



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

American Honda Motor Co., Inc. v. Honda Automobile Company

Case No. D2007-1558

1. The Parties

The Complainant is American Honda Motor Co., Inc., Torrance, California, United States of America, represented by Howard, Phillips & Andersen, Salt Lake City, Utah, United States of America.

The Respondent is an entity using the name “Honda Automobile Company,” Laurel Springs, New Jersey, United States of America.

2. The Domain Name and Registrar

The disputed domain name <honda-jp.org> is registered with Melbourne IT trading as Internet Names Worldwide.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 20, 2007. On October 23, 2007, the Center transmitted by email to Melbourne IT trading as Internet Names Worldwide a request for registrar verification in connection with the domain name at issue. On October 25, 2007, Melbourne IT trading as Internet Names Worldwide transmitted by email to the Center its verification response. The Center verified that 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 October 26, 2007. In accordance with the Rules, paragraph 5(a), the due date for Response was November 15, 2007. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 19, 2007.

The Center appointed Justin Hughes as the sole panelist in this matter on November 30, 2007. 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

Because the Respondent has defaulted in these proceedings, the Panel accepts the assertions in the Complaint as true, at least as to factual matters necessary to resolution of the dispute. Those matters are discussed individually under 6.A-C below.

5. Parties' Contentions

A. Complainant

The Complainant's contentions, as they bear on resolution of this dispute, are discussed individually under 6.A-C below.

B. Respondent

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

6. Discussion and Findings

To prevail in a UDRP action, paragraph 4(a) of the Policy requires that the Complainant must prove each of the following:

- (i) The domain name in issue is identical or confusingly similar to the trademark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) The Domain Name has been registered and is being used in bad faith.

The Complainant has properly made its case under each requirement. Indeed, it is hard to think of a case that better exemplifies the bad faith practices in domain name registration that the UDRP is designed to address.

A. Identical or Confusingly Similar

The Complainant and its parent company have a family of registered trademarks in HONDA in relation to a wide variety of automotive, vehicle, and engine products and services (Complaint paragraphs 20 –21 and Exhibits A-C). In addition to the US and European Communities registrations cited by Complainant’s counsel, the Panel notes that a prior panel observed that the Complainant’s parent company had registered the HONDA trademark in “Afghanistan, Albania, Algeria, Argentina, Armenia, Aruba, Australia, Benelux, Bermuda, Bolivia, France, Italy, Israel, Libya, Iraq, Ireland, India, Jamaica, United States of America, United Kingdom, Macedonia, Madagascar, Peru, Poland, Syria, Taiwan Province of China, etc.” *Honda Motor Company Limited v. LOKITA Enterprises*, WIPO Case No. D2003-0507 (August 8, 2003). This list probably greatly understates the extent of the HONDA trademark registrations globally (“HONDA trademarks”).

The HONDA trademarks are unquestionably famous. In both its 2006 and 2005 surveys of the world’s 100 most famous brands, *BusinessWeek* ranked “Honda” at number 19. <http://bwnt.businessweek.com/brand/2006/>. According to the BusinessWeek analysis, HONDA is the world’s fourth most valuable automotive brand after Toyota, Mercedes-Benz, and BMW (*Id.*).

While incorporation of the entirety of a trademark in a domain name does not *per se* establish confusing similarity (particularly in other fact patterns where the trademark may have descriptive uses), the Panel agrees with the Complainant that the domain name <honda-jp.org> is functionally identical to the HONDA trademarks (Complaint paragraph 33).

In the case of a globally famous mark, “[t]he addition of a geographical suffix. . . does not sufficiently alter the underlying mark to which it is added.” *Honda Motor Company Limited v. LOKITA Enterprises, supra*. This would be true even for a geographic area where the trademark holder did not operate (such as <disneyland-albania.com>). But it is doubly true when the geographic suffix added refers to the home country from which the trademark is known to come. In such a situation, the geographic name is already associated with the trademark. See, e.g. *Playboy Enterprises International, Inc. v. John Taxiarchos*, WIPO Case No. D2006-0561 (July 19, 2006); *Playboy Enterprises International, Inc. v. Federico Concas, a.k.a John Smith, a.k.a. Orf3vsa*, WIPO Case No. D2001-0745 (August 5, 2001) (in both cases, the domain name was confusingly similar because the “disputed domain name incorporates the whole of the Complainant’s trademark . . . together with [a] descriptive [phrase]... associated with the Complainant and its renowned activities.”).

The Complainant has met its burden of proving that the domain name at issue is confusingly similar to Complainant’s trademark.

B. Rights or Legitimate Interests

The consensus view is that “a complainant is required to make out an initial *prima facie* case that the respondent lacks rights or legitimate interests.” Once the complainant has made this *prima facie* case, the “respondent carries the burden of demonstrating rights or legitimate interests in the domain name.” WIPO OVERVIEW OF WIPO PANEL VIEWS ON SELECTED UDRP QUESTIONS, Section 2.1.

In the present case, the Complainant has stated that the respondent has never been authorized by Honda to make any use of the HONDA trademarks, including in a domain name (Complaint paragraph 35). The Complainant also states that there is no connection or affiliation between the Complainant and the Respondent (Complaint paragraph 35). In the absence of any word from the Respondent, the Panel accepts these statements as true. The Respondent does make use of <honda-jp.com> to point to a website, so there is no possibility that the Respondent is using the domain name for criticism or commentary on Honda Motor Co. or American Honda Motor Co.

On these grounds, the Panel is satisfied that the Respondent has no rights or legitimate interests in respect of the domain name.

C. Registered and Used in Bad Faith

The Panel does not accept that “given the strength and fame of the Honda Marks, Respondent’s bad faith is established by the fact of registration alone” (Complaint paragraph 37). Registration of a domain name confusingly similar to a famous mark could be done for legitimate noncommercial or fair use of the domain name, such as good faith criticism of the trademark holder. See 15 U.S.C. §1125 (d)(1) (B)(i) (IV) (“the person’s *bona fide* noncommercial or fair use of the mark in a site accessible under the domain name” is an evidentiary factor against bad faith determination).

Nonetheless, the Respondent’s bad faith is amply demonstrated by its phishing activities (Complaint paragraph 25-29 and Exhibits E-I). Exhibit E clearly shows the <honda-jp.org> domain name being used for electronic messages falsely informing the recipient of “winnings” from Honda. While the similar message in Exhibit F does not appear to originate from a <honda-jp.org> source, recipients of the email are instructed to contact a Mr. Paul Brown at “hondaclaimsagent@honda-jp.org”. Exhibits G and H show the furtherance of this deceptive activity as one recipient is lured into providing personal and bank information. Although these exhibits no longer show use of the <Honda-jp.org> domain name, they still identify Paul Brown, indicating that the domain name was used in at least the initial stages of such phishing attempts.

This activity falls within the type of bad faith registration and use identified at paragraph 4(b)(iv) of the Policy: “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.” See *CareerBuilder, LLC v. Stephen Baker*, WIPO Case No. D2005-0251 (May 6, 2005) (use of domain name for phishing is bad faith); *Halifax plc v. Sontaja Sanduci*, WIPO Case No. D2004-0237 (June 3, 2004) (same).

In addition, the Complainant is correct that Exhibit A, J, and K establish a *prima facie* case that the Respondent intentionally provided false contact information when applying for the registration of the domain name (Complaint paragraph 39). Provision

of misleadingly false registration information is also evidence of bad faith in the registration and use of the domain name. See *Asset Marketing Systems, LLC v. SmartBuy Corporation, Chan Organization, et. al.*, WIPO Case No. D2004-0492 (September 17, 2004); *Lincoln Property Company v. LPC*, WIPO Case No. D20010238 (April 11, 2001); *Home Director, Inc. v. HomeDirector*, WIPO Case No. D2000-0111 (April 11, 2000). See also 15 U.S.C. §1125 (d)(1)(B)(i)(IV) (bad faith shown by “the person’s provision of material and misleading false contact information when applying for the registration of the domain name, the person’s intentional failure to maintain accurate contact information”).

On these grounds, the Panel is satisfied that the third element is established.

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 <honda-jp.org> be transferred to the Complainant.

Justin Hughes
Sole Panelist

Dated: December 11, 2007