

## **ADMINISTRATIVE PANEL DECISION**

The Yokohama Rubber Co., Ltd. v. Zhang Qiang, Jade Archer, Zak Arnold, Sean Nash, Amelia James, Isabel Atkinson  
Case No. D2024-3376

### **1. The Parties**

The Complainant is The Yokohama Rubber Co., Ltd., Japan, represented by Eversheds Sutherland (Germany) Rechtsanwälte Steuerberater Solicitors Partnerschaft mbB, Germany.

The Respondents are Zhang Qiang, China, Jade Archer, Germany, Zak Arnold, Germany, Sean Nash, Germany, Amelia James, Germany and Isabel Atkinson, Germany.

### **2. The Domain Names and Registrars**

The disputed domain names <yokohamaargentina.com>, <yokohamaaustralia.com>, <yokohamaaustria.com>, <yokohamabrasil.com>, <yokohamachile.com>, <yokohamadeutschland.com>, <yokohamaeesti.com>, <yokohamafrance.com>, <yokohamagreece.com>, <yokohamahungary.com>, <yokohamaireland.com>, <yokohamaitalia.com>, <yokohamanederland.com>, <yokohamanorge.com>, <yokohamaportugal.com>, <yokohamaschweiz.com>, <yokohamasrbija.com>, <yokohamasuisse.com>, <yokohamasuomi.com>, <yokohamaturkey.com> and <yokohamauae.com> (the “Disputed Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited.

The disputed domain names <yokohamabulgaria.com>, <yokohamacanada.com>, <yokohamadanmark.com>, <yokohamahrvatska.com>, <yokohamapolska.com>, <yokohamaspain.com> and <yokohamasverige.com> are registered with Paknic (Private) Limited. (Alibaba.com Singapore E-Commerce Private Limited and Paknic (Private) Limited are collectively referred to as the “Registrars”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 16, 2024. On August 19, 2024, the Center transmitted by email to the Registrars a request for registrar verification in connection with the Disputed Domain Names. On August 20, 2024, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Unidentified Respondent) and contact information in the Complaint.

The Center sent an email communication to the Complainant on August 22, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amendment to the Complaint on August 27, 2024. On September 2, 2024, the Center sent the email regarding the Consolidation – Multiple Respondents to the Parties.

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 Respondents of the Complaint, and the proceedings commenced on September 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 23, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondent’s default on September 25, 2024.

The Center appointed Nicholas Weston as the sole panelist in this matter on September 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 was incorporated in Japan in 1917 and is the world’s 8<sup>th</sup> largest tire business by market share, with revenue of USD5.93 billion in 2022. The Complainant holds registrations for the trademark YOKOHAMA and variations of it in numerous countries, including, inter alia, Japan Trademark Registration No. 1028700 for YOKOHAMA, registered on August 27, 1973; and Germany Trademark Registration No. 929811 for YOKOHAMA, registered on April 7, 1975.

The Complainant owns the domain names <y-yokohama.com> and <yokohama.eu> from where its main websites operate.

The Disputed Domain Names were registered on November 7, 2023. A cohort of the Disputed Domain Names resolve to websites that prominently display the YOKOHAMA trademark and Complainant’s logo, and purport to sell YOKOHAMA branded tires. Other of the Disputed Domain Names are 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 it would be appropriate for the Panel to consolidate the multiple domain names in this proceeding on the basis that the registrants of the Disputed Domain Names are under common control and (it contends) “supported not only by the partially identical domain owners and the similar pattern in their contact information. The uniformity of the domain owners becomes particularly apparent regarding the equal naming patterns of the domains, each being “yokohama”+“countryname”.com. It is aggravated by the fact that the registration dates for all the 28 domains regardless of their different indicated domain owners is identical, namely the 07 November 2023, approx. at. 9:40. ...[S]creenshots of homepages of different Respondents, [show] the content and its embedding are identical. The contact details indicate a

false area code, the email addresses use a hidden anonymized mail system, have the same naming system (English first name + English last name + two digit number @[redacted].com) and the English names are apparently false. These names are uncommon in Kassel, Germany.”

The Complainant cites its trademark registrations internationally as prima facie evidence of ownership of the mark YOKOHAMA.

The Complainant submits that the trademark YOKOHAMA is well-known globally and that its rights in that mark predate the Respondent’s registration of the Disputed Domain Names. The Complainant submits that the Disputed Domain Names are confusingly similar to its trademark, because each of the Disputed Domain Names incorporates the YOKOHAMA trademark, and that the confusing similarity is not removed by addition of the relevant “geographic term”, or the generic Top-Level Domain (“gTLD”) “.com”.

The Complainant contends that the Respondents have no rights or legitimate interests in respect of each of the Disputed Domain Names because “[t]he Complainant has neither authorized the use of the term YOKOHAMA nor the use of the YOKOHAMA-trademarks to the Respondent” and none of the circumstances set out in paragraph 4(c) of the Policy apply. The Complainant also contends that given “the overall look and feel of some of the Respondent’s websites, the prominent display of the Complainant’s YOKOHAMA logo and mark on these websites, and the absence of any effective disclaimer” are not uses of the Disputed Domain Names in connection with a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy.

Finally, the Complainant alleges that the registration and use of each of the Disputed Domain Names was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to the prior use and targeting of the Complainant’s trademarks, contending that the “Respondent bears no relationship to the trademarks, and the Disputed Domain [N]ames have no other meaning except for referring to Complainant’s name, trademarks and products.” The Complainant also submits that “the infringement is caused by one single party acting upon various names and false identities.”

## **B. Respondents**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Matter – 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 the Complainant has pointed to a pattern of irregularities that suggest that the Disputed Domain Names are under common control. All of the Disputed Domain

Names were registered on the same date at the same time; the majority use Kassel, Germany in their registrant details. There is a pattern of using country names in English or the local language in each of the Disputed Domain Names that suggests a similar modus operandi. All of the Disputed Domain Name owners share the same e-mail address provider. None of the Respondents allegedly residing in Kassel, Germany uses its telephone area code 0561 in the contact phone number.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party. It is not plausible that six different people should decide to use a third-party trademark to register the Disputed Domain Names at the same time, on the same date, using the same name pattern to host, in an implausible number of instances, much the same content.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as “the Respondent”) in a single proceeding.

## 6.2 Substantive Matters

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

- (i) that the Disputed Domain Names are 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 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 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. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country. [WIPO Overview 3.0](#), section 1.2.1. The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark YOKOHAMA in numerous countries.

Turning to whether the Disputed Domain Names are identical or confusingly similar to the YOKOHAMA trademark, the Panel observes that each Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant’s trademark YOKOHAMA; (b) with, respectively, country names (in English or the local language; (c) followed by the generic Top-Level Domain (“gTLD”) “.com”.

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1. The relevant comparison to be made is with the second-level portion of the Disputed Domain Names, specifically: “yokohamaargentina”, “yokohamaaustralia”, “yokohamaaustria”, “yokohamabrasil”, “yokohamabulgaria”, “yokohamacanada”, “yokohamachile”, “yokohamadanmark”, “yokohamadeutschland”, “yokohamaeesti”, “yokohamafrance”, “yokohamagreece”, “yokohamahrvatska”, “yokohamahungary”, “yokohamaireland”, “yokohamaitalia”, “yokohamanederland”, “yokohamanorge”, “yokohamapolska”, “yokohamaportugal”, “yokohamaschweiz”, “yokohamaspain”, “yokohamasrbija”, “yokohamasuisse”, “yokohamasuomi”, “yokohamasverige”, “yokohamatrkey” and “yokohamauae”, respectively.

The Panel finds 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 country names 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.

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 Names. 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 Names such as those enumerated in the Policy or otherwise.

The Panel notes the evidence that the Disputed Domain Names are either inactive or resolve to webpages that prominently display the Complainant’s trademarks, and purport to sell tires using the Complainant’s branding and content, without any disclaimer disclosing the lack of relationship between the Parties, which supports the Complainant’s submission on that point and finds that these uses do not represent a bona fide offering of goods or services, or a legitimate noncommercial or fair use, given the substantial reputation and goodwill of the Complainant’s mark or capacity to otherwise mislead Internet users.

The Panel also notes that each Disputed Domain Name contains a country name (either in English or the local language), suggesting that the Respondent seeks to impersonate the Complainant in a targeted way. The Panel finds that that this creates the false impression that Respondent’s websites are related to, authorized by, or affiliated with Complainant, particularly considering the nature of the global business the Complainant is engaged in.

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

Based on the available record, the Panel finds the second element of the Policy has been established for all of the Disputed Domain Names.

## **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) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the evidence in this case shows the Respondent registered and has used the Disputed Domain Names in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Names and the well-known nature of the Complainant's trademark, the Panel is satisfied that the Respondent knew of and targeted the Complainant's trademark YOKOHAMA when it registered the Disputed Domain Names.

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Names other than to trade off the reputation and goodwill of the Complainant's well-known trademark. [WIPO Overview 3.0](#), section 3.1.4.

Further, a gap of several years between registration of a complainant's trademark and respondent's registration of a disputed domain name (containing the trademark) can indicate bad faith registration. In this case, the Respondent registered the Disputed Domain Names some 50 years after the Complainant established registered trademark rights in the YOKOHAMA mark.

On the issue of use, the Complainant's evidence is that each of the Disputed Domain Names are either inactive or resolve to a webpage purporting to offer for sale the Complainant's goods.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes (i) the distinctiveness or reputation of the Complainant's trademark; (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use; (iii) the Respondent's concealing their identity or use of false contact details (noted to be in breach of its registration agreement); (iv) the composition of the Disputed Domain Names, 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.

Panels have also held that the use of a domain name for illegal activity here, alleged impersonation or passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. In these circumstances also, the Panel finds the Respondent's registration and use of the Disputed Domain Names constitutes bad faith under the Policy.

Panels may take into account particular circumstances in assessing whether the respondent's registration of a domain name is in bad faith which include: (i) the nature of the Disputed Domain Name such as here where a well-known mark is used, and incorporating an additional term such as a geographic term, (ii) the chosen Top-Level Domain (e.g., particularly where corresponding to the complainant's area of business activity or natural zone of expansion), (iii) the content of that copies the Complainant's own content and branding, (iv) the timing and circumstances of the registration (all on the same day); (v) any respondent pattern of targeting marks along a range of factors, such as a common area of commerce, intended consumers, or geographic location, (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the Disputed Domain Name, or (viii) other indicia generally suggesting that the Respondent had somehow targeted the complainant. [WIPO Overview 3.0](#), section 3.2.1. In the circumstances, the Panel finds the Respondent's registration and use of the Disputed Domain Names constitutes bad faith under the Policy.

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 Names <yokohamaargentina.com>, <yokohamaaustralia.com>, <yokohamaaustria.com>, <yokohamabrasil.com>, <yokohamabulgaria.com>, <yokohamacanada.com>, <yokohamachile.com>, <yokohamadanmark.com>, <yokohamadeutschland.com>, <yokohamaeesti.com>, <yokohamafrance.com>, <yokohamagreece.com>, <yokohamahrvatska.com>, <yokohamahungary.com>, <yokohamaireland.com>, <yokohamaitalia.com>, <yokohamanederland.com>, <yokohamanorge.com>, <yokohamapolska.com>, <yokohamaportugal.com>, <yokohamaschweiz.com>, <yokohamaspain.com>, <yokohamasrbija.com>, <yokohamasuisse.com>, <yokohamasuomi.com>, <yokohamasverige.com>, <yokohamaturkey.com> and <yokohamauae.com> be transferred to the Complainant.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: October 10, 2024.