

ADMINISTRATIVE PANEL DECISION

NTT Docomo Inc. v. Domain Administrator

Case No. D2023-5129

1. The Parties

The Complainant is NTT Docomo Inc., Japan, represented by Ohno & Partners, Japan.

The Respondent is Domain Administrator, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <docomo-zemi.com> is registered with Above.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 8, 2023. On December 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 12, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 13, 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 13, 2023.

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 December 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 4, 2024.

The Center appointed Alissia Shchichka as the sole panelist in this matter on January 10, 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 is the mobile phone operator in Japan, catering to an extensive customer base of over 86 million individuals in the country through state-of-the-art wireless networks. The Complainant's operations span a diverse spectrum of integrated ICT businesses, encompassing mobile phone services, domestic inter-prefectural communication services, international communication services, solutions services, and system development services, along with associated services.

Additionally, the Complainant has established foreign subsidiaries or branches in various locations, including the United States of America ("United States"), Germany, the United Kingdom, China, the Republic of Korea, the Philippines, Singapore, and Guam, United States.

The Complainant and its parent company, Nippon Telegraph and Telephone Corporation ("NTT") own several trademarks containing the term "DoCoMo" or "ドコモ" in more than 30 territories, amongst others:

- European Union trademark registration No. 006135818, registered on June 19, 2008, for the word mark DOCOMO in classes 9, 38, and 42;
- Japanese trademark registration No. 2623495, registered on February 28, 1994 for the word mark DOCOMO ドコモ in classes 6, 9, 16, 19, 20, and 26;
- Japanese trademark registration No. 5213789, registered on March 13, 2009 for the word mark DOCOMO in classes 9, 16, 35 to 45.

The Complainant is also the owner of the domain name <docomo.ne.jp> registered since 1998.

The above trademarks and domain name were registered prior to the registration of the disputed domain name, which was registered on September 25, 2017.

The Respondent, according to the disclosed Whols information for the disputed domain name, is a Domain Administrator, located in Hong Kong, China.

According to the evidence provided by the Complainant, the disputed domain name redirects to various websites including a webpage distributing malicious software, e.g., adware or spyware; a webpage featuring pay-per-click ("PPC") links; and a third party webpage "www.fxgt.com" in the Japanese language. This particular page seeks investments in cryptocurrencies and foreign exchange (FX) trading, encouraging users to open a "Crypto Max" account. Depending on the settings of the Internet users' browsers, this particular page may be seen in English as well.

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.

First, the Complainant asserts that by using a side-by-side comparison the trademark DOCOMO is recognizable within the disputed domain name. The addition of the term "zemi" (meaning "seminar" in Japanese) preceded by a hyphen to the DOCOMO trademark does not alter the overall impression that the disputed domain name is associated with the Complainant's trademark or prevent the confusing similarity between the disputed domain name and the Complainant's trademark. Regarding the generic Top-Level Domain ("gTLD") ".com", which forms part of the disputed domain name, the Complainant requests that the Panel disregard it under the first element, as it is a standard registration requirement.

Second, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name, 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. The Complainant submits that the Respondent's activities on the websites to which the disputed domain name resolved clearly indicate that the Respondent has an intent to obtain commercial gain by misleadingly diverting consumers or tarnishing the DOCOMO trademarks.

Third, the Complainant provided evidence of the reputation of its DOCOMO trademarks. The Complainant's rights in the trademarks significantly predate the registration of the disputed domain name. These facts suggest that the Respondent was aware, or should have been aware, of the Complainant and its DOCOMO trademark. Furthermore, the disputed domain name was previously registered and used by the Complainant for providing the information on its "docomo-zemi" service, a learning support service using smartphones, tablets, etc. from 2011 until 2015. According to the Complainant, the Respondent acquired the disputed domain name after it expired and as soon as it became available with an intention to benefit from the web traffic the Complainant's DOCOMO trademark has generated. Finally, the Complainant presents evidence of the use of the disputed domain name in connection with malware or phishing activities or PPC website or third party website.

Therefore, the Complainant alleges that the registration and use of the disputed domain name was, and currently is, in bad faith, contrary to the Policy and Rules.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant carries the burden of proving:

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

The Respondent's default in the case at hand does not automatically result in a decision in favor of the Complainant, however, paragraph 5(f) of the Rules provides that if the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from the Respondent's failure to submit a response as it considers appropriate.

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.

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 mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, “-zemi”, 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.

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.

The Complainant has confirmed that the Respondent is not affiliated with the Complainant, or otherwise authorized or licensed to use the DOCOMO trademarks or to seek registration of any domain name incorporating the trademarks. The Respondent is also not known to be associated with the DOCOMO trademarks, and there is no evidence showing that the Respondent has been commonly known by the disputed domain name.

In addition, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

The use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the Complainant’s trademark. This is the case here, as the disputed domain name is also used for PPC links to online courses. [WIPO Overview 3.0](#), section 2.9.

Moreover, panels have held that the use of a domain name for illegal activity, here, distributing malware, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Finally, the nature of the disputed domain name is inherently misleading as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, 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 the Complainant's rights in the well-known DOCOMO trademarks substantially predate the Respondent's registration of the disputed domain name. Therefore, the Respondent knew or should have known of the Complainant's trademarks at the time of registering the disputed domain name. [WIPO Overview 3.0](#), section 3.2.2. Such finding has been supported by the fact that the structure of the disputed domain name, which combines the trademark DOCOMO with the word "zemi" to reference a learning support service previously offered by the Complainant. Indeed, given the prior use of the DOCOMO trademark by the Complainant in connection with its learning services, the Panel finds that the Respondent's choice of the disputed domain name was not coincidental.

Further, the mere registration of the disputed domain name that is confusingly similar to the Complainant's widely known trademarks by the Respondent, who is unaffiliated with the Complainant, can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

According to the evidence provided by the Complainant, the disputed domain name redirects to various websites including a webpage distributing malicious software, e.g., adware or spyware; a webpage featuring pay-per-click ("PPC") links; and a third party webpage "www.fxgt.com" in the Japanese language.

Panels have held that the use of a domain name for illegal activity, here, distributing malware, or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Considering the current use of the disputed domain name to distribute malware, the Panel concludes that the Respondent is using the disputed domain name in bad faith.

Regarding the disputed domain name's redirection to a third party website seeking investments in cryptocurrencies and FX trading, such use shows that the Respondent has deliberately sought to attract Internet users to another website by creating a likelihood of confusion with the Complainant's mark regarding the source, sponsorship, affiliation, or endorsement. An inherent consequence of this strategy is the anticipated increase in web traffic that the Respondent can expect through the use of the Complainant's trademark. This constitutes bad faith registration and use under paragraph 4(b)(iv) of the Policy and [WIPO Overview 3.0](#), section 3.1.4.

The fact that the disputed domain name resolves to a landing page with PPC links to a number of other websites does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 3.5.

In the absence of any evidence to contend against the Complainant's evidence and claims, this Panel accepts the Complainant's evidence and finds that the Respondent's registration and use of the disputed domain name constitutes bad faith under 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 <docomo-zemi.com> be transferred to the Complainant.

/Alissia Shchichka/

Alissia Shchichka

Sole Panelist

Date: January 24, 2024