

ADMINISTRATIVE PANEL DECISION

Toyota Motor Sales, U.S.A., Inc. v. Domain Admin, Whois protection, this company does not own this domain name s.r.o. / Hulmiho Ukolen, Poste restante

Case No. D2022-0369

1. The Parties

The Complainant is Toyota Motor Sales, U.S.A., Inc., United States of America, represented by Phillips Winchester, United States of America.

The Respondent is Domain Admin, Whois protection, this company does not own this domain name s.r.o. / Hulmiho Ukolen, Poste restante, Czech Republic.

2. The Domain Name and Registrar

The disputed domain name <toyotta.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 2, 2022. On February 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 8, 2022, 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 the Complainant on February 16, 2022 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 amendment to the Complaint on February 17, 2022.

The Center verified that the Complaint together with the amendment to 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 24, 2022. In accordance with the Rules,

paragraph 5, the due date for Response was March 16, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 20, 2022.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on March 28, 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.

The Panel observes that the Registrar confirmed the languages of the Registration Agreement to be Czech & English. The Complaint was submitted in English and the Complainant requested that English be the language of the proceedings. The Center provided opportunity for comment and, in the absence of any reply from the Respondent, determined under the Rules, paragraph 11, that the proceedings should continue in English. Whilst the Panel has discretion to determine otherwise it is in agreement with the Center that these administrative proceedings should continue in English.

4. Factual Background

The factual findings pertinent to the decision in this case are that:

- (1) Toyota Motor Corporation ("TMC") is the owner of, *inter alia*, United States Patent & Trademark Office ("USPTO") Reg. No. 843,138 dated January 30, 1968 for the trade mark TOYOTA (the "Trade Mark");
- (2) TMC and the Complainant are, respectively, in the business of manufacturing and selling motor vehicles and their parts and accessories by reference to the Trade Mark;
- (3) the public Whois information shows that the disputed domain name was created on May 17, 2004 and registered in the name of a domain privacy service, listing the registrant organization as "Whois protection, this company does not own this domain name s.r.o."¹;
- (4) the Registrar, a Czech company, identified the underlying domain name holder as Hulmiho Ukolen and the Registrant Organization as Poste restante (general delivery) with the Helsinki, Finland main post office;
- (5) on December 17, 2021 the disputed domain name resolved to "www.volvocars.com" and at times prior to that resolved to the websites of other known car makers;
- (6) the disputed domain name has been offered for sale for USD 99,999.00; and
- (7) there is no commercial or other relationship between the Parties and neither TMC nor the Complainant has authorized the Respondent to use the Trade Mark or to register any domain name incorporating the Trade Mark.

5. Parties' Contentions

A. Complainant

The Complainant asserts trade mark rights in TOYOTA and submits that the disputed domain name is confusingly similar to the Trade Mark.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name because it has no trade mark rights; is not known by the disputed domain name; the disputed domain name is for sale and has otherwise only been used for illegitimate purposes.

The Complainant alleges that the Respondent registered the disputed domain name in bad faith having targeted the Complainant's business.

The Complainant accordingly requests the Panel to order transfer of the disputed domain name.

¹ A "s.r.o." is a *Společnost s ručením omezeným* or limited liability company under Czech law.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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.

It is the responsibility of the Panel to consider whether the requirements of the Policy have been met, regardless of the fact that the Respondent failed to submit a response. Having considered the Complaint and the available evidence, the Panel finds the following:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold enquiry – a threshold investigation into whether a complainant has rights in a trade mark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to the trade mark.

Paragraph 4(a)(i) of the Policy does not distinguish between registered and unregistered trade mark rights. It is accepted that a trade mark registered with a national authority is evidence of trade mark rights for the purposes of the Policy.² The Complaint provides evidence of registration of the Trade Mark with the USPTO, a national authority, but the Panel notes that USPTO Reg. No. 843,138 and later registrations for the Trade Mark all stand in the name of TMC, not the Complainant.

The Complaint states that the Complainant is a wholly owned subsidiary of TMC and the exclusive licensee of the Trade Mark in the United States³. It is generally agreed that a trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under paragraph 4(a)(i) of the Policy.⁴ Here, there is no evidence of either assertion. In other circumstances the Panel may have found that the Complainant had not established rights. However, in the absence of any contest to the Complainant's assertions, the reasonable inference can be drawn in this case that these assertions are factually correct.⁵ Accordingly, the Panel finds that the Complainant has rights in the Trade Mark.

For the purposes of comparison of the disputed domain name with the Trade Mark, the generic Top Level Domain, ".com" can be disregarded.⁶ Thereafter, the disputed domain name simply adds an extra letter "t" to the Trade Mark in a manner which does not alter the Trade Mark phonetically and makes only a slight visual

² See section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0").

³ The Panel notes that the Respondent uses an address in Finland whereas the Complainant's licensed territory is the United States but this is not ultimately an impediment to the Complainant's assertion of trade mark rights since it is generally agreed that under the Policy rights are not limited territorially.

⁴ See section 1.4.1 of the WIPO Overview 3.0.

⁵ See generally sections 4.3 and 4.4 of the WIPO Overview 3.0.

⁶ See section 1.11.1 of the WIPO Overview 3.0.

change to it. The Panel finds that the disputed domain name is confusingly similar to the Trade Mark⁷ and so finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has the burden to establish that the Respondent has no rights or legitimate interests in the disputed domain name. Nevertheless, it is well settled that the Complainant need only make out a *prima facie* case, after which the *onus* shifts to the Respondent to rebut such *prima facie* case by providing evidence demonstrating rights or legitimate interests in the disputed domain name.⁸

Notwithstanding the lack of a response to the Complaint, paragraph 4(c) of the Policy states that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii) of the Policy:

“(i) before any notice to you of the dispute, your 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

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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”.

In consequence of these administrative proceedings, the Registrar disclosed the name of the underlying domain name registrant as “Hulmiho Ukolen”, which does not suggest that the Respondent might be commonly known by the disputed domain name. The Panel finds no other evidence that the Respondent might be commonly known by the disputed domain name.

Further, the Complainant states that there is no association between the Parties and there is nothing to contradict that claim. There is no evidence that the Respondent has any trade mark rights.

The Complainant provides evidence that the disputed domain name is for sale and that it has been used to redirect Internet users to the official websites of Volvo, Nissan, and Honda, some of the Complainant’s competitors. The Panel finds that such use does not amount to a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use, nor does it otherwise show a right or legitimate interest in the disputed domain name.⁹

The Panel finds that the Complainant has established a *prima facie* case and that the Respondent in failing to reply to the Complainant’s contentions has not rebutted such *prima facie* case. Accordingly, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out circumstances which shall be evidence of the registration and use of a domain name in bad faith. They are:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is

⁷ See, for example, *Toyota Motor Sales, U.S.A., Inc. v. Zuccarini*, Case No. D2002-0951 finding <toyoto.com> confusingly similar to TOYOTA.

⁸ See, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. D2000-0624.

⁹ See, for example, *Toyota Motor Sales, U.S.A., Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. D2018-0801.

the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location".

Several of those scenarios might be applied to the facts of this case, but as the panelists in *Playboy Enters. Int'l, Inc. v. Domain Active Pty. Ltd.*, WIPO Case No. [D2002-1156](#) observed, "[s]o far as element (iii) is concerned it is sufficient that the Complaint demonstrates that one of the four circumstances mentioned in paragraph 4(b) of the Policy applies".

Here, there is a clear case for application of paragraph 4(b)(i) of the Policy since the disputed domain name is for sale for an amount wildly in excess of the possible out-of-pocket costs directly related to the domain name (even if those costs were to include the many renewals since 2004 when the domain name was first registered).¹⁰ In terms of the Policy, the Panel finds that the circumstances indicate that the Respondent registered the domain name with the primary intention of selling it to the Complainant for a figure in excess of the registration costs.

The Panel finds that the Complainant has satisfied the third and final element of the Policy.

7. Delay

The Panel notes that the disputed domain name was created almost twenty years ago. A question has arisen in some UDRP proceedings as to whether lengthy delay in bringing administrative proceedings may somehow disentitle a complainant. It is now generally agreed that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. Those cases where a complaint may have failed due to delay have been limited to their own particular circumstances which find no parallel in this undefended case.¹¹

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 <toyotta.com> be transferred to the Complainant.

/Debrett G. Lyons/
Debrett G. Lyons
Sole Panelist

¹⁰ See, for example, *Ammunition Operations LLC v. Domain Admin, Whois protection, this company does not own this domain name s.r.o.*, WIPO Case No. D2021-0147; *GEICO v. Domain Admin, Whois protection, this company does not own this domain name s.r.o.*, WIPO Case No. D2021-2764.

¹¹ See section 4.17 of the WIPO Overview 3.0.

