Decision for dispute CAC-UDRP-101763

Case number	CAC-UDRP-101763
Time of filing	2017-11-28 11:03:13
Domain names	HMF-CRANES.COM

Case administrator

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

Complainant

Organization	HMF Group A/S

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Peter Smith

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the record owner of the following registrations for the trademark HMF:

Registration no: 1168244
Classes: 07, 12 & 37
Date of registration: 07.02.2013
Type of Registration: International Trademark (incl. EU)

Registration no: 79195053
Classes: 12 & 37
Date of registration: 25.07.2017
Type of Registration: US Trademark

Registration no: 1246971
Classes: 07, 12 & 37

Date of registration: 18.06.2008
Type of Registration: Australian Trademark

Registration no: 289123
Classes: 07, 12 & 37
Date of filing: 02.09.2016
Type of Registration: Israeli Trademark

Registration no: 40201618302V
Classes: 07, 12 & 37
Date of filing: 02.09.2016
Type of Registration: Israeli Trademark

FACTUAL BACKGROUND

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

i) LANGUAGE OF PROCEEDINGS REQUEST:

If the language of the Registration Agreement of the Disputed Domain Name is a language other than English, according to the applicable Registrar(s), the Complainant hereby files a language of proceeding request that the language of the proceeding should be English based on the following facts:

The Respondent has not replied to the cease and desist letter ("C&D letter"), nor responded that they did not understand the content of the letter.

The Disputed Domain Name includes the Complainant's trademark HMF. The Complainant is a Danish company whose business language is English and that also operates in different markets, including the UK. In addition, the Respondent has chosen to register the domain name under the Top Level domain name ".com" which is the commercial TLD, and is applicable to a broader audience than merely Denmark where the Respondent is located. A more suitable TLD if only addressing the Danish market would be the .dk extension.

The Respondent is using the Disputed Domain Name for a pay per click webpage showing information in English; e.g. "Truck hire with crane".

ii) ABOUT THE COMPLAINANT AND THE BRAND HMF

The Complainant was founded in 1945 in Denmark, when Arne Bundgaard Jensen chose to start up as an independent mechanic. The Complainant is an international group that develops, produces and markets high-tech truck mounted cranes.

The Complainant is known for its high quality and finish and to deliver innovative cranes that are extremely durable.

The Complainant's first export sales started in 1953. Today the Complainant exports to more than 50 countries in Scandinavia, Europe, North America, the Far and the Middle East as well as Australia. It is mainly loader cranes that make out the export range.The Complainant's importers are well established, market leading companies within the vehicle bodybuilding, hydraulic and transport equipment sectors.

The Complainant owns subsidiaries HMF Danmark in Denmark, HMF GmbH in Germany, HMF Ltd in the UK & HMF Norge in Norway.

The Complainant holds several trademark registrations for the trade mark HMF; for instance the following trademarks:

Registration no: 1168244
Classes: 07, 12 & 37
Date of registration: 07.02.2013
Type of Registration: International Trademark (incl. EU)

Registration no: 79195053
Classes: 12 & 37
Date of registration: 25.07.2017
Type of Registration: US Trademark

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Registration no: 40201618302V
Classes: 07, 12 & 37
Date of filing: 02.09.2016
Type of Registration: Israeli Trademark

All these trademark registrations predate the registration of the Disputed Domain Name.

The Complainant has also registered a number of domain names under generic top-level domains ("gTLD") and country-code top-Level domains ("ccTLD") containing the term HMF see for example, hmf.dk (created on 31.10.1996), hmf-crane.com (created on 25.07.2017), hmf-cranes.net (created on 22.11.2017), hmf-france.com (04.07.2013), hmf-france.fr (created on 04.07.2013), hmf-ftp.dk (created on 16.05.2012), hmf-loadercranes.com (created 29.08.2017), hmf.com.hk (created on 28.11.2008). The Complainant is using some of the domain names to connect to a website through which it informs potential customers about its trademarks and its products and services.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

i) THE DOMAIN NAME IS CONFUSINGLY SIMILAR

The Disputed Domain Name, registered on November 1, 2016, directly and entirely incorporates the Complainant’s well-known, registered trademark HMF. Neither the addition of the generic Top-Level Domain (gTLD) “.com”, nor the word “cranes” add any distinctiveness to the Disputed Domain Name. The Disputed Domain Name incorporates the HMF trademark coupled with the word “Cranes”, a term closely connected to the Complainant’s business. This exaggerates the impression that the Respondent is somehow affiliated with the Complainant, and the Respondent is somehow doing business using the Complainant`s trademark. This reasoning should apply here and the Disputed Domain Name should be considered as confusingly similar to the registered trademark HMF.

ii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name. The WHOIS information “Peter Smith” is the only evidence in the WHOIS record, which relates the Respondent to the Disputed Domain Name. When entering the terms « HMF » and “Denmark” in the Google search engine, the returned results point to the Complainant and its business activity, only.

The Respondent has not by virtue of the content of the website, nor by its use of the Disputed Domain Name shown that they will be used in connection with a bona fide offering of goods or services.

There is no evidence that the Respondent has a history of using, or preparing to use, the Disputed Domain Name in connection with a bona fide offering of goods and services. It is clear that the Complainant has become a distinctive identifier associated with the term “HMF” and that the intention of the Disputed Domain Name is to take advantage of an association with the Complainant’s business.

THE WEBSITE

The Disputed Domain Name is pointing to pay-per-click (“PPC”) website where Internet visitors find related links to the Complainant’s products and trademarks.

It is important to point out the fact that at the webpage of the Disputed Domain Name it is currently displaying the following message:

“This domain name expired on 2017-11-01. Click here to renew it.”

However and in accordance with the current who is, the domain name is actually valid until November 1, 2018.

iii) THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

It has to be highlighted that the Complainant’s trademarks predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. It is inconceivable that the unique combination of “HMF” and “cranes” in the Disputed Domain Name is not a deliberate and calculated attempt to improperly benefit from the Complainant’s rights.

THE DOMAIN NAME IS BEING USED IN BAD FAITH

The Complainant tried to contact the Respondent on November 13, 2017 through a cease and desist letter. The letter was sent to the e-mail address listed in the whois record associated with the Disputed Domain Name. In the cease and desist letter, the Complainant advised the Respondent that the unauthorized use of its trademarks within the Disputed Domain Name violated their trademark rights and the Complainant requested a voluntary transfer of the Disputed Domain Name. Unfortunately on the same day the Complainant received an undeliverable notification indicating that the email could not be delivered because the server rejected the message.

As a consequence, the Complainant sent an e-mail on November 13, 2017 asking the Registrar to assist with the following: i) Forward the C&D letter to the Respondent, ii) provide the correct e-mail address and iii) Suspend the DNS to block the content. Unfortunately, no answer has been received neither from the Respondent nor from the Registrar. Since the efforts of trying to solve the matter amicably were unsuccessful, Complainant chose to file a complaint according to the UDRP process. It has been mentioned in earlier cases that the failure of the Respondent to respond to a cease and desist letter, or

a similar attempt at contact, has been considered relevant in a finding of bad faith, e.g., News Group Newspapers Limited and News Network Limited v. Momm Amed Ia, WIPO Case No. D2000-1623; Nike, Inc. v. Azumano Travel, WIPO Case No. D2000-1598; and America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460.

THE WEBSITE

As previously indicated, the Disputed Domain Name is pointing to PPC websites where Internet visitors find related links not only to the Complainant´s products but also to the Complainant´s competitors; for instance after clicking the PPC advertisement displayed at the website for the term “HMF”, the information about Amazon.de appears. In terms of paragraph 4(b)(iv) of the Policy, this conduct constitutes bad faith as it has also been confirmed in previous cases.

The Complainant has conducted thorough searches to try to establish whether the Respondent would have any rights in the name. This has been accomplished by trademark database searches and searches on Google. The Complainant cannot find that the Respondent has any registered rights in the names or has become known under the name.

Finally, the Complainant’s International trademark registrations predate the Respondent’s Disputed Domain Name registration and the cease and desist letter remained unanswered. These cumulative factors clearly demonstrate that Respondent should be considered to have registered and to be using the Disputed Domain Name in bad faith.

To summarize, the trademark HMF is a well-known mark in several parts of the world for cranes & cranes services, including in Europe where the Respondent is located. It is highly unlikely that the Respondent was not aware of the rights the Complainant has in the trademark and the value of said trademark, at the point of the registrations. The Respondent bears no relationship to the trademark and the Disputed Domain Name has no other meaning except for referring to the Complainant's name and trademark. There is no way in which the Disputed Domain Name could be used legitimately by the Respondent. Further, the Disputed Domain Name resolves to a pay-per click website using advertisements with the Complainant`s trademark and competitors which do not represent a bona fide offering of goods or services or a legitimate non-commercial or fair use according to the longstanding judicial practice of WIPO. Inference of bad faith registration and use of the Disputed Domain Name is also given by the fact that the Respondent never replied to the Complainant’s cease and desist letter. It is reasonable to assume that if the Respondent did have legitimate purposes in registering and using the Disputed Domain Name it would have responded. Finally, the website has PPC advertisements not only related to the Complainant´s products but also to the Complainant´s competitors. Consequently, the Respondent should be considered to have registered and to be using the Disputed Domain Name in bad faith.

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, to the satisfaction of the Panel, shown 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, to the satisfaction of the Panel, shown 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

1.

The language of the Registration Agreement is English, thus, no decision on the language of the proceeding has to be made. The language of the proceeding is English.

2.
It is the view of this Panel that addition of further elements (word “cranes” and a hyphen) do not add distinctive matter so as to distinguish it from Complainant’s trademark.

The panel therefore finds that the Disputed Domain Name “hmf-cranes.com” is confusingly similar to the Complainant’s trade marks “HMF” within the meaning of paragraph 4(a)(i)of the UDRP Policy.

3.
The Panel finds that the Respondent has made no use of, or demonstrable preparations to use, neither of the domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the Disputed Domain Name, nor is commonly known under the Disputed Domain Name.

The Panel notes that the Respondent’s name nor his contact details contain any reference to the Disputed Domain Name.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name within the meaning of paragraph 4(a)(ii)of the UDRP Policy.

4.
The Complainant also proved that the Respondent uses the Disputed Domain Name as pay-per-click-website, gaining profit from it. Also, it seems obvious, that the Respondent chose the Disputed Domain Name knowing the well-known trade mark of the Complainant, as he added a fitting element “cranes” to that trademark. Further, he did not react to the cease and desist letter of the Complainant, nor to the letters of the CAC in this proceeding.

Accordingly, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith within the meaning of paragraph 4(a)(iii)of the Policy.

5.
For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **HMF-CRANES.COM**: Transferred

PANELLISTS

Name	**Dominik Eickemeier**

DATE OF PANEL DECISION 2018-01-12

Publish the Decision