

## **ADMINISTRATIVE PANEL DECISION**

Yamaha Corporation v. William Santo, Terranova  
Case No. D2024-1756

### **1. The Parties**

The Complainant is Yamaha Corporation, Japan, internally represented.

The Respondent is William Santo, Terranova, United States of America.

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

The disputed domain name <yamahadallas.com> (“Domain Name”) 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 April 26, 2024. On April 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 26, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (GoDaddy.com, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 29, 2024, 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 April 30, 2024.

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 May 1, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 21, 2024. The Respondent did not submit any formal response. However, email communications were received by email on May 3, 2024, May 6, 2024, May 7, 2024, May 9, 2024, and May 10, 2024 containing submissions that will be summarized in the Response section of this decision. Accordingly, the Center notified the Commencement of Panel Appointment Process on May 23, 2024.

The Center appointed Nicholas Smith as the sole panelist in this matter on May 30, 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 company that produces and distributes musical instruments including pianos under a trademark consisting of the word "Yamaha" (the "YAMAHA Mark").

The Complainant holds a registered trademark in the United States for the YAMAHA Mark, being trademark registration number 3,559,368, registered on January 13, 2009, for goods in classes 3, 8, 9, 15, and 21.

The Domain Name <yamahadallas.com> was registered on August 4, 2020. The Domain Name resolves to a website (the "Respondent's Website") that purports to pre-owned (second-hand) Yamaha pianos. The Respondent's Website states that it has "40 Yamaha and Kawai's to be Delivered" (Kawai being a competitor of the Complainant that also sells pianos) and does not contain a disclaimer that the Respondent is not associated with the Complainant. Finally, the Respondent's Website contains the statement "Click here to Go back to Piano Gallery Site", apparently referring to another site operated by the Respondent offering a broader range of pianos.

#### **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 Domain Name.

Notably, the Complainant contends that:

- a) The Complainant is the owner of the YAMAHA Mark, having registered the YAMAHA Mark in the United States. The Domain Name wholly incorporates the YAMAHA Mark along with the geographic term "dallas" and the ".com" Top-Level Domain ("TLD").
- b) There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Respondent is not commonly known as the Domain Name nor does the Respondent have any authorization from the Complainant to register the Domain Name.
- c) The Domain Name was registered and is being used in bad faith. The Respondent is clearly aware of the YAMAHA Mark and is using it to guide Internet users to its website for dishonest purposes. Such conduct amounts to registration and use of the Domain Name in bad faith.

##### **B. Respondent**

The Respondent states that customers visiting the Respondent's Website clearly see that the Respondent offers used Yamaha pianos from that site. The Respondent does not sell new Yamaha pianos. The Respondent has 50 Yamaha pianos in stock and has registered the Domain Name so that people looking for Yamaha pianos in Dallas can find its website. The Respondent provides various examples where dealers in musical instruments have registered domain names incorporating the name of the musical instruments that they are selling.

## 6. Discussion and Findings

### 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 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 Domain Name. Accordingly, the Domain Name is identical or 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 "dallas" 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 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.

While 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 often impossible 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. 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 record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with sufficient evidence demonstrating rights or legitimate interests in the Domain Name.

The Panel considers that the record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.
- the Respondent (as an individual, business, or other organization) has not been commonly known by the Domain Name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- the Respondent is not making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the Domain Name.

The Respondent has used the Domain Name to operate a website to sell pianos that purport to be legitimate certified pre-owned YAMAHA products. There is no evidence before the Panel that suggests the YAMAHA products sold by the Respondent are anything other than certified pre-owned and the Complainant makes no such allegations.

However, even if the Respondent is offering genuine YAMAHA products from the Respondent's Website, such use does not automatically grant it rights and legitimate interests. The principles that govern whether a reseller of genuine goods has rights or legitimate interests have been set out in a variety of UDRP decisions, starting with the case of *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The [WIPO Overview 3.0](#), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

"... Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Okidata test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The "Okidata test" does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

In this case, the Respondent's Website does not accurately or prominently disclose the Respondent's relationship with the Complainant, in particular that it is not an authorized dealer or has any particular connection with the Complainant. The Respondent's Website does not contain a disclaimer or any explanation as to the identity of the operator of the Respondent's Website (noting that a visitor to a website at a domain name including the trademark with a geographical term, advertising certified pre-owned pianos may still expect those pre-owned pianos to be offered by the Complainant).

Moreover, the Respondent does not use the site to sell only the trademarked goods and services. Rather the Respondent's Website advertises products from the Complainant's competitors such as Boston and Kawai and contains a prominent link to the "Piano Gallery Site" presumably where the Respondent offers other pianos in competition with the Complainant. Even though it is likely that the Respondent is reselling genuine YAMAHA pianos, its use of the Domain Name (also noting the nature of the Domain Name) for the Respondent's Website does not grant it rights or legitimate interests in the Domain Name.

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.

The Panel considers that the record of this case reflects that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's YAMAHA Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's Website. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

The Respondent registered the Domain Name for the purposes of operating a website specifically to sell both the Complainant's products and products such as pre-owned Kawai pianos that compete with the Complainant's pianos. The Respondent is using a Domain Name that is confusingly similar to the YAMAHA Mark to sell products in competition with the Complainant and without the Complainant's approval and without meeting the *Oki Data* test.

Based on the available record, the Panel 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 Domain Name <yamahadallas.com> be cancelled.

*/Nicholas Smith/*

**Nicholas Smith**

Sole Panelist

Date: June 10, 2024