

ADMINISTRATIVE PANEL DECISION

**SODA Inc. v. SNKRDUNK Co., Ltd. / Domains By Proxy, LLC / 123 123
Case No. D2022-1384**

1. The Parties

The Complainant is SODA Inc., Japan, represented by Soei Patent & Law Firm, Japan.

The Respondent is SNKRDUNK Co., Ltd., China / Domains By Proxy, LLC, United States of America (“United States”) / 123 123, Japan.

2. The Domain Name and Registrar

The disputed domain name <snkrduck.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 19, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 20, 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 the Complainant on April 20, 2022, 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 amendment to the Complaint on June 10, 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”).

The Respondent sent informal communications to the Center on April 21, 2022, and on April 29, 2022. The Complainant requested that the proceedings be suspended on April 28, 2022, in order to explore settlement options. The proceedings were reinstated on June 2, 2022.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2022. The Respondent did not submit a formal response. Accordingly, the Center notified the parties that it would proceed to panel appointment on July 6, 2022.

The Center appointed Keiji Kondo as the sole panelist in this matter on July 12, 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

The Complainant is operating an online marketplace for international brand sneakers under the trademark (or service mark) SNKRDUNK using the domain name <snkrduck.com>. The primary target of this online marketplace is Japanese users. The Complainant is the owner of the trademark SNKRDUNK, which is protected by Japanese Trademark Registration No. 6,400,050. The registration date of the Complainant's trademark registration is June 9, 2021. The Complainant's trademark registration covers various goods and services, including, *inter alia*, provision of an online marketplace for buyers and sellers of goods and services, and providing information concerning commercial sales by the website of the Internet.

The disputed domain name was registered on January 2, 2022. The Respondent is distributing sneakers using an online shopping site to which the disputed domain name directs. The sneakers distributed by the Respondent appear to be fake.

5. Parties' Contentions

A. Complainant

The Respondent is using "snkrduck" (instead of SNKRDUNK). The term "snkrduck" closely resembles the aforementioned Complainant's trademark SNKRDUNK. They differ in spelling by only one letter. When the consumers casually look at the Complainant's SNKRDUNK trademark and the term "snkrduck", it is unlikely that they can realize the difference. Also, they are phonetically similar. Above all, the way the "snkrduck" and its logo were presented in the Respondent's online shopping site pages is almost identical to the way the Complainant's trademark SNKRDUNK is presented in the Complainant's online marketplace pages.

The Respondent's online shopping site and the Complainant's online marketplace deal with the same products, *i.e.*, international brand sneakers, although there is a difference between fake ones and authentic ones. Both the sites target the same consumer group, *i.e.*, Japanese sneaker users.

These elements lead to the conclusion that the disputed domain name is confusingly similar to the Complainant's trademark SNKRDUNK. The main part of the disputed domain name is the term "snkrduck". Therefore, the disputed domain name is confusingly similar to the Complainant's trademark SNKRDUNK, to which the Complainant has the trademark right.

The Complainant's trademark SNKRDUNK was registered on June 9, 2021. The Complainant's online marketplace under this trademark using the domain name <snkrduck.com> was launched on December 7, 2016. The disputed domain name was registered afterwards on January 2, 2022. Therefore, the Respondent has no prior right to use the trademark SNKRDUNK or trademarks similar thereto.

The fact that the Respondent is concealing its identity indicates that the Respondent is engaged in an unscrupulous business. It is absolutely unacceptable for the Complainant to tolerate the use of the disputed domain name by a dealer of fake international brand sneakers. Therefore, there is no ground for the Respondent to have any rights or legitimate interests in respect of the disputed domain name.

The Complainant's trademark SNKRDUNK is a unique distinctive word. It must not be coincidence that the Respondent uses the disputed domain name which consists of "snkrduck" and the generic Top-Level Domain ("gTLD") ".com". Also, (i) the similarity of the way "snkrduck" and the Complainant's trademark SNKRDUNK are presented in each one's commercial site, (ii) the similarity between the logo of "snkrduck" and the logo of the Complainant's trademark SNKRDUNK, and (iii) the fact that both the Complainant and

the Respondent are dealing with international brand sneakers indicate the Respondent's deliberate action for the purpose of causing confusion with the Complainant's trademark SNKRDUNK.

The attorney of the Complainant sent the Respondent a cease & desist letter based on the Complainant's trademark registration, setting the response deadline on April 6, 2022. The attorney of the Complainant also sent the same message to the Respondent via contact function of the online shopping site of the Respondent. However, there has been no response from the Respondent. If the Respondent had any excuse for using the confusingly similar trademark and domain name, the Respondent would have responded to the cease & desist letter. Therefore, it is reasonably presumed that the disputed domain name was registered and is being used in bad faith of causing confusion.

B. Respondent

The Respondent did not submit a formal response to the Complainant's contentions. The Respondent sent informal communications to the Center on April 21, 2022, and on April 29, 2022. Those stated:

"I no longer use this domain. (snkrduck.com)
And I have voluntarily given up this domain.(snkrduck.com)
When you withdraw this lawsuit, I will delete this domain name completely.
Thank you for your cooperation."

And:

"[✓] The disputed domain name(s) should be cancelled.
This is my answer."

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns Japanese Trademark Registration No. 6,400,050 for SNKRDUNK. The disputed domain name incorporates the Complainant's trademark almost in its entirety, with the only difference being substitution of "c" for "n" in the second half of the trademark, that is, "dunk". The difference is so slight that an average observer would overlook it. Therefore, the Complainant's trademark is recognizable in the disputed domain name.

It is well-established that the gTLD ".com" should typically be disregarded in finding of confusing similarity because it is viewed as a standard registration requirement.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark within the meaning of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Respondent conceals its identity by giving false information to the Registrar. According to the communication from the attorney for the Complainant to the Center, attempts for settlement failed because the Respondent refused to disclose its identity and sign the settlement agreement.

Concealment of the identity by the Respondent is strong evidence showing that the Respondent has never been known by the disputed domain name. Therefore, the Panel finds that the Respondent has never been known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

The Respondent uses the disputed domain name to direct Internet users to an online shopping website. Therefore, it is obvious that the Respondent's use of the disputed domain name is of commercial nature;

that is, the use of the disputed domain name by the Respondent is not a legitimate noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

The Respondent offers for sale brand sneakers that the Respondent admits are fake. The Respondent's website displays messages in Japanese that, if translated into English, would read:

"SNKRDUCK is a company having manufacturing facilities for world No. 1 super copy goods."; and

"However, resale is absolutely not recommended. It would be a crime in Japan."

Moreover, the Respondent falsely identifies itself as "SNKRDUNK Co. Ltd." on its webpage, apparently attempting to cause confusion with the Complainant.

Offering fake goods for sale without disclosing the seller's identity cannot be regarded as *bona fide* offering of goods or services. Therefore, the Respondent's use of the disputed domain name is not a use in connection with a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The registration date of the disputed domain name is January 2, 2022, while the registration date of the Complainant's trademark is June 9, 2021. The Respondent falsely identifies itself as "SNKRDUNK Co. Ltd.", using the Complainant's trademark. Moreover, both the Complainant and the Respondent sell brand sneakers through online shops; that is, the Complainant and the Respondent are active in the same business area.

These facts clearly indicate that the Respondent knew the Complainant's trademark at the time of registration of the disputed domain name, and that the Respondent, by registering the disputed domain name, intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Further, it is obvious that the Respondent has been using the disputed domain name as intended at the time of registration.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) 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 <snkrduck.com> be transferred to the Complainant.

/Keiji Kondo/

Keiji Kondo

Sole Panelist

Date: July 26, 2022