

ADMINISTRATIVE PANEL DECISION

Hyundai Motor Company, Hyundai Motor America v. Frank Figueredo
Case No. D2023-1508

1. The Parties

The Complainants are Hyundai Motor Company, Republic of Korea, and Hyundai Motor America, United States of America ("United States"), represented by VLP Law Group LLP, United States.

The Respondent is Frank Figueredo, United States.

2. The Domain Name and Registrar

The disputed domain name <hyundaiofcarson.com> is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 6, 2023. On April 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 7, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainants on April 11, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on April 11, 2023.

The Center verified that the Complaint, together with the amended 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 April 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 12, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on June 12, 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 Complainants are part of a the same corporate group, a multinational conglomerate under a common control, and both Complainants have an interest in the right relied upon, and therefore a common grievance against the Respondent. Since the Complainants are part of the same group, they will be collectively referred to as the “Complainant” hereinafter.

The Complainant, founded in 1967, is selling motor vehicles it manufactures as a car line-make under the trademark HYUNDAI, currently being one of the Republic of Korea’s largest car manufacturers. In 2017, the Organisation Internationale des Constructeurs d’Automobiles (OICA) ranked the Complainant as the world’s third largest vehicle manufacturer by production volume. The Complainant maintains a total of 432 production bases and offices in 49 countries, research and developments centers in 12 countries, sales offices in 65 countries, its production and sales network spans some 200 countries and territories across the globe. The Complainant employs over 280,000 individuals and its total revenues in 2018 amounted to over USD 220 billion.

The Complainant received numerous accolades and recognitions in its industry and, through substantial investments, it has also developed a strong presence online on various social media platforms.

For the purposes of sales and distribution, the Complainant has accredited approximately 300 dealers through the United States only. Many of such dealers make use of business names and domain names configured by the combination of the Complainant’s HYUNDAI trademark and terms reflecting their business location, such as “Hyundai of (geographical location)”. However, such dealers operate websites with content only after obtaining prior approval from the Complainant and based on a strict written agreement.

The Complainant holds worldwide trademark registrations for HYUNDAI, such as the following:

- the United States Registration No. 1104727 for the word HYUNDAI, filed on March 20, 1978, and registered on October 24, 1978, covering goods in the International Class 12; and
- the European Union Trademark Registration No. 012312518 for the word HYUNDAI, filed on November 14, 2013, and registered on April 14, 2014, covering goods in the International Classes 11, 12 and 14.

The Complainant holds numerous domain name registrations which incorporate its trademark, such as <hyundai.co.kr> registered in April 17, 1994; <hyundai.auto>, <hyundai.car>, or <hyundai.com>.

The disputed domain name was registered on December 9, 2019, and, according to the evidence provided in the Complaint, it was used for a parked page displaying pay-per-click (“PPC”) pages with sponsored links to third parties, including firms potentially in competition with the Complainant.

On January 6, 2023, the Complainant sent a cease-and-desist letter to the Respondent in relation to the disputed domain name. The letter remained unanswered.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its internationally well-known trademark HYUNDAI appended by the geographic and descriptive term “ofcarson”, the Respondent

has no rights or legitimate interests in the disputed domain name, and the Respondent registered and is using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name to it.

B. Respondent

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

6. Discussion and Findings

In view of the absence of a Response, 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 HYUNDAI trademark.

The disputed domain name <hyundaiofcarson.com> incorporates the Complainant's trademark followed by the additional terms "ofcarson". 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 avoid a finding of confusing similarity. 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 generic Top-Level Domain ("gTLD") (e.g., ".com", ".info", ".org") 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 HYUNDAI, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that it has given no license or other right to use its trademark to the Respondent, 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.

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate

interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP. 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 to advance a claim to any rights or legitimate interests in the disputed domain name.

According to the records before it, the Respondent has used the disputed domain name in connection with a parking page displaying PPC links, promoting services of the Complainant's potential competitors. UDRP panels have constantly found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's marks or otherwise mislead Internet users. See section 2.9 of the [WIPO Overview 3.0](#).

Furthermore, UDRP panels have found that domain names that consist of a trademark plus certain additional terms, such as a geographic term, cannot constitute fair use as this suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#). Here, the Panel notes that the disputed domain name comprises the Complainant's trademark together with the terms "ofcarson" ("carson" being a geographic term), composition which is using the configuration reserved solely for the benefit of the Complainant's authorised car dealers, and this cannot be considered fair use as it falsely impersonate the Complainant and its authorised car dealers distribution network.

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 operates its business since 1967, holds trademark rights since 1978, promotes its business under the domain name <hyundai.co.kr> since 1994 and its HYUNDAI trademark has acquired worldwide reputation.

The disputed domain name was registered in 2019 and incorporates the Complainant's trademark with a geographical term, a configuration used by the Complainant's authorised car dealers based on a strict agreement concluded with the Complainant.

From the above, the Panel finds that the Respondent was aware of the Complainant, its business, and trademark at the registration of the disputed domain name.

At the time of filing the Complaint, the disputed domain name resolved to a webpage listing PPC links promoting, *inter alia*, goods and services in competition with those provided by the Complainant.

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 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" is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant's well-known trademark with a geographic non-distinctive descriptor, "ofcarson", and the website operated under the disputed domain name promotes goods and services similar to those offered by 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 and its authorized car dealers, for its commercial gain.

The Respondent failed to provide any argument in its favor in response to the Complainant's cease-and-desist letter and present Complaint. Along with other circumstances in this case, such facts constitute a further sign of bad faith.

Furthermore, it was consistently found by previous UDRP panels that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising descriptive terms, such in this case a geographical descriptor) to a third party's famous or widely-known trademark can create, by itself, 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 <hyundaiofcarson.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: June 26, 2023