



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Fall Nummer: D2003-0616

Entscheidung vom 29. September 2003

1. The Parties

The Complainant is Sony, Japan.

The Respondent is Sonydesign.Com, of Niigata, Japan.

2. The Domain Name and Registrar

The disputed domain name <sonydesign.com> is registered with Gandi SARL.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 6, 2003. On August 6, 2003, the Center transmitted by email to Gandi SARL a request for registrar verification in connection with the domain name at issue. On August 8, 2003, Gandi SARL transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on August 8, 2003. The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 12, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was September 1, 2003. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 3, 2003.

The Center appointed Zentaro Kitagawa as the sole panelist in this matter on September 15, 2003. 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

1. Complainant Sony is a leading manufacturer of audio, video, communications and information technology products for the consumer and professional markets.

2. Sony conducts its businesses almost exclusively in connection with the name and trademark SONY, and the SONY trademark is registered in over 193 countries including Japan, Hong Kong and the United States.

3. Sony operates five Sony Design Centers located in Tokyo, Singapore, New Jersey, San Francisco and London which are responsible for creating products with innovative designs.

4. Sony spends millions of dollars a year for advertising and promoting the SONY trademark throughout the world. The SONY mark has been disseminated through all types of advertising media such as network and cable television programming, radio broadcasting and print media as well as online advertising and promotions.

5. In the Japanese and English languages, the word SONY is a coined or invented word and does not have any meaning other than as the trademark SONY.

6. Sony conducts business on the Internet using the SONY mark. For example, Sony operates a web site at "www.sony.com" that has online games, information concerning music, movies, electronics, such as televisions, stereos and Playstation® video games.

7. Sony owns over 30 registrations in the United States and over 450 registrations in Japan for the mark SONY. These registrations cover an extensive range of goods and services. The Complaint is based upon these trademarks which are as follows:

JAPAN

Mark Registration No. International Classification of Goods/Services

SONY 0512083 Class 7

SONY 0618689 Class 9

SONY DESIGN 2066566 Class 28

SONY DESIGN 2149883 Class 9

SONY DESIGN 2175020 Class 16

UNITED STATES

Mark Registration No. Goods/Services

SONY 770275 television cameras

SONY 785967 analysis apparatus and equipment

SONY 777400 lighting apparatus

SONY 801885 electrical sound recording apparatus

SONY 1258436 video tape recorders, video disc players, video cameras, and recorded video tapes in addition to unrecorded video tapes

8. The Respondent registered with the Registrar the <sonydesign.com> domain name on January 25, 2000. Sometime thereafter, Respondent posted a Web site at "www.sonydesign.com". On the homepage, the site is introduced as the "Sonydesign labo. site" and visitors are invited to "Tell us your dreams" by submitting ideas for PC, cameras, VTRs, phones and games using an online form. The Web page further states: "Design your dreams! Digital dreams come true. SONY Design labo."

9. The Complainant unsuccessfully attempted to contact the Respondent at the address and telephone number provided in the domain name registration for <sonydesign.com>.

5. Parties' Contentions

A. Complainant

1. The disputed domain name is identical or confusingly similar to Complainant's marks SONY and SONY DESIGN (Para. 4(a)(i) of the Policy)

In evaluating the similarity between the <sonydesign.com> domain name and Complainant's marks, the relevant portion of the Respondent's domain name is "sonydesign", since the presence of the top level domain (TLD) ".com" suffix is irrelevant in the comparison of a domain name to a trademark. The <sonydesign.com> domain name is a total misappropriation of the Complainant's famous and coined marks SONY and SONY DESIGN, and is confusingly similar to Complainant's SONY and SONY DESIGN marks.

2. The Respondent has no rights or legitimate interests in the disputed domain name (Para. 4(a)(ii) of the Policy)

Firstly, there is no evidence of the Respondent's use of the disputed domain name in connection with a bona fide offering of goods and services. Based upon the numerous trademark registrations for and the fame, goodwill and notoriety associated with the SONY mark, it is impossible to conceive of a circumstance in which the Respondent could legitimately use this domain name without creating a false impression of association with Complainant.

Secondly, there is no evidence that shows the Respondent, as either an individual, business, or other organization, has been or is commonly known by the <sonydesign.com> domain name, or that it has acquired any trademark or service mark rights in the domain name. The Complainant has not licensed, contracted or otherwise permitted the Respondent in any way to use the SONY or SONY DESIGN marks or to apply for any domain names incorporating these marks, nor has the Complainant acquiesced in any way to such use or application of the marks by the Respondent. At no time did the Respondent have authorization from Complainant to register the disputed domain name.

Thirdly, there is also no evidence that shows the Respondent is making a legitimate non-commercial or fair use of the <sonydesign.com> domain name without intent for commercial gain. Based upon the foregoing, the Respondent clearly has no rights or legitimate interests in respect of the disputed domain name.

3. The Respondent registered and is using the disputed domain name in bad faith (Para. 4(a)(iii) of the Policy)

Firstly, the Complainant has not authorized the Respondent to register the <sonydesign.com> domain name. Without authorization from the Complainant, there is no conceivable bona fide use of this disputed domain name except to sell it to the Complainant or to perpetrate a fraud. Therefore, the Respondent has registered the disputed domain name primarily for the purpose of selling it to the Complainant for valuable consideration in excess of out-of-pocket costs directly related to the domain name.

Secondly, the Respondent has surreptitiously taken advantage of the goodwill Sony has garnered with great effort and expense by operating an unauthorized site at "www.sonydesign.com", designed to deceive the public into believing that product ideas were being solicited by Sony. In addition to lost investment opportunities, Sony will be forced to bear the burden of litigation expenses arising from submissions to the Respondent's site unwittingly made by the misled public who demand compensation for inventions they believed were communicated to Sony, thereby damaging the goodwill Sony has painstakingly developed over several decades.

Thirdly, there is no conceivable bona fide use of the domain name <sonydesign.com> by the Respondent. Indeed, without authorization from the Complainant, the Respondent registered a domain name incorporating the Complainant's famous SONY mark in order to lure an unsuspecting public to its site, which purports to be sponsored by the Complainant. The Respondent attempts to financially gain by deceiving the public into believing that the Complainant is soliciting product ideas through the site at "www.sonydesign.com" when instead the Respondent will be benefiting from any product ideas submitted. Moreover, the Respondent's provision of false contact information in the domain name registration of <sonydesign.com> is evidence of bad faith.

Based on the foregoing, and in accordance with Para. 4(b)(i) of the Policy, the Complainant requests the Administrative Panel a decision that the <sonydesign.com> domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

The Policy Requirements

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following:

(i) The domain name <sonydesign.com> is identical or confusingly similar to a trademark, in which the Complainant has rights,

(ii) The Respondent has no right or legitimate interest in respect of the domain name <sonydesign.com>; and

(iii) The domain name <sonydesign.com> has been registered and is being used in bad faith.

Identical or Confusingly Similar

In comparing a domain name to a trademark, the top level domain (TLD) ".com" is irrelevant. Therefore, it is clear that the <sonydesign.com> domain name is a misappropriation of the Complainant's marks SONY and SONYDESIGN and is confusingly similar to the Complainant's marks.

Rights or Legitimate Interests

It is shown that the Complainant has not licensed, contracted or otherwise permitted the Respondent to use the SONY or SONY DESIGN marks. There is also no evidence that shows the Respondent is making a legitimate non-commercial or fair use of the <sonydesign.com> domain name without intent for commercial gain. The Respondent is acting in a misleading fashion to divert consumers or to tarnish the marks at issue so as to create an impression of association with the Complainant. Therefore, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Registered and Used in Bad Faith

The Respondent's unauthorized registration and use of the disputed domain name prevents the Complainant from reflecting the marks in a corresponding domain name. Such registration and use misleads the public to its site, which purports to be sponsored by the Complainant. The Respondent also attempts to commercially gain by deceiving the public into believing that the Complainant is soliciting product ideas through the site at "www.sonydesign.com". Furthermore, the Respondent provides a false contact information in the site at "www.sonydesign.com". Therefore, it is shown that the Respondent has registered and used the disputed 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, <sonydesign.com> be transferred to the Complainant.

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Sole Panelist