

## **ADMINISTRATIVE PANEL DECISION**

Scania CV AB v. nigel mchugh  
Case No. D2024-2415

### **1. The Parties**

The Complainant is Scania CV AB, Sweden, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is nigel mchugh, United Kingdom ("UK").

### **2. The Domain Names and Registrar**

The disputed domain names <scaniatruckparts.online> and <scaniatrucksparts.online> are registered with Mesh Digital Limited (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 13, 2024. On June 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 14, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names 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 Complainant on June 19, 2024, 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 amended Complaint on June 21, 2024.

The Center verified that the Complaint 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 June 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 17, 2024.

The Center appointed Olga Zalomiy as the sole panelist in this matter on July 24, 2024. 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 is a Swedish company, which is one of the world's leading manufacturers of trucks, buses and engines for heavy transport applications that also sells a broad range of other services.

The Complainant owns numerous SCANIA trademark registrations around the world, such as:

- The United Kingdom registration No. UK 00000986385, for the SCANIA mark. registered on January 24, 1972.
- The United States of America registration No. 879387, for the SCANIA mark, registered on October 28, 1969.

Prior UDRP Panels recognized the SCANIA mark as well-known.

The Complainant also owns numerous domain names incorporating its SCANIA mark.

The Respondent, registered the disputed domain name <scaniatruckparts.online> on June 6, 2022 and the disputed domain name <scaniatrucksparts.online> on August 3, 2022. The disputed domain names redirect to the <alltruckretailerpartsuk.co.uk> domain name, which currently does not resolve to any active websites. In the past, the disputed domain names redirected to an online store under the <alltruckretailerpartsuk.co.uk> domain name, which offered for sale truck parts under the SCANIA mark along with competing goods.

#### **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 names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to its SCANIA trademarks because the disputed domain names reproduce the Complainant's mark in its entirety. The Complainant argues that the inclusion of the generic terms such as "parts" or "truck(s)" fail to alleviate the confusion between the disputed domain names and the Complainant's trademark. The Complainant argues that the addition of the generic Top-Level Domain ("gTLD") ".online" is insufficient to avoid confusing similarity.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain names because (i) ) the Respondent's is neither affiliated or has been authorized by the Complainant to use its well-known SCANIA trademark in the disputed domain names or in any other form; (ii) there is no evidence that the Respondent is commonly known by the disputed domain names; (iii) the Respondent is not using the disputed domain names for a bona offering of goods or services or for a legitimate, noncommercial purposes; (iv) the disputed domain names used to redirect users to a website under the <alltrucktrailerpartsuk.co.uk> domain name that offered for sale the Complainant's goods along with goods of its competitors. The website under the <alltrucktrailerpartsuk.co.uk> failed to accurately disclose lack of relationship with the Complainant. Currently, the disputed domain names redirect visitors to <alltrucktrailerpartsuk.co.uk> domain name, which does not resolve to an active website.

The Complainant asserts that the Respondent registered the disputed domain names in bad faith, as evidenced by the fact that the Respondent registered them with the Complainant's trademark in mind. The Complainant argues that its trademark is well-known throughout the world, so it is unlikely that the Respondent did not know about the Complainant's mark at the time of the disputed domain names' registration. The composition of the disputed domain names supports this conclusion because the disputed domain names consist of the Complainant's mark and descriptive terms "truck parts" and "trucks parts", which relate to the Complainant's business. Additionally, the Complainant highlights that its trademark registrations significantly precede the registration of the disputed domain names, indicating the Respondent's knowledge of the Complainant's mark. The Complainant contends that the Respondent's use of the disputed domain names constitutes bad faith, since the Respondent used the disputed domain names to redirect to a website that sold the Complainant's and competitor's goods, which disrupted the Complainant's business. The Complainant claims that while currently the disputed domain names direct to inactive pages displaying the statement: "The site can't be reached". Such use does not preclude finding of bad faith use because of the strong worldwide reputation of the Complainant's mark. Finally, the Complainant asserts that any claim of good faith use of the disputed domain names is not viable.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to paragraph 4(a) of the Policy, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the disputed domain names:

- (i) the disputed domain names are identical or confusingly similar to a trademark 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

### **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.

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 mark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The inclusion of the gTLD ".online" is typically disregarded in the context of the confusing similarity assessment, being a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11.1.

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

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The evidence on record shows that the Respondent is not commonly known by the disputed domain names. The Respondent is not making legitimate noncommercial or fair use of the disputed domain names or uses it for bona fide offering of goods or services, because the disputed domain names do not direct to an active website. The Respondent has not been authorized by the Complainant to use the Complainant’s distinctive trademark in a domain name.

Nor does the Respondent’s prior use of the disputed domain names establish any rights or legitimate interests of the Respondent. Previous UDRP panels have recognized that resellers or distributors using domain names containing the complainant’s trademark to undertake sales of the complainant’s goods may be making a bona fide offering of goods and thus have rights or legitimate interests in such domain names in some situations.

Outlined in the *Oki Data* case<sup>1</sup>, the following cumulative requirements must be satisfied for the respondent to make a bona fide offering of goods and services:

- “(i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to corner the market in domain names that reflect the trademark.”

Here, the disputed domain names used to redirect users to the online store under the <alltruckretailerpartsuk.co.uk> domain name. The online store offered for sale the Complainant’s goods along with goods of Complainant’s competitors. The website provided no information about the Respondent or its lack of affiliation with the Complainant. Therefore, the Respondent failed to satisfy the *Oki Data* test.

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<sup>1</sup> See [WIPO Overview 3.0](#), section 2.8.1; and *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The passive holding of the disputed domain names, which currently do not resolve to an active website, does not grant the Respondent any rights or legitimate interests.

The Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain names incorporating the Complainant's SCANIA trademarks and descriptive terms "truck(s)" and "parts" many years after the Complainant's first trademark registration. The Respondent's lack of rights or legitimate interests in the disputed domain names, the absence of a credible explanation for choosing these names, the well-known status of the Complainant's trademark, and the Respondent's use of the disputed domain names to direct to a website offering for sale Complainant's and competing goods indicate that the disputed domain names were registered in bad faith.

The UDRP establishes that, for purposes of paragraph 4(a)(iii), "bad faith" registration and use of a domain name can be established by a showing of circumstances indicating that the respondent is using the 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 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. See Policy, paragraph 4(b)(iv).

Prior UDRP panels have found "the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: (i) actual confusion, (ii) seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful, (iii) the lack of a respondent's own rights to or legitimate interests in a domain name, (vi) absence of any conceivable good faith use." [WIPO Overview 3.0](#), section 3.1.4.

Here, the Respondent who has no rights to or legitimate interests in the disputed domain names, registered the names that incorporate the Complainant's trademark and words that relate to the Complainant's business direct to a different domain name that was used for an online store selling the Complainant's and competing goods. Therefore, the Panel concludes that the Respondent registered and is using the disputed domain names to intentionally attempt to attract, for commercial gain, the Internet users to the Respondent's websites 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.

Panels 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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

## **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 names <scaniatruckparts.online> and <scaniatrucksparts.online> be transferred to the Complainant.

*/Olga Zalomiy/*

**Olga Zalomiy**

Sole Panelist

Date: August 7, 2024