# Decision for dispute CAC-UDRP-101541

| | |
|---|---|
| Case number | CAC-UDRP-101541 |
| Time of filing | 2017-06-19 09:28:31 |
| Domain names | kalmarparts.com, kalmaryedekparca.net |

## Case administrator

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

## Complainant

| | |
|---|---|
| Organization | Cargotec Patenter AB |

## Complainant representative

| | |
|---|---|
| Organization | Berggren Oy |

## Respondent

| | |
|---|---|
| Name | Zafer Akbilmez |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various "KALMAR" trademarks, including the international trademark registration no. 1019668, registered on August 8, 2009 for numerous goods and services in International classes 06, 07, 09, 12, 37, 39, and 42 (hereinafter the “trademark“). The Respondent’s home country Turkey is one of the countries covered by this international trademark registration.

The disputed domain names were registered on March 21, 2017 (kalmarparts.com) and March 2, 2017 (kalmaryedekparca.net), respectively, i.e. the Complainant’s trademark predates the registration of the disputed domain names.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant, Cargotec, is a leading provider of various lifting, loading and unloading machines, devices and equipment for use in cargo and load handling purposes. One of Cargotec's three main business units is Kalmar, which provides cargo handling equipment, automation, software and services to ports, terminals, distribution centres and other operators in heavy

industry. The company name and the trademark “KALMAR” was established in 1973, when LMV and Ljungbytruck were merged into one to form Kalmar LMV in Sweden. The first “KALMAR” trademark was registered in 1987 in Sweden, and the trademark “KALMAR” has ever since been an integral part of the promotion, marketing and sale of Complainant’s products.

The Complainant first contacted the Respondent in May/June 2015 after receiving information that the Respondent had filed a trademark application for the mark “CARGOTEC” in Turkey for services in international class 35. The Respondent is the parts manager of a Turkish company called Toyota Istif Makineleri A.S., which has been a reseller and Turkish Kalmar dealer of the Complainant’s Kalmar business unit. The Complainant proposed an amicable settlement of this dispute, and thereafter the Respondent and Toyota Istif Makineleri A.S. agreed to transfer the Turkish trademark registration to the Complainant. This case was later settled. In February 2016 the Complainant learned that the Respondent had also registered the domain name <cargotec.com.tr> on November 21, 2014. A separate dispute regarding this Turkish domain name is still pending. The Complainant contends that it is therefore obvious that the Respondent knows the Complainant and its business unit Kalmar.

The Complainant has not granted any license or other rights to the Respondent to use any of its trademarks or domains. The use and registration of the disputed domain names has not been authorized by the Complainant.

The Complainant finally contends that the Respondent has registered the disputed domain names to disrupt the Complainant’s business, and has not shown any willingness to cooperate concerning his domain name registrations.

The disputed domain names do not resolve to active websites.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are 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, to the satisfaction of the Panel, shown that the Respondent has no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are 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

Apart from the descriptive suffix “parts” or “yedek parca” (which is Turkish for “spare parts”), respectively, the disputed domain names are identical to the Complainant’s protected brand name “KALMAR”. They are therefore confusingly similar to the Complainant’s “KALMAR” trademark (within the meaning of paragraph 4(a)(i)of the Policy).

The Panel also finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain names, nor is the

Respondent commonly known under the disputed domain names. This prima facie evidence was not challenged by the Respondent. It is possible that resellers, distributors, or service providers use domain names like the disputed domain names for a bona fide offering of goods and services (within the meaning of paragraph 4(c)(i)of the Policy), and thus have a legitimate interest in such domain names. According to the well-established “Oki Data test” (cf. Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903, <okidataparts.com>; please see section 2.8 of the WIPO Jurisprudential Overview 3.0 for more details), however, the following cumulative requirements must be met in such cases:

(i) the Respondent must actually be offering the goods or services at issue;
(ii) the Respondent must use the site to sell only the trademarked goods or services;
(iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
(iv) the Respondent must not try to “corner the market” in domain names that reflect the trademark.

The Respondent does not meet any one of these four cumulative requirements.

Given the Respondent’s profession and the history of disputes between the parties it is evident that the Respondent had the Complainant's trademark in mind when registering the disputed domain names. In the absence of a Response, the Panel infers that this registration was made primarily for the purpose of disrupting the business of the Complainant (within the meaning of paragraph 4(b)(iii) of the Policy). The Respondent’s “passive holding” or non-use of the disputed domain names also supports this finding of bad faith (cf. section 3.3 of the WIPO Jurisprudential Overview 3.0).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **KALMARPARTS.COM**: Transferred
2. **KALMARYEDEKPARCA.NET**: Transferred

## PANELLISTS

| Name | **Dr. Thomas Schafft** |
|---|---|

DATE OF PANEL DECISION 2017-08-21

Publish the Decision