

ADMINISTRATIVE PANEL DECISION

Nipro Corporation v. hasting h
Case No. D2024-2420

1. The Parties

The Complainant is Nipro Corporation, Japan, represented by Markmonitor, United States of America.

The Respondent is hasting h, United States of America.

2. The Domain Name and Registrar

The disputed domain name <niproshop.com> (“Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 13, 2024. On June 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 14, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 2024 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 June 19, 2024.

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 June 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 12, 2024.

The Center appointed Jon Lang as the sole panelist in this matter on July 19, 2024. 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

Founded in 1954, the Complainant is a Japanese company publicly quoted on the Tokyo Stock Exchange and specializing in medical, pharmaceutical, and glass products. The Complainant's products are sold throughout the world. It employs some 38,000 people.

The Complainant owns more than 100 trademarks for NIPRO which have been registered by the Complainant in many countries, from as early as 1975, including Japanese Trademark No. 1105815, ニプロ (which transliterates as "nipro"), registered on February 10, 1975; United States Registration No. 1441070, for NIPRO, registered on June 2, 1987; United Kingdom Trademark No. UK00001584255 for NIPRO, registered on February 16, 1996; and European Union Trade Mark No. 003205838 for NIPRO (figurative), registered on August 23, 2004.

The Complainant is the registrant of a number of domain names, many of which incorporate the NIPRO trademark, such as <nipro.co.jp> which resolves to the Complainant's principal website in the Japanese and English languages. Furthermore, the Complainant's wholly-owned subsidiary, Nipro Medical Corporation, is the registrant of the domain name <nipro.com>.

The Domain Name was registered on April 16, 2024 and currently resolves to a web shop (the "Respondent's website") under the name "NIPRO shopping.com". The logo used on the Respondent's website is quite similar to the logo used by the Complainant.

The terms of use of the Respondent's website suggest that it is operated by "Niproshop Mobile Malaysia Sdn. Bhd. (Company Registration No. [...])". However, no company under the name "Niproshop Mobile Malaysia Sdn. Bhd." with the stated company registration number exists in Malaysia. The stated company registration number is the company registration number of a third party company which operates a website considered the largest e-commerce platform in Southeast Asia.

Not only has the Respondent used the company registration number of said third party company, it has also used its terms of use.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name. The following is a summary of its main contentions.

General

Apart from use of the Complainant's NIPRO trademark in the Domain Name and on the Respondent's website (along with a similar logo to that of the Complainant), the Respondent also uses the brand of a third party.

The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

By virtue of the Complainant's extensive use, advertising, promotion and sale of its goods and services, and the Complainant's diligence in protecting its NIPRO trademark throughout the world, using the trademark on its products extensively and at many international exhibitions around the world over the years, the Complainant's NIPRO trademark has become well-known and famous, and has been certified and registered by the Japan Patent Office as a well-known trademark.

The Domain Name incorporates the Complainant's NIPRO trademark in combination with the term "shop". This additional term is closely related to the Complainant's business activity, since it suggests a shop for the Complainant's products. Thus, the additional term "shop" alongside the NIPRO trademark causes a likelihood of confusion for ordinary Internet users, namely that the Domain Name relates to the Complainant and its products.

Where a trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) will not prevent a finding of confusing similarity. The generic Top-Level Domain ("gTLD") ".com" in the Domain Name should be viewed as a standard registration requirement and disregarded for comparison purposes.

If the gTLD is disregarded as it should be, it is clear that the remaining part of the Domain Name is confusingly similar to the Complainant's NIPRO trademark and is, therefore, highly likely to be mistaken for it.

The Complainant has been using its NIPRO trademark for over 50 years and in that time it has attained global fame. Consequently, the public perceives goods and services offered under the NIPRO trademark as being those of the Complainant. Accordingly, the Domain Name creates a clear likelihood of confusion with the Complainant's NIPRO trademark and it is likely that it could mislead Internet users into thinking that it is, in some way, associated with the Complainant.

The Respondent has no rights or legitimate interests in respect of the domain name

The Respondent is not affiliated with the Complainant in any way and has not been authorized by the Complainant to use and register its trademark, or to seek registration of any domain name incorporating it. Previous UDRP panels have found that in the absence of any license or permission from the complainant to use a widely-known trademark, no actual or contemplated bona fide or legitimate use of the domain name can reasonably be claimed.

To the best of the Complainant's knowledge, the Respondent is neither commonly known by the name "nipro" nor is in any way affiliated with the Complainant. Although the Respondent's website presents itself as a company under the name "Niproshop Mobile Malaysia Sdn. Bhd." such company (with stated company registration number) does not exist. The Respondent is also using the identity and company number of a third party. Such abuse in order to falsely present rights in the "nipro" name cannot, under any circumstances, be regarded as legitimate activity.

Apart from unauthorized use of the Complainant's NIPRO trademark within the Domain Name and on the Respondent's website, the Respondent also misuses the brand of a third party. A clear pattern of abuse of third party rights can be seen from the Respondent's operation.

The Domain Name contains the Complainant's well-known NIPRO trademark followed by the term "shop", which is closely related to the Complainant's activities, and for that reason the Respondent cannot reasonably pretend it was intending to develop a legitimate activity through the Domain Name.

The Respondent was a respondent in at least one other UDRP proceedings (*Rakuten Group, Inc. v. Hasting H*, WIPO Case No. [D2023-3877](#)) which was decided in favor of the complainant. It appears that the Respondent was impersonating the complainant and its official website. Moreover, the Respondent appears to be the registrant of several other domain names that are targeting trademarks of third parties.

Based on all available information, the Respondent has not demonstrated use of, or demonstrable preparations to use, the Domain Name in connection with a bona fide offering of goods or services. Indeed, the Domain Name resolves to a suspicious web shop that uses a similar logo to that of the Complainant, which would not support a claim to rights or legitimate interests. The Respondent's website also uses trademarks and brands of third parties and abuses the company identity of a third party company. Therefore, it is clear that the Respondent has no intention to develop a legitimate activity through the Domain Name and that it registered the Domain Name for the sole purpose of taking unfair advantage of the Complainant's reputation and of disrupting its business.

The Respondent has no rights or legitimate interests in respect to the Domain Name.

The domain name was registered and is being used in bad faith

Registration in bad faith: The earliest NIPRO trademark registration predates the Respondent's registration of the Domain Name by more than 50 years. The Complainant's trademark is widely known and used globally and it is implausible that the Respondent was unaware of the Complainant when it registered the Domain Name. It is difficult to imagine that the Respondent did not have the Complainant in mind when registering the Domain Name.

Moreover, registration of the Domain Name occurred 25 years after registration of the Complainant's domain name <nipro.com>, 27 years after registration of <nipro.co.jp>, which resolves to the official website of the Complainant, and 15 years after the registration of <nipro-group.com>, which resolves to the web presentation of the Nipro Europe Group Companies.

The Domain Name fully incorporates the Complainant's NIPRO trademark, followed by the term "shop" which directly relates to the Complainant's activities, confirming that the Respondent had the Complainant in mind when registering the Domain Name.

The Respondent has a history of bad faith registrations incorporating third party trademarks, which leaves no doubt in respect of the bad faith registration in the present case. Having in mind the previous UDRP history of the Respondent, its behavior constitutes a pattern of conduct preventing trademark holders from reflecting their marks in corresponding domain names.

Another factor which indicates the Respondent's bad faith in connection with registration of the Domain Name is that it employs a privacy shield to prevent the Complainant and panel from knowing the identity of the actual registrant and to avoid being notified of a UDRP proceeding filed against it.

Bad faith can be found where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith.

Section 2 of the ICANN Policy provides that when a person registers a domain name, they represent and warrant to the registrar that, to their knowledge, the registration of the domain name will not infringe the rights of any third party. Thus, it was the Respondent's duty to verify that the registration of the Domain Name would not infringe the rights of any third party.

The Respondent deliberately chose the Domain Name and registered it in bad faith with the Complainant in mind in order to make a commercial gain and to disrupt the Complainant's activity. In any event, a quick search for the NIPRO trademark would have revealed to the Respondent the existence of the Complainant and its trademarks. The Respondent's failure to do such a search is a contributory factor to its bad faith.

Even if the Respondent was not aware of the possibility of searching trademarks online, a simple search via any other search engine using the keyword "NIPRO", demonstrates that all the results on the first page relate to the Complainant, its activities or news in respect thereof.

Given the worldwide reputation of the Complainant and its well-known NIPRO trademark, it is certain that the Respondent was aware of the existence of the Complainant and its trademarks at the time of registration of the Domain Name.

It is clear that the Respondent registered the Domain Name in bad faith.

Use in bad faith

There is little doubt that, at all times, the Respondent was aware that the NIPRO trademark enjoys a substantial reputation worldwide.

Registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity (particularly where the domain name incorporates the mark and a descriptive term) can by itself create a presumption of bad faith.

The Respondent's use of the Domain Name to resolve to a suspicious web shop (using the identity and trademarks of third parties) confirms use in bad faith. Such action lacks any purpose beyond misleading consumers for commercial gain, especially given that the Domain Name incorporates the Complainant's distinctive and well-known NIPRO trademark in its entirety and that the Respondent uses a logo similar that used by the Complainant. This is highly likely to cause consumer confusion, leading Internet users to believe that the Respondent's website is affiliated with the Complainant when searching for the Complainant's own website. The complete absence of any connection between the Respondent's website and the Complainant's trademark further underscores the Respondent's malicious intent, reaffirming that the Respondent registered and proceeded to use the Domain Name solely to exploit the goodwill and reputation associated with the Complainant's trademark, by driving traffic to its own website.

Although the content of the Respondent's website is not related to the Complainant's field of activity, numerous previous panels have found that use of a domain name for unrelated goods or services clearly tarnishes and/or dilutes a complainant's mark and thus constitutes registration and use in bad faith.

A clear inference can be drawn from the Respondent's operations that it is trying to benefit from the fame of the Complainant's trademarks. It seems likely that the Respondent's primary motive in registering and using the Domain Name was to capitalize on or otherwise take advantage of the Complainant's trademark rights. The Respondent has both registered and used the Domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires a complainant to prove: (i) that a respondent has registered a domain name which is identical or confusingly similar to a trademark or service mark in which a complainant has rights; (ii) that the respondent has no rights or legitimate interests in respect of the domain name; (iii) that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

A. Identical or Confusingly Similar

The Complainant is the owner of the NIPRO trademark and thus clearly has rights for the purposes of the Policy.

Ignoring the gTLD “.com” (as the Panel may do for comparison purposes), the Domain Name comprises the NIPRO trademark followed by the word “shop”. Accordingly, the NIPRO trademark and Domain Name are not identical and thus the issue of confusing similarity must be considered. Application of the confusing similarity test under the UDRP typically involves “a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.” (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). Section 1.7 of the [WIPO Overview 3.0](#) goes on to provide “[...] in cases where a domain name incorporates the entirety of a trademark, [...] the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

The NIPRO trademark is incorporated in its entirety within the Domain Name. It is clearly recognizable within the Domain Name. The addition of the term “shop” does not prevent a finding of confusing similarity.

The Panel finds that the Domain Name is confusingly similar to the NIPRO trademark for the purposes of the Policy and thus paragraph 4(a)(i) of the Policy has been established.

B. Rights or Legitimate Interests

By its allegations, the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Name. Accordingly, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does in fact have such rights or legitimate interests. The Respondent has not done so and accordingly, the Complainant is deemed to have satisfied the second element. Despite the lack of any answer to the Complaint, however, the Panel is entitled to consider whether there would be anything inappropriate in such a finding.

A respondent can show it has rights or legitimate interests in a domain name in various ways even where, as is the case here, it is not licensed by or affiliated with a complainant. For instance, it can show that it has been commonly known by the domain name or that it is 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.

The Respondent here is not commonly known by the Domain Name. Further, the Domain Name has been used to redirect Internet users to the Respondent’s website, which is a web shop purporting to trade under the name “NIPRO shopping.com”, where the terms of use falsely suggest that it is operated by a company called “Niproshop Mobile Malaysia Sdn. Bhd.” That company name is followed by a company registration number of a different company, which operates a large e-commerce platform in Southeast Asia. Not only has the Respondent used the company registration number of the third party, it has also used its terms of use. Moreover, the Respondent’s website uses a similar logo to that of the Complainant.

In these circumstances, it would be difficult to conclude that there is anything noncommercial or fair about the Respondent's use. As to an absence of an intent to mislead (for commercial gain), the Respondent's choice of Domain Name, the dominant element being the Complainant's NIPRO trademark, with the addition of the descriptive word "shop", suggests the very opposite.

A respondent can also show that it is using a domain name in connection with a bona fide offering of goods or services. However, it seems clear that the Respondent set out to acquire a domain name that would create a misleading impression of association with the Complainant, which has then been used to resolve to a web shop advertising for sale a wide variety of products. These circumstances cannot amount to a bona fide offering of goods or services for the purposes of the Policy.

The Respondent has sought to create an impression of association with the Complainant and has chosen not to attempt to justify its actions. That, perhaps, is not surprising given that it appears to the Panel that there is very little the Respondent could say to challenge the Complainant's assertion that the Respondent lacks rights or legitimate interests in the Domain Name.

The Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of non-exclusive scenarios which may evidence a respondent's bad faith. They include, for instance, a respondent registering a domain name in order to prevent an owner of the trademark or service mark to which it is said to be confusingly similar or identical, from reflecting the mark in question in a corresponding domain name (provided that the respondent has engaged in a pattern of such conduct). A respondent registering a domain name primarily for the purposes of disrupting the business of a competitor is another scenario, as is a respondent intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it.

If circumstances are such as to indicate that a respondent has registered or 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 to a competitor of that complainant) for valuable consideration in excess of out-of-pocket costs directly related to the domain name, that too can be indicative of registration and use of a domain name in bad faith.

A complainant does not have to demonstrate a precise literal application of one of the paragraph 4(b) scenarios. They are non-exclusive and illustrative only, and as long as there is evidence demonstrating that a respondent is seeking to take unfair advantage of, or to abuse a complainant's trademark, such behaviour would satisfy the general principle underlying the bad faith requirement of the Policy.

The Complainant puts forward various arguments to support its contention of bad faith, some or all of which would constitute or support a finding of bad faith under the Policy. Given the worldwide reputation of the Complainant and its well-known NIPRO trademark, and the use to which the Domain Name has been put, it is clear that the Respondent was aware of the existence of the Complainant and its trademark at the time of registration of the Domain Name. The Respondent's use of the Domain Name to resolve to a misleading web shop demonstrates a clear intention to mislead consumers for commercial gain. In terms of paragraph 4(b), the Panel finds that the Respondent has intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it. More generally, it seems very likely that the Respondent's primary motive in registering and using the Domain Name was to capitalize on or otherwise take advantage of the Complainant's trademark rights, which also leads to a finding of bad faith.

In all the circumstances, the Panel finds that, for the purposes of the Policy, there is evidence of both registration and use of the Domain Name in bad faith.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <niproshop.com> be transferred to the Complainant.

/Jon Lang/

Jon Lang

Sole Panelist

Date: August 2, 2024