

## **ADMINISTRATIVE PANEL DECISION**

Engcon Holding AB v. Daniel Sjödin

Case No. D2022-1142

### **1. The Parties**

The Complainant is Engcon Holding AB, Sweden, represented by AWA Sweden AB, Sweden.

The Respondent is Daniel Sjödin, Sweden.

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

The disputed domain name <engcon.parts> 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 1, 2022. On April 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 4, 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 April 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 28, 2022.

The Center appointed Petter Rindforth as the sole panelist in this matter on May 3, 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, founded in 1990, is an international producer of tiltrotators (an hydraulic attachment/tool used on excavators), based in Sweden.

The Complainant owns the trademark ENGCON, and refers to the following trademark registrations:

- International trademark No. 1215095 ENGCON (word), registered on May 27, 2014 for goods in class 7, designating Switzerland, China, Japan, Republic of Korea, New Zealand, and United States of America;
- European Union ("EU") trade mark No. 002218352 ENGCON (word), registered on July 15, 2002 for goods in class 7;
- United Kingdom trademark No. UK00902218352 ENGCON (word), registered on July 15, 2002, for goods in class 7;
- Australian trademark No. 908252 ENGCON (word), registered April 3, 2002, for goods in class 7;
- Canadian trademark No. TMA988874 ENGCON (word), registered January 18, 2018 for goods in classes 7, 9, and 12;
- EU trade mark No. 013211115 ENGCON (word), registered on March 5, 2015 for goods and services in classes 7, 9, 12, 37, and 42;
- United Kingdom trademark No. UK00913211115 ENGCON (word), registered on March 5, for goods and services in classes 7, 9, 12, 37, and 42; and
- Norwegian trademark No. 291729 ENGCON (word), registered on March 29, 2017 for goods in classes 7, 9, and 12.

The disputed domain name was registered in the name of the Respondent on January 21, 2019, and resolved to a parking page containing sponsored links. The disputed domain name currently resolves to a blank page.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant was founded in 1990, and immediately began developing the now world-leading engcon tiltrotators. The Complainant has sales companies in the EU, Australia, North America, and Asia, with a sales of approximately SEK 1,200 million in 2018, and approximately 250 employees.

The Complainant states that the disputed domain name is confusingly similar to the Complainant's registered trademarks ENGCON, and that the existence of confusing similarity must be assessed by a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the trademark is recognizable within the disputed domain name.

The only difference between the trademark and the domain name is the addition of the Top-Level Domain ("TLD") ".parts". The remaining letters of the disputed domain name are completely identical to the trademark. A significant part of the relevant public will therefore perceive a connection between the disputed domain name and the Complainant's registered trademarks.

From the Complainants knowledge, the Respondent has not acquired any trademark or service mark rights in the disputed domain name. The Respondent's use of the disputed domain name indicates that there are no rights or legitimate interests in respect of the disputed domain name. The website contains sponsored links that lead visitors to the Complainant's competitors or related companies.

According to the Complainant, the lack of legitimate interest also concerns the fact that the Respondent is using the disputed domain name in bad faith. The Respondent is using the Complainant's trademarks and related reputation in relation to links to competitors, which is directly harmful to the Complainant. The

Complainant contends that the Respondent is intentionally attempting to divert Internet users to one or more competing websites in an effort to confuse and mislead customers.

The Complainant sent a request through the Registrar regarding the contact details for the holder of the disputed domain name. On February 25, 2022, the Respondent emailed the Respondent's contact details to the representatives of the Complainant. A cease and desist letter was sent to the Respondent on March 1, 2022. The Respondent responded with an email stating the Respondent's phone number, however, the Parties have not been able to reach a settlement and the Respondent has not transferred the disputed domain name to the Complainant, only removing the sponsored links. The fact that the links have been removed does not change the assessment of bad faith. Non-use of a domain name, including a blank page, would not prevent a finding of bad faith under the doctrine of passive holding.

The Complainant requests that the Panel issue a decision that the disputed domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, a complainant must prove each of the following:

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

### **A. Identical or Confusingly Similar**

The Complainant is the owner of the trademark ENGCON.

The relevant part of the disputed domain name is "engcon", as it has been well established in previous UDRP cases that the added TLD – being a required element of every domain name – may be disregarded when assessing whether or not a trademark is identical or confusingly similar.

As the disputed domain name consists of the Complainant's trademark ENGCON, the Panel finds that the disputed domain name is identical to the Complainant's registered trademark ENGCON and that the first element of the Policy has been met.

### **B. Rights or Legitimate Interests**

Once a complainant establishes a *prima facie* case of the second element of the Policy, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating that it does have rights or legitimate interests pursuant to paragraph 4(a)(ii) of the Policy. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 2.1.

By not submitting a response, the Respondent failed to invoke any circumstance which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name or to rebut the Complainant's *prima facie* case that it lacks rights or legitimate interests.

The Respondent has no rights to use the Complainant's trademark and is not an authorized agent or licensee of the Complainant's products, services or trademarks. There is nothing in the Respondent's name that indicates it may have become commonly known by the disputed domain name, enabling it to establish a legitimate interest in the disputed domain name, nor any evidence in the present record to indicate that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name.

On the contrary – the Panel finds that the Respondent's (prior) use of the disputed domain name for a website with sponsored links to competitors of the Complainant is an obvious attempt to mislead customers seeking the Complainant's services and website and to earn click-through revenue. Such use does not establish rights or legitimate interests. See *Fluor Corporation v. Above.com Domain Privacy / Huanglitech, Domain Admin*, WIPO Case No. [D2010-0583](#) (noting that it is "well established" that the use of a domain name to trade off Complainant's trademark is not *bona fide* and "cannot confer any rights or legitimate interests" upon a respondent); see also *CIMB Group Sdn. Bhd., CIMB-Principal Asset Management Berhad v. PrivacyProtect.org / Cyber Domain Services Pvt.Ltd.*, WIPO Case No. [D2010-1680](#) (registration of a domain name "for the purpose of misleading or diverting consumers" cannot give to rise rights or legitimate interests).

The current non-active use does not change that conclusion, as it still does not indicate that the Respondent has any rights or legitimate interests in the disputed domain name.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

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

As shown by the Complainant, a Swedish company, the trademark ENGCN is registered in a number of countries and regions around the world, including the EU. The Respondent is based in Sweden, one of the member states of the EU.

The Panel agrees with the Complainant that the trademark ENGCN is distinctive, with no obvious second descriptive meaning.

Thus, it is clear to this Panel that the Respondent had the Complainant's trademark in mind when the Respondent registered the disputed domain name.

However, in order to fulfill this third requirement, the disputed domain name must both be considered as registered and used in bad faith.

As shown by the Complainant, the disputed domain name was, up to recently, used for a website with sponsored links to competitors of the Complainant. Use of a domain name to display hyperlinks to various third-party websites, including some in direct competition with a complainant, constitutes disruption under paragraph 4(b)(iii) of the Policy and is thus evidence of bad faith registration and use. See *EBAY, Inc. v. MEOdesigns and Matt Oettinger*, WIPO Case No. [D2000-1368](#) (finding that the respondent registered and used the domain name <eebay.com> in bad faith where the respondent has used the domain name to promote competing auction sites).

As also shown by the Complainant, the disputed domain name currently resolves to a blank web page, or rather, not linked to any active web page. The question remains: Can passive holding of a disputed domain name be seen as bad faith use?

As shown by prior UDRP panel decisions, the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith. Each panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. See *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#) ("There is no active use of the domain names in the sense that they resolve to an active web site. Nevertheless the circumstances of the registration of the domain names and

Respondent's US trade mark application are indicative of his intention to hold the trade mark and the domain names for some future active use in a way which would be competitive with or otherwise detrimental to Complainant.") See also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

In this case, the Panel takes into account the following circumstances:

- the Complainant's trademark ENGCN is considered by the Panel as highly distinctive;
- the Complainant's trademark was registered in EU (covering Sweden, the home country of the Respondent), close to 17 years before the registration of the disputed domain name;
- the disputed domain name is identical to the Complainant's trademark;
- The Respondent used the disputed domain name for advertising goods connected to, and similar with, Complainant's goods up until the receipt of the Complainant's cease and desist letter;
- the communication between the attorneys of the Complainant and the Respondent indicates that the Respondent was not willing to transfer the disputed domain name without economic compensation; and
- the Respondent has not responded to the Complaint and has therefore not provided evidence of any actual or contemplated good faith use of the disputed domain name.

Thus, the Panel concludes that the disputed domain name was registered and is being used in bad faith, and that the Complainant has succeeded in proving the three elements within paragraph 4(a) 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 name <engcon.parts> be transferred to the Complainant.

/Petter Rindforth/

**Petter Rindforth**

Sole Panelist

Date: May 17, 2022