

ADMINISTRATIVE PANEL DECISION

The Japanese Institute of Certified Public Accountants v. Domain Sales, You Want Your Name, LLC
Case No. D2022-2713

1. The Parties

The Complainant is The Japanese Institute of Certified Public Accountants, Japan, represented by Bird & Bird (Netherlands) LLP, Netherlands.

The Respondent is Domain Sales, You Want Your Name, LLC, United States of America.

2. The Domain Name and Registrar

The disputed domain name <jicpa.com> is registered with Communigal Communications Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 25, 2022. On July 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 27, 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 July 27, 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 July 27, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 18, 2022.

The Center appointed Taras Kyslyy as the sole panelist in this matter on August 25, 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 the sole organization for the certified public accountant (the “CPA”) profession in Japan. It was originally formed in 1949 as a self-regulatory association. In order to practice as a CPA, a qualified person must register with the Complainant and join its membership. The Complainant, through its various committees and project teams, carries out a wide range of activities from self-regulation to the provision of services to its members.

The Complainant has rights in JICPA trademark based on the Japanese trademark registration No. 0970109, registered on July 4, 1972.

The disputed domain name was registered on July 10, 2011 and resolves to a webpage displaying pay-per-click links and a link at “dan.com” offering the disputed domain name for sale at USD 4,988.

5. Parties’ Contentions

A. Complainant

The disputed domain name is identical to the Complainant’s trademark. The disputed domain name incorporates the entirety of the Complainant’s trademark with no additions and followed by the generic Top- Level Domain (“gTLD”) “.com”.

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not licensed or otherwise authorized by the Complainant to use the Complainant’s trademark in the disputed domain name. Since the disputed domain name identical to the Complainant’s trademark carries a high risk of implied affiliation by using the disputed domain name, the Respondent deliberately creates the false impression that it is in some way authorized by the Complainant to use the Complainant’s trademark in the disputed domain name. The disputed domain name was registered 39 years after registration of the Complainant’s trademark, thus the Respondent was aware or should have been aware of the Complainant’s trademark rights. The Respondent has no rights in JICPA sign, does not use the sign in such a way it could be identified with it, which contributes to the conclusion that it is not commonly known by the disputed domain name. The lack of content of the website at the disputed domain name shows that the Respondent is not making legitimate or noncommercial fair use of the disputed domain name. It is important that the Complainant is in control of the disputed domain name to avoid possible abuse of what the CPA stands for.

The disputed domain name was registered and is being used in bad faith. The Complainant’s trademark is a highly distinctive trademark with no conventional meaning, well-known in the Japanese accountancy sector, thus the Respondent was aware or should have been aware of the Complainant’s trademark rights when registering the disputed domain name. Registration of the disputed domain name prevents the Complainant from using its trademark in a corresponding domain name with the gTLD “.com”. The disputed domain name was registered with the sole purpose of selling it for valuable consideration in excess of documented out-of-pocket costs. There is a pattern of abusive registrations by the Respondent, since in another domain dispute in 2012 it also registered a disputed domain name for reselling at a high price.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

According to section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)") the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards gTLD ".com" for the purposes of the confusing similarity test.

According to section 1.7 of the [WIPO Overview 3.0](#) in cases where a domain name incorporates the entirety of a trademark the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing. The Panel finds that in the present case the disputed domain name incorporates the entirety of the Complainant's trademark with no further additions.

Considering the above the Panel finds the disputed domain name is identical to the Complainant's trademark, therefore, the Complainant has established its case under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has established *prima facie* that the Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, the Respondent provided no evidence that it holds rights or legitimate interests in the disputed domain name.

The available evidence confirm that the Respondent is not commonly known by the disputed domain name, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainant did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

Considering the above the Panel finds the Respondent does not have rights or legitimate interests in the disputed domain name. Therefore, the Complainant has established its case under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to section 3.2.2 of the [WIPO Overview 3.0](#) noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark. The Panel finds that choosing JICPA sign with no conventional meaning and identical to the Complainant's trademark confirms the Respondent knew and targeted the Complainant and its trademark when registering the disputed domain name, which is bad faith.

According to section 3.1 of the [WIPO Overview 3.0](#) bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. To facilitate assessment of whether this has occurred, and bearing in mind that the burden of proof rests with the

complainant, paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on the respondent's website or location.

In this regard, in view of the circumstances of this case, the Panel considers that the Respondent's offer for sale is probably for a profit (in excess of the out-of-pocket costs), and finds that Respondent's probable motive for its registration was to unfairly profit of its identity with the Complainant's trademark, which supports a finding of bad faith within the meaning of paragraph 4(b)(i) of under the Policy.

The fact that the Respondent was also the respondent in *Elektromak Büro Makineleri Sanayi ve Ticaret A.Ş. v. Domain Sales, You Want Your Name LLC*, WIPO Case No. [D2012-0594](#), where the panel ordered the transfer of the domain name, supports the Panel's finding of bad faith.

Considering the above the Panel finds the disputed domain name was registered and is being used in bad faith. Therefore, the Complainant has established its case under 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 <jicpa.com> be transferred to the Complainant.

/Taras Kyslyy/

Taras Kyslyy

Sole Panelist

Date: September 7, 2022