

ADMINISTRATIVE PANEL DECISION

Hyundai Motor Company v. Fernando Morales Romero
Case No. D2022-2347

1. The Parties

The Complainant is Hyundai Motor Company, Republic of Korea, represented by Goodrich, Riquelme & Asociados, Mexico.

The Respondent is Fernando Morales Romero, Mexico.

2. The Domain Name and Registrar

The disputed domain name <hyundaiseminuevosmexico.com> (the “Disputed Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 28, 2022. On June 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 30, 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 July 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 1, 2022.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on August 4, 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 in this administrative proceeding is Hyundai Motor Company (also hereinafter Hyundai), a corporation founded in 1967 in accordance with the laws of the Republic of Korea. The Complainant is currently the largest Korean manufacturer of automobiles, which are sold around the world in large quantities included Mexico, the official website in is “www.hyundai.com.mx” and is a company that has won several international awards, recently the Complainant won the “car of the Year 2021” award in North America (and has taken top honors in the annual Top Gear 2021 awards, winning “Car of the Year” with the i20 N and Manufacturer of the Year, in recognition of the brand’s class leading model range).

The Complainant has become one of the top manufacturing companies in the world and has been using HYUNDAI mark for as long as the Complainant’s existence, since its foundation. Due to the fact that the Complainant has made extensive use of the HYUNDAI mark through the past years, the mark is now widely known as the Complainant’s identity around the world. For example, the HYUNDAI mark has become the world’s 81st most valuable brands in the year 2021 according to Interbrand.

Hyundai is the owner of the trademark HYUNDAI which is registered for, among others: cars, buses, electric cars, engines for land vehicles, wholesale and retail services for cars and car parts, and related goods and services worldwide.

The Complainant has obtained registrations for HYUNDAI mark around the world and also in Mexico. The Complainant has obtained many trademarks rights for HYUNDAI including registrations granted by the Mexican Institute of Industrial Property (“IMPI”) and also Republic of Korea and the United States of America (“United States”) as follows:

Mark	Registration Date	Registration number	Class	Country
HYUNDAI	August 6, 1993	439025	12	Mexico
HYUNDAI	November 23, 2010	1,190,338	12	Mexico
HYUNDAI TRANSYS	September 21, 2020	2,142,378	35	Mexico
H HYUNDAI DRIVE YOUR WAY (and design)	November 23, 2005	909,456	12	Mexico
HYUNDAI I19	October 17, 2007	1,006,991	12	Mexico
HYUNDAI VERACRUZ	November 16, 2005	908,232	12	Mexico
HYUNDAI SANTA FE	January 31, 2000	641,046	12	Mexico
HYUNDAI COUPE	January 24, 1996	514,731	12	Mexico
HYUNDAI (Korean characters)	October 20, 1978	40-58023	12	Republic of Korea
HYUNDAI	September, 6, 1989	40-178391	12	Republic of Korea
HYUNDAI (and design)	August 29, 1994	41-0024898	35, 36, 37, 39, and 42	Republic of Korea
HYUNDAI	October 24, 1978	1104727	12	United States
HYUNDAI	October 27, 2015	4841576	35	United States

The Complainant has proved their trademark rights of HYUNDAI and that rights were obtained since October 1978 around the world. This fact is important in order to prove that HYUNDAI trademark is well known in the world including Mexico and also has many years in the automobile market.

Also, the HYUNDAI trademark is well-known due to the fact that the Complainant has an extensive commercial and advertising activity that HYUNDAI has carried out in relation to the products it manufactures.

The Complainant owns and conducts its Internet activities under its HYUNDAI trademarks through its domain names, including <hyundai.com> registered on June 24, 1998 and <hyundai.com.mx> registered on

December 24, 2014.

The Disputed Domain Name was registered on April 12, 2022, and does not resolve to an active webpage.

5. Parties' Contentions

A. Complainant

The Complainant argues that the Disputed Domain Name is confusingly similar to its trademark HYUNDAI, due to the fact that the trademark is included in its entirety with the inclusion of other Spanish words and the inclusion of the name of the country "Mexico". Also, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the Disputed Domain Name and finally, that the Respondent registered and is using the Disputed Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

In order to prove the first element of the Policy, the Complainant must first establish that there is a trademark or service mark in which it has rights. In the present case, the Complainant has established the ownership of HYUNDAI trademark in several countries. The trademark has been registered and used in connection to the Complainant's products and services.

The Disputed Domain Name <hyundaiseminuevosmexico.com> reproduces the Complainant's HYUNDAI trademark in its entirety. The addition of the Spanish words "semi nuevos" and the country name "México" after the trademark does not prevent a finding of confusing similarity.

In the present case, the HYUNDAI trademark is recognizable in the Disputed Domain Name.

As stated at section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity. In this case, the Panel finds that the Complainant's HYUNDAI trademark is clearly recognizable within the Disputed Domain Name.

Additionally, it is well established that the Top-Level Domain ("TLD") (in this case ".com") is generally disregarded when considering whether a disputed domain name is confusingly similar to the trademark in which the complainant has rights (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's HYUNDAI trademark. Accordingly, the Complainant has complied with the first of the three elements of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie case* demonstrating that the Respondent has no rights or legitimate interests in the Disputed Domain Name in

order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel notes that there is no evidence that the Respondent has been commonly known by the Disputed Domain Name. The Respondent does not seem to have acquired trademark or service mark rights, noting HYUNDAI is a well-known trademark owned by the Complainant included in México. The Complainant has not authorized or licensed to the registration and use of the Disputed Domain Name by the Respondent.

Moreover, the Panel finds that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name. In fact, the Disputed Domain Name is not being used in connection to an active website.

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been refuted by the Respondent.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant has complied with the second element of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith.

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith namely:

“(i) circumstances indicating that you [the registrant] 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 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.”

In the present case, the Panel finds it is hard to believe that the Respondent was unaware of the Complainant and its trademark rights when it registered the Disputed Domain Name on April 12, 2022, many years after the registration and use of the well-known trademark of the Complainant. In conclusion, the Disputed Domain Name includes the Complainant’s distinctive and well-known HYUNDAI trademark in its entirety with the Spanish terms “semi nuevos” that in English signifies “almost new” and the country name “Mexico”. Due to the foregoing, Internet users could be misled to believe that the Disputed Domain Name <hyundaiseminuevosmexico.com> belongs to the Complainant or to an entity associated with the Complainant.

The Panel notes that the Complainant’s trademark HYUNDAI is well-known for vehicles and products related

to them and that the Complainant has presence on the Internet with the official websites <hyundai.com> and <hyundai.com.mx> long before the registration of the Disputed Domain Name. Thus, the Respondent knew or should have known of the Complainant's HYUNDAI trademark at the time of registration of the disputed domain. See section 3.2.2 of the [WIPO Overview 3.0](#).

Recognizing the well-known nature of the HYUNDAI trademark in the vehicles and related products, the Panel finds that the Respondent registered the Disputed Domain Name in order to capitalize somehow on the Complainant's goodwill and reputation. Moreover, the Panel finds that the composition of the Disputed Domain Name suggests sponsorship or endorsement by the Complainant in the Spanish terms "semi nuevos" that means in English "almost new" and the country name "Mexico" that infers that the disputed domain name represents Hyundai almost new cars in Mexico.

At the time of the filing of the Complaint and at the time of the decision, the Disputed Domain Name resolved to an inactive website.

It has been established in various UDRP decisions that passive holding under the appropriate circumstances does not prevent a finding of bad faith. In *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), it was found that in order to establish that the registrant was using a domain name in bad faith it was not necessary to find that it had undertaken any positive action in relation to the domain name. Indeed, in circumstances of inaction ("passive holding"), this behavior falls within the concept of the domain name "being used in bad faith". See also, section 3.3 of the [WIPO Overview 3.0](#). From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

In the present case, the Panel finds that the passive holding of the Disputed Domain Name is considered a bad faith use due to the following factors: (i) the reputation of the Complainant's trademark, HYUNDAI, which is a very well-known trademark (ii) the failure of the Respondent to submit a response and (iii) the implausibility of any good faith uses to which the Disputed Domain Name may be put.

For all the foregoing reasons, the Panel finds that the Disputed Domain Name has been registered and used in bad faith.

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 name, <hyundaiseminuevosmexico.com>, be transferred to the Complainant.

/Ada L. Redondo Aguilera/

Ada L. Redondo Aguilera

Sole Panelist

Date: August 18, 2022