



# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

### **Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation v. Distribution Purchasing & Logistics Corp.**

**Case No. D2000-0464**

#### **1. The Parties**

The Complainant in this proceeding is Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation, a Corporation duly organized under the laws of Japan located and doing business at 1-1, Shibaura 1-Chome, Minato-Ku, Tokyo 105-8001 Japan.

The Respondent in this proceeding is Distribution Purchasing & Logistics Corp. The address of Respondent as contained in the domain name registration is P. O. Box 862, Mahwah, New Jersey 07430, USA. The administrative and billing contact provided for the domain name registration is D. DeAngelo, P. O. Box 155, Ramsey, New Jersey 07446, USA.

#### **2. The Domain Name and Registrar**

The domain name at issue is <toshibastore.com>, which is registered with Network Solutions, Inc., 505, Huntmar Park Drive, Herndon, VA 20170, USA.

#### **3. Procedural History**

The WIPO Arbitration and Mediation Center (the "Center") received the Complaint of the Complainant Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation, on May 18, 2000 by e-mail and on May 22, 2000 in hardcopy.

On May 23, 2000 the Center sent an acknowledgement of the receipt of the Complaint to the Complainant. On the same date, the Center sent to the Registrar Network Solutions, Inc. a request for verification of registration data. On May 30, 2000, the Registrar confirmed, interaila, that it is the Registrar of the domain name in dispute and that toshibastore.com is currently registered in the name of the Respondent.

Having verified that the complaint satisfies the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy ("the Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("the Supplemental Rules"), the Center on May 31, 2000 sent to the Respondent in accordance with paragraph 2(a) of the Rules a notification of the administrative proceedings together with a copy of the Complaint. The Administrative panel finds that the WIPO Center has satisfied its notification obligation under paragraph 2(a) of the Rules. Respondent was given an opportunity to submit its Response. The last date for sending response by the Respondent was June 19, 2000.

The Center did not receive any response from the Respondent. Consequently, the Center, on June 21, 2000 notified the Respondent of its default and informed the Respondent that the Center would appoint an Administrative Panel as per the Rules and inform the Panel of the Respondent's default in responding to the Complaint.

On July 17, 2000 the Center appointed the Administrative Panel consisting of a single member. The date for the decision was fixed as July 30, 2000.

Till this date, no response has been received from the Respondent. The Panel therefore rules that the Respondent has forfeited its right to file a response.

The Respondent is proceeded Ex-parte. Rule 5 (e) governs this situation which reads as under:

"5(e) If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based on the Complaint".

The Panel finds that in the present case there are no exceptional circumstances that exist and therefore the present dispute is being decided on the basis of the Complaint and documents on record of the Panel.

#### **4. Factual Background**

The Complainant has provided evidence of the registration of the trademark 'TOSHIBA' in the United States Patent and Trademark Office in its favour for a number of products in International Classes 7, 9, 10, 11, 12, 16, 21 & 25 mentioned in the respective extracts of the Trademark Principal Register of United States Patent and Trademark Office, filed as Appendix "C" to the complaint.

Respondent is the current registrant of the domain name <toshibastore.com>. E-mail dated May 30, 2000 from Network Solution, Inc. to the Center confirms that

Respondent is the Registrant of the domain name at issue. The record in relation to the said domain name was created on August 24, 1998.

## **5. Parties Contentions**

### **A. Complainant**

The Complainant asserts:

- that it has substantially and continuously used the name and the mark 'Toshiba' since at least 1952 throughout most of the world and is the owner of the mark "TOSHIBA", covering numerous goods and services.

- that the domain name <toshibastore.com> registered by Respondent is confusingly similar to Complainant's mark TOSHIBA, and is otherwise identical to Complainant's mark TOSHIBA except for the use of the generic word "store".

- that the Respondent has no rights in respect of the domain name at issue. Respondent is neither an authorized distributor of Toshiba products nor it has been licensed to use the mark Toshiba by the Complainant. The Respondent has not made any demonstrable preparations to use the domain name <toshibastore.com> or the mark TOSHIBASTORE other than registering the domain name. The domain name <toshibastore.com> does not resolve to an active site; accordingly, the Complainant's customers are likely to be frustrated in their efforts to reach the Complainant's web site. The Respondent is not commonly known by the <toshibastore.com> domain name and cannot claim that it is making a noncommercial or fair use of the domain name.

- that the Respondent has registered and is using the domain name <toshibastore.com> in bad faith as evidence by the Respondent's pattern of registering multiple domain names which are identical or confusingly similar to famous and /or well-known marks.

- that registration of the domain name by the Respondent is preventing the complainant from using the domain name that incorporates its famous and well-known mark Toshiba with the generic suffix 'store'. Therefore, The Respondent's actions have unduly interfered with and disrupted complainant's ability to promote its own products and services.

- that the Complainant has used the mark TOSHIBA substantially and continuously for over 48 years on products and services throughout most of the world. The significant goodwill and value of the mark TOSHIBA is understood by the Respondent and undoubtedly is what prompted its registration of the domain name. Given the fame of the mark TOSHIBA, it is clear that the Respondent registered the domain name <toshibastore.com> with full knowledge of the Complainant's rights in the trademark and service mark TOSHIBA, either for the purpose of selling or otherwise transferring the domain name registration to the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the domain name or to

intentionally trade off of the Complainant's significant good will and value in the mark TOSHIBA to divert traffic intended for the Complainant.

## **B. Respondent**

The Respondent has not contested the allegations of the Complainant and is in default.

## **6. Discussions and Findings**

Paragraph 15(a) of the Rules instructs this Panelist as to the principles the Panelist is to use in rendering its decision: "A panelist shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Applied to this case, Paragraph 4 (a) of the Policy directs that the complainant must prove each of the following:

- (i) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and used in bad faith.

### **A. Identity or confusing similarity**

The domain name <toshibastore.com> registered by Respondent is confusingly similar to Complainant's mark TOSHIBA, and is otherwise identical to Complainant's mark TOSHIBA except for the use of the generic word "store". The use of suffix 'store' a generic word is an irrelevant distinction, which does not change the likelihood for confusion. The complainant has submitted multiple certificates of registration for the mark 'Toshiba' in its favour (Appendix A to the Complaint). The registrar Network Solution, Inc. has already confirmed vide its e-mail dated May 30, 2000 that the Respondent is the current registrant of the domain name at issue. The Administrative Panel finds that the domain name <toshibastore.com> is confusingly similar to the trademark 'Toshiba'.

### **B. Rights or legitimate interests**

The Complainant is the registered proprietor of the trademark 'Toshiba'. The registration certificates show that the complainant has claimed first commercial use of the trademark 'Toshiba' since 1967 in relation to its products.

The domain name <toshibastore.com> means a store for Toshiba products. It is asserted in the complaint that the Respondent is neither an authorized distributor of Toshiba products nor has been licensed to use the mark 'Toshiba' by the Complainant. The Respondent has not contested this assertion in the absence of any license from

the Complainant to use the mark Toshiba or use any domain name incorporating the said trademark, no actual or bonafide use of the domain name could be made by the Respondent. Appendix 'D' to the complaint shows that on May 16, 2000 an attempt was made to reach the web site of the domain name at issue, but the page or site could not be displayed. This shows that the site is inactive and the Respondent has not made any demonstrable preparations to use the domain name <toshibastore.com>.

From particulars given in the Complaint, it seems that the Respondent is not commonly known by the domain name <toshibastore.com>.

Accepting the assertions made in the Complaint to be correct and on the basis of Appendix 'C' the Administrative Panel finds that the Respondent has no rights or legitimate interests in the Domain name <toshibastore.com>.

### **C. Bad faith**

The requirement in Paragraph 4 (a) (iii) of the Policy is that the domain name "has been registered and is being used in bad faith" would be satisfied only if the complainant proves that the registration was undertaken in bad faith and the circumstances of the case are such that the Respondent is continuing to act in bad faith.

Paragraph 4(b) of the Policy provides that for the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or he has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of his documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site or location or of a product or service on his web site or location.

Network Solution, Inc. WHOIS search made on May 16, 2000 Appendix 'A' to the Complaint shows that the record in respect of the domain name <toshibasotre.com> was created on August 24, 1998 and as noted above when an attempt was made to reach the web site corresponding to the said domain name at issue, the web page or

site could not be displayed (Appendix 'D'). The Administrative Panel finds that the domain name <toshibastore.com> does not resolve to an active web site or other on-line presence. There is no evidence that a web site or other on-line presence is in the process of being established which will use the domain name. There is no positive action being undertaken by the Respondent in relation to the domain name. But, inactivity by the Respondent may also amount to the domain name being used in bad faith. In the case No. D2000-0003 Telstra Corporation Limited V. Nuclear Marshmallows, the Administrative Panel had laid down that a passive holding of a domain name by a Respondent may amount to the domain name being used in bad faith. It, inter alia, held as under:

"7.10 This understanding of paragraph 4(a)(iii) is supported by the actual provisions of the Uniform Policy. Paragraph 4(b) of the Uniform Policy identifies, without limitation circumstances that "shall be evidence of the registration and use of a domain name in bad faith", for the purposes of paragraph 4(a)(iii). Only one of these circumstances (paragraph 4(b)(iv), by necessity, involves a positive action post-registration undertaken in relation to the domain name (using the name to attract custom to a web site or other on-line location). The other three circumstances contemplate either a positive action or inaction in relation to the domain name. That is to say, the circumstances identified in paragraphs 4(b)(i), (ii) and (iii) can be found in a situation involving a passive holding of the domain name registration. Of course, these three paragraphs require additional facts (an intention to sell, rent or transfer the registration, for paragraph 4(b)(i); a pattern of conduct preventing a trade mark owner's use of the registration, for paragraph 4(b)(ii); the primary purpose of disrupting the business of a competitor, for paragraph 4(b)(iii)). Nevertheless, the point is that paragraph 4(b) recognises that inaction (e.g. passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith. Furthermore, it must be recalled that the circumstances identified in paragraph 4 (b) are "without limitation"- that is, paragraph 4 (b) expressly recognises that other circumstances can be evidence that a domain name was registered and is being used in bad faith.

7.11 the question that then arises is what circumstances of inaction (passive holding ) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith? This question cannot be answered in the abstract; the question can only be answered in respect of the particular facts of a specific case. That is to say, in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfied the requirements of paragraph 4(a) (iii), the Administrative Panel must give close attention to all the circumstances of the Respondent's behaviour. A remedy can be obtained under the Uniform Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith."

The Administrative Panel has considered whether, in the circumstances of this particular Complaint, the passive holding of the domain name by the Respondent amounts to the Respondent acting in bad faith? It concludes that it does. The particular circumstances of this case which lead to this conclusion are:

(i) the Complainant has substantially used the name and mark Toshiba since long and is the owner of many subsisting United State Registrations of the mark Toshiba,

covering numerous goods and services more particularly described in the Appendix 'C' to the Complaint;

(ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name;

(iii) the Respondent is not commonly known by the domain name registered by it. The domain name at issue is not a registered business name of the Respondent;

(iv) the Respondent has engaged in a pattern of conduct of registering popular and well known marks as domain names. Appendix 'E' to the Complaint show that besides the domain name at issue the Respondent has got registered 41 domain names, some of them like, IBMstore.com, Sanyostore.com, Polaroid.com, Duracell.com, Xeroxstore.com, Panamaxstore.com, Everydaystore.com, Olympusstore.com and sharpstore.com, are confusingly similar to the well known trademarks. Therefore Respondent is engaged in a pattern of conduct is clearly established.

(v) Respondent has not been licensed to use the mark 'Toshiba' by the Complainant.

Therefore, the panel finds that the Respondent's passive holding of the domain name at issue amounts to an instance of bad faith under paragraph 4 (a) (iii) of the policy. The Respondents has registered and used the domain name in bad faith. The panel further finds that the complainant has proved each of the three elements of paragraph 4 (a) of the policy.

## **7. Decision**

This Panel concludes that the Respondent owns a domain name <toshibastore.com> identical or confusingly similar to the Complainant's trademark (Toshiba), has no rights or legitimate interests in respect of the domain name, and registered and used the domain name in bad faith. These three facts entitle the Complainant to an order transferring the domain name from the Respondent. Panel allows the Complaint and directs that the Respondent's domain name <toshibastore.com> be transferred in favour of the Complainant.

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Ashwanie Kumar Bansal  
Sole Panelist

Dated: July 27, 2000