Decision for dispute CAC-UDRP-106790

Case number	CAC-UDRP-106790
Time of filing	2024-08-16 10:10:51
Domain names	zoomlionmx.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Zoomlion Heavy Industry Science and Technology Co., Ltd.

Complainant representative

Organization	Beijing Chofn Intellectual Property Agency Co., Ltd.

Respondent

Name	Ivan Saucedo

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 owner of many different trademark registrations for “ZOOMLION", including the following:

- Mexican trademark No. 1040126 for "ZOOMLION", registered on February 14, 2008, and duly renewed for goods pertaining to class 12.

- Mexican trademark No. 1162454 for "ZOOMLION", registered on September 2, 2009, and duly renewed for goods pertaining to class 7.

FACTUAL BACKGROUND

Founded in 1992, the Complainant develops and manufactures high-tech equipment such as engineering machinery and agriculture machinery, as well as new types of construction materials.

ZOOMLION is the first company in the industry to be listed on both A and H stock markets, with a registered capital of RMB 8.678 billion and total assets amounting to RMB 136.7 billion. By 2022, the Complainant's total revenue will reach RMB 41.6 billion with a net profit of RMB 2.3 billion. According to the latest announcement of the Hong Kong Stock Exchange, for the full year of 2023, the Complainant's net profit increased by 46.57 per cent to 56.98 per cent over the same period last year.

According to the records on the official website of Fortune China, the Complainant has been included in the list of Fortune China's top 500 companies for more than ten consecutive years since 2010. In 2009, the "ZOOMLION" trademark was recognized as a well-known trademark in Civil Judgement No. 37 of the First Instance of Zhuzhou Intermediate People's Court (2008).

The Complainant is the owner of many different trademark registrations for “ZOOMLION”.

The disputed domain name <zoomlionmx.com> was registered on September 27, 2023 and resolves to a website related to the Complainant's business, in which the Complainant's mark is displayed.

The Complainant submits that the disputed domain name is confusingly similar to its "ZOOMLION" trademark, as it incorporates the trademark entirely, and the addition of the sequence "mx" is not sufficient to escape the confusing similarity to the "ZOOMLION" trademark. This because "mx" is a generic term that cannot be used to distinguish goods and therefore does not participate in the comparative test of confusion between the disputed domain name and the Complainant's mark "ZOOMLION".

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known by it, has no relevant trademark rights, and is not related to the Complainant or authorized by it to register and use a domain name that includes the "ZOOMLION" trademark. The Complainant maintains that the Respondent’s use of the disputed domain name is not fair, because it reflects an intent to trade on the reputation of the Complainant’s trademark and falsely suggests Internet users that the associated website belongs to or is affiliated with the Complainant.

The Complainant states that the disputed domain name was registered and is being used in bad faith. It claims that its "ZOOMLION" trademark had already achieved a high level of global recognition at the time when the Respondent registered the disputed domain name, so it must have had knowledge of the trademark at this time. The Complainant adds that the Respondent’s knowledge is confirmed by the fact that the Respondent’s website includes a clear imitation of the Complainant's "ZOOMLION" brand.

The Complainant notes that the website at the disputed domain name is related to the Complainant’s business and features the "ZOOMLION" trademark. According to the Complainant, this shows that the Respondent uses the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion with the "ZOOMLION" trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or of the products and services offered there.

PARTIES CONTENTIONS

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

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Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(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 respect of the disputed domain name; and

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

1) The Complainant has established that he has rights in the trademark "ZOOMLION" at least since February 2008. The Complainant's trademark is registered well before with respect to the registration of the disputed domain name (September 27, 2023). The Panel finds that the disputed domain name is confusingly similar to "ZOOMLION" as the disputed domain name differs from the Complainant's trademark only for the letters "mx" at the end of the word, and for the top-level domain ".com". The Panel accepts that the addition of the "mx" element does not avoid the confusing similarity between the disputed domain name and the mark since "mx" simply indicates a connection with Mexico where the Complainant has two active trademark registrations (see, between many others, Grupo Rotoplas, S.A.B. DE C.V. c. Lucrecia Gomez Gomez, WIPO Case No. D2019-1919). Furthermore, in accordance with the consensus view of past UDRP panels, the Panel finds that the Top-Level domain ".com" is not sufficient to exclude the likelihood of confusion. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Complainant also searched various trademark databases in the name of the Respondent and did not find that the Respondent had trademark rights in the name of ZOOMLION. Furthermore, the Complainant points out that the disputed domain name is not used for a bona fide activity, because it resolves to a website that copies the website of the Complainant and displays the "ZOOMLION" trademark. The Respondent, in the absence of any response, has not shown any fact or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

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

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

(iv) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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 the respondent's website or location.

The Respondent registered the disputed domain name many years after the use and registration of the "ZOOMLION" mark by the Complainant. In consideration of the reputation achieved by "ZOOMLION" it is clear that the Respondent was surely aware of the Complainant trademark when he registered the domain name in dispute. Moreover, the Respondent appears to have attempted to benefit commercially from the appropriation of the "ZOOMLION" mark in the disputed domain name. The use of the mark "ZOOMLION", well-known in the construction machinery sector, to illustrate the characteristics of machinery bearing the Complainant's mark, clearly indicates that the disputed domain name was chosen by the Respondent to take advantage of the Complainant´s mark reputation. This finding leads to the obvious conclusion that the disputed domain name has been registered in bad faith (Research In Motion Limited v. Privacy Locked LLC/Nat Collicot - WIPO Case No. D2009-0320; The Gap, Inc. v. Deng Youqian - WIPO Case No. D2009-0113; AXA S.A. v. P.A. van der Wees - WIPO Case No. D2009-0206; BHP Billiton Innovation v. Ravindra Bala - WIPO Case No. D2008-1059).

The Panel also finds that, by linking the disputed domain name to a website depicting "ZOOMLION" products, the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain, by causing a likelihood of confusion with the trademark "ZOOMLION" as to the source, sponsorship, affiliation or endorsement of its websites and the products promoted therein. The conduct described above clearly falls within paragraph 4(b)(iv) of the Policy (Triumph International Vietnam Ltd v. Tran Quoc Huy - WIPO Case No. D2017-0340).

In consideration of the above, the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **zoomlionmx.com**: Transferred

PANELLISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION 2024-09-20

Publish the Decision