

## **ADMINISTRATIVE PANEL DECISION**

National Automobile Dealers Association v. Rizwan Shahzaib  
Case No. D2023-3177

### **1. The Parties**

The Complainant is National Automobile Dealers Association, United States of America ("United States"), represented by Troutman Pepper, United States.

The Respondent is Rizwan Shahzaib, Pakistan.

### **2. The Domain Name and Registrar**

The disputed domain name <nadausedcarvalue.com> is registered with Cosmotown, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 24, 2023. On July 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 27, 2023, the Registrar transmitted by email to the Center its verification response:

- (a) confirming the disputed domain name is registered with it;
- (b) confirming the language of the registration agreement is English; and
- (c) disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint.

The Center sent an email communication to the Complainant on July 31, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 31, 2023.

The Center verified that the Complaint, together with the amended 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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2023. The Respondent sent email communications to the Center on July 31, August 1, and August 12, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on September 12, 2023. 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**

The Complainant is an American trade organization representing over 16,500 franchised new car and truck dealerships. It was established in 1917. In addition to its 16,500 franchised dealer members, it also claims to represent some 32,000 franchises.

Amongst the services the Complainant provides, it conducts and publishes research into the state of the retail automobile industry in the United States including annual statistics about vehicle sales and market conditions, forecasts and quarterly and monthly reports.

The Complainant first began studying used car values in 1922. In 1933, it published its first Official Used Car Guide, providing values across 21 regions of the United States for some 40,000 subscribers. In the mid-1930s, it established the first edition of its standard for appraising used cars.

The Complaint includes evidence that the Complainant owns numerous trademarks in the United States. These include:

- (a) United States Registered Trademark No. 3,039,108, NADA, in respect of management consulting services for automobile dealers and association services promoting the interests of automobile dealers in, respectively, International Classes 35 and 42 which has been registered in the Principal Register since January 10, 2006;
- (b) United States Registered Trademark No. 4,798,592, NADA, in respect of a range of services in International Classes 35 and 41 including promoting and conducting trade shows, lobbying services and business education and training services. This trademark was registered in the Principal Register on August 25, 2015;
- (c) United States Registered Trademark No. 1,370,092, N.A.D.A. OFFICIAL USED CAR GUIDE, in respect of publications for used car values in International Class 16 and which has been registered in the Principal Register since November 12, 1985.

It is not clear from the record when the disputed domain name was registered.

A Whois search conducted by the Panel at “<https://who.is>” and at the Registrar’s website discloses the disputed domain name was registered on October 5, 2022.

Further, as discussed below, the Complaint includes a print-out for the disputed domain name from the Wayback Machine. In light of this, the Panel has viewed the history of captures by the Wayback Machine. The Wayback Machine shows captures for the disputed domain name in 2007 and early 2008, then nothing until 2013. There were single captures in each of 2013 and January 2014. After January 2014, there were no captures at all until April 4, 2023.

The website captured in 2014 appears to have been a parking page with pay-per-click (“PPC”) advertising links. It was very different in layout and content to the website captures this year.

In light of these matters, the Panel infers that the Respondent registered the disputed domain name in or about October 2022.

Currently, the disputed domain name resolves to a website which appears to be providing accurate estimates of car valuations and which generates numerous PPC links. The website is in English. When the Complaint was filed, the website featured a banner across the top:



Earlier in June 2023, a Wayback Machine capture showed that the disputed domain name resolved to a website also appearing to provide services in connection with providing estimates for used car values. That version of the website featured, in addition to the NADA Used Car Value and car device logo shown above, a very prominent depiction of the Complainant's logo-form of its trademark with two wavy lines underneath NADA above the strapline "National Automobile Dealers' Association".

The About Us page of the Respondent's website states:

"Nada used car value is basically a website for general update news related to auto industry in the market of the U.S. We provide a platform for the user to get information about used cars from different websites."

The About Us page does (at least currently) direct the browser to go to the Complainant's website for an accurate estimate which seems at the least odd given the "Get a Quote" service being offered on the landing page.

## 5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

The Panel notes that the language of the registration agreement, like the versions of the Respondent's website and the emails received from the Respondent, is English. In accordance with paragraph 11 of the Rules, therefore, English is the language of the proceeding.

### A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has proven ownership of numerous registered trademarks featuring NADA including those identified by way of example in section 4 above.

The comparison of the disputed domain name to one or other of these trademarks simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, the disputed domain name is not identical to any of the Complainant’s registered trademarks. It does incorporate, however, the whole of the Complainant’s registrations for NADA alone. See e.g., [WIPO Overview 3.0](#), section 1.7. It is also very similar to the Complainant’s registration No. 1,370,092 containing three of the five words – NADA, USED and CAR in essentially the same order and conveying very much the same idea albeit the Complainant’s registered trademark includes the word “Official”.

As this requirement under the Policy is essentially a standing requirement, these differences do not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), sections 1.7 and 1.8. Apart from anything else, the Complainant’s NADA trademarks remain visually and aurally recognisable within the disputed domain name and, the Panel considers, the same can be said for the Registered Trademark No. 1.370,092.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademarks and the requirement under the first limb of the Policy is satisfied.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

It is not in dispute that the Respondent is not part of, or licensed or associated in any way with the Complainant.

The disputed domain name is not derived from the Respondent’s own name and there is no evidence before the Panel of any other name by which the Respondent is known from which the disputed domain name could be derived.

The Respondent states in his email on August 1, 2023 after the Complainant’s logo had been removed from his website and the Complainant’s name had been partially removed:

“... currently there is nothing national automobile dealers association present on my website. My website is simply blogging & Car estimated value. It has no connection with the national automobile dealers association. I will use my own logo & content for my website. You can check it there. ....”

The Respondent further contends that the disputed domain name and his logo are unique. He also claims that he has applied for a trademark.

The Panel does not accept that this explanation establishes the Respondent is using the disputed domain name in connection with a good faith offering of goods or services of the kind contemplated by paragraph 4(c)(i).

First of all, the Respondent arrived at the revised form of the website only after notice from the Complainant.

More fundamentally, accepting that the disputed domain name and the Respondent's logo are unique in the sense of not being identical to prior names or logos, the key distinguishing element of both the disputed domain name and the current form of the Respondent's website is the word NADA.

While “nada” can be a slang term in English for “nothing”, that meaning makes no sense in the present context and so the Panel considers it most unlikely that Internet users would understand “NADA” as used in the disputed domain name or on the Respondent's website as being a descriptive or common English term. As the Complainant points out, therefore, the term NADA is distinctive in relation to both the Complainant's and Respondent's services.

As a result, the use of NADA in the disputed domain name and on the Respondent's website is very likely to signify, and be understood as signifying, services provided by the Complainant. That is false. Moreover, the prior use of the disputed domain name to resolve to a website featuring the Complainant's logo and name indicates that the Respondent has adopted NADA to take advantage of its trademark significance. Furthermore, the user of the Respondent's website is presented with a number of PPC links promoting third party products. It is well-established that such use does not qualify as “good faith” for the purposes of the Policy. See e.g., [WIPO Overview 3.0](#), section 2.13.1.

The Respondent has not provided any evidence of the claimed trademark application. When or where it was filed is not in evidence. In any event, given the length of the Complainant's use and the Respondent's targeting of the United States market, it appears highly unlikely that any trademark application made by the Respondent for its services would be successful.

Having reviewed the record, therefore, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

For the reasons discussed in section 5B above, the Panel considers it is appropriate to regard the term NADA as an invented or distinctive term in the present circumstances.

The form of the Respondent's website before the Complaint was filed shows that the Respondent was well aware of the Complainant, its trademark and the services it offered under that trademark before the Respondent registered the disputed domain name.

In addition, for the reasons discussed there, it appears that the Respondent registered the disputed domain name to take advantage of its similarity to the Complainant's trademark and to take advantage of that trademark significance.

That clearly constitutes registration in bad faith under the Policy.

Further, the manner of use including the continued use of the disputed domain name which is confusingly similar to the Complainant's trademarks and so conveys a false impression of association with the Complainant constitutes use in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

## **6. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <nadausedcarvalue.com>, be transferred to the Complainant.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: September 26, 2023