Decision for dispute CAC-UDRP-103102

Case number	CAC-UDRP-103102
Time of filing	2020-08-20 09:55:45
Domain names	cargoteckarachi.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Cargotec Oyj
Organization	Cargotec Patenter AB

Complainant representative

Organization	Berggren Oy

Respondent

Name	Asif Baqi

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint on several CARGOTEC trademark registrations listed in Annex 4 to the Complaint, among which, CARGOTEC EU trademark, No. 004219961, filed on 28.12.2004, registered on 08.06.2006, for goods and services in classes 7, 12, 37; CARGOTEC EU trademark, No. 010006443, filed on 30.05.2011, registered on 11.10.2011, for goods in classes 01, 02, 04; CARGOTEC EU trademark, No. 000040006, filed on 01.04.1996, registered on 18.05.1999, for goods in classes 07,12; CARGOTEC US-registration No. 74/059050 and CARGOTEC Pakistan registrations No. 106043, 106041 and 204970.

FACTUAL BACKGROUND

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

The Complainant Cargotec Oyj, is a leading provider of various lifting, loading, and unloading machines, devices, and equipment for use in cargo and load handling purposes and services related to them. The Complainant operates globally in

more than 100 countries around the world. In 2019 around 12 500 people worked at Cargotec and the company had sales totaling approximately EUR 3.7 billion.

The Complainant owns numerous registrations around the world for the CARGOTEC trademark including, among others, CARGOTEC EU trademark, No. 004219961, filed on 28.12.2004, registered on 08.06.2006, for goods and services in classes 7, 12, 37; CARGOTEC US-registration No. 74/059050 and CARGOTEC Pakistan registrations No. 106043, 106041 and 204970, all of which predate the registration of the disputed domain name.

Furthermore, the Complainant is the owner of a numerous portfolio of domain names registrations which contain the distinctive and dominant word element “Cargotec” listed in annex to the Complaint.

The disputed domain name <cargoteckarachi.com> has been registered on 16.09.2017 and the services provided under the domain are by the Respondent related to handling and moving cargo as the services provided by the Complainant, Cargotec Oyj.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

The Complainant's contentions are the following:

The disputed domain name <cargoteckarachi.com> is confusingly similar to the Complainant's earlier trademarks CARGOTEC. The trademark and company name CARGOTEC is reproduced in its entirety.

The Complainant sustains that the addition of the generic word “Karachi”, which simply informs the Internet user of the geographical location of the city of Karachi in Pakistan is not sufficient to escape the finding that the domain name is confusingly similar to the trademark and company name CARGOTEC. Moreover, the addition of the city of Karachi is likely to give the false impression of being Cargotec’s local office or otherwise associated party to the Complainant.

The CARGOTEC trademark is widely known among relevant group around the world due to Cargotec being a leading provider of cargo and load handling solutions operating in more than 100 countries with a sales totaling approximately EUR 3.7 billion in 2019.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name for a number of reasons.

First, the Complainant sustains that, according to the searches conducted by such on the internet and in the trademark databases, the Respondent does not have any rights preceding those of the Complainant to the name “CARGOTEC” or to the disputed domain name cargoteckarachi.com.

Because of the Complainant’s extensive earlier trademark registrations with respect to the trademark related to cargo and load handling solutions, for example, in classes 6, 7, 9, 12, 37 and 42, no one else has a right to register or use “CARGOTEC” trademark especially in connection with the goods and services related to cargo and load handling solutions.

Further, the Complainant asserts that it has not granted any license or other rights to use any of its trademarks or domains to the Respondent. The use and registration of the disputed domain name has not been authorized by Cargotec and Cargotec does not approve of the use and registration of the disputed domain.

Given the above facts and as there are no business relations between the parties, Cargotec considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Further, the Complainant contends that the Respondent has registered and used the domain name in bad faith.

The Complainant asserts that the Respondent is using the disputed domain name in order to divert traffic to its websites for the purpose of generating revenue from the use and sale of the disputed domain name.

The use and registration of the disputed domain name by the Respondent, considering the facts and circumstances of the registration and use of the disputed domain name and the prior rights held by Cargotec, has been done with the intention to attract, for commercial gain, Internet users to the Respondents web site creating a likelihood of confusion with Cargotec's CARGOTEC trademark as to the source, sponsorship, affiliation, and endorsement of the Respondent's web site.

The Complainant further asserts that the purpose of the use and registration of the disputed domain name has been to cause disruption to the Complainant's business in Pakistan. The Complainant mentions that the Respondent has not shown any willingness to cooperation concerning his registration, but recently removed/hid its name from the domain register.

Further, the Complainant argues that the Respondent is intentionally trying to gain commercial profit from the use and registration of the disputed domain name and is intentionally benefiting from the Complainant's registered well-known brand and trademark CARGOTEC as such seems to be doing business in the field of logistics solutions, being thus a competitor of the Complainant.

Further the Complainant points out that, the Respondent by therefore mentioned actions is causing detriment and damage to the Complainant's well-known brand and trademark CARGOTEC.

On these bases, the Complainant sustains that the Respondent has registered and used 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

I. Confusing Similarity

The Panel agrees that the disputed domain name incorporates the Complainant's earlier CARGOTEC trademarks, that the addition of the term "Karachi", which simply informs the Internet users of the geographical location of the city of Karachi in Pakistan, is not sufficient to escape the finding that the domain name is confusingly similar to the trademarks CARGOTEC

and that, according to other UDRP panels, “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP” (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin).

The Panel agrees that the addition of the city of Karachi to the CARGOTEC term is likely to give the false impression of being a Cargotec’s local office or otherwise associated party to the Complainant.

Moreover, the extension “.com” is not to be taken into consideration when examining the similarity between the Complainant’s trademarks and the disputed domain name (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as “.com” is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L’Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The Complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Based on the available evidence, the Respondent is not a licensee of, nor has any kind of relationship with, the Complainant, which has an extensive trademarks and domain names portfolio which incorporates the CARGOTEC name. The Complainant has never authorised the Respondent to make use of its trademarks, nor of a confusingly similar trademark in the disputed domain name.

The Panel notes that the Respondent had an opportunity to comment on the Complaint’s allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

Based on the filed evidences, the Complainant operates globally in more than 100 countries around the world, providing various lifting, loading, and unloading machines, devices, and equipment for use in cargo and load handling purposes and services related to them, having an extensive portfolio of trademarks protected in several countries / territories around the globe as well as several domain names. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant’s trademark and has intentionally registered one in order to benefit from the reputation of the Complainant’s trademark.

In the present case, the following factors should be considered:

(i) the Complainant's trademark, which is an earlier right, is highly distinctive;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iii) the Respondent registered the disputed domain name containing in its entirety a highly distinctive trademark;

(iv) the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name similar to the Complainant's trademark;

(v) the disputed domain seems to be used in a business from the field of logistics solutions, being thus a competitor of the Complainant, trying thus to gain commercial profit from the use and registration of the disputed domain name and benefiting from the Complainant's registered trademark CARGOTEC.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **CARGOTECKARACHI.COM**: Transferred

PANELLISTS

Name	**Delia-Mihaela Belciu**

DATE OF PANEL DECISION 2020-09-25

Publish the Decision