

## **ADMINISTRATIVE PANEL DECISION**

### **MAN Marken GmbH v. Dmitriy Rezinikov**

### **Case No. D2021-4114**

#### **1. The Parties**

Complainant is MAN Marken GmbH, Germany, represented by Grünecker Patent- und Rechtsanwälte PartG mbB, Germany.

Respondent is Dmitriy Rezinikov, Ukraine.

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

The disputed domain name <manservice-dn.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 8, 2021. On December 8, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 8, 2021, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on December 21, 2021 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on December 22, 2021.

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 Respondent of the Complaint, and the proceedings commenced on December 28, 2021. In accordance with the Rules, paragraph 5, the due date for Response was January 17, 2022. Respondent submitted four short emails on January 4, 2022. Accordingly, the Center sent an acknowledgement of receipt of the emails on January 24, 2022.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on February 7, 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.

Complainant requested by email the suspension of the proceeding on March 8, 2022. The Panel issued the Procedural Order No. 1 on March 15, 2022, informing the Parties of the suspension of the proceeding. The Panel further provided instructions in the event that the Parties reached a settlement, through Procedural Orders No. 2, 3, 4 and 5, extending the suspension until January 18, 2023.

#### **4. Factual Background**

Complainant is a subsidiary of MAN Truck & BUS SE, a German-based business engaged in the manufacture and service of trucks and busses under the MAN and MAN SERVICE marks. Complainant is the proprietor of, *inter alia*, the following trademark registrations:

- German trademark No. 297302 for MAN (device mark), registered on January 26, 1923 for goods in classes 6, 7, 9, 11, 12, and 19;
- German trademark No. 30358710 for MAN SERVICE (device mark), registered on November 12, 2003 for goods and services in classes 16, 35, 36, 37, 39, 41, and 42.
- International Trademark No. 914360C for MAN (word mark), registered on March 28, 2006 for goods and services in classes 7, 9, 12, 16, 25, 28, 35, 36, 37, 39, 41, and 42.

The disputed domain name was registered on September 7, 2021. It resolves to a website for Respondent's truck-service business located in Donetsk, Ukraine.

The record contains a copy of a cease-and-desist letter addressed by Complainant to Respondent dated October 27, 2021. The record does not reflect a response thereto.

#### **5. Further Procedural Considerations**

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since Respondent's mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. The Panel has reached this conclusion in part because the Center sent the Notification of Complaint by email to Respondent at its email address as registered with the Registrar and to a postmaster email address as specified by the Rules. Respondent has been able to participate in the proceeding, and in fact has sent several email communications to the Center on January 4, 2022, January 27, 2022, and March 15, 2022.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

## **6. Parties' Contentions**

### **A. Complainant**

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that its MAN mark has been used for more than 100 years, it is well known in many jurisdictions and has been comprehensively protected by registrations in over 100 countries. Its MAN SERVICE mark is also registered. Complainant operates an extensive service network internationally, with numerous authorized service partners also in Ukraine. Respondent is not part of Complainant's authorized service network. The disputed domain name is confusingly similar to Complainant's marks. The "dn" element refers to the Dontesk region, where the repair shop advertised under the disputed domain name is located.

Under the second element, Complainant states that Respondent is not commonly known by the disputed domain name. Respondent is using the disputed domain name and Complainant's MAN and MAN SERVICE marks to attract Internet users to its website where Respondent offers services for MAN vehicles and for those of competitors, creating the incorrect impression that it is part of Complainant's authorized service network.

Under the third element, Complainant states that Respondent did not respond to its cease-and-desist letter. By registering and using the disputed domain name and prominently using the MAN logo on the website, Respondent attempts to create the incorrect impression that it is part of Complainant's authorized service network. Therefore, Respondent is taking advantage of Complainant's mark and reputation for commercial gain.

Complainant requests transfer of the disputed domain name.

### **B. Respondent**

Respondent provided email messages stating that his company, Avantil Group Organization, is an official partner and distributor of MAN vehicles in Ukraine. In 2014, military hostilities began in the Donetsk region, where Respondent is located. From that time, MAN Truck and Bus in both Ukraine and the Russian Federation have refused to cooperate with Respondent's company.

## **7. Discussion and Findings**

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

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

ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) Respondent has registered and is using the disputed domain name in bad faith.

### **A. Identical or Confusingly Similar**

Complainant has provided evidence establishing that it has trademark rights in the MAN and MAN SERVICE marks through registrations in numerous jurisdictions. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.

In comparing Complainant's MAN and MAN SERVICE marks with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to it. The disputed domain name comprises Complainant's MAN SERVICE mark in its entirety, followed by the element "-dn". It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. Moreover, where the relevant trademark is recognizable within the disputed domain names, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

It is the well-established view of UDRP panels that the addition of the generic Top-Level Domain ("gTLD"), in this case, ".com", to a disputed domain name does not prevent the disputed domain name from being confusingly similar to Complainant's trademark (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

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

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent is not authorized by Complainant and has no trademark rights in the MAN or MAN SERVICE marks. The disputed domain name contains Complainant's mark in its entirety, thereby suggesting sponsorship or endorsement by the trademark owner. Such use cannot confer rights or legitimate interests. See, for example, [WIPO Overview 3.0](#), section 2.5.1.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain names.

Respondent has not provided sufficient evidence of rights or legitimate interests under the Policy. The disputed domain name resolves to the website of a truck service business, and Respondent has provided some photos of what appears to be a business premises displaying a signboard with the text "MAN Truck & Bus Center" where the Panel considers Respondent probably provides its services. However, the Panel finds that is not sufficient to support a fair use of the disputed domain name under the Policy, particularly noting that Respondent's website was advertising services not only for Complainant's MAN vehicles, but also for competing brands. The circumstances do not indicate that the cumulative requirements of the "Oki Data test" have been met. Under this test, a reseller, distributor or service provider may be making a *bone fide* offering of goods and services and thus have a legitimate interest in the disputed domain name. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); *General Electric Company v. Japan, Inc.*, WIPO Case No. [D2001-0410](#). See also [WIPO Overview 3.0](#), section 2.8. The Panel notes that Respondent is using the disputed domain name to sell services other than services related to MAN vehicles, and the site does not disclose the registrant's relationship with the trademark holder (rather, the site used Complainant's logo and pictures of its vehicles in proximity with those of competitors). The evidence demonstrates that Respondent is using the disputed domain name to attract Internet users by using Complainant's trademark. Such use cannot confer rights or legitimate interests on Respondent. See [WIPO Overview 3.0](#), section 2.5.3, and cases cited thereunder.

Respondent has not provided evidence to support its contentions of a prior commercial relationship with Complainant's agents, and therefore has not refuted Complainant's express disavowal of the existence of any relationship. See [WIPO Overview 3.0](#), section 2.11

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

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

Pursuant to paragraph 4(b) of the Policy, the Panel finds that Complainant has demonstrated Respondent's bad faith registration of the disputed domain name. Complainant's rights in its MAN mark predate by nearly a century the registration of the disputed domain name. Based on the evidence presented and Respondent's statements, it is apparent that Respondent had actual knowledge that the disputed domain name was confusingly similar to Complainant's mark. See [WIPO Overview 3.0](#), section 3.2.2. Under the circumstances, the Panel finds that Respondent registered the disputed domain name for the purpose of taking advantage of its similarities with Complainant's mark in order to attract Internet users to its website.

Turning to use of the disputed domain name, the Panel finds that Complainant has provided sufficient evidence demonstrating Respondent's bad faith. The fact that the disputed domain name resolves to a website of a business offering service for MAN and third-party trucks demonstrates that Respondent was seeking to attract Internet users by using Complainant's mark in the disputed domain name. See, for example, *Bayerische Motoren Werke AG (BMW) v. Tristram Congreve, Tricosol SL CIF: ESB9296239*, WIPO Case No. [D2021-2336](#).

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) of the Policy.

### **8. 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 <manservice-dn.com> be transferred to Complainant.

*/Ingrīda Kariņa-Bērziņa/*

**Ingrīda Kariņa-Bērziņa**

Sole Panelist

Date: January 31, 2023