

ADMINISTRATIVE PANEL DECISION

Sony Interactive Entertainment Europe Limited v. Randy McNeil
Case No. D2023-3255

1. The Parties

The Complainant is Sony Interactive Entertainment Europe Limited, United Kingdom, represented by IP Twins, France.

The Respondent is Randy McNeil, United States of America.

2. The Domain Name and Registrar

The disputed domain name <playstation-direct.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 28, 2023. On July 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 28, 2023, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 4, 2023, 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 on August 9, 2023.

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 of the Complaint, and the proceedings commenced on August 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 1, 2023.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on September 19, 2023. 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 based in United Kingdom and part of the Japanese Sony Corporation offering, amongst others, video games and digital entertainment products, most notably the home video console PlayStation.

The Complainant is the owner of trademark registrations worldwide consisting of or including the mark PLAYSTATION, such as:

- European Union trade mark no. 011686953 for PLAYSTATION (word), filed on March 25, 2013, and registered on September 4, 2013, for goods and services in Classes 9, 38, 41, 42, and 45;
- Australian trademark no. 1255472 for PLAYSTATION (word), filed and registered on June 17, 2008, for goods and services in Classes 9 and 36;
- European Union trade mark no. 001545094 for PLAYSTATION (word), filed on March 3, 2000, and registered on October 24, 2003, for goods and services in Classes 9, 14, 16, 18, 25, 28, 38, 41, and 41; and
- United Kingdom trademark no. UK00901522507 for PLAYSTATION (stylized), filed on February 21, 2000, and registered on March 15, 2001, for goods and services in Classes 32, 33, and 42.

In addition, the Complainant owns the domain name <playstation.com> including the operation of a service allowing Internet users to shop directly at the URL “http://direct.playstation.com”.

The disputed domain name was registered on May 19, 2023. It is currently inactive.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy is established in the present case:

The Complainant argues that the disputed domain name is confusingly similar to a trademark, in which it owns rights.

The disputed domain name incorporates, in its second-level portion, the Complainant's trademark PLAYSTATION in which it owns rights pursuant to Annex 4 to the Complaint, and the generic term “direct” does not prevent a finding of confusing similarity to the Complainant's trademark. In addition, the Complainant puts forth that the addition of the generic Top-Level-Domain (“gTLD”) “.com” is a standard registration requirement which can be disregarded.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Firstly, the Respondent is not commonly known by the disputed domain name. He has - according to trademark searches conducted by the Complainant as put forth in Annex 5 to the Complaint - not acquired any trademarks rights related to the term “playstation”. Nor is there any evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization.

Secondly, the Complainant has not licensed or otherwise authorized the Respondent to reproduce its trademark within the disputed domain name.

Thirdly, the disputed domain name resolves into an error page as demonstrated in Annex 6. Thus, the Respondent has not demonstrated any intent to use the disputed domain name in connection with a *bona fide* offering of goods or services. In contrast, the disputed domain name is likely to mislead Internet users, and there is no evidence that the Respondent has been making a legitimate noncommercial or fair use of the disputed domain name. In light of the repute of the Complainant's trademark, the Complainant sees no plausible fair use that could be made of the disputed domain name by the Respondent.

Fourthly, the trademarks owned by the Complainant predate the Respondent's registration of the disputed domain name by far. Therefore, the burden is on the Respondent to prove rights or legitimate interests in the disputed domain name.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith.

According to the Complainant, the disputed domain name was registered in bad faith in the first place. The Complainant and its PLAYSTATION trademarks are - according to the Complainant - so widely known and reputed beyond the threshold of notoriety that it is inconceivable that the Respondent ignored them upon registration of the disputed domain name. In this vein, the Complainant points to its Facebook page being liked by more than 38 million people worldwide, its Twitter feed being followed by 17 million people, and its Instagram account by more than 22 million people, referring to Annexes 7, 8, and 9 of the Complaint. Thus, it is clear that the Respondent had the Complainant in mind when registering the disputed domain name. A simple online search using the term "playstation" yields search engine results only related to the Complainant (Annex 10). Therefore, the Respondent knew or at the very least should have known about the Complainant when registering the disputed domain name.

On the use in bad faith, the Complainant submits that the Respondent acquired the disputed domain name to prevent the Complainant from reflecting its trademark in the corresponding domain name. The Complainant claims that the Respondent, according to the Complainant's research, has already used the disputed domain name for an active website impersonating the Complainant (Annex 11), reproducing the trademarks and offering PLAYSTATION branded products for sale. As for the present inactive use, the Complainant sees, given in particular the land-lasting international reputation of the brand PLAYSTATION, no possible way in which the disputed domain name could be used without creating trademark infringement and damage to the repute of the PLAYSTATION trademark. Thus, the fact that the disputed domain name resolves into an error page does not prevent a finding of use in bad faith. The Complainant argues that the panel must examine all relevant circumstances of the case, and it finds that the circumstances leading to use in bad faith be met in the present case, in particular the reputation of the Complainant's trademark, a non-response to the Complaint, and the Respondents concealment of its identity.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4 (a) of the Policy, a complainant must prove that each of the following three elements is present:

- (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

On the first element, the Complainant has to establish that there is a trademark or service mark, in which it has rights.

The Complainant has demonstrated registered trademark rights in and use of trademarks consisting of or comprising the mark PLAYSTATION.

Further, the test for identity or confusing similarity under the Policy, paragraph 4(a)(i) is limited in scope to a direct comparison between the Complainant's trademarks and the textual string which comprises the disputed domain name.

The Panel agrees that the disputed domain name includes the trademark PLAYSTATION in its entirety, merely adding the term "direct" as well as the gTLD ".com". Pursuant to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7, in cases where a domain name incorporates the entirety of a trademark, said domain name will be found to be identical or confusingly similar for purposes of the UDRP. Also, for the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, the Panel typically ignores the gTLD (section 1.11.1 of [WIPO Overview 3.0](#)).

Therefore, the disputed domain name is confusingly similar to the Complainant's trademark.

In view of the above, the Panel finds that the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

On the second element, under paragraph 4 (a)(ii) of the Policy, the Complainant bears the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is consistent case law of UDRP panels that it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel notes that, with respect to paragraph 4(c)(i) of the Policy, there is no evidence in the record that the Respondent before any notice of the dispute, used or prepared 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. On the contrary, there is evidence by the Complainant (Annex 11) that the Respondent, in the past, has used the disputed domain name in a way infringing the trademark of the Complainant.

The Panel further notes that, with respect to paragraph 4(c)(ii) of the Policy, there is no evidence indicates that the Respondent has ever been commonly known by the disputed domain name.

Additionally, with respect to paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent has made, and is making, a legitimate noncommercial or fair use of the disputed domain name. On the contrary, given that the disputed domain name is inactive, the Respondent is not making any use whatsoever of the disputed domain name. In light of this, and considering that the disputed domain name contains the entirety of the Complainant's trademark together with the term "direct" in an inversion of the Complainant's own operation of a service allowing to shop directly at the URL "http://direct.playstation.com", the Panel finds that it is clear that the Respondent intentionally sought to mislead unsuspecting Internet users expecting to find the Complainant through the confusingly similar disputed domain name.

Moreover, the Complainant has not authorized, licensed, or permitted in any other way the Respondent to register or use the disputed domain name or its trademark.

Therefore, the Panel finds that the Complainant has provided sufficient evidence to hold that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has satisfied the requirement of paragraph 4 (a)(ii) of the Policy.

C. Registered and Used in Bad Faith

On the third element, under paragraph 4(a)(iii) of the Policy, the Complainant has to establish that the Respondent registered and is using the disputed domain name in bad faith.

As to registration in bad faith, the Panel notes that the disputed domain name was registered many years after the registration of the Complainant's first PLAYSTATION trademark, and accepts that the disputed domain name was chosen by reference to this trademark. The Panel accepts the Complainant's evidence and claim for reputation of its PLAYSTATION trademark and concurs with the UDRP panels in *Sony Computer Entertainment America LLC v. John Chiu*, WIPO Case No. [DCO2014-0027](#), and *Sony Interactive Entertainment Inc. v. Govind Anda*, WIPO Case No. [D2019-2361](#), holding the PLAYSTATION trademark to be internationally well known. Therefore, the Panel agrees with the Complainant that it is inconceivable that the disputed domain name could have been chosen and registered without actual knowledge and even targeting of the Complainant's trademark, considering also the Complainant's use of the URL "http://direct.playstation.com". Consequently, the Panel finds that the Respondent registered the disputed domain name in bad faith.

As to use 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 in bad faith: (i) circumstances indicating registration or acquisition of the domain name primarily for the purpose of selling, renting, or otherwise transferring to the complainant who is the owner of the trademark for valuable consideration or to one of its competitors, or (ii) registration of the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, or (iii) registration of the domain name primarily for the purpose of disrupting the business of a competitor, or (iv) by using the domain name, intentionally attempting 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 its website or location.

Here, the disputed domain name resolves to an error page and is, thus, inactive. With comparative reference to the circumstances set out in paragraph 4(b) of the Policy, it is consensus view of UDRP panels that, nevertheless, the apparent lack of so-called active use of a disputed domain name does not prevent such finding of bad faith. Rather, a panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith, such as the complainant having a well known trademark, no response of the respondent, or the registrant's concealment of its identity (see section 3.3 of the [WIPO Overview 3.0](#)).

In the present case, as indicated above, the Panel holds the Complainant's trademark to be well known. Taking this into consideration, it is inconceivable to assume that the disputed domain name could be put to any use that would not amount to use in bad faith (see *Artemis Marketing Corp. v. Admin Contact, c/o PrivateName Services Inc. / Amir Cohen and Registration Private, Domains by Proxy, LLC / VMI INC*, [D2021-3480](#)). Further, the Complainant has demonstrated that the Respondent had, prior to the Complainant initiating the present UDRP procedure, misused the disputed domain name to resolve to a website falsely impersonating the Complainant and infringing the Complainant's trademark. Further, the Panel finds that the Respondent's efforts to conceal its identity through the use of a privacy service, as well as, finally the fact that the Respondent has not participated in the proceeding can be construed as further evidence that the disputed domain name was registered in bad faith and its non-use does not prevent a finding of bad faith (*TTT Moneycorp Limited. v. Diverse Communications*, WIPO Case No. [D2001-0725](#)).

In the circumstances, the Panel finds that the requirement of paragraph 4(a)(iii) of the Policy has been satisfied.

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, <playstation-direct.com>, be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: October 3, 2023