

Decision for dispute CAC-UDRP-105611

Case number	CAC-UDRP-105611
Time of filing	2023-07-10 10:38:00
Domain names	hiabhirehampshire.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Hiab AB
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Complainant representative

Organization	Atte Karineva (Berggren Oy)
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Respondent

Name	Ryan Watson
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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

Identification of Rights

The Complainant claims rights in the HIAB trademark and service mark established by its ownership of an international portfolio of registrations, including the following for which it has provided details:

- United Kingdom registered trademark HIAB, registration number UK00904420402, registered on June 19, 2006 for goods and services in classes 7, 12, and 37;
- EUTM HIAB, registration number 004420402, registered on June 19, 2006 for goods and services in classes 7, 12, and 37;
- International trademark registration HIAB, registration number 905566, registered on September 27, 2006 for goods and services in classes 7, 12, and 37, offering protection in amongst others Australia and China;
- United States trademark and service mark registration HIAB, registration number 3,485,304, registered on August 12, 2008, for goods and services in international classes 7, 12, and 37.

FACTUAL BACKGROUND

Factual Background

The Complainant is a provider of various lifting, loading and unloading machines, devices, and equipment for use in cargo and load handling purposes and services related to them.

The disputed domain name <hiabhirehampshire.com> was registered on February 10, 2023, and redirects to a website that offers services competing with those 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 in response to the request by the Center for verification of the registration details of the disputed domain name.

PARTIES CONTENTIONS

The Complainant's Contentions

The Complainant claims rights in the HIAB mark established by its ownership of the portfolio of trademark and service mark registrations described above and extensive use of the mark since 1947 in its business manufacturing lifting and loading equipment and devices and providing related services.

It is submitted that since its establishment in 1947 and its first registration of the HIAB mark in 1960 when it applied for the Swedish registration no. 106500, the Complainant has grown to have a global business, operating in more than 100 countries around the world and consequently the HIAB trademark has become well-known and enjoys significant international reputation and goodwill.

The Complainant alleges that the disputed domain name is confusingly similar to the Complainant's trademark and eponymous company name, as it incorporates identically the Complainant's HIAB trademark in combination with the indistinctive generic element "hire" and the element "Hampshire" which designates a geographical location in the United Kingdom.

It is submitted that according to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), section 1.7, in cases where, as here, a domain name at issue incorporates the entirety of a complainant's 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 standing under the Policy.

Moreover, the Complainant contends that according to the section 1.8 of the WIPO Jurisprudential Overview 3.0, where the relevant trademark is recognizable within the disputed domain, the addition of other verbal elements, such as descriptive or geographical terms, do not prevent a finding of confusing similarity.

The Complainant adds that that the generic Top-Level Domain ("gTLD") extension <.com> is not to be taken into consideration when examining the similarity between the Complainant's trademarks and the disputed domain name, because it is well established that a gTLD extension is irrelevant and insufficient to avoid a finding of confusing similarity. See *Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin*. WIPO Case No. D2003-0888, (A domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP). In its decision the panel also agreed that a descriptive component added to the complainant's trademark even adds to the confusion by leading users to believe that the complainant operates the web site associated to the disputed domain name.

The Complainant further contends that its well-known HIAB trademark as the initial, dominant, and only distinctive element in the disputed domain name, and the addition of the generic elements "hire" and "hampshire" when combined therewith are likely to be understood by Internet users as referring to the Complainant or its HIAB goods/services geographically located in Hampshire, United Kingdom.

The Complainant next alleges that the Respondent has no right or legitimate interest in the disputed domain name, arguing that pursuant to Policy paragraph 4(a)(ii), the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests, whereupon the burden of production on this element shifts to the Respondent.

The Complainant submits that as result of its rights in its extensive portfolio of earlier trademark registrations and long-standing use of

the trademark and the company name, the Complainant has exclusive prior rights to the HIAB trademark especially for goods and services related to lifting apparatus and cranes; and the Complainant asserts that it has not granted any license or other rights to use any of its trademarks, company name or domain names to the Respondent.

The Complainant asserts that neither the use nor the registration of the disputed domain name has been authorized by the Complainant, nor has the Complainant approved the use or registration of the disputed domain name.

The Complainant further asserts that the Respondent is neither affiliated with the Complainant nor authorized by the Complainant in any way to use the HIAB mark.

It is further argued that the generic additions “hire” and “Hampshire” combined with the well-known HIAB mark are likely to be understood by Internet users as referring to the Complainant, geographically located in Hampshire.

It is further contended that, to the knowledge of the Complainant, the Respondent is not commonly known by the disputed domain name and that the Respondent’s use of the disputed domain name is neither non-commercial nor fair use.

The Complainant adds that the Respondent’s use of a domain name should not be considered “fair” because 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. Domain names incorporating a registered trademark as their dominant element carry a risk of implied affiliation.

It is further submitted that according to the searches conducted by the Complainant on the Internet and in the trademark databases, the Respondent does not have any rights preceding those of the Complainant to the “HIAB” name.

The Complainant refers to a screen capture of the website to which the disputed domain name resolves which is exhibited in an annex to the Complaint; and asks this Panel to note that the disputed domain name resolves to a website offering cargo lifting and transporting services which compete with those offered by the Complainant.

It is argued that based on the pictures on the Respondent’s exhibited website, it seems the Respondent is not using the Complainant’s products to provide the services purported to be offered on the resolving website, but instead is using lifting equipment sold by the Complainant’s competitors.

The Complainant contends that therefore the content on the resolving website shows that the Respondent is not using or preparing to use the disputed domain name in connection with a *bona fide* offering of goods or services or for any legitimate purpose, but instead is simply using the disputed domain name to drive traffic to the competing website.

The Complainant refers to the decision of the panel in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, to argue that the Respondent is not making nominative fair use of the Complainant’s mark, arguing that in *Okidata* the panel put forward four conditions which should be met by a respondent, typically a reseller or authorized distributor of a complainant’s goods or services, in order to establish that it is making nominative fair use of a trademark for the purposes of the Policy, namely: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

It is submitted that in the present case, the Respondent cannot fulfil items (i), (ii), or (iii) of the conditions and, on that basis, could not be regarded as having rights or legitimate interests in the disputed domain name on the basis of nominative fair use.

The Complainant next alleges that the disputed domain name was registered and is being used in bad faith, arguing that according to the Rules, bad faith can be demonstrated, *inter alia*, by showing that the domain name is used to attract Internet users to the

respondent's website for commercial gain/profit.

The Complainant contends that it is evident that the Respondent was well aware of the Complainant's trademark and has intentionally registered and used the disputed domain name in order to benefit from and free-ride on the Complainant's reputation and goodwill.

It is added that the Respondent should also have verified from general online databases the existence of the Complainant's prior rights. The Respondent cannot have ignored the Complainant's trademark at the time of registration.

According to section 3.2.2 of the WIPO Jurisprudential Overview 3.0, noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where, as in the present case, the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark, panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark.

Therefore, it is submitted that the Respondent knew or should have known that his registration of the disputed domain name would be identical to the Complainant's mark.

The Complainant further argues that the Respondent is intentionally and actively using the disputed domain name in bad faith by intentionally attempting to attract, for commercial gain, Internet users and the Complainant's potential customers, by creating a likelihood of confusion with the Complainant's registered and well-known HIAB trademark and company name as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

Again referring to the screen capture exhibited in the annex to the Complaint, the Complainant contends that the disputed domain name directs to a website offering cargo lifting and transporting services and the Respondent therefore directly benefits financially in their business from the goodwill and reputation of the Complainant's trademark registered and used in the same field of business. Based on the pictures on the website, the Respondent is not using the Complainant's products to provide services but instead is using lifting equipment sold by competitors of the Complainant.

The Complainant concludes that by the aforementioned actions, the Respondent is causing detriment and damage to the Complainant's well-known HIAB brand and trademark.

The Respondent's Contentions

No administratively compliant response has been filed 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).

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 Complainant requested this dispute to be decided by a three-member panel. Since Respondent did not provide its candidates of panelist, the Centre chose the member of the Panel from its list of panelists.

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 Complainant's Rights

The Complainant has provided convincing, uncontested evidence that it has rights in the HIAB mark, established by the ownership of the international portfolio of registrations described above and extensive use of the mark in connection with the manufacture and sale of lifting and construction machinery, operating in over 100 countries across the world.

Confusing Similarity

The disputed domain name <hiabhirehampshire.com> incorporates the Complainant's HIAB mark in its entirety in combination with the elements "hire", "hampshire" and the gTLD extension <.com>.

The Complainant's HIAB mark is the initial, dominant and only distinctive element in the disputed domain name.

The element "hire" is descriptive, and the element "hampshire" denotes a geographical location in the United Kingdom. In the context of the disputed domain name the additional elements, either separately or in combination, do not add any distinguishing character to the disputed domain name and their presence does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's HIAB mark.

Similarly, the gTLD extension <.com> does not prevent a finding of confusing similarity as in the circumstances of this proceeding, it would be considered a necessary technical requirement for each of the disputed domain name registrations.

This Panel finds therefore that the disputed domain name is confusingly similar 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).

Legitimate Interest

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

- as result of its rights in its extensive portfolio of earlier trademark registrations and long-standing use of the trademark and the company name, the Complainant has exclusive prior rights to the HIAB trademark, especially for goods and services related to lifting apparatus and cranes, and the Complainant has not granted any license or other rights to use any of its trademarks, company name or domain names to the Respondent;
- neither the use, nor the registration of the disputed domain name has been authorized by the Complainant;
- the Complainant has not approved the use or registration of the disputed domain name;
- the Respondent is neither affiliated with the Complainant nor authorized by the Complainant in any way to use the HIAB mark;
- the generic additions "hire" and "Hampshire" combined with the well-known HIAB mark in the disputed domain name are likely to be understood by Internet users as referring to the Complainant, geographically located in Hampshire;
- to the knowledge of the Complainant, 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;
- neither can the Respondent's use of the disputed domain name be considered "fair", because 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; and domain names incorporating a registered trademark as their dominant element carry a risk of implied affiliation;
- according to the searches conducted by the Complainant on the Internet and in the trademark databases, the Respondent does not have any rights to the "HIAB" name preceding those of the Complainant;

- a screen capture of the website to which the disputed domain name resolves which is exhibited in an annex to the Complaint illustrated that the disputed domain name resolves to a website offering cargo lifting and transporting services which compete with those offered by the Complainant;
- based on the pictures on the Respondent's exhibited website, it appears that the Respondent is not using the Complainant's products to provide the services that he purports to offer on the resolving website, but instead is using lifting equipment sold by the Complainant's competitors;
- therefore the content on the resolving website shows that the Respondent is not using or preparing to use the disputed domain name in connection with a *bona fide* offering of goods or services or for any legitimate purpose, but instead is simply using the disputed domain name to drive traffic to the competing website;
- In *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, the panel set out the tests in which a respondent may establish that it is making nominative fair use of a trademark for the purposes of the Policy, namely: (i) the respondent must actually be offering the goods or services at issue; (ii) the respondent must use the site to sell only the trademarked goods or services; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark; and in the circumstances of the present case the evidence shows that the Respondent cannot establish elements (i) to (iv) of the test, and, on that basis, could not be regarded as having rights or legitimate interests in the disputed domain name on the basis of nominative fair use.

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).

Bad Faith

The Complainant has adduced clear and convincing, uncontested evidence that it has trademark and service mark rights and an extensive international reputation in the HIAB mark which long predate the registration and first use of the disputed domain name on February 10, 2023.

HIAB is a distinctive mark, and not only has the Complainant shown that it has a significant reputation in the provision of construction equipment, across over 100 countries, but it also has an established Internet presence.

Therefore, it is improbable that the disputed domain name, which consists of the mark in combination with the term "hire", which is descriptive of the services offered by the Complainant and the term "Hampshire" which is a geographical term designating a location in the United Kingdom, was chosen, and registered by coincidence.

On the balance of probabilities, the registrant of the disputed domain name knew or should have known about the Complainant, its eponymous and well-known trademark and service mark and the Complainant's rights, reputation, and goodwill when registering the disputed domain name.

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

The screen captures of the website to which the disputed domain names resolve, which have been exhibited in evidence in an annex to the Complaint, show that the disputed domain name resolves to a website which purports to offer construction services using plant and machinery manufactured by competitors of the Complainant.

The Respondent's use of HIAB mark within the disputed domain name must inevitably attract and confuse Internet users and divert

Internet traffic intended for the Complainant’s website, to the website designated by the Respondent. Such use of the disputed domain name is sufficient to establish bad faith by the Respondent for the purposes of the Policy.

The Complainant has therefore 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. **hiabhirehamshire.com**: Transferred

PANELLISTS

Name	Andrew Lothian
Name	Tom Heremans
Name	James Bridgeman

DATE OF PANEL DECISION 2023-08-17

Publish the Decision