



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	HK-1901305
<b>Complainant:</b>	SoftBank Group Corp.
<b>Respondent:</b>	Takashi Mezaki / APRENDER
<b>Disputed Domain Name(s):</b>	softbank-inc.com

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### 1. The Parties and Contested Domain Name

The Complainant is SoftBank Group Corp., Tokyo Japan.

The Respondent is Takashi Mezaki / APRENDER, Fukushima Japan.

The domain name at issue is <softbank-inc.com>, registered by Respondent with GMO Internet, Inc. d/b/a Onamae.com, Cerulean Tower, 26-1 Sakuragaoka-cho Shibuya-ku Tokyo 150-8512 Japan.

### 2. Procedural History

The Complaint was filed with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (ADNDRC)[“Centre”] on November 29, 2019, seeking for a transfer of the disputed domain name. On December 5, 2019, the Centre sent an email to the GMO Internet, Inc. d/b/a Onamae.com asking for the detailed data of the registrant. On December 5, 2019, the Registrar verified that Takashi Mezaki /APRENDER is the current registrant of the disputed domain name and that Respondent is bound by the GMO Internet, Inc. d/b/a Onamae.com registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the Centre’s Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

The proceedings commenced on December 16, 2019. In accordance with the Rules, the Centre formally notified the Respondent of the Complaint both in English, setting a deadline of January 5, 2020 by which Respondent could file a Response to the Complaint, via e-mail

to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts.

Having received no response from Respondent, the Centre transmitted to the parties a Notification of Respondent Default on January 14, 2020.

On February 6, 2020, the Centre appointed Ho Hyun Nahm, Esq., as the Sole Panelist in the administrative proceeding and with the consent for the appointment, impartiality and independence declared and confirmed by the Panelist, the Centre, in accordance with paragraph 7 of the Rules, organized the Panel of this case in a legitimate way.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the Centre has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the Centre's Supplemental Rules and any rules and principles of law that the Panel deems applicable.

### **3. Factual background**

Complainant is a Japanese multinational conglomerate holding company headquartered in Tokyo. It was founded in 1981. Complainant is engaged in a variety of businesses in semiconductors, communications and Internet services around the world. As of March 31, 2019, it has 1,302 subsidiaries, 423 associates, 26 joint ventures, 192 (consolidated basis: 76,866) employees. In 2018, it reported net sales of 9,602,236 million yen. Complainant has made significant investment over the years to advertise, promote, and protect the SOFTBANK trademark through various forms of media, including the Internet.

The disputed domain resolved to a website with commercial links one of which redirects users to Respondent's auction website where Respondent auctions off a variety of products, including the disputed domain name and other domain names. The disputed domain name is being offered for auction at Respondent's website for 100,000,000 yen.

The disputed domain name was registered on October 15, 2019.

### **4. Parties' Contentions**

#### **A. Complainant**

i) Complainant is the owner of SOFTBANK trademark. In creating the disputed domain name, Respondent has added the generic term 'inc.' to Complainant's SOFTBANK trademark, thereby making the disputed domain name confusingly similar to Complainant's trademark.

ii) Respondent is not sponsored by or affiliated with Complainant in any way. Complainant has not licensed, authorized, or permitted Respondent to use Complainant's trademark in any manner, including in domain names. Respondent is not commonly known by the disputed domain name. The disputed domain name resolves to a landing page which features multiple links. As such, Respondent is not using the disputed domain name to provide a *bona fide* offering of goods or for a legitimate noncommercial or fair use. The disputed domain name is

being offered for auction at Respondent's website for 100,000,000 yen, an amount that far exceeds Respondent's out-of-pocket expenses in registering the domain. Therefore, Respondent has no rights or legitimate interests in respect of the domain name.

iii) Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business. In light of the notoriety of Complainant's mark, it is not possible to conceive of a plausible situation in which Respondent would have been unaware of Complainant's brands at the time the disputed domain name was registered. Respondent creates a likelihood of confusion with Complainant and its trademark by registering a domain that includes Complainant's SOFTBANK. Respondent has demonstrated a nefarious intent to capitalize on the fame and goodwill of Complainant's trademark in order to increase traffic to the disputed domain name's website for Respondent's own pecuniary gain. Respondent is currently auctioning the disputed domain name. Respondent has demonstrated intent to sell, rent, or otherwise transfer the disputed domain name for valuable consideration in excess of his out-of-pocket expenses. Respondent is engaging in a pattern of cybersquatting/typosquatting. Respondent, at the time of initial filing of the Complaint, had employed a privacy service to hide its identity. It is more likely than not that Respondent knew of and targeted Complainant's trademark. Therefore, Respondent should be found to have registered and used the disputed domain name in bad faith.

B. Respondent

Respondent did not submit a response.

**5. Findings**

- i) Complainant established that it had rights in the mark SOFTBANK contained in the disputed domain name. The disputed domain name is confusingly similar to Complainant's protected mark.
- ii) Respondent has no rights to or legitimate interests in the disputed domain name.
- iii) Respondent registered and used the disputed domain name in bad faith.

**6. Preliminary Issue: Language of the Proceedings**

The Panel notes that the Registration Agreement is written in Japanese, thereby making the language of the proceedings in Japanese. The Panel has discretion to determine the appropriate language of the proceedings on appointment. *See* Section 4.5.1, WIPO Jurisprudential Overview 3.0.

In accordance with the Rules, paragraphs 11(a), 10(b) and 10(c), Complainant requests that the Panel determine English to be the language of the proceeding for the following reasons: i) the translation of the Complaint would unfairly disadvantage and burden Complainant and delay the proceedings and adjudication of this matter; ii) such additional delay, considering the obviously abusive nature of the disputed domain name and its website poses continuing risk to Complainant and unsuspecting consumers seeking Complainant or its products; iii) the disputed domain name is comprised of Latin characters; iv) the term SOFTBANK, which is the dominant portion of the disputed domain name, does not carry any specific meaning in the Japanese language; v) the additional term "inc" is an abbreviation of the English word

“incorporated”; and vi) Respondent’s Yahoo! Japan account name, heroes\_2016, contains the English word “heroes”.

In the absence of Response and no objection to the Complainant's request for the language of proceeding, the Panel decides English to be the language of the proceeding.

## 7. Discussions

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

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

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

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. *See* WIPO Jurisprudential Overview 3.0 at ¶ 4.3; *see also* eGalaxy Multimedia Inc. v. ON HOLD By Owner Ready To Expire, FA 157287 (Forum June 26, 2003) (“Because Complainant did not produce clear evidence to support its subjective allegations [. . .] the Panel finds it appropriate to dismiss the Complaint”).

### A) Identical / Confusingly Similar

Complainant contends that it is the owner of various registrations for the trademark 'SOFTBANK' on a worldwide basis. The Panel notes that Complainant registered the trademark 'SOFTBANK' with JPO (the Japanese Patent Office) (Reg. no. 1858515, registered on April 23, 1986); KIPO (the Korean Intellectual Property Office) (Reg. no. 40-0116581-0000, registered on September 11, 1985); USPTO (the United States Patent and Trademark Office) (Reg. no. 2542547, registered on February 26, 2002); EUIPO (Reg. no.002070225, registered on December 19, 2002); and WIPO (Reg. no.861654, registered on June 7, 2005).

The general consensus is that JPO, KIPO, USPTO, EUIPO, or WIPO registrations are sufficient in conferring rights in a mark under Policy ¶ 4(a)(i). *See* T-Mobile USA, Inc. dba MetroPCS v. Ryan G Foo / PPA Media Services, FA1627542 (FORUM Aug. 9, 2015) (finding that Complainant has rights in the METROPCS mark through its registration with the United States Patent and Trademark Office); *see also* Samsung Electronics Co., Ltd v. lupie jet, KR-1700157 (CENTRE May 3, 2017) (finding that Complainant has rights in the SAMSUNG mark through its registration with the Korean Intellectual Property Office). Therefore, the Panel deems Complainant’s evidence of JPO, KIPO, USPTO, EUIPO, and WIPO registrations for the SOFTBANK mark sufficient in establishing rights under Policy ¶ 4(a)(i).

Complainant contends that Respondent has added the generic term “inc” (or incorporated) to Complainant’s SOFTBANK trademark, thereby making the disputed domain name confusingly similar to Complainant’s trademark.

The Panel agrees that addition of a descriptive term 'inc' and gTLD '.com' to Complainant's mark in order to form the disputed domain name does not distinguish the disputed domain name from Complainant's mark for the purposes of a Policy ¶ 4(a)(i) analysis. *See Microsoft Corporation v. Thong Tran Thanh*, FA 1653187 (FORUM Jan. 21, 2016) (determining that confusing similarity exist where [a disputed domain name] contains Complainant’s entire mark and differs only by the addition of a generic or descriptive phrase and top-level domain, the differences between the domain name and its contained trademark are insufficient to differentiate one from the other for the purposes of the Policy.).

The Panel therefore finds that the disputed domain name is confusingly similar to Complainant’s mark SOFTBANK per Policy ¶ 4(a) (i).

## **B) Rights and Legitimate Interests**

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA741828 (Forum Aug. 18, 2006) (holding that the complainant must first make a prima facie case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); *see also AOL LLC v. Gerberg*, FA780200 (Forum Sept. 25, 2006) (“Complainant must first make a prima facie showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name. Complainant claims that Respondent is not sponsored by or affiliated with Complainant in any way. Complainant has not licensed, authorized, or permitted Respondent to use Complainant’s trademark in any manner, including in domain name. Respondent is not commonly known by the disputed domain name.

The Panel finds that a lack of contradicting evidence in the record that Respondent was authorized to use a complainant’s mark in a domain name can be evidence of a lack of rights and legitimate interests. *See Navistar International Corporation v. N Rahmany*, FA1620789 (FORUM June 8, 2015) (finding that the respondent was not commonly known by the disputed domain name where the complainant had never authorized the respondent to incorporate its NAVISTAR mark in any domain name registration).

Complainant contends that Respondent is not commonly known by the disputed domain name. The Panel is of the view that WHOIS information can be used to support a finding under Policy ¶ 4(c)(ii) that a respondent is not commonly known by a disputed domain name. *See Chevron Intellectual Property LLC v. Fred Wallace*, FA1626022 (FORUM July 27, 2015) (finding that the respondent was not commonly known by the <chevron-europe.com> domain name under Policy ¶ 4(c)(ii), as the WHOIS information named “Fred Wallace” as registrant

of the disputed domain name). The Panel notes that the WHOIS information of the disputed domain name lists 'Takashi Mezaki / APRENDER' as the registrant. Therefore, the Panel holds Respondent is not commonly known by the disputed domain name.

Complainant further asserts that the disputed domain name resolves to a landing page which features multiple links. As such, Respondent is not using the disputed domain name to provide a *bona fide* offering of goods, or for a legitimate noncommercial or fair use. The disputed domain name is being offered for auction at Respondent's website for 100,000,000 yen, an amount that far exceeds Respondent's out-of-pocket expenses in registering the domain. The Panel agrees that the manner of use of the disputed domain name by Respondent does not demonstrate a *bona fide* offering of goods or a legitimate noncommercial or fair use.

The Panel finds that Complainant has made out a *prima facie* case that arises from the considerations above. All of these matters go to make out the *prima facie* case against Respondent. As Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against it, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

### **C) Bad Faith**

Complainant contends that Respondent registered and used the disputed domain name in bad faith. Complainant contends that i) its SOFTBANK trademark, through continuous and extensive use in connection with Internet services, is well known in the world including Japan where Respondent resides; it is inconceivable that Respondent happened to register the disputed domain name incorporating the well-known SOFTBANK trademark without actual knowledge of said trademark; and iii) Respondent registered and uses the disputed domain name to exploit the goodwill of Complainant and the SOFTBANK trademark to make illegitimate interests.

While constructive knowledge is insufficient, actual knowledge of a complainant's rights in a mark is sufficient for a finding of bad faith. *See Orbitz Worldwide, LLC v. Domain Librarian*, FA 1535826 (FORUM Feb. 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding Policy ¶ 4(a)(iii) bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it."); *see also AutoZone Parts, Inc. v. Ken Belden*, FA 1815011 (FORUM Dec. 24, 2018) ("Complainant contends that Respondent's knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field.") The Panel notes that Complainant and its trademark SOFTBANK were widely-known and enjoyed a good fame and reputation, long-predating the registration of the disputed domain name, around the world including Japan where Respondent is domiciled. In light of the notoriety of Complainant's mark and the manner of use of the disputed domain name by Respondent, the Panel infers that Respondent had actual knowledge of Complainant and its trademark SOFTBANK which constitutes bad faith registration and use.

Next, Complainant contends that i) Respondent creates a likelihood of confusion with Complainant and its trademark by registering a domain that includes Complainant's SOFTBANK; ii) the disputed domain name resolves to a landing page which features multiple links; and iii) Respondent has demonstrated a nefarious intent to capitalize on the fame and goodwill of Complainant's trademark in order to increase traffic to the disputed domain name's website for Respondent's own pecuniary gain.

Use of a disputed domain name to attempt to profit from pay-per-click links may be evidence of bad faith registration and use per Policy ¶ 4(b)(iv). *See Danbyg Ejendomme A/S v. Ib Hansen / guerciotti*, FA1504001613867 (FORUM June 2, 2015) (finding that the respondent registered and used the domain name in bad faith under Policy ¶ 4(b)(iv) where the disputed domain name resolved to a website that offered both competing hyperlinks and hyperlinks unrelated to the complainant's business). Here, Complainant provides a screenshot of the disputed domain name's resolving webpage which appears to feature pay-per-click links. Therefore, the Panel finds that Respondent registered and used the disputed domain name in bad faith per Policy ¶ 4(b)(iv).


Lastly Complainant contends that Respondent is currently auctioning the disputed domain name: i) the disputed domain name is being offered for auction at Respondent's website for 100,000,000 yen, an amount that far exceeds Respondent's out-of-pocket expenses in registering the domain; and ii) Respondent has demonstrated intent to sell, rent, or otherwise transfer the disputed domain name for valuable consideration in excess of his out-of-pocket expenses. Attempting to sell a disputed domain name for excess out-of-pocket costs may evince bad faith per Policy ¶ 4(b)(i). *See Vanguard Trademark Holdings USA LLC v. Wang Liqun*, FA1506001625332 (FORUM July 17, 2015) ("A respondent's general offer to sell a disputed domain name for an excess of out-of-pocket costs is evidence of bad faith under Policy ¶ 4(b)(i).").

Therefore, the Panel concludes that the disputed domain name was registered and is being used in bad faith.

## 8. Decision

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the domain name <softbank-inc.com> be **TRANSFERRED** from Respondent to Complainant.



Ho Hyun Nahm, Esq.

Sole Panelist

Dated: February 10, 2020