Decision for dispute CAC-UDRP-101570

Case number	CAC-UDRP-101570
Time of filing	2017-06-19 09:26:14
Domain names	kalmarparts.net, kalmarspareparts.net, kalmarturkiye.com

Case administrator

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

Complainant

Organization	Cargotec Patenter AB

Complainant representative

Organization	Berggren Oy

Respondent

Organization	Privatewhois biz

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is inter alia the owner of the International trademark registration no. 1019668 KALMAR, registered on August 18, 2009 (hereinafter referred to as the “Trademark“) The Trademark registration covers various goods and services in classes 6, 7, 9, 12, 37, 39, and 42, and enjoys protection in Turkey, where the Respondent is located.

FACTUAL BACKGROUND

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

The Complainant is a provider of various lifting, loading and unloading machines, devices and equipment for use in cargo and load handling purposes. The Complainant is present in more than 100 countries around the world. One of the Complainant's three main business units is Kalmar, which provides cargo handling equipment, automation, software and services to ports, terminals, distribution centers and other operators in heavy industry. The first KALMAR trademark was registered in 1987 in Sweden.

The disputed domain names have previously been registered in the name of a person, which is a parts manager of a

company doing close business with the Complainant in Turkey. The Complainant first contacted him in May/June 2015 after receiving information that he had filed a trademark application for the mark CARGOTEC in Turkey for services in international class 35. Later on, the same person had registered the disputed domain names. Before filing the Complaint, the Complainant noticed that the Respondent information of the disputed domain names had changed into a privacy service.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain names are confusingly similar to the Complainant's Trademark.

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names. In this regard, the Complainant states that it has not granted the Respondent any license or other rights to use any of its trademarks or domains, that the use and registration of the disputed domain names has not been authorized by the Complainant and that the Complainant does not approve of the use and registration of the disputed domains.

Finally, the Complainant contends that the disputed domain names were registered and have been used in bad faith. In this regard, the Complainant contends that the purpose of the use and registration of the disputed domain names must have been to cause disruption to the Complainant’s business and that paragraph 4(a)(iii) of the Policy applies.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown 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 the Respondent to have 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 not 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

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

(i) the disputed domain names are identical or confusingly similar to the Complainant's trademark; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and

(iii) the disputed domain name have been registered and are being used in bad faith.

1. The Panel accepts that the disputed domain names are confusingly similar to the Complainant's trademarks as they fully includes the Trademark, except for the addition of the generic words "parts", "spare parts", and "turkiye". However, the Complainant's Trademark is recognizable as such within the disputed domain names and therefore confusingly similar under the Policy.

2. The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain names. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent did not deny these assertions in any way and therefore failed to prove any rights or legitimate interests in the disputed domain names.

3. However, the Panel is not convinced that the disputed domain names have been registered and are being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which, though not exclusive, shall be evidence of the registration and use of the domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website 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 the respondent's website or location or of a product or service on its website or location.

The circumstances mentioned in paragraph 4(b) of the Policy are not exclusive, while the two elements of the third requirement of the Policy are cumulative conditions: the Complainant must show that the disputed domain names were registered in bad faith and are being used in bad faith. This point is clear from the wording of the Policy and has been confirmed ever since. Please see Telstra Corporation Limited. v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (see also Telstra Corporation Limited v. Adult Web Development and Telstraexposed, WIPO Case No. D2002-0952; Telstra Corporation Ltd v. David Whittle, WIPO Case No. D2001-0434; Prada S.A. v. Mr. Chuan Sheng Wang, WIPO Case No. D2003-0758).

The Complainant contends that the disputed domain names are still registered in the name of a person, which is a parts manager of a company doing close business with the Complainant in Turkey. However, it provides no evidence in support to its allegations. Therefore, the Panel has no secure knowledge in this regard and cannot base its decision on the Complainant's contention alone.

The Complainant has not provided evidence with regard to the scope of its business activities, such as sales figures or advertising expenses in Turkey, where the Respondent is located. Based on the fact, that the Complainant provides cargo loading solutions and services for ports, terminals, distribution centers and the heavy industry, it cannot be presumed that the Respondent must have been aware of the Complainant's rights when it registered the disputed domain names.

With regard to bad faith use, the Panel notes that the Complainant has not provided any evidence with regard to the Respondent's use of the disputed domain names. However, is it well established that complains alleging the types of conduct described in paragraph 4(b) of the Policy should be supported by arguments and available evidence. Even in cases of respondent default, panels have held that wholly unsupported conclusory allegations may not be sufficient to support a complainant's case. Having visited the websites at the disputed domain names, the Panel observed that the Respondent does not actively use the disputed domain names.

It is consensus view that the lack of an active use of a domain name does not as such prevent a finding of bad faith. In such cases, the panel must examine all the circumstances of the case to determine whether a respondent is acting in bad faith. Examples of circumstances that can indicate bad faith include: a) a complainant having a widely known trademark with strong reputation; b) no response to the complaint; c) concealment of true identity; d) provision of false contact details; and e) the impossibility of conceiving a good faith use of the domain name (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574; Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131). The first and fifth prongs of the test carry the greatest weight and are generally conclusive on the issue of abusive registration: a respondent cannot hide its motivation for registering a domain name in the absence of a conceivable non-infringing use of such domain name. However, the material scope of "passive holding" as first established in Telstra Corporation Limited v. Nuclear Marshmallows is typically limited to cases, where a trademark is well known and enjoys a broad scope of protection, or where the overall circumstances of the case clearly indicate that the domain name was registered for blocking purposes targeting a complainant. Passive holding by itself does not invariably amount to bad faith use but must be seen in the light of the individual circumstances of each case.

The Complainant has not provided any convincing argument in this regard and therefore has not met its burden of showing bad faith use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **KALMARPARTS.NET**: Remaining with the Respondent
2. **KALMARSPAREPARTS.NET**: Remaining with the Respondent
3. **KALMARTURKIYE.COM**: Remaining with the Respondent

PANELLISTS

Name	**Peter Müller**

DATE OF PANEL DECISION 2017-08-23

Publish the Decision