

ADMINISTRATIVE PANEL DECISION

Mizuno Corporation v. Client Care, Web Commerce Communications Limited
Case No. D2024-0164

1. The Parties

The Complainant is Mizuno Corporation, Japan, represented by Demys Limited, United Kingdom.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <mizunoargentinaonline.com>, <mizunoaustralia-sale.com>, <mizunoaustria.com>, <mizuno-belgie.com>, <mizunobudapest.com>, <mizuno-costarica.com>, <mizuno-finland.com>, <mizunogolfnederland.com>, <mizuno-hrvatska.com>, <mizuno-norway.com>, <mizuno-outlet-greece.com>, <mizunoutlet-turkiye.com>, <mizunoportugal-lojas.com>, <mizuno-ro.com>, <mizunoshoes-store.com>, <mizuno-shoesuk.com>, <mizuno-sko.com>, <mizuno-slovenia.com>, <mizunosrbija.com>, <mizunoswitzerland.com>, <mizunouk-store.com>, <mizunousa-outlet.com> and <tienda-mizunochile.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 16, 2024. On January 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 17, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 22, 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 January 25, 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 January 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 19, 2024.

The Center appointed Zoltán Takács as the sole panelist in this matter on February 26, 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

The Complainant is a Japanese sports equipment and sportswear company founded in 1906 by Mizuno brothers.

The Complainant employs over 3,400 people with offices across Europe, Asia, North America and Oceania.

The Complainant owns numerous trademarks around the world for sports equipment and sportswear consisting or comprising MIZUNO, including:

- the Swiss Trademark Registration No. 2P-313963 for the word mark MIZUNO registered since February 25, 1982; and
- the United States Trademark Registration No. 2163515 for the figurative mark MIZUNO registered since June 9, 1998.

The Complainant operates official regional websites to which Internet users are redirected from the Complainant's primary domain name <mizuno.com> which was registered on November 26, 1996.

All the 23 disputed domain names were registered on April 7, 2023.

At the time of filing of the Complaint, 15 disputed domain names, namely <mizunoargentinaonline.com>, <mizunoaustralia-sale.com>, <mizuno-belgie.com>, <mizuno-finland.com>, <mizunogolfnederland.com>, <mizuno-hrvatska.com>, <mizunoutlet-turkiye.com>, <mizuno-ro.com>, <mizunoshoes-store.com>, <mizuno-shoesuk.com>, <mizuno-slovenia.com>, <mizunosrbija.com>, <mizunouk-store.com>, <mizunousa-outlet.com> and <tienda-mizunochile.com> were resolved to websites with similar designs featuring the Complainant's MIZUNO figurative trademark, products photographs and descriptions and marketing images and allegedly offered for sale the Complainant's products.

The remaining eight disputed domain names, namely <mizunoaustria.com>, <mizunobudapest.com>, <mizuno-costarica.com>, <mizuno-norway.com>, <mizuno-outlet-greece.com>, <mizunoportugal-lojas.com>, <mizuno-sko.com> and <mizunoswitzerland.com> have not resolved to active websites.

Currently none of the disputed domain names resolve to active websites.

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 disputed domain names.

Notably, the Complainant contends that

- the disputed domain names are confusingly similar to its MIZUNO trademark since all incorporate it with the addition of various generic and descriptive terms;
- the Respondent has no rights or legitimate interests in respect of the disputed domain names and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy;
- given the reputation of the Complainant and widespread use of its MIZUNO mark, the Respondent was most likely aware of the mark at registration of the disputed domain names and has used them to target the reputation and goodwill built up by the Complainant in the MIZUNO mark.

The Complainant requests that the disputed domain names be transferred from the Respondent to the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Matter – Multiple Domain Names

The Complaint was filed regarding 23 disputed domain names.

The Panel notes that paragraph 3(c) of the Rules provides that a complaint may relate to more than one domain name provided that the domain names are registered by the same domain name holder.

Since the disputed domain names were registered by the same Respondent, the Panel finds that this requirement is fulfilled.

6.2 Substantive Matters – Three Elements

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that:

- (i) the domain names are identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain names; and
- (iii) the domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainant's MIZUNO mark is reproduced and is clearly recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The difference between the trademark and the disputed domain names is the mere addition of hyphens and:

- terms such as "Argentina", "Australia", "Austria", "Belgie ("Belgium" in Dutch)", "Budapest", "Costa Rica", "Finland", "Nederland ("the Netherlands (Kingdom of)" in Dutch)", "Hrvatska ("Croatia" in Croatian)", "Norway", "Greece", "Turkiye", "Portugal", "Slovenia", "Srbija ("Serbia" in Serbian)", "Switzerland" and "Chile";
- various elements such as terms "online", "sale", "golf", "outlet", "lojas ("stores" in Portuguese), "shoes", "store", "sko ("shoe" in Danish) and "tienda ("shop" in Spanish); and
- two-letter international country codes "ro" (Romania), "uk" (United Kingdom) and the term "usa" (abbreviation for the United States of America).

Although the addition of the above-mentioned terms may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

As per the record set out above, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

While it is unclear whether the goods offered at the websites to which 15 out of the 23 disputed domain names resolved were even available, the Complainant has shown that the Respondent effectively impersonated the Complainant by using these disputed domain names to confuse Internet users presumably looking for the Complainant through directing them to its own, similarly looking websites which have prominently displayed the Complainant's MIZUNO figurative trademark and the Complainant's copyrighted materials such as product photographs, descriptions and marketing images.

Panels have held that the use of a domain name for illegal activity, here impersonation/passing off can never confer any rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

As mentioned above, the remaining eight disputed domain names have been passively held by the Respondent. Passive holding of a disputed domain name is neither a bona fide offering of goods nor a legitimate noncommercial or fair use and as such cannot confer any rights or legitimate interests in a domain name.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the disputed domain names reproduce the Complainant's inherently distinctive MIZUNO mark. A basic Internet search for MIZUNO returns solely the Complainant and its business.

As mentioned above, the Respondent used 15 disputed domain names for similarly looking websites which have prominently displayed the Complainant's MIZUNO figurative trademark and the Complainant's copyrighted materials. Thus, in view of the Panel it is improbable that the Respondent registered the disputed domain names without knowledge of the Complainant and its mark and for any other purpose than to target the Complainant and the mark through impersonation or false association. Such activity is illegal and constitutes bad faith under the Policy. [WIPO Overview 3.0](#), section 3.4.

The remaining eight disputed domain names appear to have not been used for active websites and currently all disputed domain names appear to be inactive. However, this does not prevent a finding of bad faith when considering the totality of the circumstances. [WIPO Overview 3.0](#), section 3.3. Given the distinctiveness of the Complainant's MIZUNO mark; the composition of the disputed domain names as mentioned above; the Respondent's failure to respond to the Complaint and provide any good faith explanation as to its registration and use of the disputed domain names, and the implausibility of any good faith use to which the disputed domain names may be put. These factors lead the Panel to conclude that the passive holding of the disputed domain names does not prevent a finding of bad faith.

The Panel finds that the Complainant has established the third element 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 names <mizunoargentinaonline.com>, <mizunoaustralia-sale.com>, <mizunoaustria.com>, <mizuno-belgie.com>, <mizunobudapest.com>, <mizuno-costarica.com>, <mizuno-finland.com>, <mizunogolfnederland.com>, <mizuno-hrvatska.com>, <mizuno-norway.com>, <mizuno-outlet-greece.com>, <mizunoutlet-turkiye.com>, <mizunoportugal-lojas.com>, <mizuno-ro.com>, <mizunoshoes-store.com>, <mizuno-shoesuk.com>, <mizuno-sko.com>, <mizuno-slovenia.com>, <mizunosrbija.com>, <mizunoswitzerland.com>, <mizunouk-store.com>, <mizunousa-outlet.com> and <tienda-mizunochile.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: March 11, 2024