:

Mark	Jurisdiction	Reg. No.	Date
JCB	Hong Kong	Reg. No. 1978B0130	(registered August 17, 1976)
JCB CARD	United States	Reg. No. 3,080,016	(registered April 11, 2006)
JCB	Japan	Reg. No. 5,656,971	(registered March 14, 2014)
JCB	Japan	Reg. No. 5,724,304	(registered December 5, 2014)
JCB	China	Reg. No. 175,373	(registered April 15, 1983)
JCB	China	Reg. No. 776,119	(registered January 21, 1995)
JCB	China	Reg. No. 3,238,171	(registered May 28, 2004)

In addition, the Complainant is the owner for the mark JCB Logo (the letters "jcb" with the colors blue red and green):

Mark	Jurisdiction	Reg. No.	Date
JCB Logo	France	Reg. No. 1,194,500	(registered February 3, 1982)
JCB Logo	Spain	Reg. No. M1088042	(registered February 17, 1986)
JCB Logo	European Union	Reg. No. 000,204,057	(registered September 16, 1998)
JCB Logo	United States	Reg. No. 3,608,075	(registered April 21, 2009)

The disputed domain name was registered on June 3, 2023. The Respondent was using the disputed domain name in connection with a website that falsely appears to be a website for the Complainant by prominently displaying, without consent or permission from the Complainant, a copy of the Complainant's JCB Logo. Currently, the Respondent has removed the Complainant's logo, however, the Panel visited "archive.org" and was able to verify that the Complainant's JCB logo (including the same colors used for each letter) was originally at the website to which the disputed domain name resolved.

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 disputed domain name is confusingly similar to its trademarks;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name;
- the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 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 to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other term "sii" may bear on assessment of the second and third elements, the Panel finds the addition of such term does 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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available 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.

Panels have held that the use of a domain name for illegal activity such as impersonation/passing off by the Complainant can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 case, the Panel notes:

- The Complainant’s registration of the JCB trademark for 47 years and the Complainant’s approximately 355 trademark registrations in 74 jurisdictions worldwide for the JCB trademark.
- That the Respondent registered the disputed domain name in 2023.
- That at the time of this decision, the content of the disputed domain name has changed (the JCB logo has been removed from the website). However, the Panel visited an older version of the disputed domain name at “archive.org”, along with the evidence provided by the Complainant, and was able to verify that the Respondent was using the JCB logo exactly with the same combinations of colors as the Complainant trademark, with no disclaimer.
- That as shown from the content on the Respondent’s website (Annex 8), it is obvious that the Respondent has created a likelihood of confusion with the Complainant, establishing bad faith under paragraph 4(b)(iv) of the Policy.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity in this case impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

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

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 <jcbsii.com> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: January 4, 2023.