Decision for dispute CAC-UDRP-106856

Case number	CAC-UDRP-106856
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Domain names	myhiab.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Hiab AB

Complainant representative

Organization	Berggren Oy

Respondent

Name	M Furqan Qureshi

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

Complainant is the owner of several trademark registrations for the mark "HIAB", either as a word or in stylized letters, including, but not limited to, European Union trademark No. 4420402, UK Trademark registration No. 00904420402, both registered on June 19, 2006, US Trademark registration No. 3485304, registered on August 12, 2008, and International trademark registration No. 905566, registered on September 27, 2006 designating inter alia Australia, Canada, China, Kenya and Russia.

FACTUAL BACKGROUND

Complainant, Hiab AB, is inter alia a manufacturer of lifting machines and cranes. Hiab AB’s history dates back to 1944.

The disputed domain name <myhiab.com> was registered on June 14, 2024.

PARTIES CONTENTIONS

1. **Complainant**

The Complainant alleges that the disputed domain name is confusingly similar to the Complainant's HIAB trademark because it contains the Complainant's registered and well-known trademark HIAB in identical form as its dominant and only distinctive element. The Complainant further contends that the generic suffix "my" in combination with the well-known trademark HIAB is likely to be understood by Internet users as referring to the Complainant or its HIAB goods/services and that the confusing similarity of the disputed domain name to the Complainant's trademarks is not eliminated by the addition of the non-distinctive word "my".

The Complainant contends that the addition of the generic Top Level Domain (gTLD) ".com" is a standard registration requirement and is irrelevant to avoid a finding of confusing similarity.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that

(i) the Complainant has the exclusive prior rights to the trademark "HIAB" as a result of the Complainant's extensive prior trademark registrations and the Complainant's longstanding use of the trademark and company name;

(ii) Complainant has not granted Respondent any licence or other right to use any of its trademarks, company name or domains;

(iii) the use and registration of the disputed domain name is not authorised by the Complainant;

(iv) to the Complainant's knowledge, the Respondent is not commonly known by the disputed domain name and its use of the disputed domain name is neither non-commercial nor fair use; and

(v) the Respondent's use of the disputed domain name should not be considered "fair" because it falsely suggests affiliation with the trademark owner; and

(vi) MyHiab is a service and application launched by Complainant to which the disputed domain name clearly refers.

The Complainant alleges that the Respondent has registered and is using the disputed domain name in bad faith.

The Complainant alleges that the Respondent registered or acquired the disputed domain name on 14 June 2024 and is offering the domain name for sale, in particular that the registration of the disputed domain name took place only a few days after the launch and publication of the MyHiab application, which is an application created by the Complainant for use by its customers. The Complainant alleges that the Respondent is intentionally and actively using the disputed domain name in bad faith by having intentionally registered the disputed domain for the purpose of selling the domain name to the Complainant or its competitor for more than the cost of registration. As can be seen from the screenshot of the website accessible through the disputed domain name, the price of the domain name was set at USD 1555, which exceeds the costs incurred by the Respondent.

The Complainant's MyHiab application was launched on 11 June 2024, while the disputed domain name was registered on 14 June 2024. The evidence provided by the Complainant regarding the launch of the Complainant's MyHiab application predates the registration of the disputed domain name. It is no coincidence that the disputed domain name was registered immediately after the launch of the MyHiab application. The timing of the registration of the disputed domain name is directly aimed at the Complainant's MyHiab application and service, with the intention of benefiting from the new MyHiab services and application launched by the Complainant.

At the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark and intentionally registered and used the disputed domain name to profit financially from the reputation and goodwill of the Complainant's distinctive and well-known trademark and company name and the release of the MyHiab service and application.

The Complainant further alleges that the disputed domain name is identical to the name of the Complainant's MyHiab service, which was published prior to the registration of the disputed domain name, which carries a high risk of disrupting the Complainant's business. By registering such a domain name, the Respondent has also deliberately attempted to attract Internet users to its website for commercial gain.

2. **Respondent**

No administratively compliant response has been submitted by the Respondent.

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).

The Complainant has successfully demonstrated that it is the rightful owner of several trademark registrations for the "HIAB" mark. The Panel recognizes that the Complainant's trademark HIAB is the only distinctive element of the disputed domain name and its incorporation in the disputed domain name leads to confusing similarity of this domain name with the Complainant´s trademark. The word element “my” is a non-distinctive possessive adjective which does not prevent the confusing similarity.

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).

A complainant is required to establish a prima facie case that the respondent lacks rights or legitimate interests. Once such a case is made, the burden of proof shifts to the respondent to demonstrate their rights or legitimate interests in the disputed domain name. Failure to do so results in the complainant satisfying paragraph 4(a)(ii) of the Policy (as per Article 2.1 of WIPO Jurisprudential Overview 3.0 and WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

Based on the contentions of the Complainant, the Panel finds that the Complainant has successfully established a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

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).

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see Article 3.1. of WIPO Jurisprudential Overview 3.0).

Registration in bad faith

In evaluating whether the disputed domain name was registered in bad faith, the Panel specifically notes that the Complainant has continuously used the HIAB mark, particularly for cranes, since the 1940s, and all trademarks on which this Complaint is based long predate the registration of the disputed domain name. The Panel also agrees with the Complainant's assertion that registering the disputed domain name shortly after the international launch of the Complainant's "MyHiab" application, which was widely promoted both online and offline, cannot be considered coincidental. Rather, this timing points to intentional conduct by the Respondent, aimed at benefiting from the introduction of the Complainant's new application.

Based on these facts, the Panel concludes it is highly probable that the Respondent was aware of the Complainant's HIAB name, its HIAB trademark, and the launch of the "MyHiab" application at the time of registering the disputed domain name. This conclusion is not only grounded in the case circumstances—where the domain name was registered just days after the introduction of the new application—but also in the presumption that the HIAB mark is, as asserted by the Complainant, highly distinctive. Therefore, the Panel finds it implausible that the Respondent would have registered the disputed domain name without the Complainant's trademark and "MyHiab" application in mind.

Accordingly, the Panel finds that by registering the disputed domain name, the Respondent targeted the Complainant's trademarks and products, specifically the "MyHiab" application, and that this constitutes bad faith registration.

Use in bad faith

The disputed domain name is currently offered for sale and is not associated with any active website. However, based on the facts of this case and in consideration of the doctrine of passive holding, the Panel finds it implausible that any good-faith use of the disputed domain name would be possible without causing detriment to the Complainant and its distinctive and widely known HIAB Trademarks. The passive retention of the disputed domain name, with the potential for its use or sale for illegitimate purposes, constitutes a form of use sufficient to satisfy the third UDRP requirement (see WIPO Case No. D2019-1357, Arcelormittal (SA) v. Clay Rush).

Accordingly, the Panel concludes that the totality of circumstances in this case—specifically, the Respondent's failure to use the domain name for a functional website and the offer to sell the domain name—supports a finding that the disputed domain name is being used in bad faith.

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

The Panel has determined that the disputed domain name is confusingly similar to the Complainant's trademark.

Based on the contentions presented by the Complainant, the Panel has found that the Complainant has satisfactorily made a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

The Panel finds that, based on the Complainant's contentions and evidence, it can be concluded that the Respondent must have been aware of the Complainant's trademarks when it registered the disputed domain name, and as such, the Respondent has registered the disputed domain name in bad faith.

Lastly, the Panel has concluded that the Complainant has successfully proven that the disputed domain name is being used in bad faith.

Therefore, for the aforementioned reasons, the Panel orders that the disputed domain name <myhiab.com> be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **myhiab.com**: Transferred

PANELLISTS

Name	**Karel Šindelka**

DATE OF PANEL DECISION 2024-10-27

Publish the Decision