



# **WIPO Arbitration and Mediation Center**

## **ADMINISTRATIVE PANEL DECISION**

### **Utada Hikaru v. Taylor Domains**

**Case No. D2007-0367**

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

The Complainant is Utada Hikaru, of New York, New York, United States of America, represented by Kenyon & Kenyon, United States of America.

The Respondent is Taylor Domains, of New York, New York, United States of America.

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

The disputed domain name <utadahikaru.net> is registered with Intercosmos Media Group d/b/a directNIC.com.

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

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy”), which was adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the “Supplemental Rules”).

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) in email form on March 12, 2007, and in hard copy form, along with accompanying Exhibits A-H, on March 14, 2007. In response to a Notice of Deficiency issued by email from the Center dated March 27, 2007, the Complainant filed an Amended Complaint with the Center by email on March 29, 2007. To simplify the ensuing decision, all references to the Complaint will be to the Amended Complaint unless the specific context mandates otherwise.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on March 22, 2007, the Center requested confirmation from the concerned registrar of information set forth in the Complaint relative to the disputed domain name: specifically, contact and registrant information for that domain name, as well as whether the concerned registrar received a copy of the Complaint from the Complainant. The Center also requested the concerned registrar to specify: (a) whether the Policy applies to the disputed domain name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of the domain name, (c) the language of the registration agreement, and (d) whether the domain name will remain "locked" during the proceeding.

Subsequently, on March 22, 2007, the concerned registrar provided its verification response to the Center through which the concerned registrar specified name and contact information pertinent to the disputed domain name to the extent present in its Whois database, and which confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative and technical contacts. The response also confirmed that Blue Intercosmos Media Group d/b/a directNIC.com is the registrar of that name, that it had received a copy of the Complaint and stated that: the Policy applied to the disputed domain name, and that the name was then held in a "locked" status. The concerned registrar also indicated, through the response, that: the Respondent has submitted, for court adjudication, to the jurisdiction at the location of the principal office of the concerned registrar; and the registration agreement is in English.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules, and the Supplemental Rules.

On March 30, 2007, the Center formally notified the Respondent, by email letter, of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Exhibits, by courier and without the Exhibits by email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, inasmuch as the notification to the Respondent occurred on March 30, 2007, then, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all preceding and succeeding correspondence between the Center and the concerned registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on April 19, 2007, to file its Response with the Center and serve a copy of the Response on

the Complainant.

As of April 19, 2007, the Center had not received a Response to the Complaint from the Respondent; hence, the Center, in an email letter April 20, 2007, notified the Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated April 25, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated April 27, 2007, notified the Parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before May 11, 2007. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, extended this due date to May 25, 2007.

This dispute concerns one domain name, specifically: <utadahikaru.net>.

The language of this proceeding is English.

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

A copy of the Whois registration record for the disputed domain name appears in Exhibit A to the Complaint. As indicated on this record, the Respondent registered the disputed domain name on July 15, 2005.

##### **A. Complainant's UTADA HIKARU Mark**

As delineated below, the Complainant claims common law trademark rights in her personal name UTADA HIKARU, based on her continuous prior use, since 1999, of her name as a mark used in conjunction with her entertainment services and recordings. The Complainant has no trademark registrations for this mark.

##### **B. Complainant**

The Complainant is currently the number one "pop" singer in Japan. Her first album "First Love" debuted in 1999 and sold more than 9.5 million copies, making it one of the most successful best-selling albums in Japan.

The Complainant was featured on the cover of *Time* magazine in a special Fall 2001 issue, entitled "Music Goes Global" (a copy of which, along with an accompanying article from the *Time* magazine on-line archive: "Diva on Campus" dated September 15, 2001, appears in Exhibit C to the Complaint).

Further, her song "Blow My Whistle" was part of the sound track of the popular American movie "Rush Hour 2," which was released in 2001. The Complainant's talent was recognized in the latter part of 2001 by MTV which featured her in solo "unplugged" MTV performances in Japan. The Complainant has also been featured in numerous magazines, newspapers and other widely distributed materials that are publicly available. Her talent is internationally recognized.

To date, the Complainant has released five albums under her name, UTADA HIKARU, which have collectively sold over 20 million copies worldwide - as indicated by a listing of her albums and accompanying sales figures in Exhibit D to the Complaint.

A profile of the Complainant can be found at <http://www.animefringe.com/magazine/02.05/feature/1/>, a copy of which appears in hard-copy form in Exhibit E to the Complaint.

The Complainant has never licensed or authorized the Respondent to use her name in any fashion.

### **C. Respondent**

The disputed domain name resolves to the Respondent's web site. A home page on that site lists several different categories of merchandise for purchase - apparently including musical items and albums bearing the Complainant's name and mark, and also more generally and unrelated to the Complainant: MP3 player reviews, DVD clubs, concert tickets for musicians other than the Complainant, and other commercial offerings. A copy of a printout of that home page appears in Exhibit F to the Complaint. The categories themselves contain links which, when activated, lead to further pages of links to specific items falling within each category - many of which are unrelated to the Complainant and/or her music - as shown by copies of printouts of the latter pages in Exhibits G and H to the Complaint.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

First, the Complainant asserts that, as a consequence of her continuous and widespread prior use of her name UTADA HIKARU since 1999 as a mark for her entertainment services and recordings, the Complainant has acquired common law trademark rights in her name which are sufficient to invoke paragraph 4(a)(i) of the Policy.

Given those rights, the Complainant implicitly asserts that, apart from the inclusion of the generic top level domain (gTLD) ".net" in the disputed domain name, the disputed domain name is identical to her mark.

Hence, the Complainant believes that she has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

#### **(ii) Rights or Legitimate Interests**

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Complainant alleges that the Respondent has:

- (a)** not used the name or any similar designation in connection with a *bona fide* offering of goods and services;

- (b) never been commonly known by any designation identical or similar to the name or any trademark or service mark that is related to that name; and
  - (c) never been authorized by the Complainant to use her name. In that regard, the Complainant asserts that there is not now and never has been any licensing or legitimate business relationship between her and the Respondent.
- (iii) Registered and Used in Bad Faith

The Complainant contends that, for any of various reasons, the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Complainant alleges that the Respondent is attempting to use the domain name to intentionally attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark UTADA HIKARU as to the source, sponsorship, affiliation. In that regard, the Complainant states that inasmuch the domain name includes her personal name, the uniqueness of the latter makes it rather difficult to foresee any justifiable use which the Respondent might claim in the disputed domain name, citing to *Utada Hikaru v. Sophia Univ*, WIPO Case No. D2003-0684 (October 29, 2003); and *Utada Hikaru v. utada fan*, WIPO Case No. D2003-0686 (October 29, 2003). In the absence of any such justification, the Respondent, through use of the domain name, is implicitly suggesting that an association of some kind exists between the Complainant and the Respondent, when in fact none exists at all.

Second, the Complainant contends that the Respondent has attempted to attract Internet users who, being familiar with the Complainant and her fame, would be confused as to the source, sponsorship or endorsement of web sites associated with her name.

## **B. Respondent**

The Respondent failed to file any Response to the allegations raised in the Complaint.

## **6. Discussion and Findings**

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations.

### **A. Identical or Confusingly Similar**

The Panel finds that the disputed domain name is identical to the Complainant's UTADA HIKARU mark.

As a general matter, the Policy does not contain any restriction whatsoever that specifically limits its reach to only registered marks. Therefore, given the apparent inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence a protectable interest under the Policy, lies with applicable national trademark law that governs the Respondent's actions that are the subject of the Complaint. Under American law, rights accrue in unregistered, so-called "common law", marks as a result of usage, though limited by geographic and product/service

markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: “Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.”

Consequently, numerous panels including this one, when faced with unregistered marks, have upheld their protectable status in the United States of America under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.*, NAF Case No. FA 95560 (November 2, 2000) held: “ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required, unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the policy.” See, e.g., *Maria Bartiromo v. “Maria Bartiromo” and Dave Walton*, WIPO Case No. D2007-0242 (April 11, 2007); *Animals for Advertising, Inc. v. Cathryn Long*, WIPO Case No. D2007-0049 (March 30, 2007); *William M. Krings v. Hugo Hernandez*, WIPO Case No. D2006-0237 (April 18, 2006); *Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a “Nelly” v. Patrick Vanderhorst*, WIPO Case No. D2005-0636 (August 18, 2005); *True Blue Productions, Inc. v. Chris Hoffman*, WIPO Case No. D2004-0930 (December 22, 2004); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *America Online, Inc. v. John Deep d/b/a Buddy USA Inc.*, NAF Case No. FA 96795 (May 14, 2001); *Missing Children Minnesota v. Run Yell Tell, Ltd.*, NAF Case No. FA 95825 (November 20, 2000); *Mike Warner 2001 v. Mike Larson*, NAF Case No. FA 95746 (November 15, 2000); *CMG Worldwide Inc. v. Naughty Page*, NAF Case No. FA 95641 (November 8, 2000); *Home Properties v. SMSOnline*, NAF Case No. FA 95639 (November 2, 2000); and *Bridal Rings Company v. Yemenian*, NAF Case No. FA 95608 (October 26, 2000). Furthermore, the panel in *United States Postal Service v. Consumer Info. Org.*, NAF Case No. FA 95757 (November 27, 2000), held: “The UDRP does not discriminate between registered and unregistered marks.” In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, eResolution Case No. AF-0536 (December 11, 2000), the panel recognized: “It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark.” In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton*, NAF Case No. FA 95970 (December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, NAF Case No. FA 95832 (November 30, 2000). Similarly, see *American Home Products Corp. v. Healthy Futures*, WIPO Case No. D2000-0454 (August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229 (May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs*, WIPO Case No. D2000-0131 (April 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and D2000-0015 (March 11, 2000).

Given that common law trademark rights in the United States of America suffice for purposes of invoking paragraph 4(a)(i) of the Policy, the inquiry shifts to whether the Complainant had acquired common law trademark rights in her name UTADA HIKARU. The Complainant’s use of her personal name as a mark in connection with her entertainment and recording services dates back to 1999 - some 6 years prior to the

date the domain name was registered, and continues to the present. Those rights are predicated on the widespread reputation and fame which the Complainant has acquired through her name during that time - a reputation which has only increased over that time and, through her growing publicity and expanding worldwide recognition, continues to do so today. Clearly, those common law rights have requisite priority over the Respondent.

Since, as a predicate, the Panel has found that the Complainant has common law rights in the mark UTADA HIKARU, then no doubt exists that the disputed domain name is, for all practical purposes, identical to that mark. The difference between the name and that mark is merely the appending of a generic top level domain (gTLD) “.net” to the mark and the omission of a space between the individual words in the mark. Well-established UDRP precedent holds that the addition of a gTLD, the deletion of spaces or other such trifling changes are utterly *de minimus*, if not completely irrelevant, in assessing identity/confusing similarity and thus is totally ignored. See, e.g., *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003).

Therefore, the Panel finds that the disputed domain name <utadahikaru.net> is identical to and sufficiently resembles the Complainant’s UTADA HIKARU mark as to cause confusion; hence, the Complainant has shown identity between that mark and that name under paragraph 4(a)(i) of the Policy.

#### **B. Rights or Legitimate Interests**

The Panel believes that the Respondent has not provided any basis that would in the circumstances here legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

There is absolutely no evidence of record that the Respondent has ever been commonly known by the domain name. Nor could the Respondent ever become so known, in light the Complainant’s continuous use of her mark for the prior 6 years and the ensuing worldwide reputation and fame she has garnered in it during that time, without infringing on the exclusive trademark rights of the Complainant. See, *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Case No. FA 95856 (December 18, 2000).

Moreover, in light of the uniqueness of the Complainant’s personal name and the fact that disputed domain name, apart from its gTLD, contains nothing more than the Complainant’s personal name, the Panel can only conclude that a high likelihood exists that the Respondent must have known of the Complainant and her notoriety at the time it registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally registered the disputed domain name and then used it to resolve to its web site which provides categorized lists of links through which the Respondent ultimately offered goods for sale, some of which include musical items and albums that bore the Complainant’s name and mark, while many others were unrelated to the Complainant and/or her music.

From the evidence of record, it is clear to this Panel that the Respondent registered and used the disputed domain name to ultimately trade on, exploit and possibly tarnish the Complainant’s reputation by using it to offer goods and services which suggested that a relationship, affiliation or connection existed between the Complainant and the Respondent, when in fact none existed at all. In that regard, the Complainant never authorized or licensed the Respondent to use her personal name and hence her UTADA HIKARU mark in any fashion, including registering and using a domain name that

contained the mark.

If the Respondent's intent was not to exploit the Complainant's reputation and her mark for its own benefit, then why would the Respondent have registered and used a name that contained the Complainant's personal name? Based on the evidence of record, the Panel can find no plausible reason. This view is buttressed by the lack of any Response filed by the Respondent and through which the Panel negatively infers that no such reason exists here.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel believes that the Respondent's actions constitute bad faith registration and use of the disputed domain name.

There can be no doubt, when the facts here are viewed in their totality, that the Respondent registered and used the disputed domain name with the specific intention of: (a) first causing confusion in the minds of Internet users who visit the Respondent's site as to whether a affiliation, endorsement, sponsorship or, more generally, a connection of some sort exists between that site and the Complainant, and (b) through doing so, opportunistically exploiting the Complainant's reputation and goodwill in her mark for the Respondent's eventual benefit and to the Complainant's detriment. This is seen in the Respondent's intentional acts of: having registered the disputed domain name which mirrored the Complainant's own personal name and mark; and then using that name to resolve to its own web site through which the Respondent offered goods for sale, some of which related to the Complainant and/or her music while many others did not. Obviously, the Respondent profits in some manner, whether pecuniary or otherwise, from the sale of any such goods through its site.

Hence, the Panel views the Respondent's actions as constituting bad faith registration and use of the disputed domain name in violation of paragraph 4(a)(iii), as well as paragraph 4(b)(iv) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

## **7. Decision**

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name, <utadahikaru.net>, is ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: May 25, 2007