Decision for dispute CAC-UDRP-106057

Case number	CAC-UDRP-106057
Time of filing	2023-12-14 13:07:56
Domain names	volkswagen-thailand.com

Case administrator

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

Complainant

Organization	Volkswagen AG

Complainant representative

Organization	Lubberger Lehment Rechtsanwälte Partnerschaft mbB

Respondent

Name	MR Martins

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 owns the following trademarks registrations:

- EU trademark for VOLKSWAGEN, registration number 703702, registered on 10 May 1999;
- Thailand trademark for VOLKSWAGEN, registration number 51590, registered on 30 October 1996; and
- International trademark for VW, registration number 1555245, registered on 12 February 2020.

FACTUAL BACKGROUND

The Complainant, Volkswagen AG, is one of the world's leading automobile manufacturers. The Complainant owns a large portfolio of trademarks, including the well-known VOLKSWAGEN mark, which is protected by various registrations worldwide, including in the EU and in Thailand.

The disputed domain name was registered on 19 June 2020 using a privacy service. The disputed domain name resolves to a website that offers various Volkswagen car models for sale.

By letter dated 4 January 2023 the Complainant requested the hosting provider Bangmod Enterprise Co., Ltd. to disclose the website operator's identity. By e-mail dated 26 January 2023, sent to <sales@volkswagen-thailand.com>, the Complainant requested that the

website cease the activities carried out under the disputed domain name. The Complainant did not receive a response.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its trademark, VOLKSWAGEN, and submits that its worldwide reputation and trademarks VOLSWAGEN and VW have been confirmed by many UDCR panels, see Volkswagen AG v. Digi Real Estate Foundation, WIPO Case No. D2005-0952; and for the trademark VW, see Volkswagen AG v. Emir Ulu, WIPO Case No. D2005-0987, Volkswagen AG v. Swiss Recruitment, WIPO Case No. D2013-0534, Volkswagen Aktiengesellschaft v. Brocante Almere, M Pippolo, WIPO Case No. D2011-0845, Volkswagen AG v. Domainmonster.com Privacy Service/Futurename, WIPO Case No. DQA2014-0002, and Volkswagen AG v. Domain Manager, WIPO Case No. D2004-0191.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name and states that:

i. its trademark VOLKSWAGEN was registered long before the registration of the disputed domain name;
ii. there is no company or business relationship between the Respondent and the Complainant;
iii. the Respondent is not a licensee of the Complainant nor associated with the Complainant; and
iv. the website using the disputed domain name <volkswagen-thailand.com> presents itself as “Volkswagen Thailand”, a part of the Volkswagen group or at least as an official partner of Volkswagen, and features the famous VW logo and VOLKSWAGEN trademark.

The Complainant asserts that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant states that the Respondent is intentionally attempting to attract internet users to its website who are interested in the Complainant’s products. The disputed domain name and the content of the website are designed to create the wrong impression that it is an official website of Volkswagen AG for Thailand or a website of an official Volkswagen licensee.

RESPONDENT:

No administratively compliant 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.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4 (a) of the Policy requires the Complainant to prove each of the following three elements:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

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

(iii) the disputed domain name has been registered and used in bad faith.

The Respondent has not filed a Response. Under paragraph 14 of the UDRP Rules, the Panel may draw such inferences from a party's default or failure to comply with Rules as the Panel considers appropriate.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant owns trademark registrations for VOLKSWAGEN that predate the registration of the disputed domain name. The disputed domain name is comprised of the Complainant's trademark, VOLSWAGEN, a hyphen and the word "Thailand". Incorporating a famous mark plus a geographic term into a domain name, results in a domain name that is confusingly similar to the famous mark, see Playboy Enterprises International, Inc. v. Zeynel Demirtas, WIPO Case No. D2007-0768.

It is generally accepted that the addition of the top-level suffix, ".com" is a standard registration requirement. It does not add any distinctiveness to a domain name and can be disregarded when assessing whether the disputed domain name is confusingly similar to the Complainant's trademark.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and that the requirements of paragraph 4(a)(i) of the Policy have been met.

B. NO RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The Complainant's famous trademark predates the registration of the disputed domain name. The Respondent is not associated with the Complainant nor authorised to use its trademark. The Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The burden of proof now shifts to the Respondent to show that it has rights or legitimate interests.

The Respondent has not filed a Response nor provided any evidence of legitimate rights or interests. The disputed domain name resolves to a website that features the Complainant's VW logo and VOLKSWAGEN trademark and offers various Volkswagen car models for sale. This is not a bona fide offering of goods or services nor a legitimate non-commercial or fair use.

Having considered these factors, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

C. REGISTERED AND BEING USED IN BAD FAITH

The disputed domain name is confusingly similar to the Complainant's well-known mark. Linking the mark VOLKSWAGEN with the word "Thailand" creates the false impression that the disputed domain name is connected with the Complainant. The website to which the disputed domain name resolves features various Volkswagen cars for sale. It appears deliberately intended to create a likelihood of confusion with the Complainant and its mark for commercial gain.

The Panel concludes that the disputed domain name was both registered and is being used in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **volkswagen-thailand.com**: Transferred

PANELLISTS

Name	**Veronica Bailey**

DATE OF PANEL DECISION 2024-01-11

Publish the Decision