

ADMINISTRATIVE PANEL DECISION

Toyota Motor Sales, U.S.A., Inc. v. Domain Admin, Whois Privacy Corp. / DL Pontiac, Host Master, Transure Enterprise Ltd
Case No. D2022-0367

1. The Parties

- 1.1 The Complainant is Toyota Motor Sales, U.S.A., Inc., United States of America (“United States”), represented by Phillips Winchester, United States.
- 1.2 The Respondent is Domain Admin, Whois Privacy Corp., Bahamas / DL Pontiac, Canada, Host Master, Transure Enterprise Ltd, United States.

2. The Domain Names and Registrars

- 2.1 The disputed domain name <tooyota.com> and <toyoota.com> (the “Domain Names”) are registered with Above.com, Inc. (“Above.com”) and Internet Domain Service BS Corp (“Internet BS”) respectively (together the “Registrars”).

3. Procedural History

- 3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 2, 2022. At that time public Whois data recorded the registry registrant ID for the <tooyota.com> Domain Name as “above_privacy” and the registrant for the <toyoota.com> Domain Name as “Domain Admin, Whois Privacy Corp.”
- 3.2 On February 3, 2022, the Center transmitted by email to the Registrars requests for registrar verification in connection with the Domain Names. On February 4, 2022, Internet BS stated the registrant of the <toyoota.com> Domain Name to be DL Pontiac. On February 8, 2022 Above.com stated the registrant of the <tooyota.com> Domain Name to be “Host Master, Transure Enterprise Ltd”.
- 3.3 On February 8, 2022, The Center provided the Complainant the registrant and contact information disclosed by the Registrars, and invited the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on February 14, 2022.
- 3.4 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”).

3.5 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 8, 2022.

3.6 On March 16, 2022, the Center sent an email to Above.com noting that the <tooyota.com> Domain Name was set to expire on April 11, 2022 and seeking confirmation that under paragraph 3.7.5.7 of the ICANN Registrar Accreditation Agreement this Domain Name would remain in Lock status after expiry and until the present proceedings were concluded and that the Complainant would have the option to renew or restore the Domain Name. On March 17, 2022 Above.com responded, in relevant part, as follows:

“The registrant will not be renewing the domain. Should the Complainant desire the domain not to expire they will need to make the renewal payment of \$20 USD”

3.7 The Center appointed Matthew S. Harris as the sole panelist in this matter on March 24, 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

4.1 The Complainant is a company incorporated in the United States and is a wholly owned subsidiary of Toyota Motor Corporation (“TMC”), a company incorporated in Japan. As such it forms part of the well-known Toyota automotive group. The Toyota business began in Japan in 1939. It now manufactures vehicles and parts in 27 countries and its products are sold in over 170 countries and regions. Sales of Toyota vehicles, parts and accessories in the United States alone have since 1958 exceeded USD 100 billion. The Complainant is the exclusive importer and distributor of Toyota vehicles in all of the United States (except Hawaii) and in a number of other territories.

4.2 TMC is the owner of numerous registered trade marks around the world that comprise or incorporate the text “Toyota”. They include:

- (i) United States registered trade mark no. 843,138 for TOYOTA as a word in stylised form, registered on January 30, 1968 in class 12; and
- (ii) United States registered trade mark no. 1,589,552 for TOYOTA as a word, registered on April 3, 1990 in classes 1 and 4.

4.3 The Domain Name <toyoota.com> was registered on September 2, 2004. The Domain Name <tooyota.com> was registered on April 11, 2005.

4.4 As at April 17, 2018 (*i.e.* shortly before the ICANN Temporary Specification for gTLD Registration Data first took effect) the recorded registrar for the <tooyota.com> Domain Name was Internet BS and the named registrant was “Domain Admin, Whois Privacy Corp.”

4.5 At some point after April 2018 the <tooyota.com> Domain Name was transferred into the name “DL Pontiac” and the registrar changed to the Above.com.

- 4.6 As at December 17, 2021, the <tooyota.com> Domain Name was used to redirect Internet users to a webpage (forming part of a website operating from the <volvocars.com> domain name) advertising the Volvo XC90 Recharge vehicle.
- 4.7 As at December 17, 2021, the <toyoota.com> Domain Name was used to redirect Internet users to a website operated by Midway USA, an online retailer specialising in outdoor equipment and supplies.
- 4.8 As at December 17, 2021, both of the Domain Names were also being offered for sale on Sedo. In the case of the <tooyota.com> Domain Name the minimum offer price sought was USD 500. No minimum offer price was set for the <toyoota.com> Domain Name
- 4.9 As at January 21, 2022, the <toyoota.com> Domain Name was being used to redirect Internet users to a website distributing malware.
- 4.10 DL Pontiac has previously been named as a respondent in the following UDRP proceedings:
- *eBay Inc. v. D Pontiac / Whois Privacy Services Pty Ltd*, WIPO Case No. [D2015-0490](#);
 - *Vectra Bank Colorado v. Domain Hostmaster, Whois Privacy Services Pty Ltd / D Pontiac*, WIPO Case No. [D2015-0982](#);
 - *Vertex Pharmaceuticals Incorporated v. Whois Privacy Services Pty Ltd / D Pontiac*, WIPO Case No. [D2015-1864](#).

In each of these cases the domain name was ordered to be transferred to the concerned complainant.

- 4.11 Whois Privacy Corp. has been named as a respondent in a very large number of UDRP proceedings (according to the Complainant in excess of 250 cases). The exact nature of Whois Privacy Corp. is addressed in greater detail later on in this decision.
- 4.12 Transure Enterprise Ltd has also been a losing respondent in a very large number of UDRP proceedings (according to the Complainant, in excess of 195 cases). It has for example registered domain names that incorporate well-known trade marks such as NIKE, MORGAN STANLEY, SEARS, STARBUCKS, and BANK OF AMERICA.

5. Parties' Contentions

A. Complainant

- 5.1 The Complainant described the Toyota group of companies, its business and its trade marks. The Complainant contends that the TOYOTA mark is world famous. Reference is also made to 12 decisions under the Policy in which the Complainant has been successful and a large number of other decisions brought by other companies in the Toyoto group.
- 5.2 The Complainant also describes when the Domain Names were registered and how they have been used since registration.
- 5.3 The Complainant contends that each of the Domain Names comprises a misspelling of the TOYOTA mark, in each case with one letter "o" being duplicated. It further contends that the circumstances of the registration and use of the Domain Names are such that the Respondent has no rights or legitimate interests in the Domain Names and the Domain Names have been registered and used in bad faith.

5.4 At the time of the filing of the Complaint the Complainant contended that both Domain Names were registered in the name of WhoIs Privacy Corp. So far as the <toyota.com> Domain Name is concerned, it relies upon the fact that shortly prior to the WhoIs details for the Domain Name having been redacted pursuant to the General Data Protection Regulation, this is the name given for the registrant. In its amended Complaint and given the details provided in response to registrar verification requests made of the Registrars, the Complainant contended that the Domain Names are under common ownership and control. This Complainant's contentions in this respect are addressed in greater detail later on in this decision.

B. Respondent

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

6. Discussion and Findings

- 6.1 There are no exceptional circumstances within paragraph 5(f) of the Rules so as to prevent this Panel from determining the dispute based upon the Complaint, notwithstanding the failure of any person to lodge a Response.
- 6.2 Notwithstanding that default, it remains incumbent on the Complainant to make out its case in all respects set out in paragraph 4(a) of the Policy. Namely, the Complainant must prove that:
- (i) the Domain Names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights (paragraph 4(a)(i)); and
 - (ii) the Respondent has no rights or legitimate interests in respect of the Domain Names (paragraph 4(a)(ii)); and
 - (iii) the Domain Names have been registered and is being used in bad faith (paragraph 4(a)(iii)).
- 6.3 However, under paragraph 14(b) of the Rules, where a party does not comply with any provision of the Rules, the Panel shall "draw such inferences therefrom as it considers appropriate".
- 6.4 The Panel will address each aspect of the Policy in turn. However, before it does so it is appropriate and necessary to address the question of whether the proceedings can continue as a single set of proceedings in respect of both Domain Names.

A. Request for Consolidation

6.5 Paragraph 3(c) of the Rules states as follows:

"The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder."

6.6 Previous panels have tended to adopt a wide interpretation of "same domain-name holder" so as to at least encompass situations where domain names are under "common control".

6.7 The process of a party's request that, and panel's consideration of whether, proceedings should continue against domain names registered in different names is referred to in a large number of cases and in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") as "consolidation". The reasons for this choice of term are set out in some detail in the recent decision in *Meta Platforms, Inc., et al. v. Domains By Proxy, LLC, et al.*, WIPO Case No. [D2022-0212](#). However, regardless of what the process is called, there is consensus as to the approach adopted. As is recorded in section 4.11.2 of the [WIPO Overview 3.0](#):

“Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants’ identity(ies) including pseudonyms, (ii) the registrants’ contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s).”

- 6.8 At the time the Complaint was initially filed, the Complainant contended that the Domain Names were most likely registered in the name of the same registrant; *i.e.*, Whols Privacy Corp. Notwithstanding that at that time the registration details for one of the Domain Names appeared to be redacted, this was not an unreasonable assumption, given that historic Whols details suggested that the relevant Domain Name had been registered in that name just prior to redaction.
- 6.9 The Complainant contends that although the name suggests otherwise, “Whols Privacy Corp.” is not a privacy service. It relies upon the decision in *John Stamos v. Ryan G Foo / PPA Media Services / Domain Admin / Whois Privacy Corp*, NAF Claim No. 1618847 where the panel is said to have concluded that rather than being a “typical, legitimately operated identity masking service”, Whois Privacy Corp. “provides a straw man/proxy service used to hide the identity of the website operator, with Whois Privacy Corp as the actual and legal registrant”.
- 6.10 The 2013 Registrar Accreditation Agreement entered into between registrars and ICANN (the 2013 RAA) defines a “Privacy Service” as a service where the registered name is registered to the beneficial user, but providing alternate contact information (see paragraph 1.2 of the Specification on Privacy and Proxy Registrations in the 2013 RAA). A “Proxy Service” is defined in that same agreement as one where the name holder “licenses use of a Registered Name” to a customer (see paragraph 1.3 of the Specification on Privacy and Proxy Registrations in the 2013 RAA).
- 6.11 Although the Panel suspects that “privacy service” is a phrase that is often used to encompass both “Privacy Service” and “Proxy Service” as defined in the 2013 RAA, it accepts that Whols Privacy Corp. appears to fall within the 2013 RAA’s definition of a Proxy Service rather than a Privacy Service.
- 6.12 When it comes to consolidation, this could well be a point of importance. As this Panel recently observed in *Meta Platforms, Inc., et al. v. Domains By Proxy, LLC, et al.*, WIPO Case No. D2022-0212, arguably the term “domain-name holder” is a broad enough term to encompass cases where the same services is used in relation to different domain names. This argument is stronger if a “Proxy Service” rather than a “Privacy Service” is involved.
- 6.13 The difficulty is that even if this is right and notwithstanding that both of the Domain Names were at some point registered in the name of “Whols Privacy Corp.”, it is not at all clear whether this is so at the date of the filing of the Complaint given the masking of the <toyota.com> Domain Name. Therefore, had this point been determinative the Panel is likely to have taken the unusual step of issuing a Procedural Order directed to the Registrar of that Domain Name seeking clarification on this point.

- 6.14 However, ultimately the Panel has reached the conclusion that this is not necessary. The reasons for this are that there are the following common features in the Domain Names and how they have been used:
- (i) The Domain Names are both examples of exactly the same type of typo-squatting in respect of the same trade mark; *i.e.*, repeating the letter “o” in the mark TOYOTA and combining this with “.com” generic Top-Level Domain (“gTLD”).
 - (ii) Both Domain Names appear to have been registered roughly 17 years ago
 - (iii) Both Domain Names have, at least at some point, been registered in the name of the “Whols Privacy Corp.” service.
 - (iv) Both Domain Names appear to have been used in December 2021 broadly the same manner; *i.e.*, for redirecting Internet users to the websites of unconnected third parties. They have also both been offered for sale through Sedo.
- 6.15 Further, the Complainant has clearly and unambiguously asserted that the Domain Names are controlled by the same person. No one purporting to be the holder of one of the Domain Names has claimed that he or she is unconnected with the controller of the other. It is perhaps unrealistic to expect that the holder of either of the Domain Names would file a formal Response just to dispute this allegation of ownership where there is no substantive defence under the Policy. However, as far as the Panel is aware this has not even been asserted informally by way of email or otherwise. This is also notwithstanding the fact that the Registrar, Above.com, appears to have recently been in contact with the registrant of the <toyota.com> Domain Name and been able to engage in a conversation with that registrant in relation to the expiry of that Domain Name.
- 6.16 The Panel is thereby persuaded that the Complainant has sufficiently made out a *prima facie* case that the Domain Names are under “common control” and that in the absence of any further argument or evidence to the contrary, these proceedings can continue in respect of both Domain Names.

B. Identical or Confusingly Similar

- 6.17 The Complainant has demonstrated that TMC owns various registered trade mark rights in TOYOTA, including registered rights in the United States. Although it is not expressly stated, it is inherent in the Complainant’s contention that it is the exclusive importer and distributor of Toyota vehicles in all but one of the states of the United States, that it is a licensee of those United States rights. The Complainant is also a subsidiary of TMC. In the circumstances the Panel is satisfied that the Complainant has relevant rights in the TOYOTA trade mark for the purposes of the Policy (as to which see section 1.4.1 of the [WIPO Overview 3.0](#)),
- 6.18 In order to satisfy the first element of the Policy it is usually sufficient for a complainant to show that the relevant mark is “recognizable within the disputed domain name” (as to which see section 1.7 of the [WIPO Overview 3.0](#)).
- 6.19 Each of the Domain Names can only be sensibly understood as a misspelling of the mark TOYOTA, combined with the “.com” gTLD. The TOYOTA mark is, therefore, clearly recognisable in each of the Domain Names.
- 6.20 The Complainant has therefore satisfied the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

- 6.21 As is discussed in the context of bad faith, the Panel accepts that the text of each of the Domain Names was chosen by the Respondent to incorporate (or if the Respondent was not the initial

registrant of the Domain Names, was acquired by the Respondent because they incorporated) a misspelling of the TOYOTA mark, and that the Domain Names have subsequently been held, with the intention of taking some form of unfair advantage of that mark.

- 6.22 There are no rights or legitimate interests in holding the Domain Names for such a purpose. On the contrary this is positive evidence that no rights or legitimate interests exist (see also section 2.15 of the [WIPO Overview 3.0](#)).
- 6.23 The Complainant has, therefore, satisfied the requirements of paragraph 4(a)(ii) of the Policy for each Domain Name.

D. Registered and Used in Bad Faith

- 6.24 The Panel has little hesitation in concluding that each of the Domain Names was registered and has been held with the intention of taking some form of unfair advantage of the trade mark rights of the Complainant's business. The main reason for this is that neither Domain Name can be read as anything other than a deliberate typosquatting variation of TMC's TOYOTO trade mark. It is difficult to conceive of how either of the Domain Names might be held or used for a legitimate purpose.
- 6.25 Further, a domain name that takes the form <[trademark].[gTLD]>, is likely to create a misrepresentation that it is either a domain name operated by, or at least authorised by, the trade mark holder. The analysis is no different where the trade mark is deliberately misspelled (as to which see, for example, *ArcelorMittal (Société Anonyme) v. Avinash Maharaj, Avinash Maharaj*, WIPO Case No. [D2020-1174](#); *Johnson & Johnson v. Ebubekir Ozdogan*, [WIPO Case No. D2015-1031](#); and sections 3.1.4 and 3.2.1 of the [WIPO Overview 3.0](#)).
- 6.26 Further, each of the Domain Names in this case was used in December 2021 to redirect Internet users to web pages that had no connection with the Complainant. Such use falls within the scope of the example of bad faith use set out in paragraph 4(b)(iv) of the Policy.
- 6.27 Finally, there is the fact that both DL Pontiac and Transure Enterprise Ltd have previously been found in numerous UDRP cases to have registered and held domain names that incorporate the trade marks of others. Transure Enterprise Ltd in particular is, in the words of the Complainant, "a notorious cyberpirate". The Domain Names provide yet another example of the Respondent's business model of taking unfair advantage of third party trade marks.
- 6.28 The Complainant has therefore satisfied the requirements of paragraph 4(a)(iii) of the Policy for each Domain Name.

7. Decision

- 7.1 For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names, <tooyota.com> and <toyoota.com>, be transferred to the Complainant.

/Matthew S. Harris/
Matthew S. Harris
Sole Panelist
Date: March 29, 2022