

Decision for dispute CAC-UDRP-105342

Case number CAC-UDRP-105342

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Domain names hiab.wales

Case administrator

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

Complainant

Organization Hiab AB

Complainant representative

Organization Berggren Oy

Respondent

Organization Laidlaw2010 Ltd

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 registered owner of a portfolio of trademark and service mark registrations including the following:

- United Kingdom registered trade mark HIAB, registration number UK00904420402, registered on June 19, 2006, for goods and services in classes 7, 12 and 37;
- EUTM registration HIAB, registration number 004420402, registered on June 19, 2006 for goods and services in classes 7, 12, 37;
- International trademark registration HIAB, registration number 905566, registered on September 27, 2006 for goods and services in classes 7, 12, 37.

Additionally, the Complainant has established an extensive reputation and goodwill in the HIAB mark by extensive use, including on the Internet, in connection with the manufacture and sale of lifting apparatus and cranes and the provision of related services.

FACTUAL BACKGROUND

The Complainant is a provider of goods and service in the field of manufacture and sales of lifting apparatus and cranes, and related services on which it uses the HIAB mark, and is the registered owner of a portfolio of trademark and service mark registrations details of which are set out above.

The disputed domain name was registered on January 22, 2016 and resolves to a website which purports to be maintained by an enterprise that offers “[p]rofessional high capacity machine moving heavy lifting and transport services” that compete with the goods and services provided by the Complainant.

There is no information available about the Respondent, except for that provided in the Complaint, the Registrar’s WhoIs and the information provided by the Registrar to the Center in response to a request for verification of the registration of the disputed domain name in the course of this proceeding.

PARTIES CONTENTIONS

The Complainant’s Contentions

The Complainant submits that it is engaged in the manufacture and sale of lifting, loading, and unloading machines, devices, and equipment for use in cargo and load-handling purposes and related services on which it uses the HIAB mark.

Established in 1944, with production of its HIAB 190 loader crane starting in 1947, the Complainant asserts that it now carries on business in more than 100 countries around the world.

The Complainant claims rights in the HIAB mark established by its ownership of the portfolio of trademark registrations described above which it asserts are registered in 30 countries and that it first applied for trademark protection for the HIAB mark 1960, resulting in the registration of its Swedish registered trademark number 106500.

The Complainant states that the disputed domain name <hiab.wales> consists identically of the Complainant’s registered trademark HIAB, in combination with the generic Top-Level Domain (“gTLD”) extension <.wales>.

Citing the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) at section 1.7, the Complainant argues that in cases such as the present, where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name at issue will normally be considered confusingly similar to that mark for purposes of its standing under the Policy.

Moreover, the Complainant submits that the generic Top-Level Domain (“gTLD”) extension <.wales> should not be taken into consideration when examining the identity between the Complainant’s trademarks and the disputed domain name it is well established that the gTLD extension in a domain name at issue is insufficient to avoid a finding of confusing similarity.

The Complainant next alleges that the Respondent has no rights or legitimate interest in the disputed domain name, arguing that to the knowledge of the Complainant, the Respondent is not commonly known by the disputed domain name, and the Respondent’s use of the disputed domain name is neither non-commercial nor fair use. According to the information provided by the Registrar, the Respondent is named “Laidlaw2010 Ltd” and the disputed domain name directs to a website offering cargo lifting and transporting services.

Furthermore, as a result of the Complainant’s extensive earlier trademark registrations and its longstanding use of the trademark and the company name, the Complainant has the exclusive prior rights to the HIAB trademark especially for goods and services related to lifting apparatus and cranes.

Furthermore, the Complainant asserts that it has not granted any license or other rights to use any of its trademarks, company name or domains to the Respondent. Adding that the Complainant has not granted the Respondent any authority to register or use the disputed domain name and the Complainant has not approved the use and registration of the disputed domain name.

It is further contended by the Complainant that the combination of its well-known HIAB mark and the <.wales> gTLD extension in the disputed domain name is likely to be understood by Internet users as referring to the Complainant or its HIAB branded goods and services geographically located in Wales.

Referring to a screen capture of the website to which the disputed domain name resolves which has been exhibited in an annex to the Complaint, the Complainant submits that the images posted on the Respondent’s website indicate that the Respondent is not using the Complainant’s HIAB products to provide its services but instead is using lifting equipment sold by competitors of the Complainant.

The Complainant contends that such use of the disputed domain name by the Respondent should not be considered “fair” if it falsely suggests affiliation with the Complainant as trademark owner, and argues that the correlation between the disputed domain name and the Complainant’s mark is central to this inquiry. Additionally, citing section 2.5.1 of the WIPO Jurisprudential Overview 3.0, the Complainant contends that other panels established under the Policy have found that when a domain name at issue is identical to a complainant’s trademark, it carries a high risk of implied affiliation.

The Complainant adds that the Respondent is also owner of other domain names such as <laidlaw.wales> and <laidlaw2010.co.uk> which correspond to the Respondent’s company name and direct to a website identical to the one available through the disputed domain name, which the Complainant argues further confirms that the Respondent does not have legitimate interest in the disputed domain name.

It is contended that given the above facts and as there are no business relationship between the Parties, and also given that the

Respondent's use of the disputed domain name is commercial and does not fall under the heading of fair use, but instead takes advantage of the goodwill and reputation, as well as the intellectual property rights of the Complainant, it is evident that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant next alleges that the disputed domain name was registered and is being used in bad faith, arguing that the Complainant's mark is widely known in its business sector and given the near instantaneous and global reach of the Internet and search engines, the Respondent cannot credibly claim to have been unaware of the mark. Therefore, the Respondent knew or should have known that their registration of the disputed domain name would be identical to the Complainant's mark.

The Complainant adds that the Respondent should also have checked from general online databases the existence of the Complainant's prior rights.

The Complainant again refers to the website to which the disputed domain name resolves, which purports to offer competing cargo lifting and transporting services. The images on the website indicate that the Respondent is not using the Complainant's products but instead is using lifting equipment sold by competitors of the Complainant. The Complainant submits that the Respondent therefore directly benefits financially in its business from the goodwill and reputation of the Complainant's registered trademark which is used in the same field of business. See *Paule Ka v. Paula Korenek* WIPO Case No. D2003-0453.: "The proper test in this Panel's view, is whether the objective consequences or effect of the Respondent's conduct is a free-ride on the Complainant's goodwill, whether or not that was the primary (subjective) intent of the Respondent."

The Complainant submits that therefore the Respondent is intentionally and actively using the disputed domain name in bad faith by attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's registered and well-known HIAB trademark and company name.

The Complainant adds that the disputed domain name <hiab.wales> and the website to which it resolves, takes advantage of the goodwill and reputation, as well as the intellectual property rights of the Complainant, and the registration of the disputed domain name also prevents the Complainant from reflecting the marking in corresponding domain name.

In conclusion the Complainant adds that the disputed domain name associates the Complainant's famous mark with a geographical indicator, the gTLD <.wales>, which could lead Internet users mistakenly to believe that the disputed domain name is associated with Complainant's activities in that region. Citing the WIPO Overview 3.0 Section 3.2.1 it is argued that the Top-Level Domain extension is an additional consideration that this Panel may take into account when considering whether the disputed domain name was registered and is being used in bad faith.

Based on all the above, the Complainant considers it evident that the disputed domain name has been registered and is used in bad faith by the Respondent.

Respondent's Contentions

No administratively complaint response has been filed.

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.

The Complainant's Rights

The Complainant has provided convincing, uncontested evidence that it has rights in the HIAB mark, established by the ownership of the portfolio of trademark registrations described above.

Furthermore, the Complainant's uncontested evidence is that it extensively uses the HIAB mark in its international business in the manufacture and sale of heavy lifting equipment and cranes and related services.

Confusing Similarity

The disputed domain name consists of Complainant's HIAB mark in its entirety in combination with only the gTLD extension <.wales>.

Complainant's HIAB mark is the initial, dominant and only distinctive element in the disputed domain name. The gTLD extension <.com> does not prevent a finding of identity or confusing similarity because in the circumstances of this proceeding, it would be considered to be a necessary technical requirement for a domain name registration.

This Panel finds therefore that the disputed domain name is identical to the HIAB mark in which the Complainant has rights, and the Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

The Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain name arguing that:

- the Respondent is not commonly known by the disputed domain name;
- the Respondent's use of the disputed domain name is neither non-commercial nor fair use;
- as a result of the Complainant's extensive earlier trademark registrations and its longstanding use of the trademark and the company name, the Complainant has the exclusive prior rights to the HIAB trademark especially for goods and services related to lifting apparatus and cranes;
- the Complainant has not granted any license or other rights to use any of its trademarks, company name or domain names to the Respondent;
- the Complainant has not granted the Respondent any authority to register or use the disputed domain name;
- the Complainant has not approved the use and registration of the disputed domain name;
- the combination of its well-known HIAB mark and the <. wales> gTLD extension in the disputed domain name is likely to be understood by Internet users as referring to the Complainant or its HIAB branded goods and services geographically located in Wales;
- the screen capture of the website to which the disputed domain name resolves which has been exhibited in an annex to the Complaint shows images that indicate that the Respondent is not using the Complainant's HIAB products to provide its services but instead is using lifting equipment sold by competitors of the Complainant;
- such use of the disputed domain name by the Respondent should not be considered "fair" as it falsely suggests an affiliation with the Complainant as trademark owner, which is not true;
- the Respondent is also owner of other domain names such as <laidlaw.wales> and <laidlaw2010.co.uk> which correspond to the Respondent's company name and which direct to a website identical to the website to which the disputed domain name resolves, which the further confirms that the Respondent does not have legitimate interest in the disputed domain name; and
- as there are no business relations between the Parties, and the Respondent's use of the disputed domain name is commercial and does not fall under the heading of fair use but instead takes advantage of the goodwill and reputation, as well as the intellectual property rights of the Complainant, it is evident that the Respondent has no rights or legitimate interests in the disputed domain name.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

Registration in Bad Faith

The Complainant has adduced clear and convincing, uncontested evidence that it has trademark and service mark rights in the HIAB mark which predate the registration and first use of the disputed domain name.

It is most improbable that the disputed domain name which is composed of only the HIAB mark in combination with the gTLD extension <.wales> was chosen and registered without knowledge of Complainant, its mark, name and business.

The use to which the disputed domain name has been put by the Respondent to resolve to a website which offers competing services in the same field of activity as the Complainant is also indicative that the disputed domain name was chosen and registered to create confusion among Internet users.

This Panel finds therefore that on the balance of probabilities the disputed domain name was registered in bad faith with Complainant and its HIAB mark in mind, intending to take predatory advantage of the Complainant's goodwill and reputation.

Registration in Bad Faith

The HIAB mark is distinctive and is recognizable as pertaining to the Complainant, its goods and services, particularly in the field of heavy lifting apparatus, cranes, and related services.

The uncontested evidence shows that the disputed domain name, which is identical with the HIAB mark is being used to resolve to a website that purports to offer competing "[p]rofessional high capacity machine moving heavy lifting and transport services".

Furthermore, the exhibited screen capture of the Respondent's website contains images of heavy lifting equipment produced by competitors of the Complainant, and the Complainant avers that the Respondent's website does not include any images of the Complainant's apparatus.

The Respondent has no connection with the Complainant, and does not even appear to be a user of the Complainant's products.

This Panel finds therefore that the uncontested evidence proves on the balance of probabilities that the Respondent is intentionally and actively using the disputed domain name in bad faith by attempting to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's registered and well-known HIAB trademark and company name.

In making this decision, this Panel has also taken into account that, as alleged by the Complainant, the gTLD <.wales> would be considered by Internet users to correspond to a geographic area or natural zone of expansion of the Complainant's business.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, the Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **hiab.wales**: Transferred

PANELLISTS

Name	James Bridgeman
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DATE OF PANEL DECISION **2023-05-09**

Publish the Decision
