

ADMINISTRATIVE PANEL DECISION

Rakuten Group, Inc. v. wer frewg
Case No. D2024-3795

1. The Parties

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

The Respondent is wer frewg, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <rakuten886889.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on September 17, 2024. On September 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 19, 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 (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 23, 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 in English on September 27, 2024.

On September 23, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On September 27, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the language of the proceeding.

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 in Chinese and English of the Complaint, and the proceedings commenced on September 30, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 21, 2024.

The Center appointed Matthew Kennedy as the sole panelist in this matter on October 25, 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 group that offers an online marketplace, portal and media services, a travel agency, online banking services, securities services, and credit cards, among other services. Its online marketplace, Rakuten Ichiba, has an active membership of about 83 million people. The Complainant has registered trademarks in multiple jurisdictions, including the following:

- Chinese trademark registration number 3819882 for RAKUTEN, registered on February 14, 2006, specifying services in class 35; and
- International trademark registration number 1719866 for RAKUTEN and device (the "RAKUTEN logo"), registered on September 8, 2022, designating China, and specifying goods in multiple classes.

The above trademark registrations are current. The Complainant has also registered the domain names <rakuten.com> and <rakuten.com.tw> that it uses in connection with e-commerce websites in English and Chinese, respectively, that offer for sale a wide range of products. Both websites prominently display the RAKUTEN logo and, in the case of the Chinese website, the characters "樂天市場", meaning "Rakuten Market".

The Respondent is ostensibly an individual based in Hong Kong, China. However, the Respondent's address in the Registrar's WhoIs database is incomplete and manifestly false.

The disputed domain name was registered on November 29, 2023. According to evidence provided by the Complainant, as at January 30, 2024, the disputed domain name resolved to an e-commerce website. The website prominently displayed the Complainant's RAKUTEN logo above the characters "日本樂天網購懶人包" (which could mean "Japan Rakuten online shopping quick guide") and offered for sale a wide range of products. Prices were displayed in TWD.

On February 22, 2024, the Complainant filed an abuse report with the Registrar regarding the disputed domain name. After the report was processed, the Respondent continued to hold the disputed domain name.

At the time of this Decision, the disputed domain name does not resolve to any active website; rather, it is passively held.

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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Complainant's RAKUTEN trademark. The Respondent has no rights or legitimate interests in respect of the

disputed domain name. The Respondent has not been authorized, licensed, or otherwise permitted by the Complainant to register and/or use the disputed domain name. The disputed domain name was registered and is being used in bad faith. It has been used to host an imposter website, passing itself off as the Complainant's website or a website sponsored by or affiliated with the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1. Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint and amended Complaint were filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that English is an official language and widely spoken in Hong Kong, China, where the Respondent is purportedly located; the Respondent is unlikely to be prejudiced as the website associated with the disputed domain name impersonates the Complainant's website and contains English words; and conducting proceedings in Chinese would add unnecessary translation costs and cause delay.

Despite the Center sending an email regarding the language of the proceeding and the notification of complaint in Chinese and English, the Respondent did not make any submission with respect to the language of the proceeding or indicate any interest in participating otherwise in this proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English. The Panel would have accepted a Response in Chinese, but none was filed.

6.2. Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed 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. See [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of the RAKUTEN trademark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1.

The sole textual element of the RAKUTEN mark is reproduced within the disputed domain name as its initial element. Despite the addition of the number “886889”, the mark remains clearly recognizable within the disputed domain name. The only additional element in the disputed domain name is a generic Top-Level Domain (“gTLD”) extension (“.com”) which, as a standard requirement of domain name registration, may be disregarded in the assessment of identity or confusing similarity. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7, 1.8, and 1.11.1.

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 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. See [WIPO Overview 3.0](#), section 2.1.

In the present case, the disputed domain name formerly resolved to an e-commerce website that prominently displayed the Complainant’s RAKUTEN logo alongside characters indicating the Complainant’s country of origin (i.e., Japan) and the Complainant’s name, and that offered for sale products of the same type as those sold on the Complainant’s e-commerce websites. The Respondent’s website gave the impression that it was operated by the Complainant. However, the Complainant submits that it has not authorized, licensed, or otherwise permitted the Respondent to register and/or use the disputed domain name. At the time of this Decision, the disputed domain name is passively held. In view of these circumstances, the Panel finds that the disputed domain name is not being used in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name. Further, the Respondent is identified in the Registrar’s database as “wer frewg”. Nothing in the record indicates that the Respondent has been commonly known by the disputed domain name.

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. 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.

Based on the 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 fourth of these circumstances is as follows:

“(iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’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 respondent’s] website or location or of a product or service on [the respondent’s] web site or location.”

The disputed domain name was registered in 2023, years after the registration of the Complainant’s RAKUTEN marks. The disputed domain name wholly incorporates the textual element of that mark, adding only a number and a gTLD extension. The website formerly associated with the disputed domain name prominently displayed the Complainant’s RAKUTEN logo, alongside the Complainant’s country of origin and the Complainant’s name. Accordingly, the Panel has reason to find that the Respondent registered the disputed domain name with the Complainant’s mark in mind.

As regards use, the disputed domain name formerly resolved to an e-commerce website that prominently displayed the Complainant’s RAKUTEN logo, alongside characters indicating the Complainant’s country of origin (i.e., Japan) and the Complainant’s name, offering for sale products of the same type as those sold on the Complainant’s websites. The Respondent’s website gave the false impression that it was operated by the Complainant. Accordingly, the Panel finds that the facts fall within the terms of paragraph 4(b)(iv) of the Policy.

The Panel takes note that the use of the disputed domain name has changed and that it is now passively held. This change in use does not prevent a finding of bad faith.

Therefore, 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 <rakuten886889.com> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: October 30, 2024