

DISPUTE RESOLUTION SERVICE

D00023817

Decision of Independent Expert

Nipro Corporation

and

Gianfranco Vestuto

1. The Parties:

Lead Complainant: Nipro Corporation
3-3-13 Toyosaki
kita-ku
Osaka
581-0072
Japan

Respondent: Gianfranco Vestuto
152-160 City Road
London
EC1V 2NX
United Kingdom

2. The Domain Name:

niproeuropa.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such

a nature as to call in to question my independence in the eyes of one or both of the parties.

14 June 2021 14:28 Dispute received
16 June 2021 13:31 Complaint validated
16 June 2021 13:34 Notification of complaint sent to parties
05 July 2021 02:30 Response reminder sent
08 July 2021 10:55 No Response Received
08 July 2021 10:55 Notification of no response sent to parties
19 July 2021 11:14 Expert decision payment received

4. Factual Background

The Complainant, Nipro Corporation (“Nipro” or “Complainant”) (Japanese: “ニプロ”; pronounced “nee-pro”), of Osaka, Japan, is a global leader in medical technology. Founded in 1954, Nipro specializes in medical, pharmaceutical, and glass products that are sold worldwide through offices located in more than 56 countries, along with 27 manufacturing plants, employing more than 29,000 workers.

Nipro or its related entities own at least 225 trademark registrations in at least 51 countries or jurisdictions worldwide that consist of or contain the trademark NIPRO (the “NIPRO Trademark”), including Japan Reg. No. 1,105,815 (registered February 10, 1975); U.S. Reg. No. 1,441,070 (registered June 2, 1987); U.K. Reg. No. 1,584,255 (registered February 16, 1996); and EU Reg. No. 3,205,838 (registered August 23, 2004). In addition, Nipro (via its wholly owned subsidiary responsible for managing sales, marketing, and business operations for North and South America, Nipro Medical Corporation), is the registrant of the domain name <nipro.com> (created May 6, 1999), which is used in connection with Nipro’s primary website.

The Respondent, Gianfranco Vestuto, is an individual who gives an address in London, UK.

The Respondent registered the Domain Name on June 2, 2020.

The Domain Name redirects visitors to Nipro’s own website at <https://nipro.com>. The Respondent is using the Domain Name to send phishing emails impersonating the Complainant. On May 18, 2021, the Complainant sent a demand letter to the Respondent about the Domain Name, but the Respondent made no reply.

5. Parties’ Contentions

Complaint

The Complaint alleges that the only difference between the Domain Name and the Complainant’s NIPRO Trademark is the addition of the geographic designation “europe” to the Domain Name. Such a difference does nothing to eliminate

similarity. See, e.g., *Starwood Hotels & Resorts Worldwide Inc. Société des Hôtels Méridien v. Sean Gerrity*, DRS Case No. D00006935, in which the panel found the domain name <lemeridiendubai.co.uk> similar to the trademark LE MERIDIEN and said:

“The name of the Domain Name is similar to the name Le Meridien. The only difference is in the addition of the word “dubai” which is a well known geographical location. It is therefore apt to designate a Le Meridien hotel in that location. That is how it would be seen and accordingly there is no difference in trade mark terms between the two.”

As stated in paragraph 2.3 of the DRS Experts’ Overview 3: “Additional elements [in a disputed domain name] rarely trouble experts.”

For all the above-mentioned reasons, the Complaint alleges, the Complainant has rights in respect of a name or mark which is similar or identical to the disputed domain name.

The Respondent is neither affiliated with the Complainant in any way, nor has he been authorized by the Complainant to use and register its trademarks, or to seek registration of any domain name incorporating said trademarks.

The Domain Name is an Abusive Registration under paragraph 5.1.2 of the DRS Policy because “the Respondent is using...the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant”.

The Complaint alleges that the Respondent is using the Disputed Domain Name to send phishing emails impersonating the Complainant and that the Respondent is using the Domain Name to redirect visitors to the Complainant’s own website at <https://nipro.com/>. The Complainant sent a demand letter to the Respondent about the Domain Name on May 18, 2021, but the Respondent did not reply.

Phishing emails imitating a complainant are clearly evidence of an Abusive Registration. See, e.g., *Aon Corporation v. Frances Jeff*, DRS Case No. D00023001 (where “the Domain Name has been used to impersonate an employee of the Complainant in an attempt to commit a phishing scam,” it “is unquestionably an Abusive Registration” because it “has been used in a way that takes unfair advantage of and is detrimental to the Complainant’s Rights (and which is almost certainly fraudulent as well)”; *O’Neill Patient Solicitors LLP v. Miss Cindy Piller*, DRS Case No. D00023574 (where “Complainant has produced evidence that the Domain Name has been used for email phishing attempts targeting the Complainant’s clients, [t]his indicates clearly that the Respondent registered and used the Domain Name to unfairly disrupt the business of the Complainant and to confuse people or businesses into believing that the Domain Name was connected to the Complainant for fraudulent purposes”); and *AXA SA v. Privacy Department*, DRS Case No. D00022727

("[g]iven the use of the Domain Name for phishing emails that impersonated the Complainant and were designed to defraud its customers, I have little difficulty in concluding that the Domain Name was registered in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights").

Further, it is alleged, redirecting a disputed domain name to a complainant's website is additional evidence of an Abusive Registration because it is likely to confuse people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with Complainant. This is true regardless of whether any instances of actual confusion may yet have occurred. See, e.g., *PJ Hayman & Company Limited v. EDOCO LTD*, DRS Case No. D00004522 (finding an Abusive Registration because "there is clear potential for such confusion"); and *Six Continents Hotels, Inc v. EDOCO LTD.*, DRS Case No. D00008824 ("actual confusion need not be shown as the potential for confusion is clear").

The Respondent's failure to reply to Complainant's demand letter dated May 18, 2021, which requested a response by no later than May 25, 2021, is further evidence of an Abusive Registration. See, e.g., *Six Continents Hotels, Inc. v. CRWJ Company Ltd*, DRS No. D00010976 (finding an Abusive Registration where respondent did not respond to a demand letter because "[h]ad there been an innocent reason for that choice [of registering the disputed domain name], it is likely that the Respondent would have advanced it").

Response

The Respondent has not provided a Response.

6. Discussions and Findings

According to paragraph 2 of the Policy, in order to succeed in a Complaint, the Complainant has to prove to the Expert that, on the balance of probabilities –

- 1) the Complainant has Rights in respect of a name or mark which is identical or similar to the disputed domain name; and
- 2) the disputed domain name, in the hands of the Respondent is an Abusive Registration.

Where, as in the present case, no response was submitted by the Respondent, this does not mean that the Complainant prevails without proving its case with evidence. A Complainant must still make out its case *prima facie* and, having done so, the burden is on the Respondent to prove otherwise.

The Complainant's Rights

The Complainant's evidence in the form of trademark registration certificates shows the Complainant first registered its NIPRO Trademark in Japan in February 1975,

nearly half a century ago. The NIPRO Trademark is currently registered in more than 51 countries and jurisdictions worldwide (including in the United Kingdom in 1996, although this is not essential to the Complainant's case).

The Domain Name differs from the NIPRO Trademark only in the addition of the geographic designation "europe". This addition does nothing to distinguish the Domain Name from the NIPRO Trademark. Moreover, the addition of a purely geographic designation arguably promotes confusion, as it suggests that the Domain Name relates to a branch office or affiliate of the Complainant located in Europe.

The Complainant has Rights in the NIPRO Trademark, which is identical or similar to the Domain Name, within the meaning and purview of para. 2.1.1 of the Policy.

Abusive Registration

An 'Abusive Registration' is defined in paragraph 1 of the Policy as being "a Domain Name which either: (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR (ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

In the present case, the Complaint alleged that the Respondent is using the Disputed Domain Name to send "phishing" emails, that is emails impersonating or which purport to have been sent by or with authority of the Complainant.

Paragraph 5.1 of the Policy sets out a non-exhaustive list of factors that may evidence an Abusive Registration. Among these factors, paragraph 5.1.2 relevantly references:

"Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant."

Thus, paragraph 5.1.2 of the Policy points to an Abusive Registration where a Respondent uses the Domain Name to impersonate the Complainant, by confusing people erroneously into believing that the Domain Name is connected with the Complainant.

Here, the Complainant has adduced persuasive evidence that Internet users who "click" on the Domain Name are automatically redirected to the Complainant's official website, thereby confusing Internet users into believing that the Domain Name is connected with the Complainant.

The Complainant proffers additional evidence of "phishing", in the form of an extensive "chain" of emails whereby a certain employee writing on behalf of the

“Purchasing Department” of a fictitious entity “Nipro Europe Ltd” (which showed the Domain Name as the email address on the email letterhead), sought to obtain credit to purchase animal feed at a cost of more than €40,000. After extensive exchanges between the fictitious Nipro Europe Ltd and the intended victim of the phishing exploit, a global distributor of animal feed ingredients, informed the Purchasing Department employee that his purchase order would be declined because no record could be found of the fictitious company.

The Complainant has made out an extremely strong case. In fact, as already mentioned, once a *bona fide* case is made out, the onus shifts to the Respondent to submit evidence to refute it. In this case, the Respondent has failed to reply. Thus, the Expert is entitled to, and does, accept the Complainants’ contentions and evidence as being true and authentic.


In summary, I find that the NIPRO Trademark is well established and has been used extensively by the Complainant on a worldwide basis.

The Respondent registered and used the Domain Name in a targeted, strategic, and calculated manner, with the intention of impersonating the Complainant, by redirecting enquiries to the Complainant’s own website and by establishing a fictitious European office of NIPRO with a UK address and the Domain Name email address, to engage in fraudulent phishing activities and deception under cover of the Complainant’s long established NIPRO Trademark.

Based on the evidence before me, I find that the Domain Name is an Abusive Registration.

7. Decision

I find that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name. Further, I find that the Complainant has established that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name be transferred to the Complainant.

Signed  Dated 29 July 2021
David Kreider