

ADMINISTRATIVE PANEL DECISION

Do House Inc. v. Super Privacy Service LTD c/o Dynadot / Wesley Karr
Case No. D2022-2451

1. The Parties

The complainant is Do House Inc., Japan, represented by Marunouchi Sogo Law Office, Japan (the “Complainant”).

The respondent is Super Privacy Service LTD c/o Dynadot, United States of America (“United States”) / Wesley Karr, United States (the “Respondent”).

2. The Domain Name and Registrar

The disputed domain name <モラタメ.net> (<xn--5ck8cb2a.net>) (the “Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

On July 6, 2022, the Complainant filed its complaint in English (the “Complaint”) with the WIPO Arbitration and Mediation Center (the “Center”). On July 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 7, 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, and confirming that the Registration Agreement is in English. On July 7, 2022, the Center sent an email communication to the Complainant providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On July 11, 2022, the Complainant filed an amended Complaint in English (the “Amended Complaint”).

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”).

On July 12, 2022, in accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2022. The Respondent did not submit any Response. On August 2, 2022, the Center notified the Respondent of its default. No further communications were received from the Respondent.

On August 19, 2022, the Center appointed Haig Oghigian as the sole panelist in this matter (the “Panel”). 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.

All communications between the Center and the Parties have been in English.

4. Factual Background

The Complainant is a company providing marketing research services and promotion services since May 2006. On May 11, 2007, the Complainant registered its trademark for モラタメ.NET (Japanese Trademark Registration Number 5044933) (the “Trademark”).

On September 30, 2019, the Domain Name was registered. On July 7, 2022, in correspondence with the Center, the Registrar confirmed the Domain Name is registered with Dynadot, LLC and Wesley Karr is the registrant of the Domain Name.

The Domain Name <モラタメ.net> in Punycode is <xn--5ck8cb2a.net>, which is identical to the Trademark in which the Complainant has the trademark rights.

According to the Complainant’s evidence, the Domain Name redirected to various websites related to third parties, some of which displayed the messages of Apple Defender Security Center fake alert scams.

5. Parties’ Contentions

A. Complainant

The following information has been taken from the Complaint, Amended Complaint and the attached Annexes.

The Domain Name <モラタメ.net> is an internationalized domain name displayed in Japanese. The Romanization of the Domain Name <モラタメ.net> is <moratame.net>.

The Complainant is a company which has been providing marketing research services and promotion services to its clients since May 2006. One of the services the Complainant provides is to provide sample products to its web members and then receive reviews of such products under the name of “モラタメ.net” using the domain name <moratame.net>. The Complainant describes this service as one of the largest and most well-known of its kind in Japan with a total of 1.2 million members, over 2.1 million products offered as samples and 130,573,624 PV accesses to the Complainant’s website from January 1, 2021 to December 31, 2021. The Complainant has conducted many TV commercials and other advertisements for its services.

When an Internet user wishes to use the Complainant’s services, they will type in <moratame.net> in Japanese characters into the address bar of his/her browser, he/she will access a site at the Domain Name <モラタメ.net> and be redirected to a website which is presumed to be related to the Respondent.

The Complainant alleges that the Respondent does not use “モラタメ.net” or any other similar names. The Complainant searched the trademark search system “TESS” of the United States Patent and Trademark Office and confirmed the Respondent does not have any registered trademarks that contain the character “moratame” which is the Romanization of “モラタメ”. The Complainant submits that the Respondent is not engaged in business for Japanese people and did not intend to use the Domain Name in Japanese because the meaning is not understood in any language other than Japanese. The Respondent is located in the United States.

According to the Complainant's investigation, the Respondent uses the Domain Name only to redirect Internet users who access the Domain Name to other websites that are presumed to be related to the Respondent. For example, when an Internet user types the Domain Name into the address bar of his/her browser, he/she will be redirected to a website such as a site in which the Apple Defender Security Center fake alert scam is displayed.

The Complainant submits that the Domain Name is identical to the Trademark in which it has rights, the Respondent has no rights or legitimate interests in respect of the Domain Name, and the registration and use of the Domain Name have been done in bad faith. The Complainant asks that the Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Domain Name fully incorporates the Trademark. It is now trite law that a domain name that wholly incorporates a registered trademark is enough to conclude that there is a confusing similarity.

The Panel agrees with the Complainant that the Domain Name is identical to the Trademark. The Panel is also of the view that the Complainant has demonstrated to the Panel's satisfaction that it has the rights to the Trademark as per the registration of the Trademark and also of its commercial use.

In light of the above, it is apparent that the Domain Name is identical to the prior registered trademark in which the Complainant has rights pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In accordance with paragraph 4(c) of the Policy, the Respondent, in order to demonstrate its rights or legitimate interests can, without limitation, refer to the following circumstances:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

No evidence was adduced by the Respondent to demonstrate any rights or legitimate interests in the Domain Name. The Respondent, having been duly notified of the Complaint and the present proceeding, has chosen not to reply to the contentions of the Complainant nor otherwise participated in this proceeding.

The Complainant registered the Trademark in 2007. The Respondent registered the Domain Name with in 2019. The Complainant is commonly known by the Trademark in Japan and has been in business since 2006. No evidence was adduced that would demonstrate that the Respondent is engaged in any business for Japanese people or that the Respondent intended to use the Domain Name because the meaning of the Domain Name ("moratame" which could mean "samples" to Japanese speaking customers) is not understood in any language other than Japanese. The Respondent is located in the United States.

No evidence was adduced that would demonstrate that the Respondent has used any trademarks similar to the one used in the Domain Name nor that the Respondent has been authorized to register any domain names including the Trademark. Nevertheless, the Respondent registered the Domain Name which is identical to the Trademark. Such construction carries a high risk of implied affiliation that cannot constitute fair use, pursuant to section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Moreover, the Complainant's evidence demonstrates that the Respondent sought to mislead users as to the association of the Domain Name with the Complainant and confuse and capitalize on the Complainant's reputation.

There is no evidence that would show that the Respondent was acting in accordance of any rights or legitimate interests upon registration of the Domain Name.

There is also no evidence that would show that the Respondent had "use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services", as per paragraph 4(c) of the Policy referred above. Rather, at the time of filing of the Complaint, the Domain Name redirected to various websites related to third parties, some of which displayed the messages of Apple Defender Security Center fake alert scams.

Therefore, the Panel concludes that the Respondent has neither rights nor legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that if the following circumstances in particular but without limitation, are present, they shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Paragraph 4(b)(iv) of the Policy is the most relevant example for this case. The evidence adduced leads the Panel to conclude that the Respondent has intentionally attempted to redirect Internet users who access the Domain Name to various other websites related to third parties, some of which displayed the messages of Apple Defender Security Center fake alert scams. Therefore, the Respondent has intended to create a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Domain Name.

Moreover, the Panel concludes that a simple trademark search or a web browser search for the Domain Name would have revealed the Complainant's rights in the Trademark. The Complainant has registered its Trademark since 2007, which is more than 12 years before the Respondent registered the Domain Name. The Panel sees no reason for the Respondent to have registered the Domain Name which is identical to the Trademark other than to trade off of the reputation and goodwill of the Complainant's reputable Trademark.

Thus, this also supports a finding of bad faith.

Lastly, the use of the Domain Name to redirect Internet users to various websites related to third parties, some of which displayed the messages of fake alert scams also illustrates the Respondent's bad faith.

As such, the Panel finds that the registration and use of the Domain Name have been done in bad faith.

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 Domain Name <モラタメ.net> (<xn--5ck8cb2a.net>) be transferred to the Complainant.

/Haig Oghigian/

Haig Oghigian

Sole Panelist

Date: September 2, 2022