

ADMINISTRATIVE PANEL DECISION

Cummins Inc. v. Hussein Hamade

Case No. D2023-3469

1. The Parties

The Complainant is Cummins Inc., United States of America (“United States”), represented by Mayer Brown LLP, Germany.

The Respondent is Hussein Hamade, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <cummins-uae.com> is registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 15, 2023. On August 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 16, 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 (Ali Hamada) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 17, 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 August 22, 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 August 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 13, 2023. The Response was filed with the Center on September 13, 2023.

The Center appointed John Swinson as the sole panelist in this matter on September 26, 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 was founded in 1919 and designs, manufactures, distributes, and services diesel and natural gas engines. The Complainant is based in Indiana, United States and carries on business on a world-wide basis.

The Complainant owns many trademark registrations for or including CUMMINS. The Complainant states that the Complainant has used the "CUMMINS" brand since 1919. The Complainant has a United States trademark registration for CUMMINS dating back to 1953.

The Complainant's first trademark registrations in the United Arab Emirates for CUMMINS are Registration Number 147932 with a filing date of December 20, 2005 for class 12 and Registration Number 92355 with a filing date of December 20, 2005 for class 7. The Complainant also has logo registrations in the United Arab Emirates for the letter "C", that has written in smaller font the word "Cummins" in the letter "C". These registrations were filed on March 11, 2000 for classes 7, 12, and 37.

The Respondent is the owner of a company that has been registered in the United Arab Emirates under the name "Cummins Diesel Spare Parts Co. LLC" since April 4, 1990. For convenience and because the parties have taken this approach, in this decision the Panel will refer to both Hussein Hamade and Cummins Diesel Spare Parts Co. LLC as "the Respondent".

The Respondent sells spare parts for the Complainant's diesel engines. There is no allegation that these are fake parts. The Complainant agrees that the Respondent "sells only genuine Cummins spare parts."

The Respondent has a physical store in the United Arab Emirates to sell these genuine spare parts. The Respondent states that he "placed the trademark of the Complainant on his shop window to indicate that he was selling genuine goods of the Complainant, but he did not claim that he was a dealer of the Complainant."

The disputed domain name was registered on November 12, 2012.

At the present time, the website at the disputed domain name is titled "CUMMINS DIESEL SPARE PARTS CO. L.L.C." The website does not appear to be fully functional and has non-functioning links. The website appears to be primarily focused on promoting the Respondent's physical store and does not appear to enable online transactions. At the bottom of the home page, there is a legend that states: "Cummins® is the Registered Trademark of Cummins Corporation."

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that use of the disputed domain name is likely to mislead users into believing that the website at the disputed domain name belongs a partner or affiliate of the Complainant (which is false since there exists no relationship between the Complainant and the Respondent). The Complainant also contends that the Respondent's website falsely purports that the Respondent is an official dealer of the Complainant.

B. Respondent

The Respondent rebuts the Complainant's contentions in respect of all three elements of the Policy.

Notably, the Respondent contends that the Respondent has been using the name "Cummins" legitimately as part of its business name for over 30 years, and before the Complainant had trademark rights in the United Arab Emirates. The Respondent is a reseller of legitimate Cummins spare parts and is not acting in bad faith.

As stated in the Response: "The Respondent registered his company in 1990. At that time the Complainant was not present on the market of United Arab Emirates. The Complainant had no trademarks registered in the United Arab Emirates in 1990. The Respondent carried his business unbothered by the Complainant till 2023."

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (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.

The *onus* of proving these elements is on the Complainant.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms, here "uae", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, 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 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. [WIPO Overview 3.0](#), section 2.1.

Paragraph 4(c) of the Policy states:

“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 your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(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; ...”

The Respondent was given notice of this disputed via a letter of demand from the Complainant on February 15, 2023.

Accordingly, for over 32 years prior to the notice of the dispute, the Respondent has been using the name “Cummins Diesel Spare Parts Co. LLC” as the name of its business. This was ten years before the Complainant had registered trademark rights in the United Arab Emirates – though clearly it was done with a view to the Complainant’s goods and services.

The question arises as to whether the Respondent’s use of “Cummins” as part of its business name and on its shopfront for over 32 years is *bona fide* in terms of the Policy. The Respondent relies on provisions of United Arab Emirates law of which the Panelist is not familiar.

The Panel notes that ordinarily the disputed domain name would fall afoul of the impersonation test articulated in section 2.5.1 of the [WIPO Overview 3.0](#). That said, the Panel is hesitant to overlook the fact of the use by the Respondent of the disputed domain name for over a decade and the fact that Respondent’s use of its business name has been open and transparent; ordinarily it may be that this business name which copies the Complainant’s name would be infringing under the terms of the Policy (c.f., *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#)) and likely under national law, but given the length of time and apparent openness of such use, the Panel considers this matter better addressed by a court of competent jurisdiction.

Based on the available record, the Panel finds the second element of the Policy has not been established.

C. Registered and Used in Bad Faith

In view of the analysis above, the Panel believes it to be unnecessary to consider this element.

7. Decision

For the foregoing reasons, the Complaint is denied.

/John Swinson/

John Swinson

Sole Panelist

Date: October 13, 2023