



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2101487
Complainant:	Kabushiki Kaisha Dentsu Group (Dentsu Group Inc.)
Respondent:	yi bin shi
Disputed Domain Name(s):	<denstu.com>

1. The Parties and Contested Domain Name

The Complainant is Kabushiki Kaisha Dentsu Group (Dentsu Group Inc.), of 1-8-1 Higashi-Shimbashi, Minato-ku, Tokyo, 105-7050, Japan (“**Complainant**”).

The Respondent is yi bin shi, of jun lian xian mu ai zhen yao ba cun 6 zu 5 hao, si chuan Province, China (Postal Code: _645250) (“**Respondent**”).

The domain name at issue is <denstu.com> (“**Disputed Domain Name**”), registered by Respondent with DomainName Driveway, Inc., of Room 747, 7/F, Star House, 3 Salisbury Road, Tsim Sha Tsui, Kowloon, Hong Kong (“**Registrar**”).

2. Procedural History

On 14 July 2021, the Complainant submitted a complaint in English (“**Complaint**”) to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“**Centre**”) pursuant to the Uniform Domain Name Dispute Resolution Policy approved by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”) on 24 October 1999 (“**Policy**”), the Rules for the Policy approved by the ICANN Board of Directors on 28 September 2013 (“**Rules**”) and the Asian Domain Name Dispute Resolution Centre Supplemental Rules for the Policy and the Rules effective from 31 July 2015 (“**Supplemental Rules**”). The Complainant in the same email elected to have the Complaint decided by a single-member panel.

On 15 July 2021, the Centre notified the Registrar by email in respect of the Complaint and requested for a verification in connection with the Disputed Domain Name and requested a lock to be placed on the Disputed Domain Name. On the same day, the Centre acknowledged to the Complainant by email the receipt of the Complaint.

On 19 July 2021, the Centre sent an email to the Registrar to follow up on the Centre’s email dated 15 July 2021.

On 21 July 2021, the Centre sent an email to ICANN to seek assistance in eliciting information from the Registrar. On the same day, ICANN confirmed by email that the Centre’s email had been forwarded to the Registrar.

On 22 July 2021, the Centre sent an email to the Complainant to provide updates on the attempts and progress of contacting the Registrar. On the same day, the Registrar responded to the Centre by email and provided the requested information in respect of the Disputed Domain Name. The Centre subsequently sent a Notification of Deficiencies of the Complaint to the Complainant by email pursuant to Article 4 of the Rules and notified the Complainant that the information of the then respondent in the Complaint was different from the Whois information provided by the Registrar, and that the Complainant had 5 calendar days (i.e. until 27 July 2021) to rectify the deficiency. The Centre further sent an email in both English and Chinese to the Complainant on the same day to draw the Complainant's attention to Article 11(a) of the Rules and to point out that the language of the Registration Agreements of the Disputed Domain Name (i.e. Chinese) was different to the language used in the Complaint (i.e. English), and requested the Complainant to respond to this issue by 27 July 2021.

On 26 July 2021, the Complainant replied by email to the Centre to provide an updated Complaint to address the administrative deficiency and to request for the use of English as the language of proceedings.

On 27 July 2021, the Centre confirmed with the Complainant by email that the Complaint was in administrative compliance with the Policy and the Rules. The Centre also, on the same day, formally notified the Respondent of the Complaint and the proceedings commenced on 27 July 2021.

The Centre sent an email to the Respondent in respect of the issue on the language of proceedings and requested the Respondent to respond accordingly by 1 August 2021.

The Respondent did not submit any reply to the Centre regarding the issue on the language of proceedings by the required time limit (i.e. by 1 August 2021).

The Respondent did not submit any Response to the Centre by the required time limit within 20 calendar days as required under paragraph 5 of the Rules (i.e. by 16 August 2021).

On 17 August 2021, the Centre sent an email to the Parties to confirm that the Centre did not receive a Response from the Respondent within the required time limit (i.e. by 16 August 2021). On the same day, the Centre appointed Ms. Li Yee Man, Rosita as sole Panelist in this matter. The Panelist accepted the appointment and sent an email to the Centre to confirm that she could act as a sole Panelist in the Complaint and was in the position to act independently and impartially between the Parties.

On 18 August 2021, the Center informed the Parties by email that Ms Li had been appointed as the sole Panelist pursuant to the Policy, the Rules and the Supplemental Rules.

3. Factual background

3.1. Complainant

The Complainant is in the business of international advertising, marketing and public relations and offers an array of products and services in over 145 countries and regions. The Complainant has 11,000 clients worldwide (with a large proportion of the Complainant's agencies engaging in creative- and media-related works) and employs over 64,000 employees. The Complainant has made a revenue of HK\$60 billion (less cost of sales) in 2020. The Complainant was the sixth largest advertising agency group

in the world based on its revenue generated in 2019 and had also won numerous awards.

The Complainant and its group companies own a global portfolio (including but not limited to in Hong Kong S.A.R., People’s Republic of China, United States, European Union, Japan and United Kingdom) of trademarks incorporating “DENTSU”. For instance, the Complainant holds, including but not limited to, the following trademark registrations:

<u>Trademark</u>	<u>Jurisdiction</u>	<u>Class(es)</u>	<u>Filing Date</u> (<u>YYYY.MM.DD</u>)	<u>Filing /</u> <u>Registration</u> <u>Number</u>
dentsu	Hong Kong	9	2002.09.20	200407504
dentsu	Hong Kong	16,35,38, 41,42	2002.09.20	200407505AA
DENTSU	Hong Kong	9,16,35	1999.01.11	199916167AA
dentsu	PRC	9 16 24 25 28 35 36 37 38 39 40 41 42 43 44 45	2017.03.14	23131772 23131771 23131769 23131768 23131767 23131766 23131765 23131764 23131763 23131762 23131761 23131760 23131759 23131758 23131757 23131756
dentsu	PRC	7	2015.11.09	18286781
DENTSU	PRC	25	2004.12.15	4416111
dentsu	PRC	42 45 43 39 36 16 35 40 38 44 9 37 41	2003.07.03	G801916
DENTSU	PRC	35	1999.02.04	1427787

DENTSU	PRC	9	1999.02.04	1420474
DENTSU	PRC	16	1999.02.04	1407577
DENTSU	United States	16,35	1999.03.18	2653057
dentsu	United States	35,41,42	2002.06.18	3113364
dentsu	United Kingdom	9,16,35,36,37,38,39,40,41,42,43,44,45	2002.09.24	00902874972
DENTSU	United Kingdom	9,16,35	1999.02.17	00901078419
DENTSU	European Union	9,16,35	1999.02.17	001078419
DENTSU	Japan	35,36,37,38,39,40,41,42	2001.09.26	4710703
dentsu	Japan	9,11,14,16,18,20,21,24,25,28,34,35,36,37,38,39,40,41,42,43,44,45	2002.06.18	4777078

3.2. Respondent

The Respondent registered the Disputed Domain Name on 29 March 2021.

The Respondent did not file any Response within the required time limit.

4. Parties' Contentions

4.1. Complainant

The Complainant's contentions may be summarized as follows:

- (i) The Disputed Domain Name is highly confusingly similar to the Complainant's "DENTSU" trademarks and the Complainant's company name "Dentsu Group Inc.". By comparison, the Disputed Domain Name only has the letters "t" and "s" interchanged.
- (ii) The Complainant provides advertising and marketing services (including creative and media services). The Disputed Domain Name led to a webpage that displayed various Japanese obscene and indecent videos and images which could easily be considered as a type of media, misleading and causing confusion to the public that contents contained in the website of the Disputed Domain Name belonged to the Complainant and/or were associated with the Complainant.

- (iii) The Complainant did not give consent to the Respondent to use any of the Complainant's trademarks and the Respondent had no legitimate interests in the Disputed Domain Name.
- (iv) The Respondent was not related in any way to the Complainant and incorporated a domain name that was highly similar to the Complainant's trademarks so as to undermine the Complainant's reputation and goodwill.
- (v) Due to the fame of the Complainant's Trade Marks and the high degree of similarity between the Disputed Domain Name and the Complainant's trademarks, it is highly unlikely that the Respondent was not aware of the Complainant when the Disputed Domain Name was registered, and that the fame of the Complainant must likely be one of the reasons that the Respondent registered the Disputed Domain Name. In addition, the Respondent had both actual and constructive knowledge of the Complainant's rights and the Respondent had registered the Disputed Domain Name in bad faith.
- (vi) The Respondent had not acquired any trademark rights in the Disputed Domain Name.
- (vii) The Respondent has not made a legitimate non-commercial or fair use of the Disputed Domain Name. By providing a number of "pay per click" links that led to a number of websites offering access to sexual contents or online gambling services, the Respondent was holding the Disputed Domain Name with an aim to seek commercial gain from the Complainant and/or the Complainant's consumers, and to benefit the Respondent financially. Neither the Respondent nor its activities had any legitimate connection with the name and marks of "DENTSU". The Complainant's trademarks, goodwill and reputation are likely to become tarnished and diluted. The Respondent was not using the Disputed Domain Name in connection with a bona fide offering of goods and services, which indicated a lack of legitimate rights and that the Respondent's use of the Disputed Domain Name amounted to bad faith.
- (viii) The Respondent's use of the Disputed Domain Name to publish obscene and indecent contents would undermine the goodwill and reputation established by the Complainant in the past 66 years and deprived the Respondent of the character of being bona fide use. Hence, the Respondent's use and registration of the Disputed Domain Name can be considered as "cyber-squatting".
- (ix) The Complainant relied on its global reputation to support its claim against the Respondent in respect of its bad faith. Given the well-known nature of the "DENTSU" marks and the Complainant's involvement in the advertising and marketing sector, any attempt to actively use the Disputed Domain Name would inevitably lead to a likelihood of confusion. The Respondent should have been aware of the Complainant's reputation and goodwill and conducted diligent searches before the registration of the Disputed Domain Name.
- (x) The Respondent's bad faith can be found when the Respondent engaged in mere passive use of the Disputed Domain Name.

4.2. Respondent

The Respondent did not file a Response to the Complainant's contentions within the required time limit.

5. Findings

5.1. Administrative Issue

(i) *Language of Proceedings*

Paragraph 11(a) of the Rules provides that “[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceedings”.

The Panel notes that a copy of the relevant Registration Agreement was not submitted as supporting document. According to the Registrar’s email to the Centre dated 22 July 2021, the relevant Registration Agreement was in Chinese.

The Panel notes that the Complaint was submitted in English and the Complainant requested the proceedings to be conducted in English for the following reasons as set out in its email to the Centre dated 26 July 2021:

- Being a company based in Japan, and although [the Complainant] has established business interests in Hong Kong and Mainland China, Chinese is not a language normally used by the Complainant [and] the staff members handling this matter;
- [The] name and mark in question are non-Chinese language marks;
- The majority of the supporting documents and search results are in English; and
- It would not be cost effective or practical to arrange Chinese translations of all supporting documents and search results.

Despite the Centre’s email to the Respondent dated 27 July 2021 to request for a reply to the Complainant’s request for the proceedings to be conducted in English, the Respondent did not provide any reply within the time limit (i.e. by 1 August 2021).

Having considered the circumstances of the proceedings (including the Complainant’s submissions above) and given that there was no contention on the issue between the Parties, the Panel determines that the proceedings should be conducted in English.

5.2 Substantive Issues

Paragraph 4(a) of the Policy provides that each of the following three findings must be made in order for a Complainant to prevail:

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

(i) *Identical / Confusingly Similar*

The Panel will only consider the first part of the Disputed Domain Name (i.e. “denstu”) as it has been well-established that “.com” in a generic top-level domain does not form part of the relevant assessment.

The Complainant had demonstrated that it was the holder of various national and regional trademarks incorporating “DENTSU” at the time of the registration of the Disputed Domain Name and of the filing of the Complaint.

As pointed out by the Complainant, there is only a trivial difference between “denstu” in the Disputed Domain Name and the Complainant’s “DENTSU” mark, with only the letters “s” and “t” interchanged. The Panel considers that such slight difference is likely to be negligible and the Disputed Domain Name is confusingly similar to the Complainant’s trademarks.

The Complainant owns a global portfolio of “DENTSU” trademarks in jurisdictions such as (including but not limited to) Hong Kong S.A.R., People’s Republic of China, United States, European Union, Japan and United Kingdom, and most of the trademark registrations were registered before the registration date of the Disputed Domain Name (i.e. 29 March 2021).

The Complainant also claimed that it owned the domain name <dentsu.com>. However, the Complainant did not provide any evidence of ownership of the said domain name. In any event, the lack of evidence in this regard does not affect the Complainant’s position that it owns a global trademark portfolio of the “DENTSU” marks.

Accordingly, the Panel is of the view that the Disputed Domain Name is confusingly similar to the Complainant’s trademarks and the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

(ii) *Rights and Legitimate Interests*

The Panel notes that the Complainant provided evidences showing that the Disputed Domain Name resolved to a website offering advertising, media and sexual content. The Panel also notes that the Complainant had reported to the Hong Kong Police regarding the child pornography and obscene content that could also be found on the said website. Considering the aforesaid, the Panel is of the view that the Respondent did not use the Disputed Domain Name in connection with a bona fide offering of goods and services.

The Panel takes into account that the Complainant’s “DENTSU” trademarks were registered and the corresponding goodwill and reputation were accrued years before the registration of the Disputed Domain Name. The Panel also notes that the Complainant did not provide consent to or authorize the Respondent to use its trademarks and/or any similar marks, and that the Respondent was not in any way related to the Complainant. There is no evidence put forward to support that the Respondent had been commonly known by the Disputed Domain Name.

The “pay per click” links found on the website led by the Disputed Domain Name manifested a commercial use of the Disputed Domain Name. This follows that, as the Panel had found that the Disputed Domain Name and the Complainant’s “DENTSU” marks to be confusingly similar, the criminal or illicit contents found

on the relevant website are likely to misleadingly divert consumers with intent for commercial gain or tarnish the Complainant's trademarks.

The above suggests, to the least, none of the non-exhaustive "defenses" specifically listed out in Paragraph 4(c) of the Policy was met. As the Respondent did not file any Response, there was no evidence or argument being put forward by the Respondent to the Panel for a determination that the Respondent has rights and legitimate interests in the Disputed Domain Name.

Having considered all circumstances, the Panel considers that the Complainant had established a prima facie case that the Respondent has no rights and legitimate interests in respect of the Disputed Domain Name.

Accordingly, the Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

(iii) *Bad Faith*

For the same reasons set out in 5(ii) above, strong inferences can be drawn against the Respondent that the Disputed Domain Name were registered and had been used in bad faith.

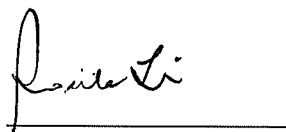
Further to the Panel's view on the negligible difference between the Disputed Domain Name and the Complainant's "DENTSU" marks, the Complainant's accrued goodwill and reputation in its "DENTSU" marks on a global basis in respect of its advertising and marketing businesses likewise support that the registration of the Disputed Domain Name is a form of "typo-squatting", and any competing commercial activities in the website of the Disputed Domain Name (such as the "pay per click" links") aim at confusing unsuspected Internet users as to the source, sponsorship, affiliation or endorsement of the website of the Disputed Domain Name.

In the absence of evidence provided by the Respondent showing the contrary and pursuant to Paragraph 4(b) of the Policy, the Panel is of the view that the Respondent had knowledge of the global fame of the Complainant's "DENTSU" marks and the Respondent had taken unfair advantage of the Complainant's "DENTSU" trademarks.

Accordingly, the Complainant has satisfied Paragraph 4(a)(iii) of the Policy.

6. Decision

For the reasons set out above and pursuant to Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the registration of the domain name <denstu.com> be transferred to the Complainant.



Li Yee Man, Rosita
Sole Panelist

Dated: 1 September 2021