

ADMINISTRATIVE PANEL DECISION

Cummins Inc. v. Peyman Shahidnoorai, Roshangar Rayaneh Tehran
Case No. D2022-2885

1. The Parties

- 1.1 The Complainant is Cummins Inc., United States of America (“United States”), represented by Saba & Co. Intellectual Property s.a.l. (Offshore) Head Office, Lebanon.
- 1.2 The Respondent is Peyman Shahidnoorai, Roshangar Rayaneh Tehran, Iran (Islamic Republic of).

2. The Domain Name and Registrar

- 2.1 The disputed domain name <cumminscenter.com> (the “Domain Name”) is registered with 1API GmbH (the “Registrar”).

3. Procedural History

- 3.1 The Complainant’s representatives engaged in email correspondence with the Registrar prior to these proceedings. On 10 March 2022, and during that correspondence, the Registrar sent an email in which they provided what was described as the “data … on file for the registrant”. That “data” identified “Peyman Shahidnoorai of Roshangar Rayaneh Tehran” as the registrant of the Domain Name and provided contact details for the registrant in Iran.
- 3.2 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 5, 2022. Although at that time the publicly available Whois details for the Domain Name stated that the “Registration Name” and “Organization” was “REDACTED FOR PRIVACY”, the Complainant used the registration details previously provided by the Registrar in its Complaint.
- 3.3 On August 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 9, 2022, the Registrar transmitted by email to the Center its verification response. In that email the Registrar identified the Registration Name and Organization details (as well as contact details) for the registrant to be “REDACTED FOR PRIVACY”.
- 3.4 Accordingly, on August 9, 2022 the Center made a further request by email of the Registrar for full contact details in relation to the Domain Name. On August 10, 2022 the Registrar responded as follows:

"Unfortunately this is the data provided to us by the reseller and all we have on this registration. We already suspended the registration due to the violation of our registration terms."

- 3.5 In light of that response, the Center asked the Registrar in an email dated August 12, 2002 to confirm whether the Domain Name was available for registration. The Registrar's response by email the same day was as follows:

"[T]he [Domain Name] remains registered for the registrant as he retains the ability to cure the violation. We are legally [sic] unable to transfer ownership of the domain name without a decision."

- 3.6 By email dated August 12, 2002, the Center wrote again to the Registrar pointing out its obligations under ICANN's Temporary Specification for generic Top-Level Domain ("gTLD") Registration Data (appendix E) and requesting that the Registrar "coordinate" with the relevant reseller "in order to provide the requested information regarding the identity and contact details of the holder of the [Domain Name]". It further informed the Registrar that absent a satisfactory response the Center might notify ICANN in this respect.
- 3.7 The Registrar did not respond to that email, notwithstanding a further email chaser from the Center on September 15, 2022. On September 21, 2022 the Center informed the Registrar that it had filed a complaint with ICANN. It also drew the Registrar's attention that it appeared to have previously disclosed underlying registration data for the Domain Name to the Complainant in March 2022 and asked the Registrar to confirm whether that registrant information remained the same.
- 3.8 Again, the Registrar did not respond to that email and on October 4, 2022 the Center informed the Registrar that unless informed otherwise by October 6, 2022, it would proceed on the assumption that the registrant information provided in March 2022 was correct. Again, no response was forthcoming.
- 3.9 The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").
- 3.10 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 27, 2022.
- 3.11 The Center appointed Matthew S. Harris as the sole panelist in this matter on November 2, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

- 4.1 The Complainant is corporation based in the United States and incorporated in Indiana. It designs, manufactures, sells and services diesel engines, turbochargers, spare parts, filters, generators, and related technology around the world.
- 4.2 The Complainant has registered trade marks that incorporate or comprise the term "Cummins" throughout the world. Its portfolio of marks includes at least six Iranian registered trade marks including:
- (i) Iranian registered trade mark No. 20400 June 26, 1960 in respect of CUMMINS as a word mark

in classes 7, 12, 35, 37, 39, and 40.

- (ii) Iranian registered trade mark No. 322380 dated February 16, 2019 in classes 7 and 12, which takes the following form:



- 4.3 The Complainant's business is also promoted from a website using the domain name <cummins.com>. The <cummins.com> domain name is registered in the name of Cummins Intellectual Property, Inc., which is a company affiliated with the Complainant.
- 4.4 The Domain Name was registered on April 28, 2015. It has been used for a website that is either wholly or predominantly in Arab script. That website also prominently displayed a logo that takes the same form as the Complainant's Iranian trade mark No. 322380 described above.
- 4.5 On a date that is not disclosed the Complainant sent a letter described as a "legal notice" to the Respondent. There was no response to that letter.
- 4.6 As far as the Panel can tell, at the date of this decision no website is operating from the Domain Name.

5. Parties' Contentions

A. Complainant

- 5.1 The Complainant refers to its business and Iranian trade marks. It contends that the Domain Name is identical to the Complainant's trade marks, asserting that the addition of the suffix "center" is "not relevant". In support of that contention, it refers to the decision in *AB Electrolux v. Zanussi Center*, WIPO Case No. [D2019-1823](#) and quotes a sentence from that decision in which the panel stated that the "addition of the element 'center' does not prevent a finding of confusing similarity".
- 5.2 The Complainant asserts that the Respondent has no right or legitimate interest in respect of the Domain Name and asserts that none of the examples of such rights or interest set out in paragraph 4(c)(iii) apply. In this respect the Complainant contends that:
 - (i) "the Respondent is not an authorized distributor or manufacturer of [the] Complainant's products"; and
 - (ii) "The website www.cumminscenter.com is promoting a shop that is 'importing and selling main spare parts of CUMMINS engines and reputable brands replacing CUMMINS' main spare parts.'"

The source of the quotation that forms part of assertion identified at (ii) above is not identified in the Complaint. But attached to the Complaint are screenshots of a webpage said to have operated from the Domain Name. From this it would appear that the quotation used is taken from that website (or perhaps is an English translation of a passage from that website).

- 5.3 So far as bad faith is concerned, the Complainant contends that as it registered its mark in the Islamic Republic of Iran, it is “very likely” that the Respondent was aware of the Complainant’s mark and products at the time of registering the Domain Name. It also contends that there is a “misappropriation” of “sufficient textual elements from the Complainant’s name” that Internet users would think an affiliation exists between the Domain Name and the Complainant that does not exist. The use of the Complainant’s mark on the website together with “photos of the Complainant’s CUMMINS spare parts” is said to lead to a likelihood of confusion on the part of consumers, again as to whether a business relationship exists.
- 5.4 The Complainant also relies upon the “legal notice” it sent to the Complainant. Exactly when this was sent is not disclosed. Similarly what exactly was said in this “notice” is not clear since the document appears again to be in Persian and no translation has been provided. However, it seems reasonably clear that the Complainant is contending that this “notice” was some form of cease and desist letter. The Complainant contends that the Respondent’s failure to respond to this “notice” is evidence of bad faith, citing in this respect the decision in *Juris A/S v. Mansoureh Mirzaei Ghaleh Mirzaei*, WIPO Case No. [DIR2014-0010](#).

B. Respondent

- 5.5 The Respondent did not reply to the Complainant’s contentions.

6. Discussion and Findings

- 6.1 There are no exceptional circumstances within paragraph 5(f) of the Rules so as to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of any Respondent to lodge a Response.
- 6.2 To succeed in these proceedings the Complainant must make out their case in all respects under paragraph 4(a) of the Policy. Namely, the Complainant must prove that:
 - (i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights (paragraph 4(a)(i)); and
 - (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name (paragraph 4(a)(ii)); and
 - (iii) the Domain Name has been registered and is being used in bad faith (paragraph 4(a)(iii)).
- 6.3 However, under paragraph 14(b) of the Rules, where a party does not comply with any provision of the Rules, the Panel shall “draw such inferences therefrom as it considers appropriate”.
- 6.4 Before addressing these substantive aspects of the Policy, the Panel notes that the Center has already made a complaint to ICANN about the Registrar’s failure to identify the underlying registrant of the Domain Name in response to the Center’s verification request.
- 6.5 The Registrar appears to contend that it was not able to provide this information because “REDACTED FOR PRIVACY” is the only information provided by the reseller of the Domain Name and that the Register holds no further information. However, this is problematic on a number of levels. First, if what the Registrar claims is correct, it is troubling that (a) the Registrar has allowed this to occur in the first place, and (b) when this was brought to the Registrar’s attention no attempt appears to have been made by the Registrar to take this up with the reseller in question to obtain the relevant underlying data (notwithstanding the Center’s direct request that it do so). Second, the Registrar’s statement is difficult to reconcile with the fact that just a few months prior to the filing of the Complainant, the Registrar not only had that information but disclosed it to the Complainant. Maybe

there is some explanation as to why the information was available in March 2022 but not in August 2022. However, despite being asked by the Center to provide that explanation, the Registrar appears to have ignored that request.

- 6.6 As the Center has already made a complaint to ICANN in this respect, the Panel does not consider it necessary or appropriate to make a formal procedural order requesting the Registrar to respond to these points or to invite the Panel to draw the Registrar's conduct to the attention of ICANN (as was done for example in *Rubis Energie v. Privacy Administrator, Anonymize, Inc.* WIPO Case No. [DCO2019-0033](#)). However, the Center may consider it useful to provide a copy of this decision to ICANN in connection with its original complaint.

A. Identical or Confusingly Similar

- 6.7 The Complainant has satisfied the Panel that it has registered trade mark rights in the term "Cummins" in Iran. In order to demonstrate the first element of the Policy it is usually sufficient for a complainant to show that the relevant mark is "recognizable with the disputed domain name" (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).
- 6.8 The Domain Name can only be sensibly understood as the term "Cummins" combined with the word "center" and the ".com" Top-Level Domain. The Complainant's mark is, therefore, clearly recognisable in the Domain Name.

B. Rights or Legitimate Interests

- 6.10 As far as the Panel can tell this is a case where the Domain Name has been used by a retailer of spare parts for the Complainant's products. Given this, the way that the Complainant has expressed its case is problematic. Essentially, the Complainant appears to take the position that merely the fact that the retailer is unauthorised by the Complainant is sufficient to support a finding of lack of rights and legitimate interests.
- 6.11 The trouble with this contention is that it ignores the fact that it has long been the case under the UDRP that a retailer, whether or not authorised by a trade mark owner, may in certain circumstances be able to use the trade mark of a third party to sell goods of that third party. The position is recorded in Section 2.8.1 of the [WIPO Overview 3.0](#) which states as follows:

"2.8.1 Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the 'Oki Data test', the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (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.

..."

- 6.12 It may be that had the Complainant properly turned its mind in its Complaint to this issue, it could have demonstrated that the “Oki Data test” was not satisfied in this case. For example, the use of a quote in the Complaint that contains the words “reputable brands replacing CUMMINS’ main spare parts”, raises a question as to whether limb (ii) of the Oki Data test is satisfied. But this is neither expressly alleged let alone properly evidenced.
- 6.13 This is not however the end of the matter. The reason for this is that it also contends that the Domain Name is inherently deceptive such that Internet users would “think [that] an affiliation exists between the domain name and the Complainant that does not exist”. The Panel accepts this is correct.
- 6.14 Again the relevant principles are addressed in the [WIPO Overview 3.0](#). In particular, section 2.8.1 states:

“Cases applying the Oki Data test usually involve a domain name comprising a trademark plus a descriptive term (e.g., ‘parts’, ‘repairs’, or ‘location’), whether at the second-level or the top-level. At the same time, the risk of misrepresentation has led panels to find that a respondent lacks rights or legitimate interests in cases involving a domain name identical to the complainant’s trademark. [See section 2.5.1 above.]”

This is not a case where the domain name is “identical to the complainant’s trademark”, but section 2.5.1 of the [WIPO Overview 3.0](#) referred to in this passage also states as follows:

“Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

As described in more detail below and in sections 2.6 through section 2.8, UDRP panels have articulated a broad continuum of factors useful in assessing possible implied sponsorship or endorsement.

At one end, certain geographic terms (e.g., <trademark-usa.com>, or <trademark.nyc>), or terms with an ‘inherent Internet connotation’ (e.g., <e-trademark.com>, <buy-trademark.com>, or <trademark.online>) are seen as tending to suggest sponsorship or endorsement by the trademark owner.

At the other extreme, certain critical terms (e.g., <trademarksucks.com>) tend to communicate, *prima facie* at least, that there is no such affiliation.

In between, certain additional terms within the trademark owner’s field of commerce or indicating services related to the brand, or which are not obviously critical (e.g., <okidataparts.com>, <nascartours.com>, <covancecampaign.com>, or <meissencollector.com>), may or may not by themselves trigger an inference of affiliation, and would normally require a further examination by the panel of the broader facts and circumstances of the case – particularly including the associated website content – to assess potential respondent rights or legitimate interests.”

- 6.15 The relevant additional term in the present case is, of course, “center”. In the view of the Panel it is more akin to a geographical term that suggests sponsorship or endorsement, than an intermediate term such as “parts”, “collector” or “campaign”, let alone a term such as “sucks” that directly and immediately signals that there is no such affiliation. Accordingly, the Panel finds that the Domain Name, even when used for a website that sells parts for the Complainant’s products, unfairly impersonates the Complainant or suggests an affiliation that does not exist. Therefore, even though the Domain Name may be being used to sell spare parts for the Complainant’s products, the Panel holds that the Respondent has no rights or legitimate interests in the same.

- 6.16 In the circumstances, the Panel accepts that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

- 6.17 The Panel accepts that the Respondent knew of the Complainant's mark at the time of registration and registered the Domain Name with the intention of taking advantage of its association with the Complainant's business and mark in order to promote the Respondent's business.
- 6.18 Again the way that the Complainant has presented its case in this respect in the Complaint is unhelpful. Although the Complainant has identified its registered Iranian marks (one of which pre-dates by many decades the registration of the Domain Name) and claims that its mark is "world famous" there is no real attempt to explain or demonstrate that alleged fame either worldwide or in Iran at the time that the Domain Name was initially registered. Also, although the Complainant provides screenshots from the website operating from the Domain Name in support of its contention that a website is being operated from the Domain Name that sells spare parts for the Complainant's products, again no attempt is made in the Complaint to explain or evidence when that particular use began. These are not trivial points in circumstances where the Domain Name appears to have been first registered over seven years ago.
- 6.19 Nevertheless, the Panel accepts that the Domain Name inherently suggests a deliberate connection with the Complainant and its business. "Cummins" is a not uncommon English language surname, but its combination with the word "center" is odd unless "Cummins" is being used in the Domain Name as a name for a business. Therefore, in the absence of argument or evidence to the contrary, the Panel accepts that a reference to a business was intended and, in particular, to the business of the Complainant.
- 6.20 Then there is the Complainant's evidence of the use of the Domain Name for a website selling spare parts for the Complainant's products. Notwithstanding the lack of evidence of when this use started, the Panel is prepared to accept absent argument or evidence to the contrary that the Domain Name was initially registered was with this sort of use in mind.
- 6.21 Accordingly, the Panel accepts that the Respondent knew of the Complainant's mark at the time of registration and registered the Domain Name with the intention of taking advantage of its association with the Complainant's business and mark. It follows from this, and the Panel's finding that the Domain Name suggests an affiliation or endorsement by the Complainant that does not exist, that the Domain Name was both registered and has been used in bad faith.
- 6.22 There is also the Respondent's failure to respond to the Complainant's letter. The Panel accepts that failure to respond to a "cease and desist" letter may provide evidence that supports a finding of bad faith registration and use. However, that failure is rarely determinative and how much weight is given to this will depend upon a number of factors, including what exactly is alleged and demanded in that letter and whether it is reasonably likely that the letter would have come to the attention of the Respondent. The difficulty in this case is that although a copy of the Complainant's "notice" has been provided, the Complainant has not provided any English translation of the same. However, there is no need to consider this point further given that the Panel has been able to find in favour of the Complainant without needing to rely upon the Respondent's lack or response to the Complainant's letter.
- 6.23 In the circumstances, the Panel accepts that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

7. Decision

7.1 For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <cumminscenter.com> be transferred to the Complainant.

/Matthew S. Harris/

Matthew S. Harris

Sole Panelist

Date: November 28, 2022