

## **ADMINISTRATIVE PANEL DECISION**

### **Volvo Trademark Holding Aktiebolag v. Nanci Nette Case No. D2022-0299**

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

The Complainant is Volvo Trademark Holding Aktiebolag, Sweden, represented by Zacco Sweden AB, Sweden.

The Respondent is Nanci Nette, United States of America (“United States”).

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

The disputed domain name <volvogroup.net> is registered with Layup Domains LLC (the “Registrar”).

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 28, 2022. On January 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 14, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 11, 2022.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on March 17, 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

The Complainant is a trademark holding company owned by AB Volvo and Volvo Car Corporation (the "Volvo Group").

The Complainant is the owner of numerous trademarks worldwide (the "VOLVO Trademark") including in the United States:

- The United States word trademark VOLVO, No 73316884, registered on December 21, 1982, and regularly renewed, for products and services in class 12,
- The United States word trademark VOLVO, No 78531596, registered on February 13, 2007, and regularly renewed, for products and services in classes 01, 02, 03, 04, 05, 06, 07, 08, 09, 11, 12, 14, 16, 17, 18, 20, 21, 22, 24, 25, 26, 27, 28, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45.

The different entities of the Volvo Group also hold and use several domain names including <volvo.com>, <volvogroup.com>, <volvocars.com> and <volvotrucks.com>.

The disputed domain name <volvogroup.net> was registered by the Respondent on November 24, 2021.

At the date the Complaint was filed, the disputed domain name resolved to a pay-per-click website, including links leading to websites of competitors of the Volvo Group.

At the time of the decision, the disputed domain name is inactive.

#### 5. Parties' Contentions

##### A. Complainant

First, the Complainant states that the disputed domain name is confusingly similar to the VOLVO Trademark, since it incorporates the VOLVO Trademark in its entirety, with the addition of the generic term "group". The Complainant underlines that the disputed domain name also closely corresponds with the Complainant's own domain name <volvogroup.com> which is connected to an active website featuring the Complainant's products and services.

Second, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, since there is no information indicating that the Respondent is somehow trading under a name corresponding to the disputed domain name. Moreover, the Complainant has not given any license or authorization of any other kind to the Respondent to use the VOLVO Trademark. The Complainant adds that the Respondent is not an authorized dealer of the Group's products or services and has never had a business relationship with the Complainant. Furthermore, the Complainant contends that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, but to generate traffic and income through a website displaying pay-per-click links of which several leads to sites operated by the Complainant's competitors.

At last, the Complainant finds that the Respondent has registered and is using the disputed domain name in bad faith, considering that: (i) the VOLVO Trademark has the status of a prominent trademark within, but not limited to, the United States and it is obvious that it is the fame and value of the VOLVO Trademark that has motivated the Respondent to register the disputed domain name, (ii) the Respondent has not responded to the cease and desist letter sent by the Complainant requesting the transfer of the disputed domain name, (iii) the disputed domain name is connected to a pay-per-click website leading to third-party websites, including to competitors to the Complainant, so that the Respondent, by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of

confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website (iv) it appears that the Respondent, Nanci Nette, has a history of registering domain names containing well-known trademarks.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

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

(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.

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

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the VOLVO Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially 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.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the disputed domain name is composed of:

- the VOLVO Trademark in its entirety, and
- the generic term "group", and
- the generic Top-Level Domain ("gTLD") ".net".

According to prior UDRP panel decisions, it is sufficient that the disputed domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of a word to a mark will not prevent a finding of confusing similarity (See *Hoffmann-La Roche Inc., Roche Products Limited v. Vladimir Ulyanov*, WIPO Case No. [D2011-1474](#); *Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#); *Bayerische Motoren Werke AG v. bmwcar.com*, WIPO Case No. [D2002-0615](#); *Swarovski Aktiengesellschaft v. mei xudong*, WIPO Case No. [D2013-0150](#); *RapidShare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#)).

The Panel considers that, in this case, the addition of the term “group” to the distinctive sign VOLVO included in the disputed domain name does not prevent a finding of confusing similarity.

Moreover, the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Therefore, the Panel holds that the disputed domain name <volvogroup.net> is confusingly similar to the VOLVO Trademarks and that the Complainant has established the first element of paragraph 4(a) of the Policy.

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

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent’s rights or legitimate interests in the disputed domain name.

These circumstances are:

- before any notice of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that the complainant shows *prima facie* that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 *prima facie* 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Indeed, it appears that the Complainant has not given any license or authorization of any other kind to the Respondent to use the VOLVO Trademark and that the Respondent is not an authorized dealer of the Group’s products or services. Moreover, the Panel finds that there is no evidence that the Respondent is known by the term of the disputed domain name or that the Respondent has the intent to use the disputed domain name in connection with a *bona fide* offering of goods or services. On the contrary, the disputed domain name was linked to a pay-per-click website, including links leading to website of competitors of the Volvo Group, which does not represent a *bona fide* offering (see section 2.9 of the [WIPO Overview 3.0](#)).

In any case, the Respondent did not reply to the Complainant's contentions.

Therefore, according to the Policy, paragraph 4(a)(ii) and 4(c), the Panel considers that the Respondent does not have rights to or legitimate interests in the disputed domain name <volvogroup.net>.

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

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the disputed domain name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

Moreover, according to prior UDRP panel decisions the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. (In some such cases, the respondent may host a copycat version of the complainant's website.) Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers (see section 3.4 of the [WIPO Overview 3.0](#)).

First, the Panel considers that it is established that the VOLVO Trademarks were registered by the Complainant before the registration of the disputed domain name and that the Volvo Group also owns several domain names containing "volvo" and "volvogroup". Therefore, there is a presumption of bad faith registration of the disputed domain name, given the fact that the disputed domain name wholly reproduces the VOLVO trademark along with the generic term "group" (see section 3.1.4 of the [WIPO Overview 3.0](#)). In addition, the Panel considers that the Complainant has provided evidence that the VOLVO Trademark is wellknown.

Moreover, the Panel points out that the disputed domain name was linked to a pay-per-click website, including links leading to websites of competitors of the Volvo Group. This use of the disputed domain name constitutes an intentional attempt of the Respondent to attract, for commercial gain, Internet users to its websites, by creating a likelihood of confusion with the Complainant's VOLVO trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website, which is a scenario constituting evidence of the Respondent's bad faith in using the disputed domain name. The fact that the disputed domain name is currently inactive, does not prevent a finding of bad faith.

The Panel finds that the following circumstances reinforce the fact that the Respondent has registered and is using the disputed domain name in bad faith:

- the Complainant has provided evidence that the VOLVO trademarks are well-known;
- the Respondent has not demonstrated any rights or legitimate interests in the disputed domain name;
- the Respondent has not provided any answer to the Complainant's contentions nor to the cease and desist letter of the Complainant;
- the Respondent has been involved in other UDRP proceedings, and previous UDRP decisions have found that the Respondent has been engaged in an abusive pattern of domain name registration to prevent mark owners from being able to utilize the domains (See, e.g., *Veolia Environnement SA v. Nanci Nette, Name Management Group*, Case No. [D2017-1511](#); *Facebook, Inc. and WhatsApp Inc. v. Registration Private, Domains By Proxy, LLC / Nanci Nette*, or WIPO Case No. [D2019-2223](#), *Slack Technologies, Inc. v. Registration Private, Domains by Proxy, LLC / Nanci Nette, Name Management Group*, Case No. [DCO2020-0018](#)).

Considering all of the above, it is not possible to conceive of any plausible actual or contemplated good faith registration and use of the disputed domain name by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the disputed domain name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

## 7. 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 names, <volvogroup.net> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Sole Panelist

Date: March 31, 2022