

DISPUTE RESOLUTION SERVICE

D00021382

Decision of Independent Expert

Zojirushi Corporation

and

Neil Easton

1. The Parties

Complainant: Zojirushi Corporation
20-5, 1-Chome
Tenma
Kita-Ku
Osaka
Japan

Respondent: Neil Easton
103b High Street
Beeston
Nottinghamshire
NG9 2LH
United Kingdom

2. The Domain Name

zojirushi.co.uk

3. Procedural History

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such

a nature as to call in to question my independence in the eyes of one or both of the parties.

The following is a brief procedural history: -

07 May 2019	Complaint received by Nominet;
08 May 2019	Complaint validated, notification of complaint sent to the parties, by Nominet;
28 May 2019	Response reminder sent by Nominet and Response received; Notification of response sent to parties;
31 May 2019	Reply reminder sent by Nominet;
05 June 2019	No Reply received, mediator appointed;
11 July 2019	Mediation failed;
19 July 2019	Expert decision payment received by Nominet.

4. Factual Background

The Complainant is a Japanese corporation, founded in 1918. It manufactures and markets internationally consumer electronic goods, such as rice cookers, bread machines and kettles. Its goods are exported to many countries, though not the UK.

The Domain Name was registered on 3 June 2017 and resolves to a website that refers to goods made by the Complainant ('the Website'). Visitors may click though to another website, 'yumasia.co.uk', that is neither owned by nor associated with the Complainant ('the Yum Asia Website'), where goods made by the Complainant and other similar goods not made by the Complainant are available for sale.

5. Parties' Contentions

The Complaint

The Complaint alleges as follows. The name 'Zojirushi' is not known to be used by any business other than that of the the Complainant. The word has no specific meaning in the English language.

The Complainant owns a number of trade marks in various jurisdictions that incorporate the word 'zojirushi', including UK registered trade marks. Copies of the registration documents are annexed to the Complaint. The trade marks all 'pre-dated' the date of registration of the Domain Name.

The Domain Name is identical to the word element of those trade marks, which itself is identical to the name of the Complainant.

The Website is used to provide some information about the Complainant and is 'marketed as "Zojirushi in the UK and Europe"'. This could easily mislead the average Internet user into believing that the Website is an official website of the Complainant, creating a risk of consumer confusion.

The Yum Asia Website advertises the Complainant's products and also those of trade competitors, including products branded as 'Yum Asia.' All references on the Website to goods made by the Complainant re-direct users to the Yum Asia Website.

Therefore, Internet users who access the Domain Name, believing they are visiting an official and/or authorised website of the Complainant could end up buying products competing with those of the Complainant, believing they were buying Zojirushi products.

The commercial relationship between the owner of the Domain Name and the Yum Asia Website is not clear. However, the circumstances indicate that the owner derives some commercial advantage from the redirection.

The Respondent has selected the Domain Name in order to attract potential customers from operation of the Website to a third-party online shopping website (i.e. the Yum Asia Website), where competitors' products are offered for sale.

The Response

The Response alleges as follows. The Respondent registered the Domain Name as an informational and tribute site. There are no affiliate links, monetary links or commercial activity at all.

The Website only gives links to persons who wish to buy the Zojirushi products referred to.

The Respondent does accept that five of the fifteen links resolve to the home page of a third-party website, a Facebook page or a recipe site. These can easily be removed. However, it is unlikely that the average Internet user would be confused by those links being on the Website.

The Respondent also asks, 'How can I be sure this is Zojirushi'? The name of the claimant on the documents is James Sanderson. It seems odd that a large Japanese corporation with an international in-house legal department should not itself be conducting these DRS proceedings.

There are also troubling discrepancies between the address of Zojirushi given for the purposes of these proceedings and that referred to in other documents. The fact that copies of trade mark registration documents have been submitted with the Complaint tells one nothing about the authority of James Sanderson, as these are public documents.

The Respondent asks further, 'Why has James Sanderson put his name as the claimant, when it should, by rights, be the person within Zojirushi that has the right to do so and then stated that James Sanderson is representing Zojirushi'?

It is quite possible that the Complaint has been made by someone impersonating Zojirushi, who is trying to destroy the Respondent's informational and tribute website, because it paints Zojirushi's products in such glowing terms.

The Respondent's use of the Domain Name is fair for the purposes of the DRS Policy ('the Policy'). The operations of the Website fall within paragraph 8.2 of the Policy (tribute sites). No commerce is conducted on the Website. It is purely informational and a tribute – to the point that Zojirushi products are available for sale in the UK and Europe.

The Complainant cannot succeed under paragraph 5.1.1.3 of the Policy, because Zojirushi does not carry on business in the UK. Therefore, there is no damage to or disruption of their business.

The Website promotes only Zojirushi products. If you click on each product, there is a re-direct to the Third-Party Website, but only to the corresponding Zojirushi product pages, as evidenced by the screen-shots accompanying the Response. No-one is likely to be misled.

In Annex 2 to the Complaint, the Complainant has misrepresented the nature of the links, by suggesting that all product links go to the home page of the Yum Asia Website. That is not so. The vast majority go straight to a specific Zojirushi product page.

As indicated at the outset of the Response, the Respondent does accept that five of the fifteen links do resolve to the home page of a third-party site. The content of the home page of the Yum Asia Website clearly distinguishes between products made by Zojirushi and those that are not made by it.

The Complainant is also wrong to state that persons could inadvertently end up buying goods made by Zojirushi's competitors. It is inconceivable that any Internet user would think that any third-party product is a Zojirushi product or *vice versa*. The difference between the products is made clear.

In fact, the Website actually harms Zojirushi's competitor(s), because it pays tribute to Zojirushi's products.

It is odd that the Respondent's tribute site is a problem for Zojirushi. The Website promotes its products in markets where there is scant information available and in which the corporation does not operate.

If, contrary to the Respondent's arguments, the Domain Name is to be transferred, the Respondent would wish to see evidence that James Sanderson is working on behalf of Zojirushi Corporation and has the right to dispute ownership of the Domain Name.

Reply

No Reply was served.

Request for Information under Paragraph 17 of the Policy

In view of correspondence on the electronic case file from Nominet to Mr James Sanderson of Sandersons, I conducted an Internet search of Sandersons as I was not

aware of who or what they are. The search (see below) resolved to a website that identified Sandersons as trade mark attorneys, based in the UK.

The following paragraph 17 request under the Policy was issued by Nominet at my request on 30 July 2019, -

(1) The Respondent is referred to the attached copy letter dated 8 May 2019 sent by Nominet to Mr James Sanderson and stated to have been copied to him. That letter refers to the following address for James Sanderson, namely 'Sandersons, D2 Knowledge Gateway, Nesfield Road, Colchester, UK C04 3ZL.' The website at 'sandersons.co.uk' gives the following address, namely 'Unit 2 Block D, Knowledge Gateway, Nesfield Road, Colchester, C04 3ZL', identifies Sandersons as patent and trade mark attorneys and identifies James Sanderson as a or the partner of that firm.

*(2) In those circumstances in particular, **the Respondent is requested to state in writing by 4pm on Monday, 5 August 2019** why the Expert should not conclude that the Complainant has instructed Mr James Sanderson and/or Sandersons to file the Complaint and act on its behalf in these DRS proceedings?*

*(3) **The Complainant is requested to supply Annex 4 to the Complaint by 4pm on Thursday 1 August 2019**, it appearing not to have accompanied the Complaint.*

*(4) **The Respondent may make any written observations in relation to Annex 4 (including any with reference to the matters in (1) and (2) above) by 4pm on Monday 5 August 2019.***

Annex 4 was received by Nominet on 31 July 2019 by email, copied to the Respondent, who sent a response to Nominet and to Sandersons by email dated 4 August 2019. The response read as follows, -

I think you have misunderstood my previous comments because I am not disputing who James Sanderson is, I am questioning if he has the right to act on behalf of Zojirushi Corporation.

During the mediation process I raised the fact that neither I or [sic] Nominet have seen any kind of proof that Zojirushi Corporation have instructed Mr Sanderson to act on their behalf. All of the information in the annexes provided by Mr Sanderson can be found by general online Google searches, there is nothing unique about the information he has provided – I can find this online also. Added to this, Mr Sanderson has the incorrect address for Zojirushi Corporation, which, if he was acting on their behalf, he would have the correct address?

I contacted Zojirushi Corporation in Japan myself to ask about this dispute and the international IP department could not confirm that Mr Sanderson was acting on their behalf. I find it very concerning that Nominet have allowed this dispute to get this far into the process without checking Mr Sanderson's letter of instruction from Zojirushi Corporation who are the rights holder. I am sure if it was the other way around and I was disputing a domain in this manner, I would be immediately asked for proof that I was acting on behalf of the rights holder. [Just] because he is well known to Nominet, it seems that the correct procedures have not been followed which is biased and prejudicial. The process so far has been flawed in this respect because during

mediation, it was the only thing I asked for before this matter was settled and Mr Sanderson could not or would not provide the proof that he is acting on behalf of the rights holder, Zojirushi Corporation.

Given that Mr Sanderson is a partner in Sanderson's patent and trade mark attorneys company I would say he is well aware of the importance of the burden of proof in a case like this and as he hasn't submitted any kind of evidence he is acting on behalf of Zojirushi Corporation and the information in the annexes is all in publicly searchable databases, this is what makes me doubt that he is acting on behalf of the rights holder. There is also a chance that this may be a malicious entity impersonating Zojirushi Corporation to get this tribute site taken down, if no proof has been provided that Mr Sanderson is acting on Zojirushi Corporation, how can I be sure this dispute is legitimate.

6. Discussion and Findings

Does Sandersons have authority to make the Complaint?

The Complaint has been made by Sandersons, a firm of trade mark attorneys. The Complainant is stated to be Zojirushi Corporation. The Complaint states that its author is James Sanderson, who is a partner in Sandersons.

Contrary to what is stated in the Response, it is not surprising that a substantial international commercial enterprise engages outside lawyers to conduct proceedings on its behalf. Further, Nominet is a UK jurisdiction, the Complainant is based in Japan and is not trading in the UK, rendering it even more likely that Zojirushi Corporation would engage a specialist firm to represent it in these proceedings.

The Respondent has speculated that the Complaint has been made without the authority of the named Complainant. The possible reason advanced in the Response is that the person or business behind the Complaint is some '*malicious entity trying to destroy my tribute and informational site*'. The Respondent has not even suggested who that person might be. The Response asserts that the '[C]omplaint may actually be going against the wishes of Zojirushi.' The Respondent says that when he contacted the Zojirushi Corporation, their IP department could not confirm that Mr Sanderson had been authorised to act on its behalf. However, the Respondent does not assert that he was told that the Complaint was not that of Zojirushi Corporation.

In those circumstances, I am satisfied that the Complaint has been properly made, by Sandersons on behalf of Zojirushi Corporation. I add that the DRS Experts are distinct from Nominet and are required to be independent and impartial in their decision-making. As indicated above, I had not heard of Sandersons and that is why I made an Internet search that then formed part of the Paragraph 17 request. At the conclusion of the Response, surprise is expressed that Zojirushi Corporation should be concerned about what is a 'tribute' site. In view of the conclusions I have reached on the substance of the Complaint (see below), there is nothing surprising about Zojirushi Corporation being concerned about the Domain Name and seeking its transfer in these DRS Proceedings.

Introduction

I have taken into account all the facts and matters relied on by each party but have limited the findings in this decision to those necessary to dispose of the dispute in accordance with the Policy. Therefore, it is not necessary to resolve all the issues raised by the parties.

I refer to, and repeat as findings, the contents of section 4 above.

What Must a Complainant Prove to Succeed in a Complaint?

A complainant is required under subparagraphs 2.1 and 2.2 of the Policy to prove on the balance of probabilities that the following two elements are present, namely: -

- he has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

By paragraph 1 of the Policy, -

‘Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.’

The Complainant has produced the results of a trade mark search issued by the Intellectual Property Office relating to trade mark registration number UK00002060737, registered on 29 November 1996 and owned by Zojirushi Corporation, showing a renewal date of 12 March 2026.

The trade mark consists of a stylised representation of ‘ZOJIRUSHI’ (consisting of a Saturn-like ring around the ‘O’) accompanied by an image of an elephant, for goods in Classes 7, 11 and 21. The ‘Mark Details’ state that “the word appearing in the mark is the transliteration of Japanese characters meaning ‘Sign of the Elephant.’”

Therefore, the Complainant has established that it is the owner of that trade mark and has Rights in respect of it. The mark is similar to the Domain Name, because it includes the word ‘ZOJIRUSHI.’

As a result, the Complainant has established Rights in respect of a name or mark which is identical or similar to the Domain Name. Accordingly, the Complainant has established that it owns Rights.

Abusive Registration

By paragraph 1 of the Policy, -

*‘an **Abusive Registration** means a Domain Name which either:*

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.’*

By paragraph 5 of the Policy, -

5. Evidence of Abusive Registration

‘5.1 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

.....’

Paragraph 8 of the Policy provides as follows, -

‘8. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

8.1 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

8.1.1 Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

8.1.1.1 used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

8.1.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or

8.1.1.3 made legitimate non-commercial or fair use of the Domain Name.

.....

8.2 Fair use may include sites operated solely in tribute to or criticism of a person or business.

.....'

I start with the Domain Name itself. Ignoring the country code suffix “.co.uk” for this purpose, the Domain Name is identical to “Zojirushi”, the dominant part of the Complainant’s trade mark. Internet users searching for the Complainant in the UK would be likely to believe that the Domain Name represented the online presence of the Complainant, that the Domain Name was owned and operated or authorised by the Complainant.

On arriving at the Website, what would they see? The home page of the Website is headed, ‘ZOJIRUSHI IN THE UK AND EUROPE’ and states,

‘Who are Zojirushi? Where can I find out more information about Zojirushi products? Where can I buy Zojirushi in the UK and Europe?’

There then appear two boxes, ‘LEARN MORE’ and ‘SHOP NOW’.

The Website also features pictures of Zojirushi products. A click on the image of those products takes the visitor to the Website to the corresponding page on the Yum Asia Website where that Zojirushi product is available for sale.

A click on ‘SHOP NOW’ takes the visitor to the Yum Asia Website, which advertises Zojirushi products and other products. These include rice cookers made by Zojirushi and those of Yum Asia, a business that also sells rice cookers.

The Respondent says that the Website is a tribute site. It is not. It is part of a commercial operation to advertise and sell Zojirushi and other products of the type

made by Zojirushi. The extolling of the Complainant and its products (i.e. the tribute and informational matters relied on by the Respondent) are in truth marketing as part of that commercial enterprise.

The Respondent has not explained his connection with the Yum Asia Website. The absence of such an explanation, his ability to control the links from the Website and the invitation on that site to buy goods that are available for sale on the Yum Asia Website justify the inference that the Respondent has a commercial interest in the Yum Asia Website.

Even if the Website were a tribute site, which it is not, the use is not solely one of tribute as required by paragraph 8.2. In particular, the invitation to ‘shop now’ takes the use outside that provision on the DRS.

A further reason why the use does not fall within paragraph 8.2 arises from two decisions in particular of the DRS Appeal Panel. In DRS 02193 (guidestar.co.uk), the Appeal Panel stated that:

"Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and intending that it should be recognised as the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is.

Rarely will it be the case that deliberate impersonation of this kind will be acceptable under the DRS Policy. Various decisions under the DRS Policy have condemned such practices including the following:

*"In the view of the majority of the Panel, in the context of a tribute site, the vice is in selecting a domain name, which is not one's own name, but which to one's knowledge is identical to the name of another, which one has selected precisely because it is the name of that other and for a purpose which is directly related to that other. For a tribute or criticism site, it is not necessary to select the precise name of the person to whom one wishes to pay tribute or criticise. In this case the domain name could have been 'ilovescoobydoo.co.uk', for example.
..... [Appeal decision DRS 00389 – scoobydoo.co.uk]."*

In DRS 06284 (rayden-engineering.co.uk) the Appeal Panel found that registration of that domain name was not justified as a criticism site, there being no exceptional circumstances so as to justify an unadorned use of the complainant's name Rayden Engineering.

Although it is possible for an unadorned use to fall within paragraph 8.2, it will take an unusual case for this to be so. That is because the registrant can make their point, if making a genuine tribute for example, by registering a domain name with a suitable identifier to make clear that it is a tribute site. There is nothing in the circumstances of this case to justify the choice and unadorned use of zojirushi, for what is essentially a purely commercial operation.

Not all uses of a complainant's name or mark are unfair under the DRS. There are a number of decisions of the Appeal Panel under the DRS relating to resellers, distributors and the like.

In this case, the Respondent is party to a commercial enterprise that makes use of the Domain Name to engage in the resale of goods made by Zojirushi.

The choice of 'zojirushi' (a name uniquely referable to the Complainant's business and a dominant part of the trade mark) to identify the Domain Name is likely to draw in the maximum number of people who might wish to find information about or buy goods of, the Complainant. They are likely to be drawn in by 'initial interest confusion', believing that the Domain Name is owned or authorised by the Complainant. No attempt has been made to differentiate the Domain Name by an identifier that might distinguish it from a domain name associated with the Complainant.

Once at the Website, the visitor's confusion is unlikely to be dispelled. That person is likely to assume that the Website is operated by the Complainant or by its authorised UK and European distributor(s) or by one of its authorised distributors. That is not the case.

The usage is made even more unfair by using the Domain Name to draw in those customers and to then offer them a choice that includes goods of the type sold by the Complainant but made by another or other manufacturers. The fact that the Complainant is not presently trading in the UK is not to the point. A trade mark owner may not wish to trade in a particular market or may have its own plans to do so. Even if it does wish to authorise the sale of its goods in a territory, it will often wish to appoint a distributor or distributors of its own choice.

In considering whether use of a domain name is fair in context, the choice of domain name is again a key consideration: see the Appeal Panel decisions in, for example, D00000248 ('seikoshop.co.uk') and D00016416 (wwe-shop.co.uk). It is highly relevant that there is no attempt to dispel confusion by use of suitable identifier in the Domain Name. Use of the Domain Name to draw Internet users to the Website that then directs them to a commercial website is itself clearly taking unfair advantage of the Complainant's Rights.

The upshot is that Internet users are likely to be confused into believing that the Website is owned and operated or authorised by the Complainant and that the Website is the online location to find out information about the Complainant's products and that visitors to that website can then buy those products or similar products made by other manufacturers at an associated website, i.e. the Yum Asia Website.

In those circumstances, use of the Domain Name cannot be justified as a legitimate means of promoting the sale of genuine goods of the Complainant.

Therefore, I find that the Domain Name has been used in a manner which has taken unfair advantage of, and has been unfairly detrimental to, the Complainant's Rights; and find that the Domain Name, in the hands of the Respondent, is therefore an Abusive Registration.

Decision

The Complainant has Rights in a name or mark, which is similar to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration.

Therefore, the Expert determines that the Domain Name 'zojirushi.co.uk' be transferred to the Complainant.

Signed

Dated 12.08.19

STEPHEN BATE