

ADMINISTRATIVE PANEL DECISION

Rakuten Group, Inc. v. Bui Quang Hieu and “Rakuten Group, Inc” Case No. D2024-1111

1. The Parties

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

The Respondents are Bui Quang Hieu, Viet Nam, and “Rakuten Group, Inc”, Japan.

2. The Domain Names and Registrar

The disputed domain names <rakutenbazaar.com>, <rakutenbazaar.net>, <rakutenglobalmall.net>, <rakutenhub.net>, <rakutenmarket.net>, <rakutenprime.com>, <rakutenprime.net>, <rakutenstore.net>, <rakutenworld.net> are all 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 March 13, 2024. On March 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 18, 2024, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain names, which differed from the named Respondent (Domain Admin, Domain Whois Protection Service) and contact information in the Complaint.

The Center sent an email communication to the Complainant on March 18, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file a separate complaint for the disputed domain name associated with a different underlying registrant or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all the disputed domain names are under common control. The Complainant filed an amended Complaint on March 19, 2024.

Again, on March 18, 2024, the Center informed the Parties in Vietnamese and English, that the language of the Registration Agreements for the disputed domain names is Vietnamese. On March 19, 2024, the Complainant requested English to be the language of the proceeding. The Respondents did not submit any comment on the Complainant’s submission.

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 Respondents of the Complaint in both English and Vietnamese, and the proceedings commenced on March 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 15, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on April 16, 2024.

The Center appointed Luca Barbero as the sole panelist in this matter on April 18, 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 a Japanese technology conglomerate which was established in 1997 and is specialized in providing over 70 different services, including an online marketplace, portal and media services, a travel agency, online banking services, securities services, and credit cards.

Owner of a professional baseball team, the Complainant has partnerships with professional sports teams outside Japan including the American professional basketball team Golden State Warriors and the Barcelona Football Club, besides being an Official Partner of the United States National Basketball Association (NBA).

The Complainant’s online marketplace, “Rakuten Ichiba”, is one of the largest e-commerce sites in Japan, with active membership of about 83 million people and domestic gross transaction volume, including financial services, of around JPY 7.1 trillion (USD 68 billion).

The Complainant has also been active in the United States since 2000 and Rakuten Rewards is the #1 Cash Back shopping companion in the United States with a community of 15+ million members.

The Complainant is the owner of several trademark registrations for RAKUTEN (annex 7 to the Complaint), including the following:

- Japan trademark registration No. 5536382 for RAKUTEN (word mark), filed on April 14, 2011, and registered on November 16, 2012, in international classes 9, 16, 35, 36, 37, 38, 39, 41, 42, 43, 44, and 45;
- Viet Nam trademark registration 4-0167947-000 for RAKUTEN (word mark), filed on March 3, 2010, and registered on July 19, 2011, in international classes 9, 16, 38, 35, 36, 39, 43, 41, 42, 44, and 45.

The Complainant is also the owner of the domain name <rakuten.com>, which was registered on September 12, 1997 and is used by the Complainant to operate its marketplace platform under the trademark RAKUTEN.

The disputed domain names <rakutenprime.net>, <rakutenprime.com>, <rakutenbazaar.net>, <rakutenbazaar.com>, <rakutenstore.net>, <rakutenmarket.net>, <rakutenglobalmall.net> and <rakutenhub.net> were all registered on July 12, 2023, whilst the disputed domain name <rakutenworld.net> was registered on May 11, 2023.

The disputed domain names resolve to inactive websites or error pages at the time of the drafting of this Decision. According to the screenshots submitted by the Complainant as Annex 8 to the Complaint – which have not been contested by the Respondents – the disputed domain names <rakutenbazaar.com>, <rakutenprime.net>, and <rakutenprime.com> resolved prior to the filing of the Complaint to active websites, offering marketplace services and publishing the same content, branding, look and feel as the Complainant’s official website, encouraging visitors to “sign up” and create accounts. The remaining disputed domain names, at the time of filing of the Complaint, were inactive.

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 names.

Notably, the Complainant contends that the disputed domain names are all confusingly similar to the trademark RAKUTEN in which the Complainant has rights as they reproduce the trademark in its entirety with the mere addition of the dictionary terms "prime", "bazaar", "store", "market", "globalmall", "hub" and "world" and the generic Top-Level Domains ("gTLDs") ".com" and ".net". The Complainant submits that the terms "bazaar", "store", "market" and "globalmall" directly describe the Complainant's online marketplace and therefore only serve to increase the likelihood of confusion.

With reference to rights or legitimate interests in respect of the disputed domain names, the Complainant contends that the Respondents are not commonly known by the disputed domain names and are in no way authorized, licensed, or consented to use the RAKUTEN marks or any variation thereof, in any way.

The Complainant further underlines that considering: i) the Complainant's rights long predate the registration of the disputed domain names; ii) that the Respondent Bui Quang Hieu is the same registrant against which the Complainant filed a prior UDRP Complaint for the disputed domain name <rakutenexpress.net> (see *Rakuten Group, Inc. v. Bui Quang Hieu*, WIPO Case No. [D2023-3870](#)), which was ruled in favor of the Complainant; iii) the Respondents have used the disputed domain names <rakutenprime.net>, <rakutenprime.com> and <rakutenbazaar.com> to actively promote services identical to the ones of the Complainant whilst publishing the same content, branding, look and feel as the Complainant's official website; and iv) the Respondents are holding the remaining disputed domain names passively, the Respondents have never operated any bona fide or legitimate business under the disputed domain names, and their use of the disputed domain names does not constitute a legitimate noncommercial or fair use of the disputed domain names. On the contrary, the Complainant submits that the Respondents are using the disputed domain names to impersonate the Complainant, preventing the Complainant from registering or using the disputed domain names.

With reference to the circumstances evidencing bad faith, the Complainant indicates that in view of the Respondents' active use of the disputed domain names <rakutenprime.net>, <rakutenprime.com>, and <rakutenbazaar.com>, the Respondents appear to have acted purposely and knowingly, to pass themselves off as sponsored or affiliated with the Complainant with the aim of either stealing consumers' personal and company information or causing confusion to consumers visiting the Respondents' websites, which either way are signs of bad faith conduct and use. The Complainant further submits that considering the content and the direct reference to the Complainant both in the naming of the disputed domain names and in the content published at the websites to which the three disputed domain names <rakutenprime.net>, <rakutenprime.com>, and <rakutenbazaar.com> resolved, the Respondents were undoubtedly well aware of the Complainant and its marks at the time of registering the disputed domain names.

The Complainant emphasizes that the passive holding of the remaining disputed domain names <rakutenbazaar.net>, <rakutenstore.net>, <rakutenmarket.net>, <rakutenglobalmall.net>, <rakutenhub.net>, and <rakutenworld.net> is also a further indication of bad faith registration and use and submits that though these disputed domain names do not publicly resolve to active websites, this does not preclude the possibility that the Respondents may in fact be using the disputed domain names in bad faith with respect to those specifically authorized to view some content or in email addresses based on the disputed domain names.

The Complainant further states that the Respondents have also used false contact information in the registration of the disputed domain name <rakutenworld.net>, since the registrant was indicated as being the Complainant, which though never registered the said disputed domain name in the first place. Moreover, the registrant email address of the disputed domain name <rakutenworld.net>, at the time of filing of the Complaint, was quanghaiuit@[...] (the same email address as the one confirmed by the Registrar for the

remaining disputed domain names). However, after filing of the Complaint, the Registrar has confirmed the email address of the Complainant's Counsel (who never registered the disputed domain name <rakutenworld.net>) as the registrant email address of this disputed domain name. In addition, the Registrar used to register this disputed domain name was also the same used for the registration of the remaining disputed domain names and is not a registrar that the Complainant would use for registration of its own domain names.

The Complainant further contends that the Respondents engaged in a pattern of bad faith registrations of domain names corresponding to well-known trademarks in which the Respondents had no rights or legitimate interests and states that, in consideration of the Complainant's goodwill and world renown, and of the fact that the disputed domain names are so obviously connected with the Complainant and its services, the Respondents were also acting in opportunistic bad faith.

Lastly, the Complainant contends that the use of privacy or proxy registration service to shield the Respondents' identity and elude enforcement efforts by the legitimate trademark owner further demonstrates the Respondents' bad faith.

B. Respondents

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

6. Discussion and Findings

6.1. Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.11.2.

As regards common control, the Panel notes that although registered in the name of different entities, the disputed domain names are under common control since:

- i) All of the disputed domain names were registered using the same Registrar;
- ii) All of the disputed domain names except for <rakutenworld.net> were registered on the same date, July 12, 2023, and were registered by the same registrant, "Bui Quang Hieu";
- iii) Although the Complainant is listed as the registrant of the disputed domain name <rakutenworld.net>, when the Complaint was initially found, the registrant email address listed in the publicly available Whois database was "quanghieuit@[...]", and the "quanghieuit" part is virtually identical to the name of the registrant of the remaining disputed domain names, "Bui Quang Hieu". Moreover, the email address "quanghieuit@[...]" has been confirmed by the Registrar as the registrant email address of the remaining disputed domain names.

iv) All of the disputed domain names contain the Complainant's RAKUTEN mark followed by similar dictionary terms, namely, "bazaar", "store", "market", "global mall", "world", "prime", and "hub", which may be used to describe the Complainant's online marketplace services.

The Panel finds that the elements highlighted and referenced above demonstrate a common control of the disputed domain names by the Respondents.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

The Panel further notes that the Respondents did not object to the Complainant's consolidation request.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants in a single proceeding.

6.2. Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative 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".

In the case at hand, the language of the Registration Agreements of the disputed domain names is Vietnamese. The Complaint was filed in English. Upon receipt of the Registrar's verification, the Center sent an email communication to the Parties both in English and Vietnamese about the language of the proceeding requesting them to comment on the issue.

The Complainant submitted a request for English to be the language of the proceeding based on the following grounds:

- the disputed domain names contain English words in Latin script, rather than Vietnamese script;
- the disputed domain names contain the Complainant's well-known RAKUTEN mark, which consist of English letters, and which are strongly associated with the Complainant's well-known online marketplace;
- the disputed domain names <rakutenprime.net>, <rakutenprime.com>, and <rakutenbazaar.com> resolved to websites that impersonated the Complainant's website and contained only English words and characters, which further indicates the Respondents' familiarity with the English language as all of the disputed domain names are under common control;
- the Complainant's counsel has no familiarity with reading and writing in the Vietnamese language, and therefore, conducting the proceeding in Vietnamese would require commissioning a translator, adding unnecessary cost to the Complainant who already bears the cost of filing, and it would cause delay in commencement of the proceeding.

The Respondents did not submit any comment about the language of the proceeding.

In view of the circumstances of the case, the Panel finds that English is the appropriate language of this proceeding and will thus proceed to render the Decision in English.

6.3. Substantive Issues

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain names registered by the Respondents are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondents have no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are 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 names. [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. Indeed, the Complainant has demonstrated ownership of valid trademark registrations for RAKUTEN (annex 7 to the Complaint).

The entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms "prime", "bazaar", "store", "market", "global mall", "hub" and "world" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Moreover, the gTLDs ".com" and ".net" can be disregarded under the first element confusing similarity test, being standard registration requirements. [WIPO Overview 3.0](#), section 1.11.

Therefore, 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 Respondents 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 Respondents lack rights or legitimate interests in the disputed domain names. The Respondents have not rebutted the Complainant's prima facie showing and have not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondents and the Complainant. The Respondents are not licensees of the Complainant, nor have the Respondents otherwise obtained an authorization to use the Complainant's trademarks.

Moreover, there is no element from which the Panel could infer the Respondents' rights over the disputed domain names, or that the Respondents might be commonly known by the disputed domain names.

According to the information provided by the Registrar to the Center, the disputed domain name <rakutenworld.net> is registered in the name of the Complainant. The Complainant submitted that it did not register the disputed domain name <rakutenworld.net>. The Respondents have not submitted any Response and have thus not provided any comment on the Complainant's assertion. In the circumstances of the case, the Panel finds that the Respondents' use of the Complainant's contact details in the Whois records of the disputed domain name <rakutenworld.net> shows the Respondents' intent to impersonate the Complainant and their lack of rights or legitimate interests in the disputed domain name.

The Panel also finds that the Respondents are not using the disputed domain names in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Indeed, based on the evidence on records, the disputed domain names <rakutenprime.net>, <rakutenprime.com>, and <rakutenbazaar.com> have been pointed to websites imitating the Complainant's official website at <rakuten.com>, featuring the RAKUTEN mark and offering marketplace services (annex 8 to the Complaint).

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

The disputed domain names <rakutenbazaar.net>, <rakutenstore.net>, <rakutenmarket.net>, <rakutenglobalmall.net>, <rakutenhub.net>, and <rakutenworld.net> have been pointed to inactive websites. Therefore, these disputed domain names have not been used in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use.

Considering the distinctiveness and reputation of the Complainant's trademark RAKUTEN encompassed in the disputed domain names, the Panel finds that the disputed domain names are inherently misleading. Prior panels found that, even where a domain name consists of a trademark plus an additional term such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, 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, in light of i) the prior registration and use of the Complainant's trademark RAKUTEN in connection with the Complainant's marketplace services, ii) the well-known character of the trademark, and iii) the composition of the disputed domain names, encompassing the Complainant's trademark with descriptive terms possibly referring to the Complainant's business, the Respondents, very likely registered the disputed domain names having the Complainant's trademark in mind.

Furthermore, the circumstance that three of the disputed domain names, <rakutenprime.net>, <rakutenprime.com>, and <rakutenbazaar.com> were pointed to websites displaying the Complainant's trademark and offering services identical to the ones of the Complainant, imitating the look and feel of the Complainant's official website, demonstrates that the Respondent was indeed well aware of the Complainant and its trademark at the time of registering the disputed domain names.

In view of the use of the disputed domain names <rakutenprime.net>, <rakutenprime.com>, and <rakutenbazaar.com> described above, the Panel finds that the Respondents intentionally attempted to attract Internet users to their websites, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of their websites and the services provided therein, according to paragraph 4(b)(iv) of the Policy.

Indeed, in view of the notoriety of the Complainant's trademark, the Panel also finds that the Respondents acted in opportunistic bad faith at the time of registration, since the disputed domain names are so obviously connected with the Complainant that its selection by the Respondents, which have no connection with the Complainant, suggests the disputed domain names were registered with a deliberate intent to create an impression of an association with the Complainant.

The Panel also finds paragraph 4(b)(ii) of the Policy applicable in this case as the Respondents registered the disputed domain names in order to prevent the Complainant from reflecting its mark in corresponding domain names and has engaged in a pattern of such conduct since they registered nine disputed domain names incorporating the Complainant's trademark as well as an additional domain name subject to a separate prior proceeding (*Rakuten Group, Inc. v. Bui Quang Hieu*, supra).

Based on the records, the disputed domain names <rakutenbazaar.net>, <rakutenstore.net>, <rakutenmarket.net>, <rakutenglobalmall.net>, <rakutenhub.net> and <rakutenworld.net> have not been pointed to active websites. Moreover, at the time of the drafting of this Decision, all the disputed domain names resolve to inactive websites or error pages. Prior panels have found that even the non-use of a domain name 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 names 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 and reputation of the Complainant's trademark, the composition of the disputed domain names, the failure of the Respondents to submit a response, and the implausibility of any good faith use to which the disputed domain name may be put and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

The Panel also finds that the indication of the Complainant's contact details in the registrant information for the disputed domain name <rakutenworld.net> is a further circumstance demonstrating the Respondent's bad faith.

Therefore, the Panel finds that the Complainant has also 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 names <rakutenbazaar.com>, <rakutenbazaar.net>, <rakutenglobalmall.net>, <rakutenhub.net>, <rakutenmarket.net>, <rakutenprime.com>, <rakutenprime.net>, <rakutenstore.net>, and <rakutenworld.net> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: May 2, 2024