Decision for dispute CAC-UDRP-106828

Case number	CAC-UDRP-106828
Time of filing	2024-09-30 11:40:45
Domain names	hoosierhrvatska.com, hoosiersuomi.com, hoosierspain.com, hoosiersverige.com, hoosierfrance.com, hoosierbelgie.com, hoosierbelgique.com, hoosieritalia.com, hoosierlietuva.com, hoosiernederland.com, hoosieraustralia.com, hoosieraustria.com

Case administrator

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

Complainant

Organization	Hoosier Racing Tire Corp.

Complainant representative

Organization	Göhmann Rechtsanwälte Abogados Advokat Steuerberater Partnerschaft mbB

Respondent

Name	Zhang Qiang

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the holder of several trademarks including the following:

- HOOSIER, European Union word mark No. 018620943, registered on May 11, 2022, in classes 12 and 25;
- HOOSIER, German word mark No. 1142010, registered on June 29, 1989, in class 12;
- HOOSIER, international figurative mark No. 1780480, registered on January 1, 2024, in classes 12 and 25.

FACTUAL BACKGROUND

The Complainant, Hoosier Racing Tire Corp., is an American company operating in the race tires business.

The Complainant is the holder of several trademarks consisting of or including the term HOOSIER. The Complainant operates through the domain name <hoosiertire.com>.

The disputed domain names <hoosierbelgique.com>; <hoosiernederland.com>; <hoosieraustralia.com>; <hoosieraustria.com>; <hoosierbelgie.com>; <hoosierfrance.com>; <hoosiersuomi.com>; <hoosiersverige.com>; <hoosierspain.com>; <hoosierhrvatska.com> and <hoosieritalia.com> were registered on November 7, 2023, and the disputed domain name <hoosierlietuva.com > was registered on November 9, 2023.

The disputed domain names all appear to resolve to a website showing the HOOSIER word and figurative marks and offering similar products to those of the Complainant (e.g. tires and apparel).

The Complainant sent a cease and desist letter to the Registrar on September 9, 2024. According to the Complainant, the Registrar did not reply within the deadline given by the Complainant.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names should be transferred to it.

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

2. The Respondent has no rights or legitimate interests in respect of the disputed domain names; and

3. The disputed domain names have been registered and are being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Identity of confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant shows to be the holder of the registered HOOSIER marks, it is established that there is a trademark in which the Complainant has rights.

The Panel observes that the disputed domain names all incorporate the Complainant's HOOSIER trademark in its entirety, adding the name of a country. In the Panel's view, such additions do not prevent the Complainant's trademark from being recognizable within the disputed domain names (see section 1.8 WIPO Overview 3.0; IM PRODUCTION v. Xue Han, CAC Case No. 104877 <isabel-marantus.com>).

Finally, it is well established that the Top-Level Domains ("TLDs") such as ".com" may be disregarded when considering whether a disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

Therefore, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain names in order to shift the burden of production to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain names (although the burden of proof always remains on the Complainant)(see section 2.1 WIPO Overview 3.0 and Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain names and that the Respondent has not acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is known as "Zhang Qiang". The Respondent's use and registration of the disputed domain names was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Fundamentally, a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner. The correlation between a domain name and the complainant's mark is often central to this inquiry. Generally speaking, UDRP panels have found that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 WIPO Overview 3.0). The disputed domain names all incorporate the Complainant's HOOSIER trademark in its entirety, merely adding the name of a country. In the Panel's view, such combination may even increase the risk of confusion with the Complainant as it can easily be considered as referring to a website of the Complainant dedicated to a specific country. Therefore, the Panel finds that the disputed domain names carry a risk of implied affiliation with the Complainant and cannot constitute fair use.

Beyond looking at the domain name(s) and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the WIPO Overview 3.0).

The Panel observes that all disputed domain names resolve to websites showing the HOOSIER word and figurative marks and offering products identical or at least similar to the Complainant's products for sale. In the Panel's view, this does not amount to a legitimate non-commercial or fair use of the disputed domain names, or use in connection with a bona fide offering of goods and services. Moreover, the Respondent does not accurately and prominently disclose its (absence of) relationship with the Complainant. As a result, the Respondent fails the so-called "Oki Data test" for legitimate resellers, distributors or service providers of a complainant's goods or services. The Panel rather considers that, in the circumstances of the present case, there are serious indications that the Respondent intends to sell counterfeit goods. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., impersonation or the sale of counterfeit goods) can never confer rights or legitimate interests on a respondent (see section 2.13 of the WIPO Overview 3.0).

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainants has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain names. In light of the above, the Complainant succeeds on the second element of the Policy.

3. Bad faith

The Complainant must prove on the balance of probabilities that the disputed domain names were registered in bad faith and that these are being used in bad faith (see section 4.2 WIPO Overview 3.0 and e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070).

In the present case, the Panel finds that the Respondent must have been aware of the Complainant and its trademark rights when it registered the disputed domain names as:

- the disputed domain names incorporate the Complainant's distinctive trademark in its entirety with the addition of a geographical term that can easily be considered to refer to the Complainant given its international presence;
- some of the Complainant's marks predate the registration of the disputed domain names by more than 30 years;
- the websites linked the disputed domain names include the Complainant's word and figurative marks and offer products identical or similar to the Complainant's products for sale.

In the Panel's view, the use of the disputed domain names described above indicates that the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain by creating a likelihood of confusion with the Complainant's trademark (see Simyo GmbH v. Domain Privacy Service FBO Registrant / Ramazan Kayan, WIPO Case No. D2014-2227).

Moreover, the Panel finds that the Respondent has also engaged in a pattern of bad faith conduct of targeting the Complainant's HOOSIER trademarks by registering 12 domain names including the HOOSIER trademark in its entirely.

Finally, the Respondent did not formally take part in the administrative proceedings. According to the Panel, this serves as an additional indication of the Respondent's bad faith.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain names were registered and are being used in bad faith. In light of the above, the Complainant also succeeds on the third and last 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. **hoosierhrvatska.com**: Transferred
2. **hoosiersuomi.com**: Transferred
3. **hoosierspain.com**: Transferred
4. **hoosiersverige.com**: Transferred
5. **hoosierfrance.com**: Transferred
6. **hoosierbelgie.com**: Transferred
7. **hoosierbelgique.com**: Transferred
8. **hoosieritalia.com**: Transferred
9. **hoosierlietuva.com**: Transferred
10. **hoosiernederland.com**: Transferred
11. **hoosieraustralia.com**: Transferred
12. **hoosieraustria.com**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2024-11-06

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Publish the Decision