

ADMINISTRATIVE PANEL DECISION

ClearBank Limited v. Yuki Yoshida

Case No. D2023-4931

1. The Parties

The Complainant is ClearBank Limited, United Kingdom, represented by Founders Law Limited, United Kingdom.

The Respondent is Yuki Yoshida, Japan.

2. The Domain Name and Registrar

The disputed domain name <clearbank.shop> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 27, 2023. On November 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 29, 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 (Whois Privacy Protection Service by onamae.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 4, 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 December 8, 2023.

On December 4, 2023, the Center informed the parties in Japanese and English that the language of the registration agreement for the disputed domain name is Japanese. On December 7, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission until the due date. After the due date, the Respondent made email communications on December 16, 2023, December 19, 2023, December 20, 2023, December 19, 2023, and January 15, 2024 regarding the language request.

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 January 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 14, 2024. The Response was filed with the Center on January 28, 2024.

The Center appointed Haig Oghigian as the sole panelist in this matter on February 28, 2024. 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, incorporated and headquartered in London, United Kingdom, is a clearing bank, a so-called “bank for banks” which delivers payment processing and banking services to financial companies, including banks, building societies, challenger banks and financial startups. The Complainant employs over 900 people and achieved a net revenue of GBP 58.4 million in the financial year 2022. The Complainant is the owner of a global portfolio of over 70 trademarks for and including its CLEARBANK mark, including but not limited to:

Jurisdiction	Mark	No.	Application Date	Registration Date
United Kingdom	ClearBank	UK00915011141	January 18, 2016	May 30, 2016
European Union	ClearBank	015011141	January 18, 2016	May 30, 2016
United States	CLEARBANK	87142412	August 18, 2016	June 27, 2017

The Complainant notes that its earliest CLEARBANK marks, registered on May 30, 2016 and June 1, 2016, pre-date the registration of the disputed domain name by almost seven years.

The Complainant submits that aside from its trademark registrations it has also developed a reputation and goodwill in relation to its CLEARBANK mark from its activities as outlined above. It has been involved in previous disputes under the Policy relating to its CLEARBANK mark and in *ClearBank Limited v. Sam Paul*, WIPO Case No. [D2019-1531](#) the panel found that it enjoys a reputation in its mark.

According to the Whois records, the disputed domain name <clearbank.shop> was registered on May 15, 2023. The disputed domain name does not resolve to any active website (but rather to a Registrar parking page).

The Respondent Yuki Yoshida (also known as “Worthmine”) is a self-described “Wannabe Universal System Designer / Freelancer”, who maintains a few social media accounts but does not provide any offerings or demonstrable preparations to offer goods or services using the disputed domain name (or otherwise).

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.

The Complainant’s contentions are as follows.

As to whether the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, the Complainant contends that a technical part of a domain name, the “.shop” Top-

Level Domain (“TLD”) is not relevant in determining confusing similarity (referencing *Alienware Corporation v. Truther*, WIPO Case No. [DCO2012-0027](#); *Belo Corp. v. George Latimer*, WIPO Case No. [D2002-0329](#)).

The Complainant continues that the entirety of the mark is reproduced within the disputed domain name, and that the disputed domain name is therefore identical or confusingly similar to the mark for the purposes of the Policy (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7).

As a result of the above, the Complainant submits that the disputed domain name is identical to a trademark in which the Complainant has rights.

Regarding whether the Respondent has rights or legitimate interests in respect of the domain name, the Complainant contends that the disputed domain name resolves to a parked page of the Registrar advertising its domain registration related services, as can be seen from the screenshot captured on November 2, 2023 of the website resolving from the disputed domain name.

The Complainant submits that the Respondent is not using (and there is no evidence that the Respondent has demonstrable preparations to use) the disputed domain name in connection with a bona fide offering of goods or services.

Furthermore, the Respondent is not a licensee of the Complainant and has not received any permission, consent or acquiescence from the Complainant to use its name and mark in association with the registration of the disputed domain name or, indeed, any domain name, service or product.

As a result of the above, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Concerning the matter of whether the domain name was registered and is being used in bad faith, the Complainant contends that by the time the Respondent registered the domain name, the Complainant was already well regarded and enjoyed a reputation in connection with its provision of financial services.

The Complainant submits even a cursory Internet or trademark search at the time of registration of the disputed domain name would have revealed the Complainant’s rights in the CLEARBANK mark and the Complainant’s business operations. This is clearly demonstrated at Annex 12, where Google searches for the terms “clearbank” and “clear bank” return results solely relating to the Complainant.

The Complainant submits that the Respondent must have therefore had knowledge or at least should have had knowledge of the Complainant’s rights in the CLEARBANK mark and/or of its activities at the time that it registered the domain name. The total incorporation of the Complainant’s reputable mark in the disputed domain name carries a high risk of implied affiliation.

The Complainant concludes that this constitutes a registration in bad faith, clearly targeting the Complainant, its CLEARBANK mark, its reputation, and its customers.

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

The Respondent claims to have registered and annually renewed the domain <clearbank.jp> since 2011. The Respondent contends that he was made aware of the Complainant’s filing of the CLEARBANK trademark in 2017 but did not act in time to register their domain as a legal entity.

The Respondent submits that only when adding the word “shop” to the domain during their annual renewal process in 2023 did their possession of the disputed domain name come to the attention of the Complainant. The Respondent also drew attention to their original registration of the <clearbank.jp> domain predating any of the Complainant’s trademark filings by five years.

The Respondent argues that there is therefore some legitimacy for the Respondent to maintain the disputed domain name.

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Japanese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that because the disputed domain name incorporates only English language words in Latin script (“clear” and “bank”), and the extension of the domain name is also an English word (“shop”), which the Complainant contends is demonstrative of the Respondent’s working knowledge of the English language.

The Complainant continues by pointing out a number of the Respondent’s publicly accessible online activity, specifically a post on the Respondent’s “GitHub” account where the Respondent offers advice on how to best implement a computer code in technical detail using English, therefore demonstrating a sufficient knowledge of the language. Given that, and that the Complainant has no knowledge of the Japanese language, the Complainant respectfully submits for the language of the proceedings to be English.

The Respondent initially requested that the language of the proceeding be Japanese claiming that while the Respondent did have a basic understanding of the English language (possessing a United Nations Associations Test English Class C certification), that it was not sufficient to properly express the Respondent’s position. After a brief period of communication, the Respondent eventually accepted to proceed in English, but requested for the Complainant and Panel to be mindful in interpreting the Respondent’s English.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see [WIPO Overview 3.0](#), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

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. The fundamental issue as to whether there might be confusion revolves around the key word “clearbank”. [WIPO Overview 3.0](#), section 1.7.

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 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.

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.

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 that while the Respondent claims to have registered the domain name <clearbank.co.jp> as early as 2011 and renewed it annually since that time, it has failed to provide evidence to demonstrate that assertion.

Through an email on January 28, 2024, the Respondent referred the Panel to Annex 1 and Annex 2, which are claimed to demonstrate the 2011 registration of <clearbank.jp>. However, the Panel found no relevant evidence to back up that claim. In any event, the alleged 2011 registration was for <clearbank.co.jp>, and not the disputed domain name, and therefore such an allegation has no direct bearing to this case.

Furthermore, the disputed domain name in question <clearbank.shop>, was registered in 2023, well after the Complainant’s initial registrations of the CLEARBANK trademark in 2016 and 2017.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the Complainant’s mark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the Respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness

or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Furthermore, the disputed domain name resolves to a parked page of the Registrar advertising its domain registration related services, as can be seen from the screenshot captured on November 2, 2023 of the website resolving from the disputed domain name (Annex 10). The Respondent has not provided any evidence that it intends to use the disputed domain name in connection with a bona fide offering of goods or services.

The Panel therefore 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 <clearbank.shop> be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: March 12, 2023