

ADMINISTRATIVE PANEL DECISION

Kubota Corporation v. Privacy Protection / zhang wei
Case No. DCO2022-0045

1. The Parties

Complainant is Kubota Corporation, Osaka, Japan, represented by Douglas M. Isenberg of The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States of America.

Respondent is Privacy Protection, United States of America / zhang wei, China.

2. The Domain Name and Registrar

The disputed domain name <kubota.co> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 7, 2022. On June 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 8, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on June 9, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on June 13, 2022.

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 Respondent of the Complaint, and the proceedings commenced on June 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 5, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 8, 2022.

The Center appointed Fernando Triana, Esq., as the sole panelist in this matter on July 14, 2022. 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

Complainant is a global manufacturing company specializing in agriculture, water, and living environment products.

Complainant owns the trademark registration KUBOTA in Japan since January 16, 1964 (Registration No. 634,179) and in United States of America since October 19, 1971 (Registration No. 922,330) (Annex 8 to the Complaint).

Complainant is the registrant of, and uses, the domain name <kubota.com>, which was registered on February 22, 1997.

The disputed domain name was registered on October 5, 2018, and it resolves to a webpage with pay-per-click links.

5. Parties' Contentions

A. Complainant

Complainant is a global manufacturing company specializing in agriculture, water, and living environment products.

Complainant is the registrant of, and uses, the domain name <kubota.com>, which was registered on February 22, 1997 (Annex 4 to the Complaint).

Respondent uses the disputed domain name as a pay-per-click parking page including links for competing services, such as, "Kubota Tractor Parts" and "Kubota Equipment."

Complainant owns the trademark registration KUBOTA in Japan since January 16, 1964 (Registration No. 634,179) and in United States of America since October 19, 1971 (Registration No. 922,330) (Annex 8 to the Complaint).

The disputed domain name is identical to Complainant's trademark.

Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized Respondent to register or use the trademark KUBOTA in any manner.

Respondent has failed to create a *bona fide* offering of goods or services under the Policy.

Respondent has never been commonly known by the disputed domain name and has never acquired any trademark rights in the disputed domain name.

Complainant's trademark is widely known, with over 757 trademark registrations, a capital of YEN 84.1 billions and a consolidated revenue of YEN 2,196.8 billions.

Respondent's actions suggest "opportunistic bad faith" in violation of the Policy.

Using a domain name in connection with a monetized parking page under the circumstances present here constitutes bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "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".

Likewise, paragraph 10(d) of the Rules, provides that "the Panel shall determine the admissibility, relevance, materiality and weight of the evidence".

The Panel placed special emphasis on the evidence filed to prove assertions, which has been thoroughly studied in order to determine its relevance and weight in reaching a decision. The statements that have been accompanied by evidence have been given more importance than the mere unsubstantiated assertions.

Paragraph 4(a) of the Policy requires that Complainant prove each of the following three elements to obtain an order that the disputed domain name be cancelled or transferred:

- (1) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (2) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (3) the disputed domain name has been registered and is being used in bad faith.

The findings, based on the evidentiary support submitted by Complainant, noting that Respondent did not reply to Complainant's contentions, will be discussed as follows: first of all, the Panel will determine whether or not the disputed domain name is identical or confusingly similar to the trademark in which Complainant has rights. Secondly, the Panel will verify if Respondent has any rights or legitimate interests in respect of the disputed domain name. Thirdly, the Panel will establish whether or not the disputed domain name has been registered and is being used in bad faith by Respondent.

A. Identical or Confusingly Similar

Complainant contends to have rights in the registered trademark KUBOTA in several jurisdictions (see section 4 above).

a) Existence of a trademark or service mark in which Complainant has rights

Firstly, it is important to point out that paragraph 4(a) of the Policy requires the existence of a trademark or a service mark.

When a sign is registered as a trademark, it is surrounded by a presumption of sufficient distinctiveness, and the owner is granted with an exclusive right over the mark, which entitles him to prevent any third party from using the registered sign or any other sign confusingly similar to it.

In this case, Complainant has proved its rights in the trademark KUBOTA in Annex 8 to the Complaint.

This information appears to be incontestable and conclusive evidence of Complainant's rights in the cited trademarks and the exclusive right to use them in connection with goods of International classes 7, 11, and 12. The registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive.

Thus, Complainant established its rights in the trademark KUBOTA.

Therefore, the Panel concludes that Complainant has demonstrated rights in the trademark KUBOTA for purposes of paragraph 4(a)(i) of the Policy.

b) Identity or confusing similarity between the disputed domain name and Complainant's trademark

Complainant alleges that the disputed domain name incorporates the trademark KUBOTA to create confusion.

On the first place, before establishing whether or not the disputed domain name is confusingly similar to Complainant's trademarks, the Panel wants to point out that the addition of a country code Top-Level Domain ("ccTLD"), here ".co", is generally disregarded when determining if the disputed domain name is identical or confusingly similar to the trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.11. Hence, the inclusion of the ".co" ccTLD, in the disputed domain name is not a factor in analyzing whether a disputed domain name is identical or confusingly similar to the mark in which Complainant asserts rights.

Furthermore, the Panel considers that the reproduction of the trademarks KUBOTA in its entirety in the disputed domain name is sufficient to establish that the disputed domain name is identical to the trademark.

In consequence, as per this reasoning, the Panel finds that, the disputed domain name is identical to Complainant's trademarks and thus, the requirement set forth in paragraph 4(a)(i) of the Policy is duly complied with.

B. Rights or Legitimate Interests

a) *Prima facie* case

Regarding the second element of paragraph 4(a) of the Policy, UDRP panels have found that requiring the complainant to prove the lack of rights or legitimate interests of the respondent in the disputed domain name is often an impossible task. It is not only proving a negative but also demands access to information that is mostly within the knowledge of the respondent.¹

In *Julian Barnes v. Old Barn Studios Ltd.*, WIPO Case No. [D2001-0121](#), the Panel stated that:

"Is the Respondent required to adduce any such evidence, if the onus is on the Complainant to prove the three elements of paragraph 4 of the Policy? While the overall burden of proof is on the Complainant, this element involves the Complainant proving matters, which are peculiarly within the knowledge of the Respondent. It involves the Complainant in the often impossible task of proving a negative. In the Panel's view the correct approach is as follows: the Complainant makes the allegation and puts forward what he can in support (e.g. he has rights to the name, the Respondent has no rights to the name of which he is aware, he has not given any permission to the Respondent). Unless the allegation is manifestly misconceived, the Respondent has a case to answer and that is where paragraph 4(c) of the Policy comes in. If the Respondent then fails to demonstrate his rights or legitimate interests in respect of the Domain Name, the complaint succeeds under this head".

¹ See *Arla Foods amba v. Bel Arbor / Domain Admin, PrivacyProtect.org*, WIPO Case No. [D2012-0875](#); see also *F. Hoffmann-La Roche AG v. Bargin Register, Inc. - Client Services*, WIPO Case No. [D2012-0474](#).

Therefore, Complainant is required to make a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Once this *prima facie* case is made, the burden of production shifts to Respondent, who must come forward with concrete evidence of its rights or legitimate interests.² If Respondent fails to do so, Complainant is deemed to have met the second element of paragraph 4(a) of the Policy.

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name because of the following: i) Respondent is not affiliated or related to Complainant, nor has Respondent been licensed, permitted or otherwise authorized by Complainant to use the trademark KUBOTA; ii) Respondent is not commonly known by the disputed domain name; iii) Respondent has failed to create a *bona fide* offering of goods or services under the Policy; and iv) Respondent has never acquired any trademark rights in the disputed domain name.

The Panel accepts these assertions as a *prima facie* case made by Complainant that shifts the burden of production to Respondent.

b) Respondent's rights or legitimate interests in the disputed domain name

Paragraph 4(c) of the Policy includes a non-limited listing of circumstances that serve to prove Respondent's rights or legitimate interests in the disputed domain name:

(i) before any notice of the dispute, Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if Respondent has acquired no trademark or service mark rights; or

(iii) Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Respondent did not file any Response, thus, failed to rebut Complainant's *prima facie* case, and to show his rights or legitimate interests in the disputed domain name. Hence, as per paragraph 14 of the Rules, the Panel shall draw such inferences therefrom as it considers appropriate:

- Respondent's use of the disputed domain name is not in connection with a *bona fide* offering of goods or services, as Respondent had a clear intention to monetize the disputed domain name by including pay-per-click links based on the confusion created with Complainant's trademark.
- There is no evidence within the file proving that Respondent is commonly known by the disputed domain name.
- There is no evidence within the file proving that Complainant licensed or otherwise permitted any use by Respondent of its trademark.
- There is no evidence within the file justifying the choice of the trademark KUBOTA to create the disputed domain name for a *bona fide* purpose. There is enough evidence within the file to prove the intention of using the trademark KUBOTA in bad faith.
- There is no evidence within the file proving Respondent's rights over the trademark KUBOTA anywhere in the world.

² See *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

- There is no evidence within the file proving that Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without the intention of commercial gain by misleadingly divert consumers.

The Panel thus concludes that Respondent lacks rights or legitimate interests in the disputed domain name.

Therefore, the second requirement of paragraph 4(a) of the Policy is met.

C. Registered and Used in Bad Faith

According to paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

(i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

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

For the Panel, it is evident that Respondent knew of the existence of Complainant's trademarks when registering the disputed domain name, in particular, when Respondent includes competing offering of goods or services within the landing page attempting to divert consumers from Complainant to Respondent or third parties. Further, it is not a coincidence that the disputed domain name is identical to Complainant's widely-known trademark. Thus, the Panel finds that Respondent deliberately took Complainant's trademarks to register the disputed domain name, which constitutes bad faith.

Panels have consistently found that the mere registration of a domain name that is identical to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4. That conclusion applies in the present case. The selection of the trademark and the pay-per-click links clearly denote that the decision was not random. In fact, it is absolutely clear that Respondent not only had prior knowledge, but also intended to register the disputed domain name to take advantage of Complainant's trademark.

Consequently, in the present case, there is no doubt that Respondent registered and uses the disputed domain name in bad faith and, thus, the requirement of Paragraph 4(a)(iii) of the Policy is fully complied with.

Therefore, the third element of the Policy, paragraph 4(a) is satisfied in the present case in respect to Respondent's bad faith registration and use of the disputed domain name.

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 <kubota.co> be transferred to Complainant.

/Fernando Triana, Esq/

Fernando Triana, Esq

Sole Panelist

Date: July 28, 2022