

ADMINISTRATIVE PANEL DECISION

Pan Pacific Retail Management (Singapore) Pte. Ltd. v. Sam Ho
Case No. D2024-2244

1. The Parties

The Complainant is Pan Pacific Retail Management (Singapore) Pte. Ltd., Singapore, represented by IP Twins, France.

The Respondent is Sam Ho, Canada.

2. The Domain Name and Registrar

The disputed domain name <dondondondonki.com> is registered with Launchpad.com Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 31, 2024. The Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name, and on June 7, 2024, 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 (None None) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 7, 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 amended Complaint on June 10, 2024.

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 June 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 16, 2024.

The Center appointed Warwick Smith as the sole panelist in this matter on August 2, 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 group of companies was founded in 1951. It operates a discount chain of retail stores in Japan, Singapore, Hong Kong, Hawaii, Malaysia, Bangkok, Taiwan, and Macau, selling a wide range of products, ranging from basic groceries to electronics and clothing. In 2022, the group generated revenues of JPY 1.94 trillion.

According to the Amended Complaint, the Group's operations outside of Singapore are conducted under the brand "Don Don Donki".

The Complainant is the proprietor of several registered trademarks, in various jurisdictions. Its registered marks include:

- (i) Australian trademark DON DON DONKI, registered under No. 2111045 on August 12, 2020, covering a range of goods and services in International Classes 18 and 35;
- (ii) Singapore trademark DON DON DONKI, registered under No. 40201613795X on January 26, 2017, covering a range of services in International Class 35.

In addition to those registered marks, the Complainant has filed an application to register its DON DON DONKI mark in Canada (where the Respondent appears to reside). This application was filed, under No. 2045189, on August 12, 2020, and it covers a range of goods and services in International Classes 18, 35, and 43.

The Complainant says that it has used its DON DON DONKI mark in commerce, in connection with its retail and other services, continuously, over a period that commenced long prior to the registration of the disputed domain name. It says that it generates significant revenue from its DON DON DONKI stores, in particular through its website at "www.dondondonki.com". It registered the domain name <dondondonki.com> on December 29, 2016. It is also the owner of the domain name <donki.com>, which it registered on July 22, 1998.

The Complainant produced a copy of the Singapore page of its principal website, at "www.dondondonki.com/sg". It consisted of a listing of the Complainant's Don Don Donki retail outlets in Singapore, with opening hours, and two small cartoon-like penguins in the center-bottom of the webpage, both wearing hats. The Complainant says that the cartoon of a penguin wearing a hat (often a Christmas hat) is the mascot of its DONKI store chain.

The Complainant says that its promotion and long use of its DON DON DONKI marks have resulted in the mark becoming well-known, and widely recognized by consumers. The Complainant's reputation is said to be evidenced clearly on the Internet – its Instagram following is said to exceed 100 million people.

The disputed domain name was registered on November 23, 2022. The Complainant produced a screenshot of the website to which the disputed domain name resolved ("the Respondent's website"), taken on May 5, 2024. Each page of the Respondent's website contained the header "Don Don Don Donki – Your key to coolest stuff from Japan!"

The Respondent's website appeared to be operating as an online shopping portal for traditional Japanese products, apparently directed to the Canadian market. The first page of the screenshot prominently featured the statement: "SHOP JAPAN ANYWHERE", and there were various click-on links under headings such as

“Unique Fashion Items.....SEE COLLECTION” (superimposed over a cartoon-like picture of a woman), and “Must Have Home Essentials” - Amazing essentials that every home should have” (accompanied by a graphic consisting of a group of small cartoon-like characters, some of whom are smiling, greeting the site visitor with “Hi” and “Hello”). Another heading was “Featured Products.....Hot picks recommended by our team”, immediately above photographs of products that appeared to be bowls, handmade in Japan. Other items listed on the Respondent’s website included tea mugs (made in Japan), stylized sake bottles shaped like a fish, and a portable grill (also said to have been made in Japan).

The Respondent’s website included the slogans: “Quality Products Best value for the money”, and “100% Happiness Guaranteed Our products are certain to bring a smile on your face.” There was a 2024 copyright claim on the last page of the Respondent’s website, made by “Don Don Don Donki”.

In accordance with normal practice, the Panel visited the Respondent’s website on August 12, 2024. The Respondent’s website appeared to be substantially the same as the screenshot the Complainant had produced, although the webpage headers “Don Don Don Donki – Your key to coolest stuff from Japan” appeared to have been removed. However, there was a footer at the bottom of each page consisting of a small animal character (it might have been a cartoon penguin) in red coloring, wearing what appeared to be a Christmas, tasseled, hat. Immediately below this little cartoon character, there appeared, in the same red coloring, the words “Don Don Don Donki”.

The “About” page of the Respondent’s website stated, under the heading “Our Company”:

“We are a Japanese lifestyle brand based on Ontario Canada. We offer a variety of unique items that you won’t typically find. We value Japanese culture...Our curated items have been tested and directly imported from Japan.....We hope to do our part in bringing awareness to such traditional craftsmanship to everyone”.

The Complainant has not licensed or otherwise authorized the Respondent to use its DON DON DONKI trademark, and the Panel did not note any disclaimer on the Respondent’s website, making it clear that the Respondent has no commercial or other relationship with the Complainant and its Don Don Donki stores.

The Complainant’s researches have disclosed no record of any company called DON DON DON DONKI in the Ontario register of companies (Ontario being the Canadian province in which the Respondent apparently resides), and a WIPO Global Brands Database “Owner” search on “Sam Ho” with an address in Canada returned no results showing trademarks owned by the Respondent. The Complainant’s check on The Wayback Machine at “www.archive.org” did not disclose any earlier use of the disputed domain name.

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. It says that the disputed domain name is confusingly similar to its DON DON DONKI trademarks, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant says that the Respondent has been impersonating the Complainant on the Respondent’s website, and that Internet users of average attention will likely believe that the disputed domain name is affiliated with or endorsed by the Complainant for its business. The use of the small penguin cartoon character in the footer of the Respondent’s website reinforces the likelihood of confusion with the Complainant’s DONKI mascot.

Even if the Respondent has purchased goods in Japan with the intent to resell them to the public in Canada or Japan, the Respondent does not meet the accepted test for a right or legitimate interest that a genuine reseller of a trademark owner’s goods might enjoy. There is nothing displayed on the Respondent’s website

to indicate that it claims any relationship with the Complainant, nor any disclaimer stating that the Respondent has no affiliation with the Complainant.¹

In support of its allegation of bad faith registration and use, the Complainant first submits that it and its trademarks were so well-known, particularly throughout Asia, that it is inconceivable that the Respondent could have been unaware of the Complainant's DON DON DONKI mark when he registered the disputed domain name. A quick trademark search would have revealed to the Respondent the Complainant and its mark, and references to the Complainant and its mark would have been the only results returned on a simple online search on "don don donki". The Respondent must have had the Complainant's name and trademark in mind when registering the disputed domain name, and the likelihood is that he registered the disputed domain name in the hope and expectation that Internet users searching for the Complainant's services and products would instead come across the disputed domain name and the Respondent's website. Such use cannot be considered to be a good faith use.

The Respondent's current use of the disputed domain name is also a bad faith use. Simply maintaining the disputed domain name has the effect of preventing the Complainant from reflecting its trademark in a corresponding domain name, and the use of the Respondent's website to effectively impersonate the Complainant cannot be considered a good faith use of the disputed domain name.

Finally on the issue of bad faith registration and use, having regard to the "long-lasting renown" of the Complainant and its trademark, the Complainant contends that the same circumstance is present here – there is no reasonably conceivable use to which the disputed domain name might be put that would not be a bad faith use.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a Complainant is required to establish each of the following –

- (i) the domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the 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).

The Complainant has established that it is the registered proprietor of the DON DON DONKI trademark described in section 4 of this decision, and it therefore has rights in respect of that mark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.2.1).

The entirety of the Complainant's DON DON DONKI mark is reproduced within the disputed domain name,

¹Referring to *Oki Data Americas Inc. v ASD, Inc*, WIPO Case No. [D2001-0903](#).

and the Panel finds that 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 in a disputed domain name (such as the additional “don” in the disputed domain name in this case) may bear on the assessment of the second and third elements of the Policy in some cases, the Panel finds that the addition of that term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s 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

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).

In this case, the disputed domain name is confusingly similar to the Complainant’s DON DON DONKI mark, and the Complainant has not authorized the Respondent to use that mark, whether in a domain name or otherwise.

While paragraph 4(c) of the Policy provides a non-exclusive list of three circumstances which, if established, may demonstrate that a respondent has rights or legitimate interests in a disputed domain name, none of those circumstances has been raised by the Respondent, and none appears to apply in this case. First, there is nothing in the record to suggest that the Respondent might be commonly known by the disputed domain name (paragraph 4(c)(ii)). The Complainant could find no record of any “Don Don Don Donki” company on the Ontario Companies Register, and its searches revealed no trademark or service mark registered to the Respondent. Secondly, there is nothing to suggest that the Respondent might have been entitled to take advantage of the “safe harbor” defense relating to legitimate noncommercial or fair use of a disputed domain name, without intent for commercial gain, which is provided for at subparagraph 4(c)(iii) of the Policy. The Respondent’s website is clearly commercial in nature, and is clearly being operated with intent to derive commercial gain. Thirdly, the Panel is of the view that the Respondent has not been using the disputed domain name in connection with any bona fide offering of goods or services (which circumstance may in an appropriate case provide a basis for a claim to a right or legitimate interest in a disputed domain name, under paragraph 4(c)(i) of the Policy). In the Panel’s view, the circumstances in this case show that the Respondent has been attempting to trade off the Complainant’s goodwill in its DON DON DONKI mark. That is apparent from the use of a brand or mark on the Respondent’s website (“don don don donki”) that is nearly identical to the Complainant’s mark, and from the use of a device in the footer on each page of the Respondent’s website, in close proximity to the “don don don donki” brand statement, that is very similar in style to the Complainant’s cartoon penguin device. The use of these features appears to have been calculated to cause confusion with the Complainant’s Don don donki products, and pointing the disputed domain name to a website with those features could never have been a bona fide use of the disputed domain name.

This is not a case where the Respondent has said that he is selling genuine goods that are marketed by some third party in Japan or elsewhere under a genuine “Don Don Don Donki” mark or brand. The Respondent has not produced evidence of any such brand, and on the face of it the Respondent appears to have appropriated the Complainant’s mark to his own use, with one minor addition that many Internet users

would not pick up. In those circumstances, the Panel accepts the Complainant's submission that the Respondent has not shown that he has any genuine "reseller", or "distributor", defense available to him, of the kind discussed in the *Oki Data* case.

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, and the Respondent has not rebutted that prima facie case by coming forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

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.

Paragraph 4(b) sets out a non-exhaustive list of four circumstances that are deemed to be evidence of bad faith registration and use. One of them is:

(iv) By using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the holder's website or location or of a product or service on the holder's website or location.

In the Panel's view, that circumstance is present in this case. The Respondent has not responded to this Complaint, and in the absence of any response the Panel concludes that the Respondent and his associates (who, according to the "About" page on the Respondent's website, have previously lived in Japan) must have been aware of the Complainant and its very substantial business conducted in Japan and elsewhere in Asia under the DON DON DONKI mark, when the Respondent registered the disputed domain name. He could not have failed to appreciate that a number of those Internet users who were familiar with the Complainant and its mark would at least initially mistake the Respondent's website for a website operated or at least endorsed by the Complainant. In the absence of a response, the Panel concludes that it was the Respondent's intention to create confusion of that sort, and that his use of the disputed domain name falls squarely within paragraph 4(b)(iv) of the Policy – by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's DON DON DONKI mark, as to the sponsorship, affiliation or endorsement of the Respondent's website.

With that finding, it is unnecessary to consider the other arguments advanced by the Complainant.

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 <dondondondonki.com> be transferred to the Complainant.

/Warwick Smith/

Warwick Smith

Sole Panelist

Date: August 16, 2024