



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2401872
Complainant:	uka Co., Ltd.
Respondent:	John Smith, E-MAIL ONLY - DOMAIN BUSINESS WILL NOT BE
Disputed Domain Name(s):	<uka.com>

1. The Parties and Contested Domain Name

The Complainant is uka Co., Ltd., of Akasaka Hillside House II 2F C, 9-5-14 Akasaka, Minato-ku, Tokyo, 107-0052 Japan.

The Respondent is John Smith, E-MAIL ONLY - DOMAIN BUSINESS WILL NOT BE, of BCM Box 1768, London, WC1N 3XX, GB.

The Disputed Domain Name is <uka.com>, registered by the Respondent with Domain Cost Club Global Domains International, Inc. DBA (“Registrar”), of 701 Palomar Airport Road #300 - Carlsbad, CA 92011 - USA.

2. Procedural History

Complainant submitted a Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“Centre”) electronically on February 16, 2024. On the same day, the Centre served an email to the Registrar to confirm the WHOIS information.

On February 16, 2024, the Centre confirmed the receipt of the Complaint.

On February 23, 2024, Registrar confirmed by e-mail to the Centre that the Disputed Domain Name was registered with the Registrar and that the current Registrant of the Disputed Domain Name is John Smith, E-MAIL ONLY - DOMAIN BUSINESS WILL NOT BE CONDUCTED VIA TELEPHONE. The Registrar has verified that Respondent is bound by its registration agreement which is in English language and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”).

On February 26, 2024, the Centre confirmed that the Complaint is in administrative compliance with the Policy and its Rules.

On February 27, 2024, the Centre served the Complaint and all Annexes, including Written Notice of the Complaint, setting a deadline of March 18, 2024 by which Respondent could file a Response to the Complaint, via e-mail.

On March 19, 2024, the Centre confirmed no Response was received within the deadline.

On March 20, 2024, having declared no conflict of interests between the parties, Mr. Paddy Tam is appointed as the single-member Panel. The Panel shall render a decision on or before April 3, 2024.

3. Factual background

A. Complainant

The Complainant was established originally under the corporate name “Mukouhara CO., LTD. (株式会社 向原)” in 1946, and has changed its corporate name to “uka Co., Ltd. (株式会社ウカ)” and adopted the brand name “uka” since 2009. The brand “uka” is originated from the Japanese word “羽化 (ウカ)”, which means the emergence when a pupa comes out of the cocoon and becomes a butterfly. The Complainant registered the domain name <uka.co.jp> on May 26, 2009. As a total beauty salon brand, the Complainant has garnered worldwide attention and the Complainant’s hand care, scalp care, hair care, face and body care, nail color, and perfume products are featured in many high fashion magazines in Japan and in Asian and European countries.

The Complainant received more than 100 beauty awards such as follows:

- MAQUIA, Best Cosmetics of the second half period of 2009
- FIGARO japon, 2011 BEST COSMETICS
- MONOCLE, Duty-free product of the year 2014
- PAULINE, BEAUTY BEST OF 2014
- VOGUE Taiwan, best of beauty, HAIR CARE
- GQ Taiwan, GROOMING SPECIAL
- 美的 (aesthetic), Best Cosmetics of the first half period of 2016, Hair Care
- VoCE, Best Cosmetics of the first half period of 2016, Hair Care
- VOGUE JAPAN, BEAUTY AWARD 2017, NATURAL WONDER GOLD
- SPUR, 2018 Best of Beauty, Best of Nail
- Marisol, Best Cosmetics Grand Prize 2019, Body Care Grand Prize
- VoCE, Best Cosmetics of the second half of 2019, Nail
- &ROSY, 2019 Best Cosmetics, Nail
- &ROSY, Best Cosmetics of the first half of 2020, Nail
- MEN’S Precious, Ranked the first place in hand care items
- MEN’S CLUB, BEAUTY The Best of The Best 2023. Hair Care
- MEN’S NON-NO, Beauty Grand Prize , Beauty Gear

B. Respondent

The Respondent appears to be an individual domiciled in London, United Kingdom.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant owns a large portfolio of the UKA trademarks worldwide.

The Disputed Domain Name consists of the UKA trademark in its entirety along with the generic Top-Level Domain (the "gTLD") ".com". The gTLD ".com" in the Disputed Domain Name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining confusing similarity under the first element of Paragraph 4(a) of the Policy.

Therefore, the Disputed Domain Name should be considered confusingly similar to the UKA trademark in which the Complainant has rights under Paragraph 4(a)(i) of the Policy.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name(s):

The Disputed Domain Name was initially registered on March 6, 2000 and Respondent's name appeared as the Representative or the Registrant since 2011. Therefore, the registration of the Disputed Domain Name by the Respondent is two years after the registration of the Complainant's UKA trademarks in Japan.

The Respondent has registered 5,472 domain names including many three-letter domain names under the name of "E-MAIL ONLY - DOMAIN BUSINESS WILL NOT BE CONDUCTED VIA TELEPHONE". There is no evidence to support that Respondent's use of, or demonstrable prepare to use the Disputed Domain Name and other three-letter domain names in connection with a bona fide offering of goods or services within the meaning of Paragraph 4(c)(i) of the Policy.

According to research conducted by the Complainant, there are nine screenshots of the website to which the Disputed Domain Name resolved between February 1, 2007 and July 23, 2020, and recent screenshots between May 27, 2016 and July 23, 2020 clearly showed that the Respondent used the Disputed Domain Name for resolving a webpage comprising pay-per-click ("PPC") links. In addition, the former Registrant displayed an offensive word between October 20, 2007 and July 16, 2008. These activities are clear evidence that the Respondent had an intent for commercial gain to misleadingly divert consumers or to tarnish the UKA trademarks as described in Paragraph 4(c)(iii) of the Policy.

Accordingly, the Respondent should be considered to have no rights or legitimate interests in respect of the Disputed Domain Name under Paragraph 4(a)(ii) of the Policy.

- iii. The disputed domain name(s) has/have been registered and is/are being used in bad faith:

As the Complainant is featured in many high fashion magazines in Japan and in Asian and European countries and the Complainant's products such as "UKA Shampoo Brush Kenzan" receives excellent customer reviews on Amazon.com in the United States of America, the Respondent must have known the existence of the Complainant or the UKA trademarks when the Respondent registered and began using the Disputed Domain Name in 2011.

The Respondent must have operated the website of the Disputed Domain Name which contains the PPC links primarily for the purpose of disrupting the business of the Complainant under Paragraph 4(b)(iii) of the Policy.

The Respondent conceals its identity several times by using the name "Private Registration", "GDPR Masked" or "REDACTED FOR PRIVACY". According to the UDRP decision (Dr. Ing. h.c. F. Porsche Aktiengesellschaft v. John Smith, WIPO Case No. D2014-1859 <porsches.com>), Respondent's name "John Smith" itself may be a pseudonym. Although the website to which the Disputed Domain Name resolves is currently inactive, the factor of the Respondent's concealing its identity must constitute sufficient evidence of bad faith registration and use.

The Complainant and the Respondent exchanged emails prior to the filing of the present complaint but no amicable resolution has been reached.

Consequently, the Disputed Domain Name has been registered and is being used in bad faith under paragraph 4(a)(iii) of the Policy.

B. Respondent

The Respondent has not filed an official response within the required period.

5. Findings

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.

In view of Respondent's failure to submit an official Response in a timely manner, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to Paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to Paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint. However, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments.

See Paragraph 4.3 of the WIPO Overview 3.0 (“Noting the burden of proof on the complainant, a respondent’s default (i.e., failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent’s default is not necessarily an admission that the complainant’s claims are true.”).

A) Identical / Confusingly Similar

To satisfy the first element under Paragraph 4(a) of the Policy, a Complainant needs to prove its rights in a trademark and the domain name is identical and/or confusingly similar to the trademark.

First, the Complainant claims rights in the UKA mark through its registrations of the Trademarks globally including but not limited to Japan, United Kingdom, European Union, United States and China. By virtue of its trademark registrations, Complainant has proved that it has rights to the mark under Paragraph 4(a)(i) of the Policy. See ADNDRC HK-2101530 <relx.shop> (“Based on the Complainant’s trademark registrations for its RELX and Design trademarks, and in addition to the Complainant’s actual use of the “RELX” mark, the Panelist is satisfied that the Complainant has rights to the mark “RELX” for the purpose of Paragraph 4(a)(i) of the Policy”). Accordingly, the Panel accepts that the Complainant has the registered trademark rights in the UKA mark.

Second, the Complainant claims that the Disputed Domain Name is identical to Complainant’s UKA trademark and the generic Top Level Domain (gTLD) .com is viewed as a standard registration requirement and as such is disregarded for the purpose of determining confusing similarity. The Panel accepts that the prominent part of the Disputed Domain Name is identical to Complainant’s UKA trademark and the gTLD .com doesn’t negate the similarity between Complainant’s UKA mark and the Disputed Domain Name for the purposes of Paragraph 4(a)(i) of the Policy. See ADNDRC HK-2201606 <alipanso.com & others> (“It is well established that the top-level generic domain “.com” does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion, and should be ignored for identifying the “confusing similarity” element.”).

For the foregoing reasons, the Panel finds the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

To satisfy the second element under Paragraph 4(a) of the Policy, a Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the domain name, and the burden of proof then shifts to the Respondent to show it does have rights or legitimate interests. See ADNDRC HK-2101464 <tencent-game.com> (“The Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondents to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name. The second element of Paragraph 4(a) of the Policy is therefore satisfied.”); see also ADNDRC HK-1700965 <infinitususa.com>.

The Panel is of the view that successfully registering a domain name does not automatically claim rights or legitimate interests to a domain name. Instead, Paragraph 4(c) of the Policy listed some common circumstances, in particular but without limitation,

if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate Respondent's rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii) of the Policy:

(i) before any notice to the Respondent of the dispute, its 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 it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial 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.

According to the evidence presented by the Complainant, the Complainant adopted the brand name “uka” 2 years before the Respondent became the Registrant or Representative of the Disputed Domain Name in 2011. The Complainant has never authorized the Respondent to use its trademarks and the Respondent is not commonly known by the Disputed Domain Name or the term “uka”.

The Complainant further alleges that the Respondent has registered more than 5,000 domain names including many three letter domain names.

Before going into the discussion, the Panel has the responsibility to highlight that registering or selling domain names itself could be a legitimate activity, see Paragraph 2.10 of the WIPO Overview 3.0 (“Over the course of many UDRP cases, panels have acknowledged further grounds which, while not codified in the UDRP as such, would establish respondent rights or legitimate interests in a domain name. For example, generally speaking, panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be bona fide and is not per se illegitimate under the UDRP.”)

In this case, although the Panel agrees in the previous section that the prominent part of the Disputed Domain Name is identical to Complainant’s UKA trademark, it does not automatically confer that the Respondent does not have rights or legitimate interests on the Disputed Domain Name.

As mentioned on the Complaint, the term “uka” can also mean “羽化 (ウカ)” in Japanese or “emergence” in English apart from Complainant’s brand. Paragraph 2.10 of the WIPO Overview 3.0 further clarified that “For example, a hypothetical respondent may well have a legitimate interest in the domain name <orange.com> if it uses the domain name for a website providing information about the fruit or the color orange. The same respondent would not however have a legitimate interest in the domain name if the corresponding website is aimed at goods or services that target a third-party trademark (in this example: Orange, well-known inter alia for telecommunications and Internet services) which uses the same term as a trademark in a non-dictionary sense.”

In the present case, the Panel is of view that the Complainant has not provided any evidence showing the distinctiveness of its UKA trademark as well as the global reputation

back to 2011 that the Respondent had actual knowledge of Complainant's trademarks at the time of its acquisition of the Disputed Domain Name from the previous registrant. The fact that being a three-letter acronym and a generic term, the Disputed Domain Name itself shows the opposite that it is not exclusively associated with the Complainant. Even if the Respondent has acquired the Disputed Domain Name primarily for the purpose of selling or renting and resolved the Disputed Domain name to a pay-per-click website for commercial gain, the generic nature of the Disputed Domain Name does not prevent the finding of Respondent's rights or legitimate interests in respect of the Disputed Domain Name. See CAC 102848 <avk.com> ("The bare allegation that the Complainant registered its trademark(s) before the registration of the disputed domain name does not establish knowledge of such trademark(s) by the Respondent. The ultimate question is whether the three letter characters in the trademark, AVK, have become so exclusively associated with the Complainant that knowledge can be inferred. While the Complainant has adduced evidence of the nature of its business globally and its reputation, it is not persuasive that the three letter character AVK trademark is especially distinctive such that at the time when the Respondent acquired the disputed domain name, knowledge of the Complainant's trademarks should be inferred. This is particularly so, given the evidence adduced about other registrations of the three letter characters AVK by third parties unrelated to the Complainant either prior to the registration of the Complainant's trademarks or thereafter.")

See also WIPO D2015-1566 <zic.com> ("Thus, as early as the year 2000 it was decided in Tenenhaus Philippe v. Telepathy, Inc, NAF Claim No. 94355 that the complainant trademark owner did not have exclusive rights to the acronym DAF, as many other parties also used it. Likewise in 2000 in Kis v. Anything.com Ltd, WIPO Case No. D2000-0770 the legitimate interest in short letter domain names seems to have been confirmed by that panel's statement that: 'The Domain Name at issue here is a three-letter second-level domain within the popular '.com' top-level domain. All or nearly all of the three-letter names have long been taken; respondent itself holds a number of other short domain names (as reflected in Network Solutions' Whois database), including 'an.com', 'hw.com', 'vz.com', 'xv.com', 'yz.com', 'zw.com', 'aex.com', 'fii.com', 'ldn.com', 'lna.com', 'mhi.com', 'nnc.com', 'otl.com', 'tj.com', 'tca.com', 'ukt.com', 'vaz.com', 'vdj.com', 'wla.com', and probably many more. Respondent appears to have selected the Domain Name 'kis.com' because of its length (if not because it represents an acronym for the Korean Information Site), rather than because it corresponds to Complainant's trademark – indeed, it seems unlikely that Respondent was even aware of Complainant's trademark when it selected the domain name.' In 2002, in Trans Continental Records, Inc v. Compana LLC, WIPO Case No. D2002-0105 a further panel again held that the complainant had not established the lack of a right or legitimate interest in the acronym in the domain name <lfo.com>, although the complainant had a trademark for LFO.")

Having considered the overall circumstances, the Panel finds that the Complainant has failed to establish a prima facie case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

For the foregoing reasons, the Panel finds the Complainant has not satisfied Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

As the Panel concludes that the Complainant has not satisfied the second element in the present case pursuant to Paragraph 4(a) of the Policy, it is not necessary to rule on the third element pursuant to Paragraph 4(a) of the Policy. See Forum FA2312002075183 <govwell.com>.

D) Reverse Domain Name Hijacking

Pursuant to Paragraph 1 of the Rules, Reverse Domain Name Hijacking (RDNH) is defined as using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name. Paragraph 4.16 of the WIPO Overview 3.0 further provides reasons articulated by panels for finding RDNH:

- i. Not likely to prove the 3 elements;
- ii. Clearly ought to have known it could not succeed;
- iii. Unreasonably ignoring established Policy precedent;
- iv. False evidence or misleading;
- v. The provision of intentionally incomplete material evidence;
- vi. Failure to disclose that a case is a refiling;
- vii. Filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis; or
- viii. Allegations without any supporting evidence.

Although the Respondent did not respond to the Complaint within the required period of time, the Panel is still obliged to review if the Complaint was brought in bad faith due to the failure of proving all the three elements under Paragraph 4(a) of the Policy by the Complainant.

Having reviewed the circumstances of the present case, the Panel is of the view that the Complainant genuinely believes that the Respondent lacks rights or legitimate interests in respect of the Disputed Domain Name. There is no fact demonstrating that the Complainant knew it could not succeed as to any of the required three elements or clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint. The Panel declines to make a finding of Reverse Domain Name Hijacking. See WIPO D2012-1548 <six.com> ("The Panel finds that there is no evidence to show that the Complainant did not believe it had a legitimate case under the UDRP based on the information available to it when the Complaint was filed. The evident weakness of the Complainant's UDRP Complaint is not sufficient in itself for a finding of Reverse Domain Name Hijacking.").

6. Decision

Having not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the Disputed Domain Name <**uka.com**> Shall **REMAIN WITH** the Respondent.



Paddy Tam
Panelist

Dated: March 21, 2024