Decision for dispute CAC-UDRP-101460

Case number	CAC-UDRP-101460
Time of filing	2017-03-03 09:48:46
Domain names	hasznaltauto.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Használtautó Ltd.

Complainant representative

Organization	Nagy-Baranyi Law Office

Respondent

Organization	Autoweb Kft. / Gabor Nemethy

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending proceedings which relate to the disputed domain name.

The Panel has duly noted that the Complainant had initially taken judicial action against the

Respondent regarding, inter alia, the disputed domain name. The Panel has received evidence that said judicial action had been dismissed by the competent court without issuing any summons.

As there currently are no pending legal proceedings, the Panel shall proceed to render a decision.

IDENTIFICATION OF RIGHTS

Complainant has provided evidence to the Panel that it owns the following national Hungarian trademarks:

- semi-figurative trademark "Hasznaltauto + device" No. 187831, filed on December 1, 2005, and duly renewed, covering goods and services in classes 35, 38 and 41 ;

- semi-figurative trademark "Hasznaltauto.hu + device" No. 188321, filed on May 17, 2004, and duly renewed, covering goods and services in classes 35, 38 and 41 ;

- semi-figurative trademark "Hasznaltauto.hu + device" No. 192489, filed on November 9, 2005, and duly renewed, covering goods and services in classes 35, 38 and 41.

FACTUAL BACKGROUND

The Complainant is a Hungarian online service provider incorporated on October 1, 2001 and headquartered in Budapest, Hungary. Its main activity is the provision of information on used cars to internet users through the domain name <hasznaltauto.hu>, which was registered on October 25, 1999. The corresponding website provides online advertising spaces for new, used and test cars offered for sale, which can be accessed through the website database searching tool.

The Respondent is Gabor Nemethy - AutoWeb Kft. The Respondent registered the disputed domain name <hasznaltauto.com> on October 2, 2001. The disputed domain name points towards a website on which users can access advertisements and sales offers for used cars. The Respondent is also the registrant of other domain names used in relation to sales of used cars and motorcycles (<autoweb.hu> registered in 1997, <motor.hu> registered in 2000...).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

THE COMPLAINANT:

1. The disputed domain name is identical or confusingly similar to the Complainant's trademarks, as it fully reproduces the Complainant's trademark with no other element.

2. The Respondent has no right or legitimate interest in the disputed domain name because:

- The Complainant has never authorized or licensed the Respondent to use their trademark;

- The Respondent is not known under disputed domain name;

- The Respondent used the disputed domain name in bad faith as it is using an identical domain name for identical services as those of the Complainant;

- The phrase "hasznaltauto" is not a common and generic Hungarian phrase as it is one single word while the common and generic phrase is "hasznalt auto" ;

- The phrase "hasznaltauto" is not descriptive: the website <hasznaltauto.hu> is not used for selling used cars but to provide information about used cars.

3. The Respondent registered and is using the disputed domain name in bad faith:

- The HASZNALTAUTO trademarks are well-known in Hungary ;

- The Complainant registered the domain name <hasznaltauto.hu> on October 25, 1999 ;

- The Complainant's company was incorporated on October 1, 2001 ;

- It is unlikely that the Respondent registered the <.com> version of a domain name when the <.hu> version was already registered, without knowing about prior registration of said <.hu> version.;

- The Respondent therefore registered and is using the disputed domain name in connection to services identical to those of the Complainant in order to benefit from the distinctiveness, fame and goodwill obtained by the Complainant and to

generate traffic on their webpage by creating a likelihood of confusion on the origin or affiliation of the website with the Complainant.

THE RESPONDENT:

1. The Respondent has a legitimate interest in the disputed domain name as:

- The Respondent is using, through their corresponding website, the phrase "hasznaltauto" in its generic and descriptive meaning, which is "used car". The services are therefore offered in good faith;

- The Respondent had already started using the disputed domain name in connection with a bona fide offering of services before any notice of the dispute was related to them since the first one was delivered in January 2017.

2. The Respondent did not register and is not using the disputed domain name in bad faith as :
- The Complainant's trademarks were registered long after registration of the disputed domain name by the Respondent ;

- The Complainant does not have any prior Common law or unregistered trademark rights on the sign "hasznaltauto".

- The Complainant's domain name <hasznaltauto.hu> (registered in 1999) was not used prior to the registration of the disputed domain name ;

- The Complainant's company was incorporated only one day prior to the registration of the disputed domain name ;

- The Respondent is using the disputed domain name under its generic and descriptive meaning which is "used car" ;

- The Respondent is displaying the phrase "hasznaltauto" under a form and a coloring which are totally different from the display of the Complainant’s trademark :

- The Respondent never offered to sell the disputed domain name to the Complainant or to any third party.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has failed to show, to the satisfaction of the Panel, the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has failed to show, to the satisfaction of the Panel, the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

I. The Panel finds that the disputed domain name <hasznaltauto.com> is identical to a trademark in which the Complainant has rights as the disputed domain name wholly incorporates the Complainant’s trademark "HASZNALTAUTO". Even though the Complainant's trademark was registered after the Respondent had registered the disputed domain name, it is well established under the UDRP that registration of a domain name before a complainant acquires trademark rights in a name

does not prevent a finding of identity or confusing similarity (see e.g. Digital Vision, Ltd. v. Advanced Chemill Systems, WIPO Case No. D2001-0827). The Panel however points out that the verbal element "HASZNALTAUTO" (which means "used car" in Hungarian) within the semi-figurative trademark "HASZNALTAUTO + device" has a very low degree of distinctiveness.

II. The Panel finds that the Respondent has a legitimate interest in the disputed domain name as said disputed domain name consists of generic and descriptive words ("hasznalt" which means "used" and "auto" which means "cars" in Hungarian) and is used in connection with a purpose relating to its generic or descriptive meaning (the Respondent's website contains advertisements and sales offers for used cars). To support such findings, the Panel considers that the Complainant's semi-figurative trademark HASZNALTAUTO is distinctive only to a very low degree when used in connection with services related to used cars. The Panel consequently finds that it would be inappropriate to give the Complainant a wide monopoly over all domain names, even descriptive ones, that incorporate the element "hasznaltauto" in connection with services related to used cars (see e.g. EAuto, L.L.C. v. EAuto Parts, WIPO Case Number D2000-0096). As a matter of fact, no likelihood of confusion may be caused when a generic and descriptive term is used for the purpose of describing an element which is part of one's activity.

Also, the Respondent started using the disputed domain name in connection with a purpose related to its generic or descriptive meaning long before any notice was delivered to them by the Complainant in relation to the disputed domain name. The Panel concludes that the Respondent has been using the disputed domain name with a bona fide offering of services before any knowledge of the present dispute.

III. While it is not necessary to proceed, the Panel finds that the disputed domain name was not registered and is not being used in bad faith. It is indeed a well-settled matter under the Policy that, unless exceptional circumstances emerge, the registration of a disputed domain name that precedes acquisition of rights in a trademark by a complaining party does not constitute registration in bad faith. The Respondent registered the disputed domain name approximately four years prior to the Complainant's trademark application filings and has maintained its registration of the disputed domain name since then, which does not constitute nor provide the basis for a finding of bad faith (see e.g. TDBBS, Inc. v. Mark Dimitrijevic, WIPO Case No. D2016-2111).

The Panel finds that the Complainant failed to submit sufficient evidence regarding the fame and the use of the domain name <hasznaltauto.hu> prior to the disputed domain name registration. Therefore, the Panel considers that there is no evidence of any privileged prior knowledge or reason to anticipate the trademark plans of the Complainant or of the trademark’s previous owner. Even if the Respondent had previous knowledge of the Complainant's prior domain name <hasznaltauto.hu>, the Respondent could not have anticipated that the Complainant would later file trademark applications for said term given the strictly descriptive nature of the domain name <hasznaltauto.hu> (see e.g. CKL Holdings N.V. v. Paul Flammea, WIPO Case No. D2016-1340).

Finally, the Panel deems that the Respondent has not been using the disputed domain name in bad faith : it has been legitimately using it in the course of trade in direct connection with its generic and descriptive meaning, i.e. in relation to "used cars". Said use of the disputed domain name by the Respondent therefore falls within fair trade practices.

The Panel also finds that Respondent, by using the disputed domain name, has not intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation, or endorsement of its website. As a matter of fact, the Respondent displays the stylized word "hasznaltauto" under a different design and using different colors on its website. Furthermore, the http://www.hasznaltauto.com/ displays the Respondent's company name "Autoweb" under the word "hasznaltauto", which indicates to Internet users that the disputed domain name is in no way connected to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **HASZNALTAUTO.COM**: Remaining with the Respondent

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2017-04-26

Publish the Decision