



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.:	HK-2001357
Complainant:	Bandai Spirits Co., Ltd.
Respondent:	Domain Admin/Domain Privacy Guard Sociedad Anónima Ltd.
Disputed Domain Name(s):	<banpresto.com>

1. The Parties and Contested Domain Name

The Complainant is Bandai Spirits Co., Ltd., of 5-29-11 Shiba, Minato-ku, Tokyo, Japan 108-0014.

The Respondent is Domain Admin/Domain Privacy Guard Sociedad Anónima Ltd., of #729, AZ Business Center, Avenida Perez, Chitre, Panamá, Panama 0395

The domain name at issue is <banpresto.com> (the “Domain Name”), registered by Respondent with PDR Ltd. d/b/a/ PublicDomainRegistry.com, of Unit No. 501, 5th floor and Unit IT Building No 3, NESCO IT Park, Western Express Highway, Goregaon (East), Mumbai Maharashtra 400063, India (“Registrar”).

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the “Center”) on May 22, 2020. On May 22, 2020, the Center transmitted by email to the Registrar a request for registrar verification for the Domain Name. On May 23, 2020, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 31, 2020 providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Complainant submitted the amended Complaint.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from April 28, 2016 (the “Supplemental Rules”).

Under Paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 4, 2020. Under Paragraph 5 of the Rules, the due date for filing a Response by the Respondent was June 24, 2020. The Respondent submitted no response by this deadline date.

The Center appointed Olga Zalomiy as the sole panelist in this matter on July 9, 2020. The Panel finds 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.

3. Factual background

The Complainant is a Japanese manufacturer of toys. The Complainant owns the following trademark registrations:

TRADEMARK	JURISDICTION/ TM OFFICE	REGISTRATION NUMBER	REGISTRATION DATE	IC CLASS
BANPRESTO	JP / JPO	2326967	August 30,1991	21
BANPRESTO	JP / JPO	3105299	December 26,1995	40
BANPRESTO	KR /KIPO	400255953000	December 15,1992	39
BANPRESTO	EU/EUIPO	000422832	February 22,1999	9, 41,42
BANPRESTO	US/USPTO	3254358	June 26,2007	9

The Respondent registered the Domain Name on November 24, 1998. The Domain Name does not resolve to an active website. In the past, the Domain Name used to resolve to a webpage that displayed pay-per-click links to the Complainant’s website as well as websites of third parties. The Domain Name is offered to the public for sale on a third-party platform at a price of 8,999 USD.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. The Complainant asserts that the Domain Name is identical to the Complainant’s BANPRESTO trademark because the Domain Name incorporates the Complainant’s BANPRESTO trademark in its entirety. The Complainant contends that the addition of the generic Top-Level Domain (“gTLD”) “.com” is viewed as a standard registration requirement and, as such, is disregarded under the confusing similarity test.
- ii. The Complainant alleges that the Respondent has no rights or legitimate interests in the Domain Name because the Complainant did not authorize or permitted the Respondent to use the BANPRESTO trademark or to register the Domain Name incorporating it. The Complainant contends that the Respondent is not commonly known by the Domain Name because its name does not resemble the Domain Name. The Complainant contends that the Respondent is using a privacy service to conceal its identity, which equates to lack of rights or legitimate interest in the

Domain Name. The Complainant asserts that the Respondent is not making a *bona fide* offering of goods or services or legitimate, noncommercial fair use of the Domain Name because it does not resolve to any active website. The Complainant contends that the Domain Name is offered for sale at Afternic domain name marketplace for 8,999 USD, which exceeds the Respondent's out-of-pocket expenses in registering the Domain Name. The Complainant asserts that in March of 2020, the Respondent tried to sell the Domain Name for 22,400 USD, which is an additional evidence of a lack of rights or legitimate interest. The Complainant alleges that even though the Domain Name was registered on November 25,1998, the Respondent became the owner of the Domain Name between October 7,2013 and October 9,2013.

- iii. The Complainant alleges that the Respondent registered the Domain Name in bad faith because it registered the Domain Name with the knowledge of the Complainant's trademark and the Complainant's business. The Complainant contends that because the Domain Name is identical to the Complainant's trademark, it is impossible that the Respondent selected the Domain Name without any knowledge of the Complainant and its trademark. The Complainant argues that the Respondent's passive holding of the Domain Name can be a factor in the finding of bad faith registration and use where no good faith use of the Domain Name is plausible. The Complainant alleges that the Respondent used to use the Domain Name to direct to a webpage that displayed pay-per click links. Further, the Complainant argues that the Respondent's offer to sell the Domain Name for consideration exceeding its out-of-pocket expenses, constitutes bad faith. The Complainant contends that the Respondent's use of the privacy service to conceal its identity also evidences its bad faith.

B. Respondent

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

5. Findings

It is a consensus view among UDRP panelists that “[a] respondent's default does not automatically result in a decision in favor of the complainant... [T]he complainant must establish each of the three elements required by paragraph 4(a) of the UDRP.”¹ A panel may draw inferences from a respondent's default.²

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

¹ Paragraph 4.2., WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”)

² Paragraph 4.3., WIPO Overview 3.0.

A) Identical / Confusingly Similar

To satisfy the first UDRP element, a domain name must be “identical or confusingly similar” to a trademark, in which a complainant has rights.

The Complainant has established its rights in the BANPRESTO trademark by submitting copies of BANPRESTO trademark registrations. Pursuant to section 1.2.1 of the WIPO Overview 3.0, “[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”. Therefore, the Complainant satisfied the UDRP standing requirement.

The Domain Name consists of the Complainant’s BANPRESTO trademark, and the gTLD “.com” “Where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”³ It is well-established, that the applicable gTLD should be disregarded under the confusingly similarity test as a standard registration requirement.⁴ Because the Domain Name consists of the entirety of the Complainant’s trademark and the gTLD should be disregarded from the assessment of confusing similarity, the Domain Name is identical to the Complainant’s BANPRESTO trademark.

Thus, the first element of the UDRP has been satisfied.

B) Rights and Legitimate Interests

Under the second UDRP element, a complainant must make a *prima facie* case in respect of the lack of rights or legitimate interests of the respondent⁵. Once the complainant has made out the *prima facie* case, the respondent carries the burden of producing evidence demonstrating it has rights or legitimate interests in the domain name⁶. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.⁷

Pursuant to paragraph 4(c) of the UDRP, the following may demonstrate rights or legitimate interests in the Domain Name:

- (i) before any notice of the dispute, the respondent’s 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) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

³ Section 1.7, WIPO Overview 3.0.

⁴ Section 1.11.1, WIPO Overview 3.0.

⁵ Section 2.1, WIPO Overview 3.0.

⁶ *Id.*

⁷ *Id.*

(iii) the respondent 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 Panel finds that the Complainant has made out *prima facie* case in respect of the lack of rights or legitimate interests of the Respondent. First, the Complainant has not authorized or licensed the Respondent to use the Complainant's BANPRESTO trademarks in any manner.

Second, the Respondent, whose identity is concealed by the privacy shield, is not commonly known by the Domain Name, which supports finding of a lack of rights or legitimate interests.

Third, the evidence on file shows that the Respondent is not using the Domain Name in connection with *bona fide* offering of goods or services or legitimate, noncommercial fair use of the Domain Name as the Domain Name is not resolving to an active website. The evidence submitted by the Complainant consists of a current screenshot of the website associated with the Domain Name that displays the message "This website can't be reached" and the December 7, 2018 screenshot of the website associated with the Domain Name, which shows that the website at the Domain Name used to display per-per-click ("PPC") links related to the Complainant's trademark as well as other PPC links. It is well-established that "the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users".⁸

Since the Respondent has failed to rebut the Complainant's case, the Panel holds that the second element of the UDRP has been satisfied.

C) Bad Faith

Under the third UDRP element, the Complainant is required to prove that the Domain Name was registered and is being used in bad faith.

The Complainant contends that the Respondent registered the Domain Name for bad faith purpose because the Domain Name is currently offered for sale for 8,999 USD on a third-party domain name marketplace. In general, "[c]ircumstances indicating that a domain name was registered for the bad-faith purpose of selling it to a trademark owner can be highly fact-specific; the nature of the domain name (e.g., whether a typo of a famous mark, a domain name wholly incorporating the relevant mark plus a geographic term or one related to the complainant's area of commercial activity, or a pure dictionary term) and the distinctiveness of trademark at issue, among other factors, are relevant to this inquiry".⁹

Here, the Respondent registered the Domain Name, which is identical to the distinctive BANPRESTO trademark, several years after the trademark was registered. Further, there is no evidence that the Respondent has an independent or a legitimate right to use the Domain Name that is identical to the Complainant's mark. Thus, it is likely that the Respondent registered the Domain Name to profit off the trademark's goodwill. These circumstances coupled with the Respondent's generalized attempt to sell the Domain Name through a

⁸ Section 2.9, WIPO Overview 3.0.

⁹ Section 3.1, WIPO Overview 3.0.

third-party platform for 8,999 USD, indicate that the Domain Name was registered for the bad faith purpose of selling it to the Complainant or its competitor.

It is well-established that non-use of a domain name would not prevent a finding of bad faith under certain circumstances. The following circumstances have been considered “relevant in applying the passive holding doctrine include:

- (i) the degree of distinctiveness or reputation of the complainant’s mark;
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use; and
- iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and
- (iv) the implausibility of any good faith use to which the domain name may be put”.¹⁰

All of those circumstances are present in this case. The Complainant’s mark is distinctive. The Respondent failed to submit a response or to provide any evidence of actual or contemplated good-faith use of the Domain Names. The Respondent concealed its identity under the privacy shield. In the Panel’s view, any good faith use of the Domain Names is implausible.

Therefore, the Panel finds that the Domain Name was registered and is being used in bad faith. The third element of the UDRP has been satisfied.

6. Decision

Under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <banpresto.com> be transferred to the Complainant.



Olga Zalomiy
Sole Panelist

Dated: July 14, 2020

¹⁰ Section 3.3. WIPO Overview 3.0.