

ADMINISTRATIVE PANEL DECISION

Clark Equipment Company v. pdram abrahimi
Case No. D2023-0901

1. The Parties

The Complainant is Clark Equipment Company, United States of America (“United States”), represented by Quarles & Brady LLP, United States.

The Respondent is pdram abrahimi, Denmark.

2. The Domain Name and Registrar

The disputed domain name <bobcatsale.com> is registered with CSL Computer Service Langenbach GmbH dba Joker.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 28, 2023. On March 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 2, 2023, 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 (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 3, 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 amendment to the Complaint on March 6, 2023.

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 March 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2023. The Respondent did not submit a formal response. Accordingly, the Center notified the Respondent’s default on March 29, 2023. On April 4, 2023, the Center received an email communication from a party named as the Respondent but with a different email address than confirmed by the Registrar.

The Center appointed Marilena Comanescu as the sole panelist in this matter on April 3, 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, Clark Equipment Company, which does business as Bobcat Company, is a leading global provider of compact construction equipment and related goods and services used in the mining, construction, landscaping, and agriculture industries. In 1958, the Complainant introduced the first compact loader into the market under the name BOBCAT. The Complainant has advertised, sold, and distributed BOBCAT branded goods and services through its own e-commerce platforms and a robust worldwide dealer network, including on the territory where the Respondent is apparently located.

The Complainant has received numerous awards and industry recognitions for its BOBCAT branded goods.

The BOBCAT equipment is sold, rented, and serviced throughout the world through an extensive dealer network based on licence agreements, granting authorization to use the BOBCAT mark in connection with the dealer's business name, some dealers being also authorised to use the BOBCAT mark in their domain names.

The Complainant owns trademark registrations for BOBCAT in many jurisdictions around the world, such as the following:

- the United States trademark registration number 670566 for the word BOBCAT, filed on May 7, 1958, registered on December 2, 1958 and covering goods in Nice class 7; and
- the Qatar registration number 90392 for the word BOBCAT, filed on July 8, 2014 and registered on April 20, 2016.

The Complainant owns domain names incorporating its trademark BOBCAT such as "www.bobcat.com" (the principal website, registered on March 28, 1997), <bobcatequipment.com>, or <bobcatpartsonline.com>.

The disputed domain name <bobcatsale.com> was registered on March 5, 2022 and at the time of filing the Complaint, it was used to advertise and sell replacement and after-market parts that display the BOBCAT mark and/or were advertised as being compatible with BOBCAT-branded equipment. The Respondent's identity is not publicly displayed on the website under the disputed domain name, and, when the Panel visited the website under the disputed domain name, at the bottom part of the website there was a note stating: "This website belongs to Karin No company".

The Respondent is not an affiliate of the Complainant nor licensed to use, advertise or sell BOBCAT-branded goods.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its worldwide well-known trademark BOBCAT, commercial name and domain name <bobcat.com>; that the Respondent has no rights or legitimate interests in the disputed domain name; and 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. However, in an email received by the Center on April 4, 2023, a party named as the Respondent stated: "Me Pedram Abrahimi as Carinno company manager. We only sell after market bobcat parts and have no claim on having any dealership from bobcat. Even on bobcatsale.com we only sell aftermarket parts and The reason for choosing such domain is only for comfort of our customers. We had no information about right of ownership on this domain. We of course obey international rules and ready for any action. I appreciate if you help me keep this domain."

6. Discussion and Findings

In view of the lack of a formal response filed by the Respondent's, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the BOBCAT trademark.

The disputed domain name <bobcatsale.com> incorporates the Complainant's trademark with an additional term, "sale". However, such addition does not prevent a finding of confusing similarity, as the Complainant's trademark is clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether geographical, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name does not prevent a finding of confusing similarity, where the relevant trademark is recognizable within the domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is well established in decisions under the UDRP that the Top-Level-Domain ("TLD") (e.g., ".com", ".shop", ".info", ".net") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark BOBCAT, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the mark BOBCAT, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

In line with the case law, “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”. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has put forward a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent has not replied to the Complainant’s contentions and has not come forward with relevant evidence to rebut the Complainant’s *prima facie* case.

There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain name or that the Respondent made a *bona fide* offering of goods or services or a legitimate noncommercial use under the disputed domain name.

In fact, at the time of filing the Complaint the disputed domain name resolved to a commercial website featuring the BOBCAT trademark and offering for sale purportedly BOBCAT genuine products or products compatible with the BOBCAT branded goods.

In certain cases, panels have recognized that resellers or service providers using a domain name containing the complainant’s mark to undertake sales or repairs related to the complainant’s goods and services may have a legitimate interest in such domain name. Relevant UDRP panel decisions in relation to this issue are helpfully summarized in section 2.8 of the [WIPO Overview 3.0](#) as follows:

Normally, a reseller, distributor or service provider can be making a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements normally include the actual offering of goods and services at issue, the use of the site to sell only the trademarked goods, the site’s accurately and prominently disclosing the registrant’s relationship with the trademark holder and the respondent not trying to “corner the market” in domain names that reflect the trademark.

This summary is based on UDRP panel decision *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). At least one condition that is outlined has clearly not been satisfied by the Respondent in this case: at the time of filing the Complaint, on the website under the disputed domain name there was no accurate and clear information regarding the Respondent’s rights and its (lack of) relationship with the Complainant and no disclaimer. Further, images of the Complainant’s trademarks and official pictures were displayed without any consent from the Complainant, thus generating a likelihood of confusion for the Internet users accessing the Respondent’s website and suggesting a false commercial relationship between the website under the disputed domain name and the Complainant.

In addition, and without prejudice to the above, UDRP panels have found that domain names that consist of a trademark plus an additional term cannot constitute fair use if they effectively impersonate or suggest sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant used the name and holds registered trademark rights for BOBCAT for more than six decades and gained substantial worldwide reputation in connection with compact construction equipment, replacement parts thereof, and related retail services.

The disputed domain name was created in March 2022 and incorporates the Complainant’s mark with an additional descriptive term “sale”. Furthermore, it is used to provide purportedly BOBCAT branded goods.

For the above reasons, the Panel finds that the disputed domain name was registered in bad faith, with knowledge of the Complainant, its business and particularly targeting the Complainant's trademark.

The Respondent is using without permission the Complainant's distinctive trademark in order to get Internet traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant. This impression is created particularly by the incorporation of the Complainant's trademark in the disputed domain name, and the content on the website provided thereunder which includes the Complainant's trademark and images of official products.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website or other on-line 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" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's trademark and the website operated under the disputed domain name displays the Complainant's trademark and has no disclaimer or accurate information about the (lack of) relationship between the Respondent and the Complainant, indeed in this Panel's view, the Respondent intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain.

The Complainant promotes and sells its BOBCAT branded goods and services through an approved network of dealers, based on specific licence agreements, and therefore such use made by the Respondent also disrupts the Complainant's business.

Further, previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar to a third party's well-known trademark can, by itself, constitute a presumption of bad faith for the purpose of Policy. See section 3.1.4 of the [WIPO Overview 3.0](#).

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 <bobcatsale.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: April 17, 2023